

AESTHETIC FUNCTIONALITY IN TRADE DRESS: POST-SECONDARY AESTHETIC FUNCTIONALITY PROPOSED

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The original intent of trademark law¹ was to protect an owner's interest in marks² which the owner affixes to products or advertising for the purpose of indicating the source of those goods as the owner's own. Recently, trademark law began expanding its protection under the heading of trade dress.³ This expansion has created significant controversy.⁴ One major criticism of the expansion is that trade dress law is protecting dress that possesses aesthetic functionality,⁵ where aesthetic functionality should be strictly enforced as a bar to protection.⁶ This Article examines the protection of trade dress controversy, and proposes a bar to protection of trade dress that possesses aesthetically functional

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1. See 15 U.S.C. § 1127 (1998) (defining trademark as any word name symbol or device that is used or intended to be used in commerce and is capable to distinguish the goods from the goods of others).

2. A mark is defined by the Lanham Act as any word, term, name, symbol, or device, or combination thereof that does or is capable of indicating to the consumers the source or origin of the goods or services.

3. See *Two Pesos v. Taco Cabana*, 505 U.S. 763 (1992); *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995).

4. The exact nature of the criticism varies by author.

5. See *Qualitex*, 514 U.S. at 170 (quoting the definition of aesthetic functionality in the RESTATEMENT THIRD OF UNFAIR COMPETITION § 17 as "aesthetic value lies in its ability to confer a significant benefit that can not be practically duplicated by the use of alternative designs").

6. See Mitchell M. Wong, *The Aesthetic Functionality Doctrine and the Law of Trade Dress Protection*, 83 CORNELL L. REV. 1116 (1998); Willajeanne F. McLean, *Opening Another Can of Worms: Protecting Product Configuration as Trade Dress*, 66 U. CIN. L. REV. 119 (1997).

aspects unless the aesthetic functionality owes its origin entirely to secondary meaning.⁷

This Article begins with a brief summary of trademark law. The summary covers the purposes, scope, and expansion of trademark law in the area of trade dress. The second section of the Article will illustrate trade dress protection as it has been applied in three significant cases in the field.⁸ The third section of the Article will introduce the identification theory⁹ along with the potential impact of its application. The final section of the Article will propose a post-secondary aesthetic functionality theory, as well as compare and contrast it with both the court's approach and the identification theory.

I. BASIC TRADEMARK LAW

It is necessary to start with a review of basic trademark law before diving into the heart of the issue. The relevant language to this exploration arises out of section 43(a) of the Lanham Act¹⁰ which provides in part:

(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.

7. See *Abercrombie & Fitch, Co. v. Hunting World, Inc.*, 537 F.2d 4 (Cal. App. 2d 1976) (secondary meaning is a pairing of the mark with the source of the good or service to such an extent that the public has come to identify the mark with the source).

8. See *Two Pesos*, 505 U.S. 763 (1992); *Qualitex*, 514 U.S. 159 (1995); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 2000 U.S. Lexis 2197 (2000).

9. *Id.*

10. 15 U.S.C. § 1125 (1998) (a/k/a § 43(a) of the Lanham Act).

A trademark may consist of any word, term, name, symbol, or device, or any combination thereof, that does, or is capable of, indicating to the consumers the source or origin of the good or service.¹¹ For example, when an individual sees the "Golden Arches" the consumer knows that the food comes from McDonald's. The "Golden Arches" is a symbol that have no purpose but to signify the source¹² of the goods.¹³

A. PURPOSES FOR TRADEMARK PROTECTION

Source indication is the premise of all trademark law.¹⁴ Granting a limited monopoly¹⁵ on a particular mark serves two purposes: it minimizes consumer confusion,¹⁶ and preserves the goodwill companies have established.¹⁷

1. Lessening Consumer Confusion

Purchasing a product for the first time may be trial and error. For example, if you are in the market for chicken noodle soup for the first time you may have to buy a few different brands before you find the one that you like the best. Because the company (Campbell's for example) that made the soup you like placed a label on the can indicating the manufacturer, you will be able to return to the store and purchase the same brand of soup with minimal difficulty. If protection were not granted to a company's mark, competing companies would be able to make a low quality soup, place the Campbell's mark, or one confusingly similar to it, on the can, and leave the consuming public none the wiser until long after the purchase was made. By granting a monopoly on a mark, consumers are guaranteed that the products they purchase are made by the company they want to patronize, and are able to avoid purchasing products from companies with which they have had a bad experience.

11. *Id.* § 1125 (§ 43(a) of the Lanham Act).

12. "Source" refers to the entity to which the product or service owes its origin.

13. "Goods," as used, will refer to products as well as services.

14. 15 U.S.C. § 1125 (1998) (§ 43(a) of the Lanham Act).

15. *Wal-mart Stores v. Samara Bros.* No. 99-150, Nov. 18, 1999, Amicus Brief Supporting Petitioner.

16. *Park 'N Fly v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) (discussing the interest in lessening consumer confusion).

17. *Id.*

2. *Protecting a Company's Good Will*

The second principle purpose of trademarks is to protect the goodwill of the companies.¹⁸ If a company manufactured a low quality soup and put Campbell's mark on it, Campbell's would suffer damage to its reputation and lose customers through no fault of its own. In short, the protection of good will encourages companies to produce quality products.¹⁹ If each producer affixes its reputation to the can, it will be less likely to make a poor soup. Consumers are expected to be rational in that they will not pay the same price for a product of lesser quality. If a company wants to compete in the market with Campbell's soup, it will either have to make a soup of equal quality or reduce its prices.

B. WHAT CAN BE A TRADEMARK?

As previously noted, any word, term, symbol, or device, or combination thereof, may gain protection as a trademark. Generally, all that is required is that the mark indicate the source or origin of the good or service. The court in *Abercrombie & Fitch*²⁰ set out a test that is widely followed in determining what types of marks may be protected, and under what showing.²¹ There are also certain bars to protection²² that can apply to a mark. However, both the *Abercrombie & Fitch* test and the bars to protection remain unsettled²³ in the expansion of trademark law called trade dress.

1. *The Abercrombie & Fitch Test*

*Abercrombie*²⁴ distinguished five categories into which a potential mark could fall, and set forth the accompanying requirements for gaining protection. The five categories are: generic, descriptive, suggestive,

18. See *supra* note 13.

19. *Kenner Parker Toys, Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 354 (Fed. Cir. 1992).

20. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

21. *Id.* (defining generic, descriptive, suggestive, arbitrary and fanciful marks and their corresponding requirements for a showing of secondary meaning).

22. See § 2(a)-(d) of the Lanham Act (bars to registration) (15 U.S.C. § 1052).

23. *Wal-Mart Stores, Inc.*, 165 F.3d 120 (2d Cir. 1998).

24. *Abercrombie & Fitch*, 537 F.2d 4 (2d Cir. 1976).

arbitrary, and fanciful.²⁵ The first category, generic, is never protectible. A generic term is one that has become known as the name of the product itself, not as a source indicator for the product. Generic names are also characterized as ones that are necessary for competition²⁶ in a particular market. A good example of a mark that once was valid and has lost its protection because it became generic is the escalator.²⁷ Escalator was once a brand name for a moving staircase. In time, the general public began to refer to any moving staircase as an escalator. Once the general public comes to know a mark not as a brand name of a particular item, but as the name of that item itself, it has become generic. It has become necessary for other moving staircase manufacturers to use the name escalator in order to compete in the business.

The second category is the descriptive mark. A descriptive mark is one that describes the product.²⁸ For example, in *Park 'n Fly v. Dollar Park & Fly*,²⁹ the name "Park 'n Fly" was found to be descriptive of the service it provides.³⁰ Park 'n Fly was a parking ramp at several airports. The description of the product or service is in the name. Descriptive marks are not completely barred from trademark protection.³¹ These marks are not considered inherently distinctive³² of the source or origin. In order to qualify for protection, they must be able to show secondary meaning.³³ Secondary meaning refers to pairing of a mark with the source to such an extent that the public has come to identify the mark with the source.³⁴

The next category is the suggestive mark. As the name implies, this type of mark merely suggests to the consumer the nature of the product.³⁵ Tide, for example, may be suggestive of laundry detergent. Suggestive marks are automatically presumed worthy of trademark protection if they are found not to be too descriptive.³⁶ This presumption is referred to as inherent distinctiveness.

25. *Id.*

26. *Id.*

27. *Haughton Elevator Co. v. Seeberger*, 85 U.S. PAT. QTLY. 80 (Comm'r Patents 1950).

28. *Abercrombie & Fitch*, 537 F.2d 4 (2d Cir. 1976).

29. *Park 'n Fly, Inc.*, 469 U.S. 189 (1985).

30. *Id.*

31. *Abercrombie & Fitch*, 537 F.2d 4 (2d Cir. 1976).

32. *Id.*

33. *Id.*

34. *Circuit City Stores v. Carmax, Inc.* 165 F.3d 1047 (6th Cir. 1999).

35. *Abercrombie & Fitch*, 537 F.2d 4 (2d Cir. 1976).

36. *Id.*

The final two categories are also presumed to be worthy of protection because they are inherently distinctive.³⁷ Arbitrary refers to a mark that has no logical connection to the product itself.³⁸ For example, Camel has no logical relation to a cigarette. When used in such a manner, the creator of such a mark is automatically granted trademark protection. Similarly, a fanciful mark is one that is completely made up. It, too, is presumed worthy of protection due to its inherent ability to identify the source.³⁹

2. *Functionality as a Bar to Protection*

Among the bars to protection⁴⁰ and the ability to register a mark⁴¹ are genericism, abandonment, and functionality. Of these, it is functionality⁴² which requires exploration before this Article can dissect the issue of trade dress protection. Functionality analysis asks whether the word, term, symbol, or device is "essential to the use or purpose of the article or if it affects the cost or quality of the article."⁴³ Under the functionality doctrine, no mark may be protected that is found to be functional.⁴⁴ It is considered the domain of patents, rather than trademarks, to grant protection to useful features of a product.⁴⁵ Accordingly, it is in the application of functionality analysis that the controversy surrounding trade dress protection lies.⁴⁶

C. TRADE DRESS PROTECTION

Trade dress refers to the design or appearance of a good or service as it is in the marketplace.⁴⁷ For example, the decor of a restaurant,⁴⁸ the

37. *Id.*

38. *Id.*

39. *Id.*

40. 15 U.S.C. § 1064(3) (genericism, abandonment, and functionality).

41. See § 2(a)-(d) of the Lanham Act (15 U.S.C. § 1052).

42. *Id.*

43. *Windmill Corp. v. Kelly Foods Corp.*, 1996 Lexis 3473 (6th Cir. 1996).

44. 15 U.S.C. § 1064(3).

45. *Bonito Boats, Inc. v. Thundercraft Boats, Inc.*, 489 U.S. 141 (1989).

46. *Id.*

47. *Falcon Rice Mill, Inc. v. Community Rice Mill, Inc.*, 725 F.2d 336, 337 (5th Cir. 1984).

48. *Two Pesos*, 505 U.S. 763 (1992).

decorative pattern on a product,⁴⁹ or even mere color⁵⁰ of a product have all received trade dress protection. Often the concern over the concept of trade dress protection is that the dress is functional, either in the strict sense or aesthetically.

III. TRADE DRESS APPLIED AND AESTHETIC FUNCTIONALITY

Aesthetic functionality⁵¹ adds a new concern to the strict sense of functionality. Whereas functionality looks to whether the dress adds to the use, performance, value, or quality of the product,⁵² aesthetic functionality looks at whether the dress makes it more appealing to the public by aesthetic means.⁵³ If the dress of the product is necessary to compete in the particular market, then trademark protection is not afforded.⁵⁴ A mark should never add marketability to a product for reasons other than its ability to indicate its origin.⁵⁵ Three cases have demonstrated that aesthetic functionality is prevalent in fact scenarios where trade dress protection is sought.

A. TACO CABANA

In *Two Pesos v. Taco Cabana*,⁵⁶ the United States Supreme Court found protection for the motif of a Mexican style restaurant. Taco Cabana started a small chain of Mexican restaurants in Texas. Taco Cabana characterized the motif as

a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals. The patio includes interior and exterior areas with the interior patio capable of being sealed off from the outside patio by overhead garage doors. The stepped exterior of the building is a festive and

49. *Carillon Importers Ltd. v. Frank Pesce Group, Inc.*, 913 F. Supp. 1559 (S.D. Fla. 1996).

50. *Qualitex*, 514 U.S. 159 (1995).

51. *Publications Int'l, Ltd. v. Landoll, Inc.*, 164 F.3d 337, 339 (7th Cir. 1998).

52. *Windmill Corp.*, 1996 Lexis 3473 (6th Cir. 1996).

53. *Publications Int'l*, 164 F.3d 337, 339 (7th Cir. 1998).

54. *Kompan A.S. v. Park Structures, Inc.*, 890 F. Supp. 1167, 1180 (N.D.N.Y. 1995).

55. *Pagliero v. Wallace China Co.*, 198 F.2d 339, 343 (9th Cir. 1952) ("If the feature is an important ingredient in the commercial success of the product, the interest in free competition permits its imitation in the absence of a patent or a copyright.")

56. *Two Pesos*, 505 U.S. 763 (1992).

vivid color scheme using top border paint and neon stripes. bright awnings and umbrellas continue the theme.⁵⁷

Two Pesos, another chain of Mexican restaurants, created a motif similar to that of Taco Cabana. Taco Cabana brought suit to stop Two Pesos from infringing its trade dress.

The jury found Taco Cabana's motif was inherently distinctive, nonfunctional, and that the restaurant chain had not yet established any secondary meaning. Despite the finding of no secondary meaning, the Supreme Court granted Taco Cabana trade dress protection. The Court treated the trade dress issue the same as a trademark issue.⁵⁸ It applied the *Abercrombie & Fitch* analysis and determined that the motif of the restaurant was inherently distinctive because it was either suggestive, arbitrary or fanciful.⁵⁹ As such, it was presumed to be distinctive of the company's goods, and therefore protectible.⁶⁰

There are many reasons to question the holding in the *Taco Cabana* decision.⁶¹ First, the motif of the restaurant was not suggestive, arbitrary or fanciful, but rather descriptive of its goods.⁶² When entering a Mexican restaurant, the motif describes the product or service the consumer is about to purchase. By simply walking in, a consumer would know that this is a restaurant and that it serves primarily Mexican food. If the motif is found to be descriptive of the product or service, then proof of secondary meaning must be shown in order to receive protection.⁶³ Because Taco Cabana had not developed secondary in its motif at the time of trial,⁶⁴ it should not have received protection.

Further, a showing of secondary meaning should always be required before trade dress protection is granted.⁶⁵ Because trade dress is protection to a feature of the product itself, it should not be held to the

57. *Id.*

58. *Id.*

59. *Id.*

60. *Id.*

61. See Wong, *supra* note 6; McLean, *supra*, note 6.

62. Willajeanne F. McLean, *The Birth, Death, and Renaissance of the Doctrine of Secondary Meaning in the Making*, 42 AM. U. L. REV. 737, 748 (1993) (discussing an argument advanced by Two Pesos in front of the Fifth Circuit).

63. *Abercrombie & Fitch*, 537 F.2d 4 (2d Cir. 1976).

64. *Two Pesos*, 505 U.S. 763 (1992).

65. Ronald J. Horta, *Without Secondary Meaning, Do Product Design Trade Dress Protection Function as Infinite Patents?*, 27 SUFFOLK U. L. REV. 113 (1993).

same standard as the traditional marks listed in the text of the Lanham Act.⁶⁶

Other critics contend that because trade dress seeks to protect a feature of the product, protection should be the province of patents or copyrights.⁶⁷ Courts have traditionally recognized the need to keep these areas of intellectual property law separate;⁶⁸ *Two Pesos* blurs the distinction.⁶⁹ The law of patents protects novel products or aesthetically pleasing features of products (design patent)⁷⁰ whereas the law of copyrights protects original works of authorship.⁷¹ Various legal authors fear that *Two Pesos* either creates an overlap into patent or copyright law, or that it stretches trademark law to create a "catch-all" category to protect features of product that may slip through the cracks of intellectual property law.⁷²

The most compelling argument against the reasoning of *Two Pesos* is that the motif of the Taco Cabana restaurant chain is aesthetically functional.⁷³ By developing a motif intended to attract attention, symbolize the type of food served therein, and create a festive dining atmosphere, Taco Cabana attempted to increase its patronage. Thus, the motif serves a purpose other than to indicate the producer of the good or service. The motif does not add to the quality of the food, nor is it necessary to serving Mexican food, yet it still serves a function.

B. QUALITEX

The United States Supreme Court case of *Qualitex Co. v. Jacobson Products Co.*,⁷⁴ has received similar criticism. Qualitex was the manufacturer of pads for dry cleaning presses. The company had always made its pads in a particular shade of green. Over time, the relevant consuming public had become aware of the connection between the

66. See McLean, *supra* note 62, at 740.

67. See Tom W. Bell, *Virtual Trade Dress: A Very Real Problem*, 56 MD. L. REV. 384 (1997).

68. *Bonito Boats, Inc.*, 489 U.S. 141 (1988).

69. See Bell, *supra* note 67, at 402.

70. *Bonito Boats, Inc.*, 489 U.S. 141, 146-51 (1988).

71. 17 U.S.C. § 102(a).

72. See Bell, *supra* note 67; Melissa R. Gleiberman, *From Fast Cars to Fast food: Overboard Protection of Product Trade Dress Under Section 43(a) of the Lanham Act*, 45 STAN. L. REV. 2037 (1993); Wong, *supra* note 6.

73. See McLean, *supra* note 62, at 774.

74. *Qualitex*, 514 U.S. 159 (1995).

particular color of the pads and the source from which they came. In other words, the color of the pads developed secondary meaning.

Enter Jacobson Products, an unrelated company, which decided to make its press pads in the same color used by Qualitex. Qualitex brought suit seeking protection of the color of its pads through trade dress. Considering a line of other decisions, which granted protection to such things as sounds, scents, and shape, the Court found no logical reason why color, alone, could not receive protection.⁷⁵ It reasoned that "since human beings might use as a symbol or device almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive."⁷⁶ Thus, the Court acknowledged that color is capable of indicating source.⁷⁷ However, because consumers would not normally expect color to be a symbol of the manufacturer, i.e., not be inherently distinctive,⁷⁸ the Court required a showing of secondary meaning before color could be afforded protection under trademark law.⁷⁹ Qualitex was able to show that the color of its product had acquired secondary meaning, and therefor the Court granted it protection.

Qualitex was not the first decision to grant trade dress protection to mere color of a product.⁸⁰ Owens Corning Company received rights in the color pink for insulation because a federal district court found that the pink color was capable of indicating source.⁸¹ The *Owens Corning* court reasoned that so long as a company's monopoly in a color does not restrict the ability of others to compete in a particular market, and so long as the color is not functional or aesthetically functional, then there is no reason to bar the protection of mere color.⁸²

In reaching its decision in *Qualitex*, the Court rejected several arguments advanced by Jacobson Products. Among these was Jacobson Products' argument that color, alone, is an aesthetically functional aspect of a product.⁸³ Color makes a product more or less desirable depending on taste of the consumers. The Court rejected this argument by granting protection of color only to products where the color has no relation to

75. *Id.*

76. *Id.*

77. *Id.*

78. *Qualitex*, 514 U.S. 159 (1995).

79. *Id.*

80. *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) (holding that the color pink for insulation could receive trademark protection).

81. *Id.*

82. *Id.*

83. *Qualitex*, 514 U.S. 159, 169 (argument set forth by the respondent).

the marketability of the product, other than sparking in the mind of consumers the goodwill of the company that produced the product.⁸⁴ For example, the color pink is totally irrelevant to the marketability of insulation.⁸⁵ It is not functional. It does not enhance the performance of the product. It is not cheapest, or easiest, way to produce the product. And it is not the product's natural color. Neither is pink insulation aesthetically functional. Insulation, once installed, is not seen by the consumer. Consumers purchase pink insulation not because they like the color pink, but because they know that pink insulation is manufactured by a company that has proven itself in the market as a manufacturer of quality insulation.⁸⁶ The Court in *Qualitex* found the same to be true of the press pads.⁸⁷

The Court also rejected Jacobson Products' argument that protecting mere color would hinder competition in the relevant market.⁸⁸ Jacobson Products argued that because there are only a limited number of colors, the grant of monopolies on colors would eventually dry up the alternative colors to make a product.⁸⁹ The Court considered and rejected this argument reasoning that protection would not be granted in markets where the color depletion theory could become reality.⁹⁰

Jacobson Products also argued that protection of mere color is bad for entrance into the market because a manufacturer will be unable to determine how close its color may come to those in existence.⁹¹ The Court dismissed this argument, concluding that it was a problem businesses already deal with in trademark law⁹² and that courts are constantly required to draw fine lines between marks that are substantially similar.⁹³ Although the Supreme Court appears to recognize that a complete bar on the protection of mere color would be substantially easier for lower courts and manufacturers to interpret, the Court seems

84. *Id.* at 169

85. *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116 (Fed. Cir. 1985).

86. *Id.*

87. *Qualitex*, 514 U.S. 159 (1995).

88. *Id.* at 168 (argument of respondent).

89. *Id.*

90. *Qualitex*, 514 U.S. 159.

91. *Id.* at 167 (argument of the respondent).

92. *Id.*

93. *Id.*

to believe it would be unjust to treat mere color differently for that reason alone.⁹⁴

C. WAL-MART STORES

In the more recent case, *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*,⁹⁵ the Supreme Court, arguably, took a step in the right direction. In *Wal-Mart Stores, Inc.*, the Court finally delineated the scope of protection for product features.⁹⁶ In that case Wal-Mart allegedly copied the design of clothing made by Samara Brothers.⁹⁷ Wal-Mart sold these clothes at its stores and made a substantial profit. The Supreme Court did not deal with the copyright and patent issues that were present in this case. Rather, the Court wrestled with whether to afford trade dress protection to the mere design of a product where no showing of secondary meaning was made.

Samara Brothers was unable to show that consumers had already drawn a connection between the style of its clothes and itself. Samara Brothers urged the Court to apply the same standard established in *Two Pesos*. Essentially, Samara Brothers argued that the product feature at issue was capable of being inherently distinctive in much the same way that the motif of the Taco Cabana restaurant was distinctive.⁹⁸ Although it is not mentioned in the decision, it is safe to assume that Samara Brothers considered the style of its clothes to be suggestive, arbitrary, or fanciful and, therefore, inherently distinctive under an *Abercrombie & Fitch* analysis.

The Supreme Court took the first and critical step towards limiting the rapidly expanding coverage of trade dress.⁹⁹ The Court reasoned that the *Wal-Mart* facts are better compared to those in *Qualitex* than to those of *Two Pesos*.¹⁰⁰ As in *Qualitex*, the Court found that the dress sought to be protected was incapable of being inherently distinctive.¹⁰¹ Just as color is not generally thought of by the consuming public of

94. *Id.*

95. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 2000 Lexis 2197 (2000).

96. *Id.*

97. *Id.*

98. *Two Pesos*, 505 U.S. 763 (1992).

99. *Wal-Mart Stores, Inc.*, 2000 Lexis 2197.

100. *Id.*

101. *Id.*

being a source indicator, so too are features of a product.¹⁰² The Court held that in a case such as this, where a feature of the product itself is concerned, as opposed to its packaging, a showing of secondary meaning is required before protection will be granted.¹⁰³ By not overruling the decision in *Two Pesos*, the Court suggests that the motif of the restaurant is more akin to the packaging of a product than it is a feature of the product itself.¹⁰⁴

This appears to be a step in the right direction as the *Wal-Mart* decision created boundaries¹⁰⁵ to the ever increasing problems of granting trade dress protection. Although the effort is to be applauded, it is far from being the correct solution to the problem. Although the *Wal-Mart* decision is too recent to have inspired published criticisms, the Court did take steps to counterargue some of its own propositions. Namely, the Court recognized that it will be difficult for lower courts to determine whether they are dealing with a product feature, or some ornamental packaging. For example, is the shape of the bottle a package design, or is it a feature of the product itself?¹⁰⁶

D. SUMMARY OF THE REASONING OF THE COURTS

The Lanham Act did not create trade dress, the courts did. And what the courts have established on a case by case basis is hard to justify. It appears the decisions were written without an appreciation of their prospective adverse impact.

The law of trade dress can be summarized using the three cases discussed. Where the packaging of a product is at issue, the *Abercrombie & Fitch* analysis will be applied in the same way it is applied to marks.¹⁰⁷ If the packaging of a product is not generic or descriptive of the product, then it will be entitled to protection without a showing of secondary meaning.¹⁰⁸ However, if a feature of the product is at issue, such as the color or design of the product, a showing of secondary

102. *Id.*

103. *Id.*

104. *Id.*

105. *Id.*

106. *Id.*

107. The combined effect of *Two Pesos*, 505 U.S. 763 (1992), and *Wal-Mart Stores, Inc.*, 2000 Lexis 2197 (2000).

108. The combined effect of *Two Pesos*, 505 U.S. 763 (1992), and *Abercrombie & Fitch*, 537 F.2d 4 (2d Cir. 1976).

meaning is always required.¹⁰⁹ This is so because the courts apparently felt that the packaging of a product is generally thought of by the consuming public as a source indicator, whereas a feature of a product is not.¹¹⁰

The rationales of the courts appear to follow the competition theory that author Mitchell Wong characterized as the majority approach.¹¹¹ According to this majority approach, the court inquires whether the protection of certain trade dress candidates would have anti-competitive effects in the particular market.¹¹² If the grant of protection would hinder competition then no protection should be granted.¹¹³ This is a relatively lax standard to apply,¹¹⁴ certainly more so than the identification theory.

Under the courts' approach, a product's dress is still required to indicate source, however, the courts have allowed dress to do more.¹¹⁵ So long as the dress was predominantly used to indicate source, it is permitted to possess a certain level of aesthetic functionality.¹¹⁶ *Taco Cabana* is a good example.¹¹⁷ The motif was found to be inherently distinctive, and therefore it indicates source. Thus, even though the motif was designed to attract and appeal to customers, the principle purpose of the motif was to let consumers know they are in a Taco Cabana. The Court found that allowing Taco Cabana to retain rights in the motif does not hinder other restaurants from designing their own motif or becoming equally successful.

The recent decision in *Wal-Mart* does not change this principle.¹¹⁸ The courts find this to be the better test because all the goals of trademark law are fulfilled.¹¹⁹ Competition is not restricted, consumer confusion is minimized, and the goodwill of the company that designed the dress is protected.¹²⁰

109. *Wal-Mart Stores*, 2000 Lexis 2197.

110. *Id.*

111. See Wong, *supra* note 6.

112. *W.T. Rogers Co. v. Wendell R. Keene & Keene Mfg.*, 778 F.2d 334 (7th Cir. 1985).

113. *Id.*

114. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17, cmt. c.

115. *Kellogg v. Nabisco*, 305 U.S. 111, 118 (1938) (stating that the "primary significance ... in the minds of the consuming public is not the product but the producer").

116. See Wong, *supra* note 6, at 1144.

117. *Two Pesos*, 505 U.S. 763 (1992).

118. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 2000 Lexis 2197 (2000).

119. *Id.*

120. *Qualitex*, 514 U.S. 159 (1995).

IV. THE IDENTIFICATION THEORY

Another popular theory is the identification theory.¹²¹ The identification theory has been the choice for many critics¹²² who disagree with the decisions of cases like *Taco Cabana*¹²³ and *Qualitex*.¹²⁴

The identification theory suggests that protection should only be given to dress that has absolutely no other function than to indicate the source or origin of the good or service.¹²⁵ Under this test, Taco Cabana would be without protection for its motif due to the aesthetic purposes the motif serves. Compared to the majority approach, the identification theory utilizes a very strict standard for protection and would certainly limit the scope of trade dress rights afforded.¹²⁶

There are two persuasive arguments in favor of this theory. First, it is a very workable test, and can be applied with greater ease.¹²⁷ Accordingly, manufacturers would know precisely what can and cannot be copied and can and cannot be protected.¹²⁸ This is beneficial to the manufacturer who, for example, wishes to open a Mexican restaurant in Texas and needs to know whether or not it is infringing Taco Cabana's rights before investing time, money, and effort in designing a new restaurant.

Second, the identification theory draws a more distinct line between the branches of intellectual property law.¹²⁹ Although, most may feel that Taco Cabana should be able to gain rights to the design it invested time and effort to create, the identification theory merely suggests that, due to its functional aspects, that design should be protected by patents or possibly copyrights (to the extent it is not functional).¹³⁰ Subscribers to this theory feel that trademark law has been stretched far enough and needs to start making more boundaries, and this theory satisfies that need. The simple rule is that if the dress aids the commercial success of the product then it is aesthetically

121. See Wong, *supra* note 6, at 1144.

122. *Id.*

123. *Two Pesos*, 505 U.S. 763 (1992).

124. *Qualitex*, 514 U.S. 159 (1995).

125. See Wong, *supra* note 6.

126. *Id.*

127. *Id.*

128. *Id.*

129. *Id.*

130. *Id.*

functional and therefor should go without protection under trademark law.¹³¹

V. POST-SECONDARY AESTHETIC FUNCTIONALITY PROPOSED

This Article proposes a new solution to the aesthetic functionality doctrine as it applies to trade dress. Both the courts' approach and the identification theory leave something to be desired; each has its strengths and its weaknesses. This author's proposal might best be described as a mutation of the identification theory although it encompasses a small portion of the leniency of the courts' approach.

This new proposition might best be referred to as the Post-Secondary Aesthetic Functionality Theory. As the name implies, it is a hybrid of the principles of secondary meaning and aesthetic functionality. In its most abstract, but perhaps most confusing, form, the Post-Secondary Aesthetic Functionality Theory suggests that dress which contains any aesthetic functionality should be barred from protection. However, once the dress has been proven to carry secondary meaning without aesthetic functionality, it may obtain protection even though the secondary meaning later develops into aesthetic functionality.

Take the *Owens Corning*¹³² case for example. When Owens Corning first started making insulation pink there was no secondary meaning and no aesthetic functionality to the color. Over time, the company grew into a reputable manufacturer of insulation, and the color pink became known for the quality of the product as well as reputation of the company. Pink served no other purpose at that time other than to indicate source. Under the facts up to this point, Owens Corning should be able to obtain protection on the color because there is no aesthetic functionality and secondary meaning has been established.¹³³ So far this is in complete accordance with the identification theory. The two theories separate when the color pink begins to create its own aesthetic functionality.

Let's assume that the color pink becomes so popular for insulation that it becomes a driving factor in the decision making of consumers in the particular market. Here we are left with the situation of whether or

131. *Id.*

132. *Owens-Corning*, 774 F.2d 1116 (Fed. Cir.1985).

133. This conclusion drawn in the event that either theory advanced were applied.

not to protect color under the identification theory because the color no longer is devoid of any aesthetic functionality. The identification theory would say no.¹³⁴ The post-secondary aesthetic functionality theory, on the other hand, would argue that Owens Corning should retain trade dress protection in their color because the aesthetic functionality that exists now was created solely by secondary meaning. Thus, even though the meaning of the color pink may no longer be strictly "secondary" (because the color is creating a strong market for product), but is a combination of secondary meaning and the appeal of the color, protection will still be afforded as long as the appeal of the color owes its origin solely to secondary meaning. It may come to the point where green insulation is less desirable, not because consumers dislike the color green, dislikes the company that makes green insulation or prefers the company that makes pink insulation, but because pink has become "the" color to have as insulation. The color pink may become so commonplace in the insulation business that consumers have a bias toward that color. Who wants green insulation when everyone has pink?

The *Taco Cabana*¹³⁵ decision would come out the other way under this theory. The motif of the restaurant contains aesthetic functionality prior to establishing secondary meaning.¹³⁶ Unless the motif can be shown to be entirely neutral and lacking of any attention drawing capacity, the aesthetic functionality exists. Samara Brothers would also fail to obtain protection because the design of clothes certainly possesses aesthetically functional aspects. Post-secondary aesthetic functionality can only come to existence when secondary meaning is created prior to the creation of aesthetic functionality. *Taco Cabana* would have no rights in trade dress law under this theory.

A. CONTRASTED WITH THE TWO LEADING THEORIES

The post-secondary aesthetic functionality theory addresses the concerns raised by both the identification theory and the court's approach, but which neither is able to resolve successfully.¹³⁷ All

134. See Wong, *supra* note 6 (a feature that serves any purpose beyond source identification would not receive protection).

135. *Two Pesos*, 505 U.S. 763 (1992).

136. *Id.*

137. Suggested advantages of the competition and identification theory discussed *supra* as well as in Wong, *supra* note 6.

purposes of trademark law remain intact,¹³⁸ and trade dress law would finally meet its boundaries.¹³⁹

1. Post-Secondary Aesthetic Functionality v. Identification

The identification theory posits that it is the most workable definition of the boundaries of trade dress law.¹⁴⁰ Post-secondary aesthetic functionality is right on par with this claim. This new theory creates a workable rule for manufacturers and the courts alike. Simply put, a manufacturer should not expect to obtain trademark rights in any dress that enhances its edge in the market other than to signify its source. The concern over making rules that work easily for the public and the courts alike seems to be forgotten in trademark law. Predictability of results permits a manufacturer to know what he can or can not do, debates over minutia will decrease, and the precious court docket will be filtered.

Another claim to righteousness of the identification theory is that it aids in the separation between the branches of intellectual property law.¹⁴¹ Post-secondary aesthetic functionality would serve the same purpose. As stated earlier, many may feel that Taco Cabana deserves rights in its motif and that other Mexican restaurants should not be able to copy Taco Cabana's motif. Because Taco Cabana invested the effort and creativity into designing its restaurants, the motif should belong to it, exclusively. Post-secondary aesthetic functionality agrees but holds that the protection should not come from trademark law. This appears to be the province of copyrights.¹⁴² Copyrights afford rights in architectural design¹⁴³ as well as art work.¹⁴⁴ Taco Cabana's motif is a combination of the two and should be protectible as such. For those product designs which do not fall within copyright protection, there are also design patents. Most any example of trade dress that would be barred by the post-secondary aesthetic functionality test would find protection in another field. Trademark does not need to be the protector of all that holds the capacity to identify source.

138. See Wong, *supra* note 6.

139. *Id.* at 1164.

140. See Wong, *supra* note 6.

141. *Id.*

142. 17 U.S.C. § 102(a) (1998) (subject matter).

143. *Id.* § 102(a)(8) (architectural works).

144. *Id.* § 102(a)(5) (pictorial, graphic, and sculptural works).

Another ill sought to be avoided by identification theory is anti-competitive effects a monopoly may carry.¹⁴⁵ The fewer monopolies granted, the more competition is enhanced. Conversely, the elimination of a monopoly will allow other companies to enter the market¹⁴⁶ and allow the consumer to decipher which company produces the better good at the better price.¹⁴⁷ In short, permitting a company to maintain a monopoly on a product feature that is aesthetically superior does not foster a strong economy.

2. Post-Secondary Aesthetic Functionality v. The Courts

The courts' approach holds that it is the most effective means to protect the goodwill of the companies.¹⁴⁸ It is certainly true that the goodwill of the company was protected in the *Qualitex*¹⁴⁹ and *Owens Corning*¹⁵⁰ decisions. *Taco Cabana*, on the other hand, had no goodwill to protect as it was unable to establish secondary meaning.¹⁵¹ As such it had created no substantial connection between the motif of the restaurant and the quality of its products.¹⁵² The Supreme Court simply found that the motif was inherently distinctive.¹⁵³ Mere creativity of the dress of a good should not receive automatic protection in trade dress when aesthetic functionality is present. By not requiring a showing of secondary meaning seemingly limitless dress will be able to gain protection.

The Court in *Wal-Mart* took a step to rectify this problem by requiring a showing of secondary meaning when a product feature is at issue, but this, too, is a difficult distinction to draw. However, instead of taking a case by case approach of litigating the difference between a feature and a package, the post-secondary aesthetic functionality test would simply bar the discussion. Only one question need be answered: Was it aesthetically functional prior to establishing secondary meaning?

145. See Wong, *supra* note 6, at 1162 ("Because the identification theory prevents monopolization of even more features than the competition theory, the identification theory protects competition equally well, if not better than, the competition theory.").

146. *Id.*

147. *Id.*

148. *Qualitex*, 514 U.S. 159 (1995); *Two Pesos*, 505 U.S. 763 (1992).

149. *Qualitex*, 514 U.S. 159 (1995).

150. *Owens-Corning*, 774 F.2d 1116 (Fed. Cir. 1985).

151. *Two Pesos*, 505 U.S. 763 (1992).

152. *Two Pesos*, 505 U.S. 763 (1992).

153. *Id.*

Another of the benefits claimed by the courts' approach is that it minimizes consumer confusion.¹⁵⁴ First, a consumer cannot be confused by a product feature which does not carry secondary meaning.¹⁵⁵ If the feature has not been paired sufficiently with the source, consumers will not inaccurately assign it a source. The argument then shifts to future consumer confusion. The courts' approach will protect packaging that is sufficiently distinctive as to identify its source.¹⁵⁶ By doing so, consumers will be able to more readily pair dress with particular sources.¹⁵⁷ This may be true, but certainly not necessary to a successful economy. If consumers are presumed to be rational they will be quick to understand that you must look to a product's mark, not dress, to determine the source. This already exists in markets where most or all possible dresses have been explored. In the automobile industry, for example, a Geo Tracker and a Suzuki Sidekick have almost identical dress and product features. Thus, consumers have learned to differentiate between the two by looking to the trademark: on the back, front, and side of the vehicle there will either be a S symbol for Suzuki or the Geo world symbol for the Tracker. Accordingly, the post-secondary aesthetic functionality theory would not leave the consumer vulnerable in the marketplace, but would enhance the consumer's discretion.

B. ADVANTAGES OF THE POST-SECONDARY AESTHETIC FUNCTIONALITY THEORY

In discussing the arguments that favor the courts' approach and the identification theory, it has been established that the post-secondary aesthetic functionality theory is equally capable of satisfying those objectives. So what further advantage is there to the post-secondary aesthetic functionality theory?

First, the post-secondary aesthetic functionality test allows companies and courts alike to predict the boundaries of the trade dress protection.¹⁵⁸ Second, it aids in the separation of the three branches of

154. *Qualitex*, 514 U.S. 159, 163 (1995).

155. Any other conclusion would be contrary to the definition set forth in *Abercrombie & Fitch*, 537 F.2d 4 (2d Cir. 1976).

156. *Two Pesos*, 505 U.S. 763 (1992).

157. *Id.*

158. See Wong, *supra* note 6 (claiming that the competition theory fails to sufficiently protect against monopolization).

intellectual property which the courts have blurred.¹⁵⁹ Third, it promotes the economy through competition by eliminating the monopolies granted by the courts.¹⁶⁰ Fourth, it protects the goodwill of companies by not making a hard line rule against aesthetic functionality in all its forms as the identification theory seeks to do.¹⁶¹ Finally, it minimizes consumer confusion by allowing a company rights in the post-secondary aesthetic functionality that it has long and firmly established through its pairing of the feature with the company's reputation, which the identification theory would bar.¹⁶²

V. CONCLUSION

The law of trademarks has exceeded its purposes through the wide grant of trade dress protection in several recent decisions. Numerous critical commentaries have been written as legal scholars seek to find a workable solution to that problem. As this Article has illustrated, there is another viable solution: the post-secondary aesthetic functionality theory. The Supreme Court's adoption of the competition theory is simply too lenient. The boundaries are disappearing and trade dress is spinning out of control. Treating trade dress according to the letter of the trademark law may sound logical, but marks need to be separated from dress. They are not unequal and dissimilar. A mark does not carry the likelihood of having functionality or aesthetic functionality that dress does. The *Abercrombie* test applies well to marks for that reason, and it works poorly for dress for the same reason. How does a fact finder determine if an ornamental design is arbitrary or fanciful? How can a design be suggestive or descriptive of product and not be functional? These categories have definitions when discussing marks, but they make little to no practical sense when applied to dress. The Court in *Wal-Mart* recognized these problems, but came up short on the solution.

A mark has only one purpose by definition; it is used to indicate source. A competitor has only one reason for wanting to copy a trademark; to profit from another's goodwill. True, the same can be a motivation in copying dress, but it is not the only possible motivation. Rather, a company may want to prove in the market place that they can

159. See discussion on separating the branches intellectual property law *supra*.

160. See, e.g., *Qualitex*, 514 U.S. 159 (1995); *Two Pesos* 505 U.S.763 (1992) (each granting monopolies over the respective dress).

161. See Wong, *supra* note 6.

162. *Id.*

provide consumers with the same product at a lower price or perhaps higher quality. Would barring that opportunity help the economy?

The secondary aesthetic functionality theory borrows much from the identification theory. It adds, however, protection in situations when protection is the most deserved in trade dress. The lines between the branches of intellectual property are strengthened, consumer confusion is minimized, goodwill of companies fostered, and predictability is injected into a field of law sorely in need of it.