Trademark Protection of Container and Package Configurations - A Primer

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TRADEMARK PROTECTION OF CONTAINER AND PACKAGE CONFIGURATIONS—A PRIMER*

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INTRODUCTION

The majority of the consuming public today, whether consciously or subconsciously, purchases goods by means of symbols.1 These symbols include not only brand names, labels and distinctive coloring, but also the shape of the product's package or container.2

The significant role that packages and containers play in today's market seems to be a function of the relationship between television and other advertising media and the supermarket and similar self-service stores.3 As the consumer is inundated with more elaborate and creative displays of merchandise, the resulting effect is to purchase by sight.4 In such a setting, the consumer confronts the package instead of the salesman.5

Often, the merchandise being purchased is neither so specialized and distinctive nor so complex as to require the scrutiny of a sophisti-

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1. As the Supreme Court stated in Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co., 316 U.S. 203, 205 (1942):

   The protection of trademarks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. . . . The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. . . .


4. Lunsford, supra note 3.

5. "Packaging is often vitally more important to customers than the contents of the package." OXENFELDT, EXECUTIVE ACTION IN MARKETING 345 (1966).
The package or container becomes both a salesman and an advertisement on the shelf by attracting attention, describing the product's features, looking convenient, making a favorable overall impression and giving the consumer confidence that he is purchasing the same product that had satisfied him previously. A distinct and appealing visual identity for a product has thus become a highly prized goal in today's commercial marketplace. Simply stated, those products that stand out sell first. A manufacturer which markets dishwashing detergent or cleansers, for example, must differentiate its product from similar products scattered among thousands of feet of shelf space. The merchandising goal is to design a package or container configuration that will be successful in not only attracting purchases but also in creating a consumer recognition symbol.

To meet these marketing needs, companies have expended and continue to expend large amounts of money for research, development and advertising to establish a substantial market for their product, which the consuming public identifies by its familiar package or container shape. These expenditures and marketing techniques mandate that free competition (the ability to copy package and container configurations) be subordinated to the interest of the honest businessman and of the public in not being deceived as to the source of the product.


7. Marks, supra note 3 at 14.


9. Marks, supra note 3 at 14.


12. Gamboni, supra note 11 at 976.


14. Public Interest, supra note 13. As the legislative history of the Lanham Act states: Trade-marks, indeed, are the essence of competition, because they make possible a choice between competing articles by enabling the buyer to distinguish one from the other. Trade-marks encourage the maintenance of quality by securing to the producer the benefit of the good reputation which excellence creates. To protect trade-marks, therefore, is to protect the public from deceit, to foster fair competition, and to secure to
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It is unfair competition to represent one’s product in such a manner that consumers are induced to believe that the merchandise they are buying is that of one producer when it is actually the merchandise of a competitor who has copied the packaging of its rival.\(^5\) Equity demands that the businessman’s investment of time, money and effort in developing his distinctive package or container be protected against imitation by a competitor calculated to deceive the public and capitalize upon the labors of the competitor.\(^6\)

This article discusses the foundations of trademark protection afforded to package and container configurations. After exploring the likelihood of confusion test, the basic premise of trademark protection, the article will demonstrate that the 1964 *Sears* and *Compco* \(^17\) decisions, which were once thought to have changed over 100 years of legal protection of designs, have had little or no effect on the protection of package and container shapes. Finally, the article will discuss the circumstances under which package and container configurations may obtain trademark protections and what rights those protections entail.

BACKGROUND AND THE BASIC PREMISE—THE LIKELIHOOD OF CONFUSION TEST

The essential issue in trademark infringement actions (both statutory and at common law) is whether the purchasers are likely to be misled or confused as to the source of different products.\(^8\) This issue remains the same, whether the court’s focus is on trademark infringement or unfair competition.\(^9\) To establish that a likelihood of confusion exists in the customer’s mind as to the source or origin of the package or container sold by a competitor, a plaintiff must prove that there is a public desire for a product made by the plaintiff.\(^20\) The public desire must be for the manufacturer, not the product,\(^21\) and if there

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15. *See supra* note 10 and accompanying text.
17. *See infra* notes 53 and 54.
21. American Footwear Corp. v. General Footwear Co., 609 F.2d 655, 663 (2d Cir. 1979),
is confusion, it must be confusion as to the origin of the product and not as to the goods themselves. This is known as the “likelihood of confusion” standard, under which competitor-created confusion among purchasers as to the source of goods becomes actionable.

The proper test under this standard is whether the defendant’s package or container has features which are of such character and are used in such a way as to be likely to confuse a prospective buyer. The

22. As stated by the court in Spangler Candy Co. v. Crystal Pure Candy Co., 235 F. Supp. 18 (N.D. Ill. 1964), aff’d, 353 F.2d 641 (7th Cir. 1965):

The import of confusion is that the consumer must have something in mind, even though it is somewhat vague, with which to confuse another product.

Unless the package collocation has acquired a secondary meaning, the plaintiff is faced with what has been called “buyer indifference”. The buyer to be deceived, must be looking for something.

23. "(C)onfusion cannot be assessed in a vacuum, [the] underlying and crucial importance regarding a finding of 'likelihood of confusion' is the particular market, that is, the consuming public the goods are directed toward." American Rice, Inc. v. Arkansas Rice Growers Co-Op., 532 F. Supp. 1376, 1385 (S.D. Tex. 1982).


[Many of the cases cited regarding these trademark principles] deal with the issue of
issue is not necessarily whether a defendant's package or trade dress is identical to the plaintiff's in each and every particular, but rather, whether there is a similarity of the overall impression.

The deciding factor is whether a likelihood of confusion exists. In testing for a likelihood of confusion, the court disregards small differences and looks to the overall appearance of the package as seen by a potential purchaser. "The elements of the parties' dress, packaging and labels to be considered are open-ended. Anything which the ordinary purchaser sees should be considered. This includes size, shape, color, design, texture, word and symbol marks of both the product and its dress and package." In addition to the similarity of the marks, the courts consider extrinsic facts such as the types of goods, the classes of prospective purchasers, the competitive relationship of the parties, the relationship between the channels of trade and trademark registerability, [but this] does not lessen their instructive value to this Court considering the infringement of a registered mark. The issue of extending trademark recognition and protection from infringement to a three-dimensional object patterned after a registered two-dimensional mark, where the object undoubtedly has utilitarian aspects not present in the source-indicating mark, must be answered by the application of general trademark policy.


Actual proof of confusion is not necessary to obtain injunctive relief from a deceptively similar package when the action is brought at the incipiency of the alleged infringement: "[p]laintiff should not be expected to stand by and await the dismal proof." De Costa v. CBS, Inc., 520 F.2d 499, 514 (1st Cir. 1975), cert. denied, 423 U.S. 1073 (1976). Of course, the opposite is also true. "[A]fter the lapse of substantial time if no one appears to have been actually deceived, that fact is strongly probative of the defense that there is no likelihood of deception..." Id., quoting from 3 CALLMAN, UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 80.6 (3d ed. 1969).

A party seeking monetary damages must not only demonstrate a likelihood of confusion but also that it has been damaged. Schutt Mfg. Co. v. Riddell, Inc., 673 F.2d 202, 206 (7th Cir. 1982). See also Invicta Plastics (USA) Ltd. v. Mego Corp., 523 F. Supp. 619, 622 (S.D.N.Y. 1981).

27. See Alberto-Culver Co. v. Andrea Dumon, Inc., 466 F.2d 705 (7th Cir. 1972), wherein even though both parties marketed a deodorant spray in identical cans, the labels were sufficiently different to avoid confusion. See also Howw Mfg., Inc. v. Formac, Inc., 213 U.S.P.Q. 793, 796 (N.D. Ill. 1981).


29. "[T]he greater the similarity between the products and services [provided by the defendant and plaintiff], the greater the likelihood of confusion." Exxon Corp. v. Texas Motor Exchange of Houston, Inc., 628 F.2d 500, 505 (5th Cir. 1980). Similarity, however, is not dispositive of the issue. McGregor-Doniger, Inc. v. Drizzle, Inc., 599 F.2d 1126, 1133 (2d Cir. 1979).

30. Id. See MCCARTHY, supra note 28 at §§ 23:3-16.
32. Id.
ties' advertising, the public awareness of plaintiff's trademark, manner of trademark use, the degree of care likely to be exercised by consumers, the defendant's intent in adopting its mark, the trend towards expansion in the respective trade or industry as to territory of line of merchandise, evidence of actual confusion and the strength of plaintiff's mark.

38. Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc., 659 F.2d 695, 703-04 (5th Cir. 1981). Intent of the defendant in adopting a mark is only one of the factors to be considered. However, if a plaintiff can demonstrate that a defendant adopted a mark with the intent of obtaining unfair commercial advantage from the reputation of the plaintiff, then "that fact alone 'may be sufficient to justify the inference that there is confusing similarity.'" Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 263 (5th Cir.), cert. denied, 449 U.S. 899 (1980).

Courts have often used the terms "passing off" and "palming off" in describing a guilty defendant's conduct. "Palming off" or "passing off" is the selling of a good or service under the name or mark of another. McCARTHY, supra note 28, § 25:1. The terms historically were used in the context of describing a "wrongful intent" on the part of the defendant to pass or palm off his goods as being those of the plaintiff, but most courts have come to use the terms to describe cases where likelihood of confusion is present. McCARTHY, supra note 28, § 25:1. Thus, the courts have shifted from emphasizing the wrongful action to emphasizing the effect on the customer. The shift has come about in large part as the result of an effort by the courts to conform the test for common-law trademark infringement with the test for statutory trademark infringement. McCARTHY, supra note 28, §§ 23:1, 23:30.


In reverse passing-off cases, the originator of the misidentified product is deprived of the advertising value of its name and of the good will that otherwise would stem from public knowledge of the true source of the product. McCARTHY, supra note 28 at § 3:5.
40. Id. Although showing actual confusion could be significant, such evidence is not necessary to a finding of likelihood of confusion. General Mills, Inc. v. Henry Regency Co., 421 F. Supp. 359, 361 (N.D. Ill. 1976); Fremont Co. v. ITT Continental Baking Co., Inc., 199 U.S.P.Q. 415, 422 (S.D.N.Y. 1977); RESTATEMENT OF TORTS § 728 (1938).
41. Determination of trademark strength is probably the most important factor in determining likelihood of confusion. Narwood Productions v. Lexington Broadcast Serv. Co., 541 F. Supp. 1243, 1247 (S.D.N.Y. 1982). What is intended by references to "strong" and "weak" marks is the effect of such marks upon the mind of the consuming public. Strength was defined in McGregor-Doniger, Inc. v. Drizzle, Inc., 599 F.2d 1126, 1131 (2d Cir. 1979) as:
The term ‘strength' as applied to trademarks refers to the distinctiveness of the mark, or more precisely, its tendency to identify the goods sold under the mark as emanating from a particular, although possibly anonymous, source.

"A mark that is strong because of its fame or its uniqueness, is more likely to be remembered and more likely to be associated in the public mind with a greater breadth of products or services, than is a mark that is weak because [it is] relatively unknown or very like similar marks or very like the name of the product." James Burrough Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 276 (7th Cir. 1976). In general, "strong marks are given...protection over a wide range of related products...
Each product has its own separate threshold for confusion of origin. If a product is relatively inexpensive, the customer will normally pay less attention to what he is purchasing than if the item or service is expensive. Therefore, less similarity between trademarks of inexpensive goods is required to show likelihood of confusion than would be required if the parties competed in a market of expensive goods.

The test of customer confusion is not whether the products can be differentiated when subjected to a side-by-side comparison, but rather whether they create the same general overall impression. If the similarities in appearance are such that they would be unduly confusing to the average consumer, the defendant has violated the plaintiff's rights.

The likelihood of confusion test refers to ordinary purchasers and not to careless ones. It is the casual or ordinary, non-discerning buyer and variations on appearance of the mark, [while] weak marks are given a narrow range of protection both as to the products and as to visual variations.” McCarthy, supra note 28, § 11:24. Strength of a mark may be derived from the intrinsic quality of the mark or from its public history. E. I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. 502, 512 (E.D.N.Y. 1975). The ultimate test of a mark's strength is its actual recognition among the consuming public. Id. The court said:

Strength or weakness is primarily a question of assessment of a mark's distinctiveness or popularity. Where the public has been educated to recognize and accept a particular mark as the hallmark for a particular source of that product, or the mark itself is inherently unique or has been the subject of wide advertisement, it is a strong trademark. Id. For example, in Haig & Haig, Ltd. v. Maradel Products, Inc., 249 F. Supp. 575 (S.D.N.Y. 1966), plaintiff, a distiller of scotch whiskey, had registered trademarks for its name (PINCH) and the shape of its bottle. Defendant copied the shape of the bottle for its after-shave lotion called "Scotch 'n Soda" as well as for its bubble bath called “Pinchy.” The court denied any relief on the grounds that the bottle shape was weak and that because defendant's products were far different from plaintiff's there would not be a likelihood of confusion.

42. The ascertainment of the probability of confusion resulting from the similarity of configurations is not solvable by a precise rule or measure. It is a matter of varying human reactions to situations and not capable of exact appraisement. Colburn v. Puritan Mills, 108 F.2d 377, 378-79 (7th Cir. 1939). “The greater the value of an article the more careful the typical consumer can be expected to be. . . .” McGregor-Doniger, Inc. v. Drizzle, Inc., 599 F.2d 1126, 1137 (2d Cir. 1979).


44. See Fisher Stoves, Inc. v. All Nighter Stove Works, Inc., 206 U.S.P.Q. 961 (1st Cir. 1980), wherein the court held that customers purchasing expensive wood burning stoves would not be confused because each manufacturer displayed its name and logo prominently, clearly identifying its origin.


who is to be protected. In weighing the evidence of the likelihood of confusion, the court strives to place itself in the shoes of the ordinary prospective purchaser, using his ability to discriminate and taking into account his propensity for carelessness.

Until 1964, packages and containers, like product shapes, were protectable and registerable only if they were distinctive and if the contents were identifiable as belonging to a particular source. If a manufacturer's package or container had acquired secondary meaning, a competitor was forbidden from simulating its design. If the simulated package or container design was functional, a competitor could freely simulate its appearance. This was so even if the shape had acquired secondary meaning. The originator was denied any interest therein to avoid creating a monopoly in non-patented functional features.

In 1964, the United States Supreme Court in Sears, Roebuck & Co. v. Stiffel Co., and in Compco Corp. v. Day-Brite Lighting, Inc., appeared to wipe out over 100 years of common law dealing with unfair competition by holding that protection against copying—other than

48. Some courts, however, have held that a higher standard of care is required on the buyer's part. The Seventh Circuit Court of Appeals stated "A new competitor is not held to the obligations of an insurer against all possible confusion. He is not obligated to protect the negligent and inattentive purchaser from confusion resulting from indifference." Life Savers Corp. v. Curtiss Candy Co., 182 F.2d 4, 8 (7th Cir. 1950).

Another court stated it would disregard the "undiscriminating prospective purchaser" and be guided by the effect upon the person who looks for brand names. Chun King Sales, Inc. v. Oriental Foods, Inc., 136 F. Supp. 659, 663 (S.D. Cal. 1955), aff'd in part, rev'd in part, 244 F.2d 909 (9th Cir. 1957).

In Fotomat Corp. v. Cochran, 437 F. Supp. 1231 (D. Kan. 1977), the court, finding defendant's copying of plaintiff's building shape for drive-thru photographic services illegal, stated that no matter how different the buildings were there would still be some confusion. Such "irrelevant confusion" was not protectable. Id. at 1240. However, those people falling between these less observant and more observant people, are entitled to protection from being confused. Id.

See Artus Corp. v. Nordic Co., Inc., 512 F. Supp. 1184, 1191 (W.D. Pa. 1981) (defendant "is not obligated to protect the negligent and inattentive purchaser from confusion resulting from indifference, or make the market foolproof").

Judge Learned Hand criticized the Seventh Circuit's Life Savers ruling, stating that "we must leave the last word to the Supreme Court." American Chicle Co. v. Topps Chewing Gum, 208 F.2d 560, 563 (2d Cir. 1953). In fact, the Supreme Court did state in an early case that the test is one of likelihood of confusion to "the ordinary purchaser in the exercise of ordinary care and caution in such matters. . . ." McLean v. Flemming, 96 U.S. 245, 255 (1877).


50. West Point Mfg. Co. v. Detroit Stamping Co., 222 F.2d 581, 593 (6th Cir. 1955); New England Duplicating Co. v. Mendes, 190 F.2d 415, 418 (1st Cir. 1951); McCarthy, supra note 28, § 7:23, at 189.


52. Alan Wood Steel Co., 150 F. Supp. at 862.


that afforded by the constitutionally authorized patent system—is not permissible.\textsuperscript{56} The Supreme Court held that federal patent laws preempted state causes of action for unfair competition based upon the alleged copying of unpatented products.\textsuperscript{57}

In the \textit{Sears} case, the Stiffel Company had obtained design and mechanical patents covering the design and operation of a "pole lamp."\textsuperscript{58} Sears sold an exact copy.\textsuperscript{59} There was no evidence that the Stiffel lamp had acquired secondary meaning.\textsuperscript{60}

The district court and Seventh Circuit found that Stiffel's patents were invalid, but held that the copying by Sears constituted unfair competition under Illinois common law because there was a likelihood of confusion of buyers as to source.\textsuperscript{61} The Supreme Court, however, reversed, holding that the state had no power to require Sears to change the design of its lamp.\textsuperscript{62} The Supreme Court held that a state could not, consistent with the United States Constitution, extend the life of a federal patent beyond its expiration date, or give protection to things which did not qualify for federal patent protection.\textsuperscript{63} The Court found the fact that there would be a likelihood of confusion caused by the look-alike lamps was irrelevant.\textsuperscript{64} The Court stated:

Of course there could be 'confusion' as to who had manufactured these nearly identical articles. But mere inability of the public to tell two identical articles apart is not enough to support an injunction against copying or an award of damages for copying that which the federal patent laws permit to be copied.\textsuperscript{65}

In the \textit{Compco} case, the Day-Brite Lighting Company had obtained a design patent on a fluorescent light fixture reflector which had cross-ribs claimed to give it both strength and attractiveness.\textsuperscript{66} Compco marketed a reflector with the same overall appearance as the Day-Brite reflector.\textsuperscript{67} As in \textit{Sears}, the district and appellate courts held the patent invalid,\textsuperscript{68} but the courts enjoined the Compco Company

\textsuperscript{56} \textit{Sears}, 376 U.S. at 231; \textit{Compco}, 376 U.S. at 238.
\textsuperscript{57} \textit{Id.}
\textsuperscript{58} 376 U.S. at 225-26.
\textsuperscript{59} \textit{Id.} at 226.
\textsuperscript{60} \textit{Id.}
\textsuperscript{61} Stiffel Co. v. Sears, Roebuck & Co., 313 F.2d 115 (7th Cir. 1963) (which includes a summary of the unreported district court opinion).
\textsuperscript{62} 376 U.S. at 232-33.
\textsuperscript{63} \textit{Id.}
\textsuperscript{64} \textit{Id.} at 232.
\textsuperscript{65} \textit{Id.}
\textsuperscript{66} 376 U.S. at 234.
\textsuperscript{67} \textit{Id.} at 235.
\textsuperscript{68} Day-Brite Lighting, Inc. v. Compco Co., 311 F.2d 26 (7th Cir. 1962) (which includes a summary of the unreported district court opinion).
from making and selling its reflector on the basis of Illinois Unfair Competition Law. The appellate court found that the concurrent sale of the two products was likely to cause confusion in the trade. However, the Supreme Court reversed, holding that even though the reflector was nonfunctional, had acquired secondary meaning and defendant's copy was likely to cause confusion, no injunction against copying could be granted.

According to the Supreme Court in the Sears and Compco cases, lower courts could not enjoin the copying of an article unprotected by patent or copyright, since such an injunction would be inconsistent with federal patent and copyright policy. The Court said that even though the design of an article might cause confusion among purchasers as to the identity of the article's producer, that could not furnish a basis for prohibiting the copying or selling of the article regardless of the copier's motives. Secondary meaning and functionality were held relevant only to a possible application of state law requiring labeling or precautions to correctly identify the source of products.

69. Id. at 30.
70. Id.
71. 376 U.S. at 237.
72. "[M]ere inability of the public to tell two identical articles apart is not enough to support an injunction against copying." Sears, 376 U.S. at 232.
73. Compco, 376 U.S. at 238.
74. Sears, 376 U.S. at 232 (footnotes omitted). The Uniform Deceptive Trade Practices Act ("Act"), adopted by most states in one form or another (see Alexander and Coil, The Impact of New State Unfair Trade Practices Acts on the Field of Unfair Competition, 67 TRADE-MARK REP. 625, 630 (1977)) was drafted with the Sears and Compco decisions in mind. The Act, in part, reads:

A person engages in a deceptive trade practice when, in the course of his business, vocation or occupation, he:

1. passes off goods or services as those of another;
2. causes likelihood of confusion or of misunderstanding as to the source, sponsorship, approval or certification of goods or services;
3. causes likelihood of confusion or of misunderstanding as to affiliation, connection or association with or certification by another;

(12) engages in any other conduct which similarly creates a likelihood of confusion or of misunderstanding.

See, e.g., ILL. REV. STAT. ch. 121½, § 312.

Section 313 provides for injunctive relief against violators as follows:

A person likely to be damaged by a deceptive trade practice of another may be granted injunctive relief upon terms that the court considers reasonable. ***Relief granted for the copying of an article shall be limited to the prevention of confusion or misunderstanding as to source (emphasis supplied).

The word "article" is defined in the Act as "a product as distinguished from a trademark, label or distinctive dress packaging. . . ." [§ 311(1)]. The notes to the Act set forth the significance of this definition and its application.

The definition of "article" in Section 311(1) of the Act, when read with the restriction on the granting of relief found in Section 313, clearly indicates that injunctive relief against copying is prohibited only with respect to articles, and is not restricted with respect to trademarks, labels or distinctive dress or packaging.
Sears and Compco did not decide, or even consider, the boundaries between federal patent\(^7\) and federal trademark law. Though the patent and trademark laws provide overlapping protection to the qualifying package or container shape, a design patent grant and a trademark registration are based upon entirely different legal theories.\(^6\)

On the one hand, patent protections are statutory rights and patent principles require inventive novelty and nonobviousness.\(^7\) When protection is granted, it gives the holder monopoly power to exclude anyone, for a limited period of time, from making, using or selling the patented object, regardless of whether the infringer is in competition.\(^8\)


The Act prevents conduct which is likely to confuse purchasers as to the source of a product, including the copying of distinctive packaging. Filter Dynamics Int'l, Inc. v. Astron Battery, Inc., 19 Ill. App. 3d 299, 311 N.E.2d 386 (1974). Like the Lanham Act, the plaintiff must establish not just confusion but a likelihood of source confusion, which can only arise when the first seller's product is associated by the public with a particular source of supply. \(\text{Id}\). Similarly, the package shape must not be functional. Duo-Tint Bulb & Battery Co. v. Moline Supply Co., 46 Ill. App. 3d, 145, 151, 360 N.E.2d 798, 803 (1977).


The requirement of invention in a design patent is not satisfied by a design which is merely new and pleasing. McCarthy, supra note 28, § 7:30.

The policy of the United States patent laws is that one who has invested time and labor in develop-
On the other hand, trademark rights are common law rights arising from the use of a distinctive mark which identifies one's goods and which distinguishes them from those manufactured and sold by others. Trademark registration does not require invention or novelty but is premised upon rights developed through actual use. This constitutes an acknowledgement that the container or package acts as an indication of the source of origin for the product contained in the package. Protection is not limited in time and may extend for an unlimited period unless lost by nonuse, misuse or overuse.

Moreover, federal trademark law serves the dual purpose of protecting both the trademark owner and the public from confusion, mistake and deception. Registration only precludes others from copying the configuration on similar or related goods which might create confusion or deception among potential purchasers.

A number of subsequent lower court decisions reveal significant judicial dissatisfaction with the Sears and Compco rationale and have viewed the actual holdings of Sears and Compco very narrowly. Courts have continued to uphold protection against the unfair copying of a new product shall have the benefit of his invention, by being given the right to exclude others completely from the use of his invention. Western Elec. Co. v. Milgo Electronics Corp., 190 U.S.P.Q. 546, 549 (S.D. Fla. 1976).

79. Section 45 of the Lanham Act (15 U.S.C. § 1127) defines “trademark” as “any word, name, symbol or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.”


81. Trade-mark Cases, 100 U.S. 82 (1879).

82. MCCARTHY, supra note 28, § 16.1.

83. The issue of whether a bottle configuration may obtain trademark registration during the life of its design patent was decided in Application of Mogen David Wine Corp., 328 F.2d 925 (C.C.P.A. 1964). There, the court discussed the distinction between patent law and trademark law. (See notes 77-78, supra). In the concurring opinion, Chief Judge Worley stated that the real issue was whether competition would be hindered.

84. When a mark is abandoned, it falls into the public domain as a matter of law and is subject to appropriation by the next person to control the nature and quality of the mark. Manhattan Indus., Inc. v. Sweater Bee By Banff Ltd., 627 F.2d 628, 630 (2d Cir. 1980). See also Phi Delta Theta Fraternity v. J. A. Buchroeder & Co., 251 F. Supp. 968 (W.D. Mo. 1966) (antitrust misuse).


85. James Burrough Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 276 (7th Cir. 1976).

86. Scarves by Vera, Inc. v. Todo Imports, Ltd., 544 F.2d 1167, 1172 (2d Cir. 1976). In In re Pepsi-Cola Co., 120 U.S.P.Q. 468 (T.T.A.B. 1959), the court held that while a design patent allows the patentee to prevent any manufacture or use of a protected configuration, trademark protection is of a more limited scope and only registers the holder's rights to use the mark as an identifier of his goods.

87. The Second, Third and Eighth Circuit Courts of Appeals have recently held that the
of packaging which will create a likelihood of confusion as to source. These decisions refer to the *Sears* exception for "distinctive dress in the packaging of goods."\(^8\) Where the traditional tests of secondary meaning, nonfunctionality, and likelihood of confusion are met, copying will still be prohibited.\(^8\)

Courts have also drawn the distinction between products and packaging referred to in *Sears* and *Compco*. Unlike the pole lamp and fluorescent lighting fixture, containers and packages are not ordinarily considered "products."\(^8\) The package is simply a nonfunctional feature of the product.\(^9\) It is not a part of, and has no relation to, the product itself.\(^9\)

A package or container only acquires trademark significance for *Sears-Compco* doctrine did not address itself to rights recognized by § 43(a) of the Lanham Act which makes certain kinds of unfair competition federal statutory torts. In *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210 (8th Cir.), *cert. denied*, 429 U.S. 861 (1976), the court ignored *Sears* and *Compco*. In that case, plaintiff sought relief under Section 43(a) of the Lanham Act when defendant copied the exterior design of the plaintiff's semi-trailer. The court stated that the Supreme Court's discussion of the questions of functionality and secondary meaning was mere dictum. *Id.* at 1214. Thus, the finding that the existence of the federal patent law prohibits liability for the copying of unpatented features was rejected.

Similarly, in *Time Mechanisms, Inc. v. Qonaar Corp.*, 422 F. Supp. 905 (D.N.J. 1976), the court protected the ice cream cone shape of a parking meter cover which was non-functional and had secondary meaning. Following the Eighth Circuit's *Fruehauf* decision, the court held that the trademark laws protect interests distinct from those under the patent laws. *See also S K & F Co. v. Premo Pharm. Labs, Inc.*, 625 F.2d 1055, 1064 (3d Cir. 1980) and *Ives Labs, Inc. v. Darby Drug Co.*, 601 F.2d 631, 642-43 (2d Cir. 1979).

Even the Supreme Court appears to have eroded the *Sears-Compco* holdings in later cases. For example, in *Lear Inc. v. Adkins*, 395 U.S. 653 (1969), the Supreme Court held that a patent licensee was not estopped to deny the validity of a licensor's patent when sued for royalties.

In *Goldstein v. California*, 412 U.S. 546 (1973), petitioners challenged the California statute prohibiting record or tape piracy as being violative of the copyright clause of the Constitution. The Court, indicating that states may wield more power in the area of unfair competition, upheld the statute, stating that the Copyright Clause of the Federal Constitution does not vest the power to issue copyrights solely in the federal government. Similarly, in *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974), the court held that States may exercise regulatory power over discoveries. Trade secret protection was not federally preempted because the patent law did not explicitly endorse or forbid the operation of trade secret law and the objectives of each were not in conflict. *See also Important Trends, supra* note 75, at 98.

\(^8\) *Sears*, 376 U.S. at 232.

\(^9\) Normally, trade dress is thought to include packages, boxes and bottles (see note 90, *infra*) and this would seem to include within the Court's exception the many cases concerning the configuration of packages which hold products.


\(^92\) *Id.*
the enclosed product\textsuperscript{93} and, for the most part, may be used by others for unrelated products.\textsuperscript{94} Thus, the \textit{Sears-Compco} rule which permits one to sell an identical copy of a competitor's public domain product\textsuperscript{95} does not give a competitor the freedom to imitate the appearance of the package or container in which that product is sold.\textsuperscript{96} The \textit{Sears-Compco} cases permitting product imitation thus appear to have no real applicability to the container or package in which the product is sold.\textsuperscript{97}

Courts have also disregarded the \textit{Sears} and \textit{Compco} decisions on the ground that the Lanham Act\textsuperscript{98} is a federal statute.\textsuperscript{99} Therefore, the preemption theories of \textit{Sears} and \textit{Compco} are not controlling because they dealt only with the protection of product design under state unfair competition law.\textsuperscript{100} The focus of both \textit{Sears} and \textit{Compco} was the Supremacy Clause of the Constitution—whether state law can extend the effective term of patent protection granted by federal statutes.\textsuperscript{101} The Supreme Court in \textit{Sears-Compco} had no occasion to discuss, in even general terms, legal recognition and protection of the subject matter of a design patent as a trademark.\textsuperscript{102}

\textbf{PROTECTION OF PACKAGING AND CONTAINERS—THE LANHAM ACT AND MORE}

Congress, by authority of the Commerce Clause of the United States Constitution, has given federal recognition to the public interest in recognizing trademarks to prevent confusion, mistake and deception.\textsuperscript{103} If the public recognizes and accepts a package or container

\textsuperscript{93} Id.
\textsuperscript{96} Id.
\textsuperscript{97} Id.
\textsuperscript{100} Id. \textit{See} notes 75 through 86 supra.
\textsuperscript{103} As stated in \textit{Ives}, supra note 102:

It is surely true that in the \textit{Sears} and \textit{Compco} opinions the Supreme Court said nothing about the federal tort created by Section 43(a). Stiffel's and Day-Bright's claims were treated as resting solely on state unfair competition law which was held invalid as in conflict with federal patent law. The opinions can be read as limited to rights claimed under state unfair competition law granting protection equivalent to that of federal patent or copyright laws for products not enjoying valid patents or copyright protection. The Court, it can be strongly argued, had no need to be concerned with marking out the boundaries of a federal tort over which it had control and which Congress could contract if the courts were pressing it further than that body desired. The Eighth Circuit took essentially this position in \textit{Truck Equipment Service Co. v. Fruehauf Corp.}, 536 F.2d 1210, 1214-15, \textit{cert. denied}, 429 U.S. 861, 97 S. Ct. 164, 50 L. Ed. 2d 139 (1976).
shape in a trademark sense, its owner seeks only federal recognition of that interest and the public is protected. The trademark laws take nothing from the "public domain;" they merely grant federal recognition to existing private and public interests.\(^\text{104}\)

The courts have thus continued to acknowledge an owner's rights in package and container configurations both under the Lanham Act and common law unfair competition when the owner establishes secondary meaning (or distinctiveness) and nonfunctionality.

A. The Lanham Act

The purpose of the Lanham Act\(^\text{105}\) is to protect source identification rights,\(^\text{106}\) the good will of the product and business,\(^\text{107}\) and the public from confusion due to deceptive trademarks.\(^\text{108}\) A trademark is a distinctive mark of authenticity through which the merchandise or services of a particular producer or manufacturer may be distinguished from those of competitors.\(^\text{109}\) Distinctive packaging, like a name or product shape, may indicate the source or origin of a product.\(^\text{110}\) Where the container or package shape functions as a product's label, the right to prevent a competitor's simulation of that shape can only grow out of actual use and consumer identification with the user.\(^\text{111}\)

Under such circumstances, duplication by a competitor could lead to consumer confusion as to the product's source. Accordingly, a non-

The court there sustained claim under § 43(a) for copying the exterior design of a hopper grain trailer which was found to be nonfunctional and to have acquired secondary meaning. While we previously left this question open. . . we are now prepared to agree with the Eighth Circuit.

\(^{601}\) F.2d at 642 (footnotes omitted).

\(^{104}\) Ives Laboratories, Inc. v. Darby Drug Co., 601 F.2d 631 (2d Cir. 1979); Truck Equip. Serv. Co. v. Fruehauf Corp., 536 F.2d at 1210, 1214-15.


\(^{107}\) James Burrough, Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 274 (7th Cir. 1976); Scarves By Vera, Inc. v. Todo Imports Ltd., 544 F.2d 1167, 1172 (2d Cir. 1976). This includes protecting the senior user's "interest [in] preventing others from getting a free ride on the reputation and good will he has established. . . ." Mushroom Makers, Inc. v. R. G. Barry Corp., 441 F. Supp. 1220, 1225 (S.D.N.Y. 1977), aff'd, 580 F.2d 44 (2d Cir. 1978), cert. denied, 439 U.S. 1116 (1979).


functional feature is entitled to protection under the Lanham Act if that feature has acquired a secondary meaning (or is inherently distinctive) and if its use by a competitor is likely to cause customer confusion as to the product's source.\textsuperscript{112}

Intent by a businessman to utilize a container or package shape as a trademark, however, is, in and of itself, insufficient.\textsuperscript{113} Not everything that a person adopts and uses with the intent that it function as a trademark necessarily achieves this status or is legally capable of doing so.\textsuperscript{114} Similarly, not everything that is recognized or associated with a single source is necessarily a protectable mark.\textsuperscript{115} The shape itself must be such that it is nonfunctional and such that the purchaser will realize that, upon viewing the configuration, it is the manufacturer's mark identifying the product.\textsuperscript{116}

Trademark Registration

Registration on either the Federal Principal Register\textsuperscript{117} or Supplemental\textsuperscript{118} Register does not enlarge the trademark owner's substantive rights.\textsuperscript{119} Trademark rights are common law rights arising from the appropriation and use of a distinctive mark in one's business.\textsuperscript{120} The

\begin{itemize}
\begin{quote}
[W]e see nothing inconsistent between a finding that a distinctive design has become sufficiently identified with its original producer to serve as an indication of its source and a finding that the design is nonetheless not insignificantly related to its utilitarian function. [C]ourts have generally treated the issue of functionality... as a separate consideration from secondary meaning.
\end{quote}
\item \textsuperscript{119} Keebler Co. v. Rovira Biscuit Corp., 624 F.2d 366, 372 (1st Cir. 1980); Griesedieck Western Brewing Co. v. Peoples Brewing Co., 149 F.2d 1019, 1022 (8th Cir. 1945); Schwinn Bicycle Co. v. Murray Ohio Mfg. Co., 339 F. Supp. 973, 979 (M.D. Tenn. 1971).
\end{itemize}
Lanham Act simply codifies these rights.\textsuperscript{121} Registration is a recording method by which to notify and inform the public and competitors that rights are asserted in a particular mark.\textsuperscript{122}

The Lanham Act does, however, give registrants certain procedural advantages.\textsuperscript{123} Registration grants the registrant the right to sue in federal court without regard to diversity of citizenship or the amount in controversy,\textsuperscript{124} prevents the registration of the same or of a confusingly similar mark upon either register by another party,\textsuperscript{125} and enables the registrant to recover damages, attorney's fees and obtain injunctive relief against an infringer.\textsuperscript{126}

Principal Registrants\textsuperscript{127} are granted additional rights: \textit{prima facie} evidence of the registrant's exclusive right to use the registered mark in

\textsuperscript{121} In re Deister Concentrator Co., 289 F.2d 496, 501 (C.C.P.A. 1961). The effect of Lanham Act registration is to shift the burden of proof from the plaintiff, who in a common law infringement action would have to establish his right to exclusive use, to the defendant, who must first introduce sufficient evidence to rebut the presumption of plaintiff's right to such use. Dan Robbins & Associates, Inc. v. Questor Corp., 599 F.2d 1009, 1013-14 (C.C.P.A. 1979).

\textsuperscript{122} Schwinn Bicycle Co. v. Murray Ohio Mfg. Co., 339 F. Supp. 973, 979 (M.D. Tenn. 1971), \textit{aff'd}, 470 F.2d 975 (6th Cir. 1972). A condition precedent to obtaining a federal registration is prior use in interstate or international commerce or in commerce with the Indian Tribes. Trademark Cases, 100 U.S. 82 (1879).

\textsuperscript{123} \textit{See infra} notes 125 through 130. Although the rights obtained from registration are, for the most part, procedural, the registrant obtains the right to exclude a prior user from those parts of the United States in which he was not actually using the mark prior to the federal registration. In other words, the first to obtain a federal registration may restrict a prior user to the geographical territory in which he was actually using the mark before the registration occurred. Dawn Donut Co. v. Hart's Food Stores, Inc., 267 F.2d 358 (2d Cir. 1959).


The rule that trademark rights arise solely from use should not detract from the substantive value of federal registration. Palladino, \textit{Trademarks and Competition: The IVES Case}, 15 J. MAR. L. REV. 319, 320 n.7 (1982).

\textsuperscript{125} 15 U.S.C. \S 1052(d).

\textsuperscript{126} 15 U.S.C. \S\S 1114, 1116, 1117. Specifically, 15 U.S.C. \S 1117 provides that a successful plaintiff is entitled (subject to the principles of equity) "to recover (1) defendant's profits, (2) any damages sustained by the plaintiff and (3) the costs of the action." The trial court also has discretion to award judgment for up to three times the amount of actual damages "according to the circumstances of the case" and states that "[i]f the Court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be just, according to the circumstances of the case." This Section also now provides for an award of reasonable attorney's fees to the prevailing party in "exceptional cases." 15 U.S.C. \S 1117 now applies to 15 U.S.C. \S 1125(a). \textit{See} Metric & Multistandard Components v. Metric's, Inc., 635 F.2d 710, 715 (8th Cir. 1980).

With regard to the issue of compensatory remedies, 15 U.S.C. \S 1117 is not considered to be a model of clarity in draftingmanship. In fact, it has led one court to conclude that "[u]nless there is at least some evidence of harm arising from defendant's violation, a court may not award a money judgment based on profits or damages." Electronics Corp. of America v. Honeywell, Inc., 358 F. Supp. 1230, 1234 (D. Mass.), \textit{aff'd per curiam}, 487 F.2d 513 (1st Cir. 1973), \textit{cert. denied}, 415 U.S. 960 (1974). However, a decision to order an accounting is addressed in large measure to the discretion of the trial court. Fuller Products Co. v. Fuller Brush Co., 299 F.2d 772, 777 (7th Cir.), \textit{cert. denied}, 370 U.S. 923 (1962).

connection with the goods or services specified in the certificate;\(^\text{128}\) the right, after continuous use of the mark for five years after registration, to have the registration become incontestable and thereby constitute conclusive evidence of the registrant’s exclusive right to use the mark;\(^\text{129}\) and the ability to prevent goods from being imported into the United States bearing infringing marks.\(^\text{130}\)

A configuration or shape of a container itself is not, however, registerable.\(^\text{131}\) It may be registerable for the particular contents thereof\(^\text{132}\) if the selection of the package or container shape is not dictated solely by functional, ornamental, or any consideration other than to create an arbitrary shape which indicates origin and distinguishes the applicant’s goods in commerce.\(^\text{133}\) These considerations apply equally to registration on both registers.\(^\text{134}\)

At common law, no trademark rights as such existed for the shape of a package or container. In 1946, Congress enacted § 23 of the Lanham Act\(^\text{135}\) providing for the registration on the Supplemental Register of, among other things, a mark which constitutes a “package.”\(^\text{136}\) Registration on the Supplemental Register constitutes recognition that the package is nonfunctional, capable of indicating origin and capable of distinguishing the registrant’s products from other products.\(^\text{137}\) Such registration acts as an initial step to obtaining acceptance on the Principal Register.\(^\text{138}\)


132. Id.

133. In re Winnebago Industries, Inc., 174 U.S.P.Q. 404 (T.T.A.B. 1972). In In re Fre-Mar Industries, Inc., 158 U.S.P.Q. 364 (T.T.A.B. 1968), the applicant sought to register a canister shaped like a flashlight as a container for tire repair products. The shape, while functional for a flashlight, was distinctive for holding such products. It was adopted for the principal purpose of identifying the applicant and any functional features, such as the gripping surface, were simply incidental thereto. Accordingly, it was held to be registerable as a trademark.


136. 15 U.S.C. § 1091 states:

For the purposes of registration on the supplemental register, a mark may consist of any trade-mark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, or device or any combination of the foregoing, but such mark must be capable of distinguishing the applicant’s goods or services. (emphasis supplied).


138. Ex parte Haig & Haig Ltd., 118 U.S.P.Q. 229 (Comm't Pats. 1958). A mark must have been used for one year preceding the filing of an application for registration on the Supplemental
The package or container shape may become eligible for registration on the Principal Register if and when it acquires secondary meaning through customer association with the source.\textsuperscript{139} Registration on the Supplemental Register affords the registrant no presumptive right to exclusive use.\textsuperscript{140}

Registration on the Federal Principal Register requires either that the mark is arbitrary or inherently distinctive,\textsuperscript{141} or if the configuration is not inherently distinctive, it must be proven to have acquired secondary meaning.\textsuperscript{142} In other words, an applicant must present proof that a nondistinctive package or container creates a commercial impression separate and apart from the label and word marks appearing on the label. An applicant must show that the package serves as an indication of origin for the product inside the package or container.

There is no express provision in the Lanham Act for registration of container or package configurations on the Principal Register.\textsuperscript{143} By 1960, however, the Court of Customs and Patent Appeals held that the § 45 list of “word, name, symbol or device”\textsuperscript{144} was not an all-inclusive list, but that other types of marks were included within the list.\textsuperscript{145} Thus, container configurations also became registerable as trademarks on the Federal Principal Register.\textsuperscript{146}

**Functionality**

The doctrine of functionality has played a large role in limiting trademark and common law protection for package and container shapes. Trademark law did not develop to protect function,\textsuperscript{147} but to

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\textsuperscript{142} Application of Minnesota Mining and Mfg. Co., 335 F.2d 836, 838 (C.C.P.A. 1964).


\textsuperscript{144} See infra note 146.

\textsuperscript{145} In re Kotzin, 276 F.2d 411, 414 (C.C.P.A. 1960).

\textsuperscript{146} In the case of Ex Parte Haig & Haig, Ltd., 118 U.S.P.Q. 229 (Comm'r Pats. 1958) the applicant's distinctive PINCH bottle for scotch whiskey was granted registration on the Principal Register. Although the Principal Register did not expressly provide for "packages" or "containers," the Commissioner held that the nature of the article cannot preclude registration. The decisive question is whether the applicant's bottle functions as a trademark. The evidence established that the bottle had acquired a secondary meaning and registration was granted.

\textsuperscript{147} The nonfunctionality requirement is not created by statute but by court decisions. In re Mogen David Wine Corp., 328 F.2d 925, 931 (C.C.P.A. 1964). See In re Water Gremlin Co., 635 F.2d 841 (C.C.P.A. 1980), wherein the court refused to register a package design made to contain
protect the trademark owner's integrity of identity and to protect the public from confusion, mistake and deception.\textsuperscript{148} There is an overriding public policy of preventing monopolization of use of the container or package shapes which are mainly functional or utilitarian as opposed to shapes which are mainly arbitrary, artistic and designed to perform a source-indicating purpose.\textsuperscript{149} This is based upon a desire to assure the continued viability of the common law right to copy essential features of marketable products.\textsuperscript{150} Where, however, competition in the underlying product can be undertaken without necessarily adopting the competitor's non-functional designs, the law can grant protection to such designs.\textsuperscript{151}

In determining whether a package is registerable under the Lanham Act, the law requires that the configuration must be essentially functional in order to bar registration.\textsuperscript{152} The fact that a purely arbitrary container configuration may perform a function which could be served equally well by containers of many other shapes will not itself preclude trademark registerability if secondary meaning is established.\textsuperscript{153} Where a shape or feature of construction is arbitrary it may become a legally recognizable trademark because there is no public interest to be protected.\textsuperscript{154} In other words, protection is not denied

fishing sinkers because the configuration was considered functional. For a recent discussion of functionality, see Zelnick, The Doctrine of Functionality, 73 TRADE-MARK REP. 128 (1983).

\begin{enumerate}
\item[\textsuperscript{148}] See supra notes 106 through 117.
\item[\textsuperscript{149}] Keene Corp. v. Paraflex Industries, Inc., 653 F.2d 822, 824 (3d Cir. 1981); Vuitton et Fils S.A. v. J. Young Enterprises, Inc., 644 F.2d 769, 776-77 (9th Cir. 1981); Application of Deister Concentrator Co., 289 F.2d 496, 505 (C.C.P.A. 1961).
\item[\textsuperscript{150}] As stated long ago in Luminous Unit Co. v. R. Williamson & Co., 241 F. 265, 269 (N.D. Ill.), \textit{aff'd}, 245 F. 988 (7th Cir. 1917):
\begin{quote}
[Where the particular form is adopted to carry out economic, structural or functional requirements, such act is no evidence of fraud or unfair competition. Necessary elements of mechanical construction, essential to the practical operation of a device and which cannot be changed without either lessening the efficiency or materially increasing expense, afford no presumption of an interest to compete unfairly.
\end{quote}
\item[\textsuperscript{153}] Many shapes perform some utilitarian purpose but will not be considered "functional" in a trademark sense. In re Deister Concentrator Co., Inc., 289 F.2d 496, 506 (C.C.P.A. 1961). In Time Mechanisms, Inc. v. Qonaar Corp., 422 F. Supp. 905 (D.N.J. 1976), an ice-cream cone-shaped parking meter cover was held protectable even though it contained the parking meter components. Similarly, in In re Fre-Mar Industries, Inc., 158 U.S.P.Q. 364 (T.T.A.B. 1968), a flashlight shaped container for automobile tire repair parts was protectable even though it also functioned to contain the repair materials and in In re Mogen David Wine Corp., 372 F.2d 539 (C.C.P.A. 1967), a wine decanter configuration could be protected (if secondary meaning was established) even though it functioned to hold wine.
merely because the shape or feature also serves a useful purpose.\textsuperscript{155}

If, on the other hand, the package shape or feature contributes only to its utility, durability or effectiveness or the use with which it serves its function, it cannot be protected.\textsuperscript{156} This rule is to permit the public to benefit from useful progress in the industrial and commercial arts.\textsuperscript{157}

The question of functionality is not whether the mark itself, considered alone, is functional, but whether the mark, in relation to the product it contains is a functional part of that product.\textsuperscript{158} The principal issue is whether the configuration was dictated by functional or utilitarian considerations or by a conscious effort to create an arbitrary design or shape to indicate origin and distinguish the applicant's goods.\textsuperscript{159} In other words, was the shape adopted primarily to be orna-
mental, or to make the goods easier to pack, to use or to make even more saleable.\textsuperscript{160}

The fact that a design is recognizable as a source of origin is not alone sufficient to make it protectable or registerable.\textsuperscript{161} Functional shapes, though they may have attained a secondary meaning, are not entitled to trademark registration.\textsuperscript{162} The general consideration is whether the configuration was dictated by functional or utilitarian considerations or by a conscious effort to create an arbitrary shape to indicate origin and distinguish one’s goods.\textsuperscript{163} If a part or feature is functional to the configuration, then all similar configurations will have a similar functional part or feature.\textsuperscript{164} Such part or feature will not, therefore, be significant in identifying the configuration or in distinguishing between similar configurations.\textsuperscript{165} A purchaser would not think a functional part or feature was placed there to indicate who manufactured it. He would think it was put there simply because it is part of the nature of the product and is part of what makes it work.\textsuperscript{166}

The entire functionality doctrine stems from the public interest in enhancing competition.\textsuperscript{167} The question, as set forth in the Restate-
The courts, unfortunately, have not been consistent in defining either the scope or basic purposes of functionality. Some courts, following the Restatement, have expanded the functionality concept to include any feature that is considered to be an important ingredient in the commercial success of the product, while defining as nonfunctional those traits unrelated to the basic consumer demands in connection with the product.

The Restatement of Torts definition of functionality is very broad. It includes aspects of configurations which operate only to make them attractive and more marketable, thereby permitting extensive simulation. The comment to section 742 makes it clear that functionality depends on whether the feature affects or contributes to the efficiency of the product or the ease or economy of its manufacture or 

A feature of goods, or of their wrappers or containers, may be functional because it contributes to efficiency or economy in manufacturing them or in handling them through the marketing process. It may be functional, also, because it contributes to their utility, to their durability or to the effectiveness or ease with which they serve their function or are handled by users. When goods are bought largely for their aesthetic value, their features may be functional because they definitely contribute to that value and thus aid the performance of an object for which the goods are intended. Thus, the shape of a bottle or other container may be functional though a different bottle or container may hold the goods equally well. A candy box in the shape of a heart may be functional, because of its significance as a gift to a beloved one, while a box of a different shape or the form in which a ribbon is tied around the box may not be functional. Or a distinctive printing type face may be functional though the print from a different type may be read equally well. The determination of whether or not such features are functional depends upon the question of fact whether prohibition of imitation by others will deprive the others of something which will substantially hinder them in competition.
marketing. It does not require the defendant to establish that the feature was essential.\textsuperscript{173} This relieves the imitator of the burden of demonstrating that imitation of the feature was, in some way, essential. It implies that the availability of substitutes for the simulated feature is basically irrelevant.\textsuperscript{174}

It appears that the Restatement's drafters intended the definition to include aspects of goods which operate only to make the goods attractive and therefore marketable. A feature which gives the consumer a substantial reason for purchasing the product as opposed to merely distinguishing it from other products is considered functional.\textsuperscript{175} By contrast, if a feature serves primarily to identify a product and does not contribute substantially to the product's value, as determined by consumers, it is nonfunctional and may not be copied.\textsuperscript{176}

The broader scope of aesthetic functionality, which in turn permits the widest imitation, is illustrated by the Ninth Circuit's decision in \textit{Pagliero v. Wallace China Co.}\textsuperscript{177} In \textit{Pagliero}, the court permitted the defendant to copy the designs originated by the plaintiff for its hotel china.\textsuperscript{178} The plaintiff brought an unfair competition action under the Lanham Act, alleging that the defendant had copied the designs allegedly created and used by the plaintiff in its various lines of china.\textsuperscript{179} The plaintiff sought damages and an injunction against the use by a competitor of a name and design similar to that employed on the plaintiff's hotel china.\textsuperscript{180} Plaintiff claimed that the designs had become so associated in the minds of the public with plaintiff's business that common law trademark rights were established through secondary meaning.\textsuperscript{181} The Ninth Circuit Court of Appeals refused to enjoin imitation of the pattern, holding that the decorative features of china were very closely related to its saleability and were therefore functional.\textsuperscript{182}

\textsuperscript{173} \textit{Id.} The fact that a configuration or device may be produced in other forms or shapes does not necessarily detract from the functional nature of the configuration. \textit{Pagliero v. Wallace China Co.}, 198 F.2d 339, 344 (9th Cir. 1952); \textit{In re Honeywell, Inc.}, 187 U.S.P.Q. 576, 579 (T.T.A.B. 1975), \textit{aff'd}, 532 F.2d 180 (C.C.P.A. 1976).

\textsuperscript{174} \textit{See supra} note 172.


\textsuperscript{177} 198 F.2d 339 (9th Cir. 1952). For a recent discussion of aesthetic functionality, see Duff, \textit{Aesthetic Functionality}, 73 \textit{TRADE-MARK REP.} 151 (1983) and \textit{Note, The Broad Sweep of Aesthetic Functionality: A Threat to Trademark Protection of Aesthetic Product Features}, 51 \textit{FORDHAM L. REV.} 345 (1982).

\textsuperscript{178} \textit{Id.} at 344.

\textsuperscript{179} \textit{Id.} at 340.

\textsuperscript{180} \textit{Id.}

\textsuperscript{181} \textit{Id.}

\textsuperscript{182} \textit{Id.} at 343-44.
The court assumed the presence of secondary meaning and stated the well-established rule that protection against copying will not be extended to "functional" features, i.e., features which serve other than a trademark purpose and are important ingredients in the commercial success of the product. The aesthetically pleasing designs were held to be an important selling feature of the china and not adopted solely to indicate origin of manufacture. Since the defendant included its name as manufacturer on the underside of all its china, the court found no likelihood of confusion and permitted the defendant to continue using the designs.

The difficulty with accepting such a broad view of functionality is that it provides a disincentive for development of imaginative and attractive designs. The inquiry should instead focus on the extent to which the design feature is related to the utilitarian function of the product. When the design itself (including its package or container) is not significantly related to the utilitarian functions of the product, but is merely distinctive or arbitrary, then it is entitled to protection as a trademark if it is arbitrary in shape or has acquired the necessary secondary meaning.

Only recently has the concept of functionality been placed in a proper prospective by the Court of Customs and Patent Appeals in In re Morton-Norwich Products, Inc. There, the applicant sought to register a container shape as a trademark for spray starch and similar products. The Patent and Trademark Office examiner denied registration, finding the container to be "merely functional," "essentially utilitarian" and "non-arbitrary." The Trademark Trial and Appeal Board agreed.

The Court of Customs and Patent Appeals reversed, finding that the container shape was not barred from registration by reason of the functionality doctrine and remanded the case for further consideration.

183. Id. at 343.
184. The court went so far as to say "[T]he possibility that an alternative product might be developed has never been considered a barrier to permitting imitation. . . ." Id. at 344.
185. Id. at 344.
187. The Ninth Circuit Court of Appeals recently may have retreated from its holding in Pagliero. In Vuitton et Fils, S.A. v. J. Young Enterprises, 644 F.2d 769 (9th Cir. 1981), the court disapproved the district court's holding that "any feature of a product which contributes to the consumer appeal and saleability of the product is, as a matter of law, a functional element of that product." Id. at 773.
188. 671 F.2d 1332 (C.C.P.A. 1982).
189. Id. at 1334.
190. Id.
191. Id. at 1335.
of the secondary meaning issue.\textsuperscript{192} The court pointed out that many trial and appellate courts have failed to define the scope of functionality, merely concluding that if a configuration is "functional" it is not protectable and if it is "non-functional," it may be protected.\textsuperscript{193}

The court properly focused on functionality as an element of competition.\textsuperscript{194} The broad definition of the Restatement (and the oft-cited \textit{Pagliero} case) utilizing the terms "affects" and "contributes" was considered to be so broad as to be meaningless\textsuperscript{195} because every design "affects" or "contributes to" the utility of the article in which it is embodied.\textsuperscript{196} The correct inquiry is whether preventing competitors from copying the package will hinder effective competition.\textsuperscript{197} Citing the Lanham Act definition that a trademark is "any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others,"\textsuperscript{198} the court concluded that a container design could function as a trademark, so long as it was not functional and identified its manufacturer or seller.\textsuperscript{199}

Functionality, according to the \textit{Morton-Norwich} court, relates to the design of the thing being considered, that is, its appearance and not the thing itself.\textsuperscript{200} The degree of a design's utility, and not the mere existence of a utilitarian design, is the issue.\textsuperscript{201} Thus, the question is not whether the individual parts of a package are essential but whether the design of the whole assembly of those parts is essential.\textsuperscript{202}

A court must consider the degree of the design's utility.\textsuperscript{203} A shape is protectable unless the particular design is essential to its use.\textsuperscript{204} Previous courts had viewed this problem as one involving the need to copy

\textsuperscript{192} Id. at 1344.
\textsuperscript{193} Id. at 1337.
\textsuperscript{194} Id. at 1339.
\textsuperscript{195} Id. at 1340.
\textsuperscript{196} Id.
\textsuperscript{197} Id. at 1341.
\textsuperscript{198} Id. at 1336.
\textsuperscript{199} Id. at 1343.
\textsuperscript{200} There is a distinction between "de facto" functionality and legal or "de jure" functionality. The former is protectable but the latter is not. Id. at 1337. De facto functionality indicates that although the design of a container, or any of its features is directed at the performances of a function, it may be legally recognized as a designation of origin. De jure functionality indicates the design cannot be protected. Id. For example, in Fotomat Corp. v. Cochran, 437 F. Supp. 1231 (D. Kan. 1977), the roof of plaintiff's photo-center was considered de facto functional. It does protect people and the building's contents from the weather. This alone, however, does not mean the roof is considered functional in the legal, or de jure, sense.
\textsuperscript{201} Morton-Norwich, 671 F.2d at 1338.
\textsuperscript{202} Id.
\textsuperscript{203} Id.
\textsuperscript{204} Id.
TRADEMARK PROTECTION

in order to compete effectively in the market place. Stated another way, will prohibiting copying hinder the competitor in competition? Is the shape the best or one of a few superior designs available?

Most designs are utilitarian to some extent. This, in and of itself, will not bar registration. The fact that a container is highly useful and performs its intended functions well, does not render the shape functional. When the exact same functions may be performed by many other shapes there can be no functional advantage in the shape. It is not enough to say that the container design must be accommodated to the functions performed. The design must be dictated by them to be considered functional. As the Morton-Norwich court pointed out:

[A] molded plastic bottle can have an infinite variety of forms or designs and still [function] to hold liquid. No one form is necessary or appears to be 'superior.' The same functions can be performed by a variety of other shapes with no sacrifice of any functional advantage. There is no necessity to copy appellant's trade dress to enjoy any of the functions of a spray-top container.

The question whether a package configuration is essentially functional or utilitarian is generally not an easy one to resolve. The guidelines set forth in Morton-Norwich provide a stepping stone for the courts to review this principle in a more objective manner. Container and package designs, as opposed to product configurations, are usually not dictated by the functional requirements of the product. They can be more easily arbitrary and ornamental. Thus, when seeking registration or relief in court, the owner of a container or package (as opposed to a product) should be more readily able to establish the shape as non-functional. This, however, will not be enough to obtain protection for the configuration. There is another element one must establish—secondary meaning.

Secondary Meaning

Secondary meaning, the additional requirement for trademark

205. Id. at 1339.
206. Id.
207. Id. at 1338.
208. Id. at 1341-42.
209. Id. at 1342.
210. Id.
211. Id.
212. Id. (emphasis in original).
213. The term "Secondary Meaning" is somewhat of a misnomer. The plaintiff must actually prove that the primary meaning of the symbol is that the product comes from a particular source.
To establish secondary meaning the owner of the trademark must show that the package or container design identifies the source of the article in the consumer's mind and that purchasers are moved to buy it because of its source.

However, the fact that two competitors use similar or even identical packaging for their respective products, and that the purchasing public is likely to be confused as a result, does not alone establish that one company's package has obtained secondary meaning. If the buyer class is indifferent at the outset, and fails to associate a package shape with a company's product, the law will not afford protection, no matter how closely or deliberately it is imitated by another. Thus, if the company can not establish secondary meaning, a competitor's imitation of the package will not lead to the public's misidentification of its source.

The point of inquiry is whether the relevant public under-


As recently defined by the Second Circuit in American Footwear Corp. v. General Footwear Co., 609 F.2d 655, 663 (2d Cir. 1979), cert. denied, 445 U.S. 951 (1980):

The doctrine of secondary meaning requires not only that the mark have a subordinate meaning, but also that the primary significance of the mark in the minds of the consumers is the identification of the producer, not a designation of the product. The crucial question... always is whether the public is moved in any degree to buy an article because of its source. Each case must... be decided on its facts with consideration given to such elements as the length and exclusivity of use, sales levels, and extent of advertising and promotion.


The trademark laws do not protect against the possibility that a member of the general public might fall under the mistaken impression that the companies are related. Rather, the trademark laws are intended to protect those members of the public who are or may become customers of either from purchasing the products of one of them under the mistaken assumption that they are buying a product produced or sponsored by the other.


218 Spangler Candy Co. v. Crystal Pure Candy Co., 353 F.2d 641, 647 (7th Cir. 1965). As stated by MCCARTHY, supra note 28, § 15:16:
stands the mark as a designation of a particular origin. This may be an anonymous producer, since consumers often buy goods without knowing the personal identity or actual name of the manufacturer. The primary significance of the mark in the minds of the consumers must be the identification of the producer and not a designation of the product itself.

Secondary meaning is often difficult to establish. No precise

The important evidentiary point to be kept in mind is that evidence of the seller's efforts to achieve buyer association and secondary meaning is merely circumstantial evidence from which the ultimate factual conclusion may be inferred. The crux of the matter is whether the seller's efforts have borne fruit in the minds of a substantial number of buyers—do they, in fact, associate [the plaintiff's product] with a single source? (Emphasis in original).


Recently, it appeared that the federal district court in the Southern District of New York had accepted the argument that a plaintiff is entitled to protection if he can establish secondary meaning "in the making" even though secondary meaning has not yet attached to his mark. For example, the court granted protection in Orion Pictures Co. v. Dell Publishing Co., 471 Supp. 392 (S.D.N.Y. 1979). There, the pre-released publicity of a film not yet released was extensive and amply demonstrated. The court found that although secondary meaning, as such, did not exist because the film was not yet on the market, defendant's scheme for its own promotional literature, advertising and marketing, "was counting on the plaintiff's publicity as the primary means by which to promote" the defendant's product. Id. at 396. In National Lampoon, Inc. v. American Broadcasting Co., 376 F. Supp. 733 (S.D.N.Y.), aff'd on other grounds, 497 F.2d 1343 (2d Cir. 1974), the district court said:

Strong evidence of secondary meaning has been presented by plaintiff. . . . [E]ven assuming secondary meaning has not yet come to full fruition, "A mark with secondary meaning in the making should also be protected, at least against those who appropriate it with knowledge or good reason to know of its potential in that regard, or with an intent to capitalize on its quality. 'Piracy should no more be tolerated in the earlier stages of development of quality than in the later.'" 3 CALLMAN, UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES 356 (3d ed. 1971).

376 F. Supp. at 747.


Each case must be decided on its own facts. Secondary meaning is generally proven through extensive advertising, distribution availability, sales volume, length and manner of use, and market share, which create in the minds of the consumers an association between different products bearing the same mark. This association suggests that the products originate from a single source. These elements are all evidence of a party's intent to establish secondary meaning but are certainly not conclusive.


Sales per se, however, have no more evidentiary value than do sales figures, per se. The issue is not whether applicant's product is popular but rather whether the purchasing public recognizes the configuration of the container in which it is sold as an indication of source or origin. In re Semel, 189 U.S.P.Q. 285, 288 (T.T.A.B. 1975).


See also Johnny Carson Apparel, Inc. v. Zeeman Mfg. Co., 203 U.S.P.Q. 585, 590 (N.D. Ga. 1978) ("Plaintiff may have invested a great deal of money in advertising the suit and in pointing out its supposedly distinctive design features, but much more is required to establish secondary meaning"); In re Semel, 189 U.S.P.Q. 285, 287 (T.T.A.B. 1975) (substantial advertising of cylin-
Once an applicant can establish the non-functionality and secondary meaning (or distinctiveness) of his container or package configuration, he will be entitled to register it on the principal register, and receive all the statutory benefits therefrom. If he can prove only that the shape is non-functional and capable of becoming distinctive, then supplemental registration is in order.

Normally, however, companies do not display their goods in bare containers or packages without other source indicia. While it is often difficult to establish a secondary meaning to the contour of a container or package, there are shapes and forms of containers and packages which are so unique or distinctive that through long utilization, they do become associated with a particular product.

B. Section 43(a) of The Lanham Act

Although packaging can be registered on the federal register as a trademark, many businesses do not register container or package shapes, relying instead on Section 43(a) of the Lanham Act to obtain redress from infringement. Section 43(a) creates a distinct federal
The statutory tort of unfair competition designed to afford broad protection by providing a remedy to a party aggrieved by another's "false designation of origin" of his product, even though he does not have a federally registered trademark. The essence of a claim under § 43(a) is that a competitor's packaging or labelling deceives purchasers as to the source of its goods; i.e., that consumers buy the competitor's product and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any carrier to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or in the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.


The court in L'Aiglon Apparel, Inc. v. Lana Lobell, Inc., 214 F.2d 649, 651 (3d Cir. 1954), stated:

We find nothing in the legislative history of the Lanham Act to justify the view that this section is merely declarative of existing law. . . . It seems to us that Congress has defined a statutory civil wrong of false representation of goods in commerce...
thinking it to be that of the plaintiff.\textsuperscript{242} The factors relevant to this inquiry are essentially the same as those relevant in determining trademark infringement (secondary meaning and non-functionality),\textsuperscript{243} but


On its face, Section 43(a) gives standing to sue to "any person who believes that he is or is likely to be damaged." L'Aiglon Apparel Inc. v. Lana Lobell, Inc., 214 F.2d 649, 650 (3d Cir. 1954). The word "person" in this section includes "juristic persons" (e.g., firms, corporations, unions and associations as well as "natural persons"), 15 U.S.C. § 1127. Nor must the plaintiff be in actual competition with the alleged wrongdoer. F.E.L. Publications Ltd. v. National Conference of Catholic Bishops, 466 F. Supp. 1034, 1044 (N.D. Ill. 1978). The Second Circuit Court of Appeals has ruled, however, that this Section does not give standing to consumers. Colligan v. Activities Club of New York, Ltd., 442 F.2d 686, 687 (2d Cir. 1970), \textit{cert. denied}, 404 U.S. 1004 (1971).

\textsuperscript{243} Black & Decker Mfg. Co. v. Ever-Ready Appliance Mfg. Co., 684 F.2d 546, 550 (8th Cir. 1982); Vibrant Sales, Inc. v. New Body Boutique, Inc., 652 F.2d 299, 301 (2d Cir. 1981); Midway Mfg. Co. v. Dirksschneider, 543 F. Supp. 466, 484-85 (D. Neb. 1981); Howw Mfg., Inc. v. Formac, Inc., 213 U.S.P.Q. 793, 797 (N.D. Ill. 1981). However, the Second Circuit (Perfect Fit Industries, Inc. v. Acme Quilting Co., 618 F.2d 950, 952-54 (2d Cir. 1980); Flexitized, Inc. v. National Flexitized Corp., 335 F.2d 774, 781 (2d Cir. 1964), \textit{cert. denied}, 380 U.S. 913 (1965)) and Ninth Circuit (Audio Fidelity, Inc. v. High Fidelity Recordings, Inc., 283 F.2d 551 (9th Cir. 1960)) have held that secondary meaning is established merely by proving that the defendant has copied plaintiff's configuration. This rule was articulated by then Judge Learned Hand in American Chickle Co. v. Topps Chewing Gum, Inc., 208 F.2d 560, 563 (2d Cir. 1953):

[\textit{I}t is generally true that, as soon as we see that a second comer in a market has, for no reason that he can assign, plagiarized the "make-up" of an earlier comer, we need no more; for he at any rate thinks that any differential he adds will not, or at least may not, prevent the [inherently intentional] diversion and we are content to accept his forecast that he is "likely" to succeed. Then we feel bound to compel him to exercise his ingenuity in quarters further afield.]


\textit{[R]elief has been granted in New York in a wide variety of situations to insure that "one may not misappropriate the results of the skill, expenditures and labors of a competitor"...A doctrine particularly developed in New York is that of granting relief upon the theory of the misappropriation of a property right or a commercial advantage of another...Particularly where the defendant's conduct has involved a clear attempt to profit at the expense of plaintiff...New York courts have deemed the conduct to be unfair competition despite the fact that plaintiff's mark has not acquired a secondary meaning.}

As stated in Florence Mfg. Co. v. J. C. Dowd & Co., 178 F. 73, 75 (2d Cir. 1910), "\textit{It is so easy for the honest business man, who wishes to sell his goods upon their merits, to select marks and packagings that cannot possibly be confused with his competitor's that courts look with suspicion upon one who, in dressing his goods for the market, approaches so near his successful rival that the public may fail to distinguish between them."

The Fifth Circuit has also supported this proposition. In Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 263 (5th Cir.), \textit{cert. denied}, 449 U.S. 899 (1980), the court stated: "[\textit{I}ntent of defendants in adopting [its mark] is a critical factor, since if the mark was adopted with the intent of deriving benefit from the reputation of [the plaintiff] that fact alone 'may be sufficient to justify the inference that there is confusing similarity.'" Secondary meaning is not necessary if the package or container configuration is arbitrary or distinctive. Chevron Chemical Co. v. Voluntary Purchasing Groups, Inc., 659 F.2d 695, 702 (5th Cir. 1981).

However, even in New York relief based solely on intentional copying is not unlimited. In E. R. Squibb & Sons, Inc. v. Cooper Labs, 536 F. Supp. 523 (S.D.N.Y. 1982), the court stated that prior knowledge of plaintiff's mark alone will not be grounds for relief when the mark is not
the scope of inquiry into similarity of design is considerably broader.\textsuperscript{244} Section 43(a) is meant to protect the public from confusion as to the source of goods being purchased.\textsuperscript{245} Secondary meaning becomes important in the protection of containers and packages under this statutory provision,\textsuperscript{246} because without it, no inference of deception exists.\textsuperscript{247} Consumer confusion of two products is not proof that the arbitrary or suggestive. There may be many legitimate reasons for copying a descriptive mark other than to confuse the purchasing public as to source.

The applicability of a defendant's intent was placed in proper prospective in Brooks Shoe Mfg. Co., Inc. v. Suave Shoe Corp., 533 F. Supp. 75 (S.D. Fla. 1981), \textit{aff'd}, 716 F.2d 854 (11th Cir. 1983). There, the court stated that intent is only one factor to be considered in establishing secondary meaning. The Second Circuit ignores the requirement that in order to obtain trademark protection, a plaintiff must establish that its mark is associated by the public with one source. To this effect the court stated:

By contending that secondary meaning should be implied when intent to \textit{copy} is proven, Plaintiff is asking this Court to find a violation of section 43(a) solely on the basis of Defendant's intent without requiring proof of secondary meaning or likelihood of confusion. This approach could result in the imposition of liability based on Defendant's subjective intent instead of an objective determination that there is a likelihood that the public would be confused. The Court feels that such an approach would be improper because section 43(a) was designed to protect the public from deceptive trade practices, not to punish persons who copy a mark or a name, and the requirement of proving secondary meaning insures that liability will only be imposed when the trade practice at issue is truly deceiving.

533 F. Supp. at 82 n.14 (Emphasis in original).

\textit{See also} Original Appalachian Artworks, Inc. v. Toy Loft Inc., 684 F.2d 821, 831-32 (11th Cir. 1982). "The defendant's intent to tread on the goodwill of the plaintiff, while certainly a relevant factor in establishing a likelihood of confusion... is not the only factor." (Citation omitted).


It means that wrongful diversion of trade resulting from false description of one's products invades that interest which an honest competitor has in fair business dealings—an interest which the courts should and will protect... . It represents, within this area, an affirmative code of business ethics whose standards can be maintained by anyone who is or may be damaged by a violation of this segment of the code. In effect it says: you may not conduct your business in a way that unnecessarily or unfairly interferes with and injures that of another; you may not destroy the basis of genuine competition by destroying the buyer's opportunity to judge fairly between rival commodities by introducing such factors as falsely descriptive trade-marks which are capable of misinforming as to the true qualities of the competitive products.


Proof of confusion, by itself, is not sufficient to support a \textsection 43(a) claim for false designation of origin when the product is not registered. Plaintiff must establish secondary meaning (\textit{see supra} notes 168 through 187). 15 U.S.C. \textsection 1114, which provides the principal remedy for violation of a
consumers associated its package or container with a particular source. A competitor may desire to copy a container shape merely because he finds it attractive; and if the shape is not associated with any particular source, the consuming public will assume it is simply a typical package or container used in the industry and will not make assumptions as to its sources.  

When the packaging of a product has attained a secondary meaning, the purchasing public associates that package with the producer of the product, not just with the product itself. If a competitor then copies that package, the public is likely to believe that the competitor's product is also produced by the original producer. Under such circumstances the plaintiff can establish a false designation of origin within the meaning of the statute.

The additional requirement of 43(a) is that the copied features be nonfunctional. This requirement limits protection to unique or distinctive identifying features of an object and is indicative of a concern that first-comers not be allowed to prevent the widespread use of useful but nonpatentable features.

Section 43(a) does not require the showing that anyone has actu-

registered mark, permits recovery when copying "is likely to cause confusion." Section 43(a), however, does not use the language "likely to cause confusion." The reason for this difference is that a registered mark is presumed to represent the source of origin in the minds of the purchasing public while unregistered marks do not. Plaintiff must prove secondary meaning. John Deere and Co. v. Payless Cashways, Inc., 681 F.2d 520, 523 (8th Cir. 1982); Vibrant Sales, Inc. v. New Body Boutique, Inc., 652 F.2d 299, 304 (2d Cir. 1981), cert. denied, 455 U.S. 909 (1982). See Vuitton et Fils S.A. v. J. Young Enterprises, Inc., 644 F.2d 769, 774, 775 (9th Cir. 1981) (plaintiff's handbag design was registered on the Principal Register and the court thus assumed the mark was intended to indicate the product's origin. The burden thus shifts to the defendant to rebut the presumption of plaintiff's right to such protected use). Waples-Platter Companies v. Gen. Foods Corp., 439 F. Supp. 551, 574 (N.D. Tex. 1977).

248. In Spangler Candy Co. v. Crystal Pure Candy Co., 235 F. Supp. 18 (N.D. Ill. 1964), aff'd, 353 F.2d 641 (7th Cir. 1965), the defendant sold a candy sucker in packaging and shape almost identical to plaintiff's. In fact, the defendant admitted that he tried "to get as close to (plaintiff) as I thought good ethics and good taste would allow me to." 353 F.2d at 643. Without proof of secondary meaning, however, the court refused to grant relief. See also Keebler Co. v. Revira Biscuit Corp., 624 F.2d 366 (1st Cir. 1980) (cylindrical cans for soda crackers) and Brooks Shoe Mfg. Co. v. Suave Shoe Corp., 533 F. Supp. 75, 93 (S.D. Fla. 1981).

249. See supra notes 213-36.

250. "The question is what is the likely ultimate impression, upon customers and potential customers of the relevant... products which will be created by what is said and what is reasonably implied." Dallas Cowboys Cheerleaders v. Pussycat Cinema, 467 F. Supp. 366, 374 (S.D.N.Y. 1979), aff'd, 684 F.2d 546 (2d Cir. 1979) (emphasis by court).


ally been deceived. The courts have interpreted the statute as applying to situations where the misleading designation has a tendency to deceive, or is likely to cause confusion. A right to relief exists, however, only if the total impression of the package, including its size, shape, color and design, upon the customer will be likely to cause him to confuse the origin of the product.

C. Common Law Unfair Competition

Trademark protection is based on whether a certain symbol actually functions as an indicia of source and whether the defendant's symbol is likely to cause confusion. Unfair competition law is much broader. It encompasses misappropriation of the skill, expenditures and labor of another. There, the issue revolves around the total selling image of plaintiff's product, package and advertising. The relevant inquiry is whether the parties' product's overall impression is


aff'd, 604 F.2d 200 (2d Cir. 1979).

254. Id. Original Appalachian Arts, Inc. v. Toy Loft Inc., 684 F.2d 821, 831 (11th Cir. 1982).


256. See supra notes 106 through 116.

257. Hesmer Foods, Inc. v. Campbell Soup Co., 346 F.2d 356, 358 (7th Cir.), cert. denied, 382 U.S. 839 (1965). The essence of unfair competition is the sale of one's own goods for those of another person. Standard Paint Co. v. Trinidad Asphalt Mfg. Co., 220 U.S. 446, 461 (1911). The purposes of unfair competition are three-fold: "first to protect the honest trader in his business; second, to punish the dishonest trader who diverts his competitor's business by unfair means; and third, to protect the public from deception." 3 CALLMANN, UNFAIR COMPETITION, TRADE-MARK AND MONOPOLIES § 34, at 32 (1967).

Traditionally, trademark infringement is but a part of the broader law of unfair competition, the general purpose of which is to prevent one person from passing off his goods or his business as the goods or business of another. Hanover Star Milling Co. v. Metcalf, 240 U.S. 403, 412-14 (1916). Unfair competition involves any violation of a right arising from the operation of an established business. The focus, generally, is on the buyer's likely confusion between two products based on an examination of everything that is likely to have an impact upon the purchaser. MCCARTHY, supra note 28, at § 2.2. "The essence of... unfair competition is fair play." Time Mechanisms, Inc. v. Qonaar Corp., 422 F. Supp. 905, 915 (D.N.J. 1976).


likely to cause confusion. If so, then a finding of unfair competition is justified. The elements a court must consider are broad. Anything which the ordinary purchaser sees, including the size, shape, color(s), of a package or its label is included. Once the first user can establish a likelihood of confusion between its products and another's, relief will be justified.

CONCLUSION

Packaging continues to play a significant role in successfully marketing products to the public. Large amounts of time, money and effort are expended to distinguish one's product from another. There are various methods whereby a company can protect its packaging once it establishes that it is distinctive (or has acquired a secondary meaning) and is nonfunctional. It is essential that each be kept in mind when designing a package shape. All too often, one finds too late that its configuration is not protectable and all the energy used to develop it can be appropriated by a competitor with little or no sanctions available to remedy the situation.


It is often stated that the law of trademarks is only a part of the broader law of unfair competition. The distinction between trademark infringement and unfair competition has been stated in Jean Patou, Inc. v. Jacqueline Cochran, Inc., 201 F. Supp. 861, 863 (S.D.N.Y. 1962), aff'd, 312 F.2d 125 (2d Cir. 1963), as follows:

Trade-mark infringement rests on a relatively narrow principle compared to unfair competition. The essential element of a trade-mark is the exclusive right of its owner to use a word or device to distinguish his product. On the other hand, a claim of unfair competition considers the total physical image given by the product and its name together. Thus unfair competition exists if the total impression of package, size, shape, color, design and name upon the consumer will lead him to confuse the origin of the product.


262. Id. at § 8.3.