

# Dilemma of Trade Dress, Informational Values and Enigmatic Distinctiveness; Semiotics Illuminating the Status of Distinctiveness

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## Introduction:

Nowadays, we are living in the most visualized world. Every day and everywhere we are looking at plenty of visual characters that each one has stood to a specific concept. Visual communication in all its manifestations provides a broad framework which sufficiently flexible to reflect varying degree of realism.<sup>1</sup> We are surrounded by symbolic visual signs that have been used to direct our attentions to a specific source. They mutely *illustrate* some kind of information which is taken by us interpretatively. At the same time, we are commonly using verbal signs to communicate and more specifically *explain* our intended messages. We employ a lingual system of communication to conclusively and less interpretatively express our messages.<sup>2</sup>

Principally, any system which a sign utilizes to communicate will put it in an independent structural position. In an informational-commercial context, different utilized communicational systems have emerged as various and independent

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<sup>1</sup>G. H. Jamieson, *Visual Communication: More Than Meets the Eye* 16 (Bristol Intellect Books, 2007),

<sup>2</sup> Roland Barthes, "The Rhetoric of the Image" in *Image, Music, Text* 39 (Stephen Heath, et al. trans. 1977). ("all images are polysemous; they imply, underlying their signifiers, a 'floating chain' of signifieds, the reader able to choose some and ignore others. Polysemy poses a question of meaning and this question always come through as a dysfunction.")

trademark subject-matter. Within the trademark law system, each of *word mark* and *trade dress* plays its own communicational roles based on laws which govern each of lingual and visual systems of communication. Classically, word marks have been the most traditional communicational tools by which producers have strived to interact with their relevant consumers. Over time, in particular, within modern commercial context, visual presentation intensively or even primarily<sup>3</sup> has been used for introducing the commercial identities. Producers have begun to use visual signs like shape, color, packaging, designs, etc., to identify and distinguish their goods/services.

In the U.S. trademark law trade dress generally is referred to “[t]he overall appearance and image in the marketplace of a product or a commercial enterprise.”<sup>4</sup> From a legal point of view, assimilating the concepts “trademark” and “trade dress” lies in the expanding nature of modern trademark system. Originally, trade dress protection was not classified as a subsection of trademark system; rather distinctive packaging and product designs were protected through common law action for unfair competition.<sup>5</sup> Hence, the semantic distinction between trademark and trade dress emanates from the historical line which has been demarcated between the law of unfair competition and trademarks.<sup>6</sup>

From a historical point of view, protection of what is known as “trade dress” could be divided into protection of packaging or “dressing” and product designs.<sup>7</sup> In its very nature, it was matched up to packaging or labeling for goods and products’

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<sup>3</sup> Sandra Moriarty, Visual Communication as a Primary System, 14 Journal of Visual Literacy, 11, 21, (1994). “I would like to suggest that visual communication is as much a primary system as verbal language, and that language based communication has been inappropriately privileged in contemporary Western culture.”

<sup>4</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992) (citing *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983)). It is also defined as “[t]otal image and overall appearance [which] may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques “. *Two Pesos*, 505 U.S. at 764-65 n.1 (quoting *Blue Bell Bio-Med. v. Cin-Bad, Inc.*, 864 F.2d 1253, 1256 (5th Cir. 1989) and *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983).

<sup>5</sup> RESTATEMENT (Third) of Unfair Competition § 16 cmt. a. (1995)

<sup>6</sup>J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 8:1 (3d ed. 1995)

<sup>7</sup> RESATEMENTS *supra* note 5.

“Trade dress traditionally includes the appearance of labels, wrappers, and containers used in packaging a product as well as displays and other materials used in presenting the product to prospective purchasers. The design features of the product itself are also sometimes included within the meaning of “trade dress,” although the substantive rules applicable to the protection of product designs differ in some respects from those applicable to packaging and related subject matter.”

designs were not considered as “technical trademarks.”<sup>8</sup> Through time, teleological interpretations of the concept of “trademark” resulted in that courts circumspectly considered the shape or configuration of products as protectable trade dress.<sup>9</sup> In 1946 Congress enacted the Lanham Act to prohibit “unfair competition” which caused by using “in commerce any word, term, name, symbol, or device, or any combination thereof “or any “false designation of origin,” a “false or misleading description of fact,” or a “false or misleading representation of fact”.<sup>10</sup> Subsequent to the Act’s passage, courts began to protect trade dress primarily by referring to common law action against unfair competition.<sup>11</sup> With the passage of time, the courts gradually come to recognize trade dress as a newfound version of trademarks.<sup>12</sup> In that course, especially after its 1988 amendment the term “device” in Section 43(a) of Lanham Act has had a formalistic role in paving the way to create trade dress with its modern *trademarkized* concept.<sup>13</sup>

We know trademark system does not, in essence, get its value from its ability to incentivize innovation or creativity; rather it is valued because of its informational applicability. By the same token, trade dress as a new member of trademarks’ family should be analyzed and examined within the same framework which trademarks are valued. It is clear that trade dress as a visual material is supposed to play the same role which traditional trademarks like word marks, should do.

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<sup>8</sup>SocieteAnonyme de la Distillerie de la Liqueur Benedictine de L'Abbaye de Fecamp v. Puziello, 250 F. 928, 928 (E.D.N.Y. 1918). “The statute of February 20, 1905, allowing the registration of a trade-mark in use for more than 10 years, does not alter the fundamental proposition, that a trade-mark is a design or mark rather than a container or package.” ;Philadelphia Novelty Mfg. Co. v. Rouss, 40 F. 585, 587 (C.C.S.D.N.Y. 1889) “[I]n ordinary circumstances, the adoption of packages of peculiar form and color alone, unaccompanied by any distinguishing symbol, letter, sign, or seal, is not sufficient to constitute a trade-mark.”

<sup>9</sup> Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 209 (2000); “[t]rade dress”--a category that originally included only the packaging, or “dressing,” of a product, ... in recent years has been expanded by many courts of appeals to encompass the design of a product.”

<sup>10</sup> Lanham Trademark Protection Act ch.540, § 1, 79 Pub. L. No. 489, 60 Stat. 424, 15 U.S.C. §1125, section 43(a)

<sup>11</sup> Amy B. Berge, Trade Dress Protection: What’s Left for the States?, 27 N. Ky. L. Rev. 1056, (2000).

<sup>12</sup> See Two Pesos, *supra* note 4, at 764-65 n.1 (quoting Blue Bell Bio-Med. v. Cin-Bad, Inc., 864 F.2d 1253, 1256 (5th Cir. 1989) and John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 980 (1th Cir. 1983).

<sup>13</sup> Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 162 (1995) “The term ‘trade-mark’ includes 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.” *See also* S. REP. No. 100-515 (Sept. 7, 1988), § 35. Explaining that “[a]s written, Section 43(a) appears to deal only with false descriptions or representations and false designations of geographic origin. Since its enactment in 1946, however, it has been widely interpreted as creating, in essence, a federal law of unfair competition. For example, it has been applied to cases involving the infringement of unregistered marks, violations of trade dress and certain nonfunctional configurations of goods and actionable false advertising claims. *See also* Kipling v. G.P. Putnam's Sons, 120 F. 631, 636 (2d Cir. 1903) (“it is customary to publish books with ornamental designs stamped or printed on the covers, but no one... ever imagined that such pictures and ornaments were the trade-marks of the authors of the books.”

Part I of the present article seeks to as a matter of fact assess trade dress's potentiality of communicating information within an informative context. In that part, we try to explain that how and to what extent trade dress as a visual indicator is capable of meeting the trademark system's goals by serving the richer and easier information to retrieve. Moreover, we show that how trade dress's more effective abilities could positively affect the producers and consumers' economic interests.

Basically, in an informational context materials are valued based on their degree of making the system richer. The way by which a trademark *inter alia* trade dress could promote the quality of an info-commercial system is the element of "distinctiveness". Generally, there are two kinds of distinctiveness which marks should at least have one of them; (1) inherent distinctiveness; (2) acquired distinctiveness or secondary meaning. To be considered as an inherent distinctive it could be *presumed* that the mark immediately and upon its use could serve as a source identifier.<sup>14</sup> Otherwise, it should be proved that by long use it has developed a secondary meaning so that consumers come to understand it as a designator of the goods/services of a specific trader.<sup>15</sup> To be eligible for protection, a trade dress as a trademark should distinctively make its relevant goods/services identifiable and distinguishable. Trademark's context has routinely accustomed to face with the question of distinctiveness when it is posed in regard to traditional trademarks. The expanding scope of trademark subject-matters which has led to create the non-traditional trademarks (like trade dress) has made the question of distinctiveness more than ever challengeable. Since, any independent system (like, visual, lingual, auditory, etc.) of communication through which symbolic signs produce meaning has its own structures, analyzing each one of them based on the others' rules would result in some basic inquiries. In terms of trade dress

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<sup>14</sup> McCarthy, *supra* note 6, § 11:4 Two Pesos, *supra* note 4, at 763, 768, ("[A] mark is inherently distinctive if "[its] intrinsic nature serves to identify a particular source.")

<sup>15</sup> BLACK'S LAW DICTIONARY 199 (4th ed. 1968); "While generic names, geographical names, and names composed of words which are merely descriptive are incapable of exclusive appropriation, words or names, which have a primary meaning of their own, such as words descriptive of the goods, service, or place where they are made, or the name of the maker, may nevertheless, by long use in connection with the business of the particular trade, come to be understood by the public as designating the goods, service, or business of a particular trader. This is what is known as the doctrine of "secondary meaning"; and is the origin of the law of unfair competition, as distinguished from technical trademarks or trade-names. Saunders System Atlanta Co. v. Drive It Yourself Co., 158 Ga. 1, 123 S.E. 132, 135; Richmond Remedies Co. v. Dr. Miles Medical Co., C.C.A.Mo., 16 F.2d 598, 602." Two Pesos, *supra* note 4, at 769 ("When used to describe a product, they do not inherently identify a particular source, and hence cannot be protected. However, descriptive marks may acquire the distinctiveness which will allow them to be protected under the [Lanham] Act.")

distinctiveness, this problem has emerged as employing the rules of verbal signs' system for analyzing visual signs system. In the case of examining trade dress distinctiveness, the U.S. Courts have always found themselves choosing between the traditional test (*Abercrombie* spectrum) which is originally accorded to verbal marks and constructing a tailored test which is commensurate with innate characteristics of trade dress. In that course, in Part II we have divided the courts into three groups of courts with ontological, traditional and neutral approaches. We have traced and explain the essentials of all three approaches and criticized the main decisions especially at the Supreme Court level. In this part we have found that no one of the courts whether with ontological, traditional, or neutral approaches has suggested a concrete, applicable criterion toward the question of trade dress distinctiveness. Accordingly, in part III we have tried to give a more precise analysis employing semiotics. In this section, it is shown that from a semiotic point of view visual signs system within which trade dress communicates its messages has a different structural status in comparison with a lingual system. Therefore, trade dress requires an independent analysis which completely makes its mechanism of making the distinction more interpretative than lingual signs. Meanings which a trade dress will produce do not come out obviously; they are latent and wait to be explored.

***Trade dress informational value within the informational context:***

In its ancient format, the marks as possessive and proprietary indicators involved the signing cattle and animals.<sup>16</sup> It is uncontested that historically the trademark law has fundamentally constructed to put both producers and consumers in a protective position.<sup>17</sup> In other words, source indicating as the informational-protective function is the main bases and functional arms of trademarks.<sup>18</sup> This is what the senate in its 1999 report has supposed regarding the trademark's functions

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<sup>16</sup> Diamond SA ,The Historical Development of Trademarks, 73 Trademark Rep. 223, (1983). See also L Bently and B Sherman, Intellectual Property Law, 639 (2d ed. Oxford University Press 2004)

<sup>17</sup> B Mahaffey-Dowd, Famous Trademarks: Ordinary Inquiry by the Courts of Marks Entitled to an Extraordinary Remedy, 64 Brook L Rev 424. (1998); See also Dan Shanahan, The Trademark Right: Consumer Protection or Monopoly?, 72 Trademark Rep. 234, 239 (1982). He argues that trademark law has served this property through its primary function i.e. source indication. In his view, other functions are secondary or derivative traits.

<sup>18</sup> Mark A. Lemley, The Modern Lanham Act And the Death Of Common Sense, YALE L.J.1687,1715 (1999), referencing Ralph S. Brown, Jr., Advertising And the Public Interest Legal Protection of Trade Symbols" reprinted in 108 YALE L.J. 1619, 1621 (1999), quoting from Learned Hand "[w]e are nearly sure to go astray in [trademark law] as soon as we lose sight of the underlying principle that the wrong involved is diverting trade from the first user by misleading customers who mean to deal with him."

based upon the Lanham Act. It restated that the primary trademark's functions are two dominant things;

[O]ne is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trademark owner.<sup>19</sup>

The Senate Report for the 1988 amendments also provides that the words "symbol or "device" are covered under the definition of a trademark "so as not to preclude the registration of colors, shapes, sounds or configurations where they function as trademarks."<sup>20</sup> In the case of trade dress protection, the same rationales have been adopted in *Two pesos, Inc. v. Taco cabana, Inc.* stating that, "Protection of trade dress, no less than of trademarks, serves the Act's purpose to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers".<sup>21</sup>

Justice *White* in the course of proving the trade dress's ability to be inherently distinctive has supported his arguments through contending that trade dress as a newfound kind of trademarks have shared rational and functions with trademarks in its traditional sense. This framework of addressing the trademark is the information-transmission model which is traditionally applied to justify the traditional trademarks.<sup>22</sup> As the most basic rational, this model finds its applicability in the informational connection which trademarks could establish between consumers and producers. Based on this model consumers and producers are put in positions in which they are considered as two fundamental bases of trademark system and each of them will be benefited due to the other's role in that

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<sup>19</sup> S. REP. No. 79-1333 (1946) as reprinted in 1946. U.S.C.C.A.N. 1274, 1274-75

<sup>20</sup> S. REP. No. 100-515, at 44 (1988); U.S. Code Cong. & Admin. News, 1988, at 5577, 5580

<sup>21</sup> 505 U.S., 112 S.Ct. 2753, 763, 769 (1992)

<sup>22</sup> Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86, B.U.L. REV.547, 549(2006). Contending that "[T]he core of trademark law, as it is understood today, is based on a model which I shall call the "information transmission model." This model views trademarks as devices for communicating information to the market and sees the goal of trademark law as preventing others from using similar marks to deceive or confuse consumers".

framework.<sup>23</sup> As a matter of fact, trademark rights including trade dress is not an in essence absolute and independent property right which could be treated like other kinds of property rights; rather it should be principally examined so that it is not a property right unless it maintains its informational value.<sup>24</sup> Just like other human social contracts in “state of nature”<sup>25</sup> – e.g. materials of language or even designating a magistrate to rule\_ trade mark system and particularly trade dress should also be addressed as a co-created contractual thing that society (producers and consumers) has designed to do some pre-intended socio-economic purposes.<sup>26</sup> Accordingly, the protective function of trademark system whether for consumers by preventing from deception or for producers by securing their good will has emanated from the *informational interaction* between producers and consumers.<sup>27</sup> The unconditionality which this model suggests for the sake of information transmission between its parties, i.e. producers and consumers, has potentially paved the ways to have such a teleological deduction that anything which has a potential for carrying a message might be employed as a trademark. This kind of instrumentalism is what nowadays emerges as trademark subject-matter’s expansion. Therefore, by virtue of that informative understanding which in fact is based on the consumer-producer, approach it seems that trade dress should be analyzed and examined just like a communicative tool which trademark system has lately developed to facilitate reaching its goals.<sup>28</sup> According to the broad and teleological definition of trademarks which in *Qualitex Co. v. Jacobson Products*

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<sup>23</sup> However some scholars believe that consumers will ultimately enjoy trademark system. Producers’ competition will eventually benefit consumers. For example Dogan and Lemley arguing that “[s]ince consumers are the ultimate intended beneficiaries of trademark protection, one could argue that it [makes] more sense to vest [the right to control the use of trademarks] in consumers, not producers.”. Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461, 467 (2005).

<sup>24</sup> Stacey L. Dogan & Mark A. Lemley, *A Search Costs Theory of Limiting Doctrines in Trademark Law*, 97 Trademark Rep. 1228, (2007). Stating that “[F]irst and most generally, trademarks are not property rights in gross, but limited entitlements to protect against uses that diminish the informative value of marks.”

<sup>25</sup> It refers to the pre-contractual condition that human society had no political or organized order in its legal sense. See Ross Harrison, *Locke, Hobbs, and Confusion's Masterpiece; An Examination of Seventeenth-Century Political Philosophy* 70 (Cambridge University Press, 2003)

<sup>26</sup> Lord Mackenzie Stuart, *The Function of Trade Marks and the Free Movement of Goods in the European Economic Community*, IIC Int. Rev. Ind. Prop. Copyr. Law, 27,30 (1976)

<sup>27</sup> We believe other functions that have ever been proposed justifying the trademarks efficiency like promoting producer’s competition, enhancing marketplace efficiency, producing with high quality and so on, are all springing from the informative equity of trademarks. See Daniel M. McClure, *Trademarks and Unfair Competition: A Critical History of Legal Thought*, 69 Trademark Rep. (1979); Nicholas Economides, *The Economics of Trademarks*, 78 Trademark Rep. 526 (1988).

<sup>28</sup> Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 Va. L. Rev. 2099, 2121–2 (2004). He pointed out that the recent expansions within US trademark law inter alia trade dress protection are due to “core information transmission” models which influenced by enforcement costs.

Justice *Breyer* handed down “*almost anything [which]...is capable of carrying meaning*”<sup>29</sup> could be regarded as a protectable trademark. He also went on to found that “[i]t is the source-distinguishing ability of a mark not its *ontological* status as color, shape, fragrance, word, or sign that permits it to serve these basic purposes.”<sup>30</sup> In the modern world within which we are bombarded by a huge amount of symbols that are signaling their relative targets, using human sensory abilities like the visual ability to symbolize any tradable thing would not be unexpected. We have building and shaping our commercial vision by words and by images which we have gathered into our mind over time.<sup>31</sup> The filled up memories with a huge number of verbal signs make a proper room to use consumers’ mental imagery to build and shape their commercial outlook. As a communicative instrument which is acting within an informational context it would be interesting to claim that trade dress in its legal definition which is basically founded on visual characteristics of goods or services *per se* or their packaging could meet the late informational rational even in more effective way than trademark in its restricted sense. According to what explained if it is supposed that one of the most important factors in proving the efficiency of the trademark system<sup>32</sup> is consumer’s ability to recall and memorize a mark and its associated features<sup>33</sup> trade dress as a trademark would enjoy much more justifications via serving more visible image to recall. This is what will influence the interests of the both groups of consumers and producers.

### ***Visual Information as Valuable and most Transmittable units***

There are several technical studies in the realm of communication science which have proposed a series of models which illustrate the mode of communication between designs and consumers through the visual properties of objects. These

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<sup>29</sup> *Qualitex Co. v. Jacobson Prods.*, 514 U.S. 159, 162-64 (1995), stating that: “Since human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning this language read literally in not restrictive”.

<sup>30</sup>*Id.* at 164-71.

<sup>31</sup> Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 974 (1993).

<sup>32</sup> Consumers’ ability to distinguish and to secure the mark owners’ goodwill through preventing confusingly use of similar marks

<sup>33</sup> Economides, *supra* note 28, arguing that “[T]he degree of a trademark's success is a function of: (a) the consumer's ability to recall the mark and its associated features; (b) the inability of others to use a confusingly similar mark; and (c) the reluctance of firms to change the variety and quality features of the trade-marked product”. It is obvious that these aforementioned factors only when can prove the trademark’s system efficiency that operate interdependently. In other words, whenever the function of each of these factors is enhanced and promoted other factors will be influenced to function better consumer’s ability to recall.



models suggest that regardless of the geometric and other measurable facets the good/services' visual attributes *inter alia* their packages will be able to function as a transmitter of the goods/services' source information.<sup>34</sup>

Simultaneously, from psychological point of view, if it is assumed that the relevant consumers in the market have been playing a role just like one a learner supposed to play in a learning process it would be uncontested that “*nodes*” (meaning) could be interlocked and retrieved more effectively in the consumers’ “*cognitive network*” (mind) when a producer uses the visual forms.<sup>35</sup> Technically speaking, applying packaging or goods/services’ *own* visual features as a three-dimensional medium of communication could reduce the consumers’ “*extraneous cognitive load*”<sup>36</sup> to link or in its legal term *associate* with a design as a distinctive source indicator.<sup>37</sup> When a good/services’ visual attributes are used to transmit some information into the consumers’ minds all visual elements which construct the goods/services’ appearance could have a trademark role within an overall image. Therefore, in a comparison between traditional trademarks and their parallel trade dress the traditional trademarks in spite of their visibility due to their small space that they occupy in the whole body of a good/service will have lesser chance to retrieve a specific good/service which they have been affixed.<sup>38</sup> Speaking in

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<sup>34</sup>W. L. SCHRAMM, *How communication works*, In THE PROCESS AND EFFECTS OF MASS COMMUNICATION 3-26. (1961). *See also* R. MONÖ, *Design for Product Understanding: The Aesthetics of Design from a Semiotic Approach*, (Stockholm, Liber. 1997). *See also* Annika Olsson & Andreas Larsson, *Value Creation in PSS Design through Product and Packaging Innovation Process*, In INTRODUCTION TO PRODUCT/SERVICE-SYSTEM DESIGN, 93, 100 (Tomohiko Sakao, Mattias Lindahl ed., 2009). (Concerning the communicative function of packaging they arguing “[I]n the business to consumers domain the package is the interface of the product to the consumers and must be considered as the integrated part of product. The integrated product and package system ... can help to communicate with user what kind of outcome they can expect from using a product or service.”)

<sup>35</sup> J. Jacoby, *The Psychological Foundations of Trademark Law: Secondary Meaning, Genericism, Fame, Confusion and Dilution*. 91 Trademark Rep. 1013, 1025 (2001)

<sup>36</sup> The Cognitive Load Theory initially developed by John Sweller in the late 1980s. Based on this theory, there are three main types of cognitive load i.e. intrinsic, germane and extraneous. Each of the aforementioned types of cognitive load can influence and subsequently reduce the quality of a learning process. The intrinsic load refers to the inherent difficulty of the topic which is generally immutable. The germane load refers to the loads which emanate from the processing and functions of the schemas. The extraneous load is related to the manner of representing the information to the learner. The instructional design of tasks has an important role in reducing the two late types of loads. The situation in which consumers need to recall a good/service’s source information reducing the extraneous load could have an important effect on facilitating and quickening the process of retrieving. The studies which have been done in this regard have shown that using the visual mediums could considerably limit the level of extraneous load that probably will be imposed on consumers as learners. For more information *see*, P. Chandler & J. Sweller, *Cognitive Load Theory and the Format of Instruction*, 293–332 (1991).

<sup>37</sup> Lawrence Solan, *The Oxford Handbook of Language and Law*, 482 (2011), *see also* R. Clark, et al., *Efficiency in Learning: Evidence-Based Guidelines to Manage Cognitive Load*, (2006).

<sup>38</sup> However, it is worth mentioning that this kind of arguments could be accurate provided that the juxtaposition is between trade dress and the marks such as verbal, device, graphical marks which their main or primary way to be

contradiction with word marks, when the concept of a trademark is transfigured into the concept of trade dress any visible part of the good/service acts as a visual symbol which conveys a hierarchy of meaning which embodies a thousand words to express verbally.<sup>39</sup>

Merging with the economical perspective, these advantages of trade dress could pave the way to lessen *search costs* even more than traditional trademarks to prevent uncalled for and undesirable selections.<sup>40</sup> In info-economic term, when a lots of information are compacted into a trademark the cost of what a consumer might be incurred through allocating time and money to investigate a good/service's attributes will be lessened.<sup>41</sup> Consumers will pay for shorthand information of a trademark as long as the profits are higher than costs which properly they will incur without using trademarks. As a doctrinal matter, as the opportunity cost<sup>42</sup>, time<sup>43</sup> and monetary cost get lesser the applicability and efficiency of *what* by which the search cost get lessened (regardless of what it is) will be increased. Accordingly, a tool which is easier and swifter to transmit the source, price or quality information is the more effective tool for decreasing search

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perceived is via sight. For instance, concerning verbal marks, in first phase they are seen and in second phase they will be read and perceived. Therefore, regarding other non-visible trademarks which are in connection with other human senses like aural or scent marks the comparison would not be appropriate.

<sup>39</sup> Keith Aoki, *How the World Dreams Itself to Be American: Reflections on the Relationship between the Expanding Scope of Trademark Protection and Free Speech Norms*, 17 *Loy. L.A. Ent. L. Rev.* 523, 526 (1997)

<sup>40</sup> *Qualitex*, *supra* note 30, at 163-64. (Arguing that trademark law "reduce[s] the customer's costs of shopping and making purchasing decisions" (quoting McCarthy, *supra* note 6, § 2.01[2], at 2-3.))

<sup>41</sup> WM Landes and R A Posner, *The Economics of Trademark Law*, 78 *Trademark Rep.* 270 (1988). (Stating that "I need not investigate the attributes of the brand I am about to purchase because the trademark is a shorthand way of telling me that the attributes are the same as that of the brand I enjoyed earlier."); *see also* *Qualitex*, *supra* note 30, at 163-64, ("[T]rademark law, by preventing others from copying a source-identifying mark, 'reduce[s] the customer's costs of shopping and making purchasing decisions,' for it quickly and easily assures potential customer that this item-the item with this mark-is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past.")

<sup>42</sup> An opportunity cost is the "[c]ost of an alternative that must be forgone in order to pursue a certain action. Put another way, the benefits you could have received by taking an alternative action". So if the selection is made wrongly the opportunity cost will be increased through missing the other alternative selections which consumer might make to purchase. Trademarks could lessen this risk cost by information which they provide for consumers. Opportunity cost is also "[t]he basic relationship between scarcity and choice". Investopedia, accessed via <http://www.investopedia.com/terms/o/opportunitycost.asp>. James M Buchanan, "opportunity cost", *The New Palgrave Dictionary of Economics*. Second Edition. Eds. Steven N. Durlauf and Lawrence E. Blume. Palgrave Macmillan, (2008). *The New Palgrave Dictionary of Economics Online*. Palgrave Macmillan. [http://www.dictionaryofeconomics.com/article?id=pde2008\\_O000029](http://www.dictionaryofeconomics.com/article?id=pde2008_O000029) doi:10.1057/9780230226203.1222 (last visited 16 April 2016)

<sup>43</sup> Stigler, George J. 'The Economics of Information', 69 *J. Pol. Econ.* 213-225 (1961). (He has pointed out that time is the effective factor in evaluating the search cost. Concerning the role of time in searching costs he has argued: "[a]side from the differences in tastes time will be more valuable to a person with a larger income". He has continued, trademark and advertising in general will reduce the search costs via determine the places of sellers and buyers.)

costs.<sup>44</sup> For the modern society, which is becoming more visual rather than lexical,<sup>45</sup> trade dress could ease the process and shorten the time required to get relevant information by serving as a *characterful* image which can be vividly retrieved. In this regard, consider a consumer in a competitive market who has entered a supermarket and is faced with many kinds of goods which are put on the shelves. That consumer has already purchased and experienced a good with a specific or favored price or quality and now wants to purchase another one. In this scenario, the consumer has two choices to find their favorite good: by retrieving its traditional trademark, or by intuitively recollecting the production or package's overall visual features. In today's marketplace, many consumer decisions are made only by employing the visual communication which impresses and directs consumers' minds to receive a specific, indicative message from them. Concerning the visual properties, particularly of goods/services with more a unique appearance, the overall image will be easier and faster to be retrieved than a sign which is located on a part of a good or used in some parts of a service. A consumer could spend his/her time and energy scanning shelves to find his favorite good's traditional trademark among numerous trademarks, or alternatively could try to find them by *their own distinctive* visual attributes like shape, size, package and other visual features which he/she has saved in his memory.<sup>46</sup> When a product or service *by itself* (presuming the design and package as an integrated visual pack) could play a trademark role as independent of its parallel traditional trademark, the consumer will gain access to a more obtainable and less effortful and time-consuming search to retrieve information. At this point, through more efficient and actual indicators, the informational and economic values of trade dress converge and make a strong info-economic effect. As Professor Beebe observes:

Quite obviously, consumer search costs are minimized only to the extent that the trademark (as signifier) *actually* refers to a

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<sup>44</sup> William Landes & Richard A. Posner, "Trademark Law: An Economic Perspective", 30 J.L. & Econ. (1987) 274-75; *see also* Stephen L. Carter, The Trouble with Trademark, 99 Yale L.J. 759, 761 (1990). ("Successful trademarks are valuable because of the information that they convey.")

<sup>45</sup> Graeme B. Dinwoodie, The Death of Ontology: A Teleological Approach to Trademark Law, 84 IOWA L. REV. 615 (1999), "[O]ur semiotic senses are in state of tumult. Society is becoming more visual and less lexical."

<sup>46</sup> Wal-Mart Stores v. Samara Bros 529 U.S. 205, 212, (2000) ("[A] garish form of packaging (such as Tide's squat, brightly decorated plastic bottles for its liquid laundry detergent) may attract an otherwise indifferent consumer's attention on a crowded store shelf")

product or source for which the consumer is searching. Similarly, product quality is enhanced only to the extent that the owner of a trademark attaches that trademark (as signifier) to products whose quality it *actually* controls. Both the semiotic and economic accounts of trademark law are concerned with the *informational* efficiency and integrity of the trademark system, and both assume that the sign must be intact for this efficiency and integrity to obtain.<sup>47</sup>

By the same token, presuming that trade dress could act more effectively in lessening search costs, it could be argued that in a competitive market within which the total price of a good is formed of the nominal price and the cost of searching, these more facilitative advantages of trade dress for information transmission will increase the social welfare<sup>48</sup> (by decreasing social loss), motivate the competitive state and, improve product quality<sup>49</sup>. At least from a theoretical point of view, all of those benefits would be possible by promoting higher *quality of information*.<sup>50</sup>

On the supply side, the public policy inhering to trade dress as being beneficial to consumers as an informational asset could be re-applied to producers in terms of their goodwill.<sup>51</sup> Within an information-based structure, anything that helps to enrich the quality of applicable information would certainly benefit all parties who are contributing to the system.<sup>52</sup> Therefore, as much as it is proved that trade dress could act efficiently in providing consumers with richer and more accessible

<sup>47</sup> Barton Beebe, *The semiotic account of trademark doctrine and trademark culture*, In TRADEMARK LAW AND THEORY A HANDBOOK OF CONTEMPORARY RESEARCH, 42, 48 (Graem B. Dinwoodie & Mark D. Janis eds. 2008 )

<sup>48</sup>Mark P. McKenna, A Consumer Decision-Making Theory of Trademark Law, 98 VA. L. REV, 68,74 (2012) citing William M. Landes& Richard A. Posner, “The Economic Structure of Intellectual Property Law”, 30 J.L. & Econ. 265, 274-79, (Arguing that “the total cost of a good is an aggregate of the nominal price and the cost of searching with respect to that good. When search costs are reduced, social welfare is increased because the cost premium a brand owner charges for trademarked goods is less than the cost of a search without the trademarks.)

<sup>49</sup> Scandia Down Corp. v. Euroquilt, Inc., 772 F.2d 1423, 1430 (7th Cir. 1985) “A trademark also may induce the supplier of goods to make higher quality products and to adhere to a consistent level of quality”

<sup>50</sup>Stacey L. Dogan& Mark A. Lemley, *supra* note 25, (Arguing that “Trademark law . . . aims to promote more competitive markets by improving the quality of information in those markets.”)

<sup>51</sup> Robert G. Bone, *supra* note 23, at 556. (“[I]t is certainly possible to restate the core policies of trademark in terms of “goodwill” by equating goodwill with all the information consumers have about a specific brand.”)

<sup>52</sup> Barton Beebe *supra* note 48, at 48, (Arguing that “[B]oth the semiotic and economic accounts of trademark law are concerned with the *informational efficiency* and integrity of the trademark system.”)

source information, producers will benefit by having a greater ability to prevent others from using their goods/services indicative outward appearance in a confusing manner and appropriating their market reputation and goodwill. In today's market milieu within which consumers purchase products or services to bring meaning to their lives, differentiation through establishing a reciprocal interaction between producer, consumer, and products/services' designs, plays a vital role in preserving a producer's commercial and competitive position within their market.<sup>53</sup> Hence, when the visual features of a good/service (excluding purely or aesthetically functional one feature) could *potentially* function as an indicator of source, a producer will have access to numerous *potential* trademark rights for each visual feature of his production. From a legal standpoint, this broadened capacity will provide producers with more powerful tools to strongly secure their goodwill against their rivals and allow them to gain a competitive advantage by obtaining a trademark right over their source-identifying and distinguishing goods/services' face.

The imaginary channel of communication between producers and consumers will provide to both parties an uncomplicated way of interaction which does not need any pre-existing source of information (language) for comprehension. In today's modern society, which is becoming ever more detextualized,<sup>54</sup> employing a visual language as a way of communication will provide producers with the potential of circumventing many linguistic, cultural, and geographical restrictions<sup>55</sup> and also illiteracy related issues<sup>56</sup> which plague word marks. From an informational perspective, what makes a sign capable of conveying information (acting as a signifier) and being a legally protectable trademark is an element of *distinctiveness*. Trade dress is designed to serve the same purposes as word marks, and they thus both require distinctiveness to be a legally protected trademark.

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<sup>53</sup> Keiko Powers, *Color Design and Purchase Price: How Vehicle Colors Affect What Consumers Pay For New and Used Cars*, *THE PSYCHOLOGY OF DESIGN: CREATING CONSUMERS APPEAL*, 87, (Rajeev Batra, Colleen Seifert & Diann Brei Routledge eds. 2016). See also Adèle Martin & Denis Darpy, *Design and Identities: the Case of Carsharing* "19th DMI: ACADEMIC DESIGN MANAGEMENT CONFERENCE DESIGN MANAGEMENT IN AN ERA OF DISRUPTION", 51,53 (Erik Bohemia, et al. eds. 2014)

<sup>54</sup> Graeme B. Dinwoodie, *supra* note 46, at 641, (Observing that "[i]n our culture a wide range of things are doing what verbal trademarks were originally meant to do. This is facet of the detextualization of society, and the cause of a third convergence concern.")

<sup>55</sup>*Id.*

<sup>56</sup> Thomas S O'Connor, "Trade dress: The increasing importance of an ancient yet new form of intellectual property protection", 67 *Journal of Business Research*, 303,306 (2014).

However, to what extent do trade dress and word marks perform their functions similarly? Could they be treated and examined by applying the same criterion? These are the main questions which illustrate a tension between traditional trademarks and trade dress.

## ***II. Distinctiveness; shared prerequisite, different in assessment:***

As a doctrinal concept, the principal shared function between trade dress and trademark protection is the distinctiveness clause. However, in practice, just as one dress could have its own posture and be looked at differently when put on by two different persons, applying a distinctiveness requirement for trade dress has its own special challenges and characteristics. The non-traditional quiddity of the trade dress as a newly attached member to the traditional trademarks' family has put it in a position in which it has challenged the traditional rules of the distinctiveness prerequisite. In the language of the Lanham Act, a mark is distinctive when it "identif[ies] and distinguish[es] [a party's] goods . . . from those manufactured or sold by others" and "indicate[s] the source of the goods."<sup>57</sup> In the informational context, trade dress; like other kinds of trademarks, should legally have a sufficient amount of both constitutional elements of distinctiveness i.e. *source distinctiveness* (an identifier) and *differential distinctiveness* (a distinguisher).<sup>58</sup>

There are two different approaches to examining distinctiveness as a prerequisite for trade dress: traditional and ontological. The ontological approach tries to examine trade dress distinctiveness according to the intrinsic characteristics of trade dress, while the traditional approach tries to assume trade dress as an example of trademarks that could be treated just like other traditional trademarks. Relying upon the traditional approach, trade dress distinctiveness should be treated like other trademarks and be evaluated based on the traditional tests, specifically using the *Abercrombie* spectrum, which categorizes trademarks into specific classes. In the next section, we look at each of these approaches with an emphasis on the relationship between word marks and trade dress. The trade dress distinctiveness requirement is more problematic given that the Supreme Court has not provided clear guidance to lower courts in how to determine whether a given

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<sup>57</sup> 15 U.S.C. § 1127.

<sup>58</sup> Barton Beebe, *supra* note 49, at 52 stating that "[T]rademark law should reconceptualize trademark distinctiveness as consisting of source distinctiveness and differential distinctiveness."

trade dress is distinctive. In other words, the Supreme Court's judgments simply compel lower courts to consider secondary meaning for different kinds of trade dress, but do not prescribe guidance by which the courts should be applying the distinctiveness test for trade dress.<sup>59</sup>

#### *A. The ontological approach:*

The ontological approach has been employed by courts which describe trade dress as an entity which is correlated to trademarks, but which nevertheless draw a distinction based on the innate capacities of trade dress.<sup>60</sup> For the purpose of analyzing this approach, we have selected two salient cases which more than other similar cases have developed this kind of treatment concerning trade dress distinctiveness. One of the remarkable cases in which the court tried to develop a test upon the ontological approach is *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*<sup>61</sup> In this case the Court of Customs and Patent Appeals (CCPA) developed a special *objective* test for product designs. It held:

In determining whether a design is arbitrary or distinctive this court has looked to whether it was a "common" basic shape or design, whether it was unique or unusual in a particular field, whether it was a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods, or whether it was capable of creating a commercial impression distinct from the accompanying words.<sup>62</sup>

The court asked whether the trade dress is "capable of creating a commercial impression distinct from the accompanying words".<sup>63</sup> In addition, the court, rather than applying the *Abercrombie* test, which focuses on the relation between a mark and its associated product/service,<sup>64</sup> set forth a structural explanation founded on

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<sup>59</sup> *Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd.* 40 F.3d 1431, 1442 (3d Cir. 1994).

<sup>60</sup> In *Wal-Mart Stores Inc. and Qualitex Inc.*, the Supreme Court ultimately required proof of secondary meaning for product designs. However, the tests which have been applied by the courts with ontological approach are important for perceiving the whole image of trade dress's distinctiveness.

<sup>61</sup> 568 F. 2d. 1342 (C.C.P.A. 1977)

<sup>62</sup> *Id.*, at 1344.

<sup>63</sup> *Id.*

<sup>64</sup> Several courts subsequently have adopted this test seeking to determine the inherent distinctiveness of product configurations. See *Ashley Furniture Industries, Inc.*, 187 F.3d 363; *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d

the relationship between the past relevant creatures in the field and the trade dress at issue.<sup>65</sup> Presuming that there is a reliable source in the past to refer the court concluded that only the features which are “unusual” or “unique” in relation to the other homologous designs could be considered as an inherent trade dress.<sup>66</sup> By this resolution, the court has wanted to put the perception of relevant consumers at the center of the question of distinctiveness. It also devised the “*relevant field*” as the referential source that a trade dress should be examined in reference to. By doing so, the court has developed a quasi-patent test in which the concept of inherent distinctiveness has been reintroduced in a fashion that resembles the conditions “*novelty*” and “*non-obviousness*” in design patent examination. Within that framework, the “*relevant field*” should play the role that the “*prior art*” in patent context should do. Under that criterion, for the purpose of anticipating the consumers’ reaction<sup>67</sup> it should be determined if the trade dress in question is non-obvious or unusual *ex-ante* in the eyes of the public as ordinary observers.<sup>68</sup> In fact, the court by incorporating the role of consumers into its test attempted to consider the consumers’ perception as the active source of inquiring the distinctiveness. Under the test’s elements the questions of being unusualness, uniqueness and, on the other hand, not being “commonly-adopted” and “well-known form” should be explored in *reference to the public*.

But it is not clear that while the court could refer the public to answer the question of unusualness or uniqueness why won’t it be able to refer the question of distinctiveness to the public, specifically? In other words, when in the court’s opinion there is no problem with surveying the public’s mind regarding the commonness of a design why should it not be simply surveyed as the question of distinctiveness, generally?

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27 (1st Cir. 1998); *Landscape Forms, Inc.*, 113 F.3d 373; *Duraco Products, Inc.*, 40 F.3d 1431; *Krueger Int’l, Inc.*, 915 F. Supp. 595.

<sup>65</sup> *Stuart Hall Co., Inc. v. Ampad Corp.*, 51 F.3d 780, 787 (8th Cir. 1995).

<sup>66</sup> This idea has also been pointed out by the Restatement (Third) of Unfair Competition; stating that using the common features “makes it unlikely that consumers will view them as distinctive of the good or services of a particular seller.”, RESTATEMENT, *supra* note 5, § 13, cmt.d. See also *McCarthy, supra* note 6, §7.2 at 7-5.

<sup>67</sup> *In re Days-Ease Home Products Corp.*, 197 U.S.P.Q. 566,568 (T.T.A.B. 1977); (“[T]he question of inherently distinctive obviously must be determined in relation to... which would condition the reaction of purchasers to the shape, and what would be the anticipated reaction of the average purchaser to this shape.”).

<sup>68</sup> *Crouch, Dennis, A Trademark Justification for Design Patent Rights*, 24 *Harv. J. L. & Tech.*, 2, 31 (stating that “[t]he design patent distinctiveness measures of novelty and non-obviousness are also ascertainable *ex ante* (even before any product reaches the hands of a consumer) as opposed to the *ex post* creation of trade dress rights. In this sense, design patents could be seen as filling the position of inherently distinctive trade dress that was eliminated in *Wal-Mart*”).



Also, the court has tied the inherent distinctiveness to the unusualness and uniqueness of designs and presumed that when a design is uncommon in the eyes of consumers it would necessarily mean that it signifies the source of the good. But even in cases wherein it is proved that a design is uncommon and even when it is determined in reference to consumers it could not be presumed that the design in question will be able to identify the source.<sup>69</sup> Actually, the positive answer to the question of uniqueness or unusualness just merely indicates the quality of uniqueness or usualness not the source of a symbol within an informational context. Put differently, a potential correlation or disrelation between a design and other designs in the field does not imply a causation or non-causation of engendering inherent distinctiveness. The court ignored that a trade dress is supposed to act in a structure in which the primary duty of a mark is to transmit some sort of information which help consumers to identify a product/service's origin. Without any referential source of designs' meaning and also the countless possibilities in which a design might be embodied mere being uncommon or unique could at best guarantee a signifier's ability to be distinctive *from* other signifiers not distinctive *of* the signified.<sup>70</sup>

### ***B. Packaging v. product design***

Over years, in response to the inapplicability of traditional categorical approach (*Abercrombie* spectrum) the courts with an ontological approach have developed their idea of demarcating a bright line between product design and other forms of trade dress's distinctiveness. Within this group, the Third Circuit in *Duraco Prods., Inc. v. Joy Plastic Enter. Ltd.*<sup>71</sup> developed a compound test which was specifically designed for product designs.

The Third Circuit in *Duraco Prods.Inc.* kept the way that the court in *SeabrookFoods, Inc.* had already started. The court argued "that trade dress is inherently distinctive only if 'so unique, . . . in a particular market, that one can assume, without proof, that it will automatically be perceived by customers as an

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<sup>69</sup> Graeme B. Dinwoodie *supra* note 45, at 657, (noting that "[A] unique design should not be regarded as inherently distinctive merely because of its uniqueness, although clearly that helps.")

<sup>70</sup> Barton Beebe *supra* note 47, at 52, (stating that "Corresponding to the semiotic relation of 'signification,' source distinctiveness describes the extent to which a trademark's signifier is distinctive of the signified. Corresponding to the semiotic relation of 'value,' differential distinctiveness describes the extent to which a trademark's signifier is distinctive from other signifiers in the trademark system.")

<sup>71</sup> 40 F.3d 1431,(3d Cir. 1994)

indicia [sic] of origin—a trademark”<sup>72</sup> It totally denied the properness and suitability of categorical tests to be applied for product configurations arguing that there is no chance to establish a dialectic relationship between a product and its design as a symbol of which one can relate the signifier to the signified.<sup>73</sup> But the court did not clarify that if the product design has no symbolic meaning then how a product design could transmit the source information.<sup>74</sup>

However, the court developed its own test and found that to be inherently distinctive a product design must be “(i) unusual and memorable; (ii) conceptually separable from the product; and (iii) likely to serve primarily as a designator of origin of the product.”<sup>75</sup> It explained that to be unusual the trade dress must have “a unique, individualized appearance, so that a consumer informed of all the options available in the market could reasonably rely on it to identify a source.”<sup>76</sup> The court did not specify how and by what parameters should ascertain these terms. Also it is not clear how referencing to a consumer who is informed of *all* available options in the market would be operable. Is there any reasonable consumer who is well informed and cognizant of *all* possible and available options?

The “memorability” also has been explained as “striking or unusual in appearance, or prominently displayed on the product packaging or otherwise somehow apt to be impressed upon minds of consumers, so that it is likely to be actually and distinctly remembered”. Requiring memorability which trademarks’ informational sufficiency for transferring the source information are dependent on is a redundant condition which does not add much anything to the analysis.<sup>77</sup> However, it seems the court wanted to illustrate the process by which an overall image of a product would certainly be retrieved. Referring to other designs in the field to define usualness and memorability suggest that the court, like *Seabrook* test, attempted to

<sup>72</sup> Duraco Prod. at 1449, (quoting Martin P. Hoffman, “Trade Dress/Product Simulation Overview”, C913, A.L.I.-A.B.A. 219, 222 (1994)).

<sup>73</sup>*Id.*, at 1440-41

<sup>74</sup> Maybe, what the court intended was to articulate the trade dress’s signification in relation to other relevant trade dresses in the field. However, indication to the source (signified) is an essential part of distinctiveness which should not be ignored.

<sup>75</sup>*Id.*, at 1449

<sup>76</sup>*Id.*

<sup>77</sup> Smith, Lars S., Trade Distinctiveness: Solving Scalia’s *Tertium* Quid Trade Dress Conundrum, Mich.St. L. Rev. 243, 302. (2005) (Stating that “[t]his element does not appear to add much of anything to the analysis because if consumers cannot remember the mark, it obviously fails to identify and distinguish the source of the goods.”). Graeme B. Dinwoodie, Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress, 75 N.C. L. Rev. 471, 536 (1997). (Stating that “[t]he “memorable” nature of the feature would not appear to add very much to the analysis in predicting whether a shape or feature is likely to operate as a source identifier with consumers it surely is relevant that the shape is likely to register with the consumer.”)

articulate designs' distinctiveness as a most *contextualized*<sup>78</sup> matter in relation to other designs and most *determinative* in perspective informational context.

The second element of this test is conceptual separability of the trade dress from its product. The court explained that an inherently distinctive product design “must be recognizable by the consumer ‘as an indicium of the source, rather than a decorative symbol or pattern. . . .’”<sup>79</sup> The court improperly employed a counterpart notion of copy right’s rules which is originally devised to a different goal. Copyright law principally protects aspects of original works that do not fall within the scope of other provinces of intellectual property including useful parts which are fallen into the patent law’s domain. However, the US Copyright Act provides an exception to that rule by excluding the works which “can be identified separately from and are capable of existing independently, of the utilitarian aspects of the article.”<sup>80</sup> The court employs this appellation rejecting distinctiveness not for useful parts of designs but for esthetic features. Furthermore, it is not specified that how should it be determined whether an aspect of a design is mere ornamental or source indicator? How could it be predicted that a consumer will use which one of the visual attributes of a design to understand a product’s origin?

It seems the court futilely strived to make a completely probabilistic and contextualized matter as a predictable thing. In fact, when a design performs in a purchasing context all visual features of a design could potentially act as an informational transmitter and the consumers as receivers of that information are the only referential source who decides to take any of those features indicative or merely ornamental.<sup>81</sup> There are endless possibilities which unpredictably

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<sup>78</sup> What the court explained in defining the unusualness and memorability is something like what in psychology of visual perception known as theory of Top-down processing. Upon this theory (which has been proposed by Richard Gregory in 1970), the visual perception is a constructive process which is performed as a Top-down process. Accordingly, the viewers’ past experiences and prior related knowledge help to precept a stimulus, visually. Based on this theory, much of information reach the eye is lost on the way of reaching the brain. Therefore, hypotheses which flow from our past experiences, have a great role in our visual perception and retrieval. *See* for more information, Vicki Bruce et al. *Visual Perception: Physiology, Psychology and Ecology* 81-84 (Psychology Press, 2010); Nicky Hayes , *Foundations of Psychology* 46-49 (Cengage Learning EMEA, 2000).

<sup>79</sup> *Duraco Prod.* at 1449

<sup>80</sup> 17 U.S.C. § 101 (2000):

“Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”

<sup>81</sup> Rochelle Cooper Dreyfuss, *We Are Symbols and Inhibit Symbols, So Should We Be Paying Rent? Deconstructing The Lanham Act and Rights of Publicity*, 20 *COLUM.-VLA.J.L.& ARTS* 123, 153-54 (1996).

consumers take a seemingly ornamental feature as a source signifier and vice versa.

The same rationale could be applied criticizing the final part of the *Duraco Inc.* i.e. “likely to serve primarily as a designator of origin”. There are many of interrelated, variable and thus unpredictable parameters which within a purchasing context will influence consumers’ decisions.<sup>82</sup> Hence, out of a commercial situation and without knowing possible market’s facts, predicating consumers’ decisions just by application a design’s visual features as either source indicator or merely ornamental would be nearly impossible. However, the court imperfectly endeavored to articulate a non-conclusive evidentiary presumption in determining this part of the test. It contended that the producer’s intent of exerting a specific design is a reliable reference which could be addressed as an indication of that a design likely serves as a source designator.<sup>83</sup> The court did not propose any structure by which this part of test could be performed. Actually, it was not substantially able to explain any structure in this regard. Any structure should *ex ante* answer the question which logically no one except consumers would be able to answer, unless as *ex posted*. There could be no presumption that an adopted design would certainly fail or succeed in conducting consumers’ minds to take a design as distinctive or merely ornamental. It would vary based on consumers’ behavior which is completely affected by market’s circumstances.

It is clear that the courts both in *Duraco prods.* and *Seabrook Inc.* by introducing design marks as a dual interaction between product and consumers rather a triadic interaction between product, producer and, consumer sought to switch on an independent concept of signification within the trade dress context. But they failed in replacing an alternative which in addition to the relationship between a signifier and other signifiers explain the semantic relationship between a design and the signified. In other words, they failed to determine the point wherein the “*subjective*

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(Noting that designs have served a dual property of decorating and source identifying. He observes that in a purchasing context determining that consumers employ what kind of those properties is a contextualized matter.)

<sup>82</sup> Robert Unikel, Better by Design: The Availability of Trade Dress Protection for Product Design and the Demise of Aesthetic Functionality,” 85 Trademark Rep. 312. 335 (1995)

<sup>83</sup> This part of *Duraco*’s test is the same approach that followed by the Second Circuit in *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995). The court held that designs on children's sweaters are product features and that products’ designs are exerted to be primarily function as esthetic or functional elements. Therefore the proper test to determine inherent distinctiveness is to ask whether product features are “likely to serve primarily as a designator of origin of the product.” The Second Circuit like Third Circuit referred this question to the producer's intent to use a product design as source identification.

impressions that [a design] arouses in each observer and the *objective*, external thing to which it refers”<sup>84</sup> have converged to make a trade dress significant.

### ***C. The Traditional Approach***

Traditionally courts examine the trademarks distinctiveness upon a categorical approach which set forth by judge Friendly in *Abercrombie & Fitch Co. v. Hunting World, Inc.*<sup>85</sup> Based on this classification marks are classified in (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful. Under this test, the last three of these categories are deemed inherently distinctive while descriptive marks are protected only upon a showing of secondary meaning and generic could not inherently act as a protectable trademark. This categorical approach works well with work marks which have or will have a dictionary-based meaning.<sup>86</sup>

But, to what extent is it expected that this taxonomy could be transplanted to the trade dress? And to what extent could it function properly in determining the trade dress distinctiveness with no verbal reference. Moreover, contemplating the precedent of requiring the secondary meaning as the absolute condition for trade dress protection?<sup>87</sup> Could trade dress like traditional trademarks be examined by the same rules? Responding to such fundamental questions the Supreme Court in *Two Pesos, Inc. v. Taco Cabana, Inc.* broke the ground to employ the traditional test for trade dress. The Court reasoned upon the plain language of § 43(a) of Lanham Act which permits the registration of any mark "by which the goods of the applicant may be distinguished from the goods of others".<sup>88</sup> It also refused the

<sup>84</sup> Tom W. Bell, *Virtual Trade Dress: A Very Real Problem*, 56 M D. L. REV. 384, 412 (1997).

<sup>85</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4,9 (2d Cir. 1976).

<sup>86</sup>Mark P. McKenna, *Teaching Trademark Theory through the Lens of Distinctiveness*, 52 St. Louis U. Pub. L. Rev. 843, 848 (2008). Stating that “[I]t is relatively easy for courts to determine whether and how those meanings relate to the products or services with which they are used. But product design and packaging features rarely have such generally understood meanings, and as a result, the traditional framework is less helpful.”

<sup>87</sup> Stephen F. Mohr ET AL., *U.S. Trade Dress Law: Exploring the Boundaries* 11 (Int'l Trademark Ass'n eds.) (1997); The critical question[s] of fact . . . [are] whether the public is moved in any degree to buy the article because of its source and what are the features by which it distinguishes that source. (quoting *Crescent Tool Co. v. Kilborn & Bishop Co.*, 247 F. 299, 300 (2d Cir. 1917)). Before the *Two Pesos, Inc.*, there were plenty of lower courts which at least in the case of product configuration required proof of secondary meaning. *See, e.g., Vibrant Sales, Inc. v. New Body Boutique, Inc.*, 652 F.2d 299 (2d Cir. 1981); *LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 75 (2d Cir. 1985); *Union Mfg. Co. v. Han Baek Trading Co.*, 763 F.2d 42, 48 (2d Cir. 1985);

<sup>88</sup> *Two Pesos, Inc.*, *supra* note 4, quoting 60 Stat. 428. In spite of speared tendency of lower courts in requiring proof of secondary meaning some courts support suitability of trade dress to be considered inherently distinctive. *See,*

traditional nineteenth-century jurisprudence which requires proof of secondary meaning for “non-technical” marks which involve the elements of product’s packaging and other product’s features which were free to copy by all producers unless proving a secondary meaning.<sup>89</sup> The Court founded that when there are sufficient grounds to presume that a trade dress in an informational context could designate a brand from its very first use, there would be no need to require proof of secondary meaning.

While the necessarily imperfect (and often prohibitively difficult) methods for assessing secondary meaning address the empirical question of current consumer association, the legal recognition of an inherently distinctive trademark or trade dress acknowledges the owner’s legitimate proprietary interest in its unique and valuable *informational* device, regardless of whether substantial consumer association yet bestows the additional empirical protection of secondary meaning<sup>90</sup>

Therefore, given to the historical tendency in requiring secondary meaning for non-technical marks the Court needed a proper framework which has sufficient susceptibility giving a legal potentiality to reintroduce the trade dress as an entity which could *ab intio* originate its source without any need of proof of secondary meaning. As the most accepted criterion, the *Abercrombie* spectrum has such capacity to make the courts able to predict the consumers’ semantic reaction. The court’s belief of suitability of *Abercrombie* test of distinctiveness for trade dress is in spite the fact that it was fundamentally designed for language based signs not visual signs, which have their own mechanism to communicate.

Despite of that, the Court by means of a teleological interpretation of the statute argued that “trademarks and trade dress under § 43(a) serves the same statutory purpose of preventing deception and unfair competition” therefore “there is no

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e.g., *Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 696 (5th Cir. 1981) (holding that trade dress in the form of packaging could be protected under the Lanham Act without showing secondary meaning).

<sup>89</sup> James L. Hopkins, *Hopkins On Trademark* § 3, at 11 (1905). *See also*, *Avery v. Meikle & Co.*, 81 Ky. 73, 85-86 (1883); *Dennison Mfg. Co. v. Thomas Mfg. Co.* 94 Fed. 651, 657 (D. Del. 1899); In comparison to the *Abercrombie* taxonomy the “technical marks” might be categorized into fanciful and arbitrary marks and non-technical marks have been fallen into the descriptive marks. Amasa C. Paul, *The Law Of Trade-Marks Including Trade-Name and Unfaircompetition* §§22, 24 (1903)

<sup>90</sup> *Two Pesos, Inc.*, *supra* note 4, at 770-71 (quoting *Taco Cabana Int’l, Inc.*, 932 F.2d at 1120, n.7)

persuasive reason to apply different analysis to the two” toward applicability of *Abercrombie* test for the purpose of assessing their distinctiveness. In its language:

[it is] quite right... in this case, to follow the *Abercrombie* classifications consistently and to inquire whether trade dress for which protection is claimed under § 43(a) is inherently distinctive. If it is, it is capable of identifying products or services as coming from a specific source and secondary meaning is not required.<sup>91</sup>

At first glance, whether *Abercrombie* test could properly be applied for trade dress or not, there is some kind of irrelevancy in the Court’s way of syllogizing upon assimilating the trade dress and traditional trademarks’ distinctiveness. Actually, it is not clear on what basis the Court has deducted an *ontological* conclusion from a *teleological* argumentation. As the predicate-term if it is premised that trademarks could act as a tool for identifying/distinguishing a good/service among other similar breeds and trade dress could do this task too, the logic conclusion would be that trademarks and trade dress could be employed reaching the same goals; not that they have to be treated with the same manner. Based on the Court’s premises, trademarks and trade dress are incontrovertibly intended to meet the same purpose of enriching the informational culture and subsequently preventing deceptive or unfair competition. But it would not necessarily mean that they should be treated like each other in all aspects.<sup>92</sup> By way of example, both of pen and pencil are commonly intended to write, but each of these tools could meet this purpose by its own special *mechanism*. So, each of them should be examined based on its own innate characteristics; pen as pen and pencil as pencil. It would be an immaterial and irrelevant analogy if we *test* and *take* them as the same things just because of that they are both meant to write.

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<sup>91</sup>*Id.* at 774

<sup>92</sup> Graeme B. Dinwoodie *supra* note 45, at 656 noting that “[A]ssimilationists properly attribute to product design trade dress protection the same positive values as are assigned to trademark protection of words, and thus accord shapes equivalent protection as source identifier. But this model fails to acknowledge the important differences between words and shapes...”

At first stage, as mentioned, the Court in *Two pesos* has found that trade dress generally could be inherently distinctive.<sup>93</sup> In doing so, the Court arranged its arguments by employing the terms of *Abercrombie*. But it did not do that by using the test exhaustively. The Court tried to engraft the *Abercrombie* test onto trade dress with the trade dress own characteristics, but it failed to show that how it functions when employed for determining the distinctiveness of a trade dress. For instance, in the case of packaging, it held that “the first user of an arbitrary package, like the first user of an arbitrary word, should be entitled”<sup>94</sup> to be protected without showing that it acquires secondary meaning. However, it didn’t clarify *how* and *what kinds* of packages could function as arbitrary trade dress.

The Court eventually, held that the respondent’s trade dress (general appearance of the exterior and interior design of the restaurant) is inherently distinctive and accorded its finding with the terms of *Abercrombie* test.<sup>95</sup> Nonetheless, it didn’t specify that the trade dress at issue has been fallen into which one of suggestive, fanciful or arbitrary categories. These kinds of obscurities cast doubts on the applicability of the traditional test for trade dress, in particular product configuration, over lower courts.

#### ***D. Split among Lower Courts***

Within the period between *Two Pesos* and *Wal-Mart Stores*, the circuits left in bewilderment toward employing the taxonomical approach. This bewilderment engendered a split and eccentricity among the lower courts.<sup>96</sup> However, some of their findings to the advantage or disadvantage of assessing the trade dress distinctiveness based on the *Abercrombie* classification are remarkable. In *Pebble*

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<sup>93</sup> *Two pesos Inc.*, *supra* note 4, at 770

<sup>94</sup>*Id.* at 787

<sup>95</sup>*Id.* at 774. *See also* Chad M. Smith, *Undressing Abercrombie: Defining When Trade Dress Is Inherently Distinctive* 80 J. Pat. & Trademark Off. Soc’y 401, at 404 (1998) (Questioning about how a trade dress should be considered as an inherently distinctive upon the findings of the Court in *Two pesos Inc.*)

<sup>96</sup>There are many examples of cases in which the courts have endorsed applicability of *Abercrombie* taxonomy for trade dress *See, e.g.*, *Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695,702 (5th Cir. 1981); *Jeffrey Millstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27,31-32 (2d Cir. 1995), (applying the test for greeting cards’ design). *Best Cellars, Inc. v. Grape Finds at Dupont, Inc.*, 90 F. Supp. 2d 431, 451 (S.D.N.Y. 2000), “[T]rade dress is classified on a spectrum of increasing distinctiveness as generic, descriptive, suggestive, or arbitrary/fanciful”; *Insty\*Bit, Inc. v. Poly-Tech Indus., Inc.*, 95 F.3d 663,672-73 (8th Cir. 1997), *Stuart Hall Co., Inc. v. Ampad Corp.*, 51 F.3d 780, 785 (8th Cir. 1995), (The court adopted the *Abercrombie* taxonomy in determining inherent distinctiveness for all types of trade dress cases). *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 936 (7th Cir. 1989)



*Beach Co. v. Tour 181Ltd.*,<sup>97</sup> the Fifth Circuit upheld the traditional test to be applied for trade dress of a golf hole. The Court in that case, put trade dress in the same position in which word marks have stood in traditional test. Although, the court tried to shape and fit the concept of product configuration's distinctiveness into the *Abercrombie* test helping of auxiliary concepts, it defined the inherent distinctiveness in opposition to genericness and based on the *relationship* between a product and the features that form trade dress. It argued that where a trade dress would have relationship with the relevant product that it comprises some *commonplace features* of the good/service to which it is exerted. It pointed out when a trade dress is not commonplace (generic) that serves some "individualized characteristic".<sup>98</sup> At the same time, the court tried to define the suggestive trade dress comparing to the descriptive marks and argued that when a trade dress could be suggestive that "suggests, rather than describe, some particular characteristic of the good or services to which it is appli[ed]."<sup>99</sup> However, it did not clarify how a trade dress could suggest or describe the product/service to which the trade dress has been questioned.

In *Fun-DamentalToo, Ltd v. Gemmy Industries Corp.*,<sup>100</sup> the Second Circuit divided the trade dress's distinctiveness into two kinds of packaging and product configuration. The court tried to defend the applicability of traditional test for packaging cases and described products' generic configuration as "trade dress that consist of the shape of a product that conforms to a well-established custom is generic".<sup>101</sup> It exemplified its criterion stating that "the cosmetic industry's common use of black, rectangular shaped renders that packaging generic".<sup>102</sup> In this regard, it presumed that consumers commonly, unlike the product configuration, "rely on packaging for information about the product and its

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<sup>97</sup> 155 F.3d 526,(5th Cir. 1998)

<sup>98</sup> *Id.* at 541, citing *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790 (5th Cir.1983).

<sup>99</sup> *Id.*

<sup>100</sup> 111 F.3d 993, 1000-05 (2dCir. 1997)

<sup>101</sup> *See also*, *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 1570-71 (Fed. Cir. 1995) ("walking fingers" are generic for telephone directories). *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1048-49, 47 USPQ2d 1332, 1336-37 (9th Cir.1998) (holding that grape-leaf designs have become generic emblems for wine).

<sup>102</sup> *Fun-DamentalToo, Ltd.*, 111 F.3d at 1000. *see also* *Paddington*, 996 F.2d at 583-84 (soda industry practice would render green cans generic for the purpose of packaging lime-flavored soda). *Sunrise Jewelry Manufacturing Corp. v. Fred S.A.* 175 F.3d 1322, 1325-26 (Fed. Cir. 1999) (holding that a registered trade dress consisting of a "metallic nautical rope design" for clocks, watches, and jewelry is generic). *Nora Beverages, Inc. v. Perrier Group of Am., Inc.*, 164 F.3d 736, 744 (2d Cir. 1998)

source.”<sup>103</sup> The court noted that the product configuration lays in the product itself, therefore, could not be simply separated and defined as “descriptive “ or “arbitrary” in relation to the product they are applied. In contrast, the product packaging is associated with the product, thus, a “style creates an image of the product more readily separated from the product itself.”<sup>104</sup> Also, the court reasoned that unlike the product configuration which for there may be an infinite set of ways to configure, there is an endless number of packaging options which are just “limited only by bounds of imagination”.<sup>105</sup> Upon these arguments, the court concluded that the packaging are suitable to be examined based on the *Abercrombie* classification and there is no reason to abandon the traditional test and applying other non-traditional tests<sup>106</sup>

In *Ashley Furniture Industries, Inc. v. Sangiacomo N.A., Ltd.*,<sup>107</sup> the Fourth Circuit applied the traditional trademark test and found that the plaintiff's product configuration (furniture) might be inherently distinctive. The Court accepted that the plaintiff's trade dress has never been used in the bedroom furniture field and to be considered a distinctive trade dress, and breached the lower court's ruling that the trade dress was not distinctive as a matter of law.<sup>108</sup> The court tried to present a more illustrative and comprehensible image of examining product configuration's distinctiveness using the *Abercrombie* spectrum. In its language at length:

[I]t is not inherently impossible, illogical, or anomalous to apply the *Abercrombie* categories to product configuration. The configuration of a banana-flavored candy, for example, would be generic if the candy were round, descriptive if it were shaped like a banana, suggestive if it were shaped like a monkey, arbitrary if it were shaped like a trombone, and fanciful if it were formed into some hitherto unknown shape<sup>109</sup>

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<sup>103</sup> *Fun-DamentalToo, Ltd.*, 111 F.3d at 1000

<sup>104</sup> *Id.* at 1000-1001

<sup>105</sup> *Id.* at 1001. See also, Margreth Barrett, “Trade Dress Protection for Product Configurations and the Federal Right to Copy”, 20 HASTINGS COMM. & ENT. L.J. 477-78, (1998). (noting that accessible product features is fewer than the endless combination of product packaging trade dress. Therefore, protecting product designs is more likely to have a negative effect on competition.).

<sup>106</sup> *Fun-DamentalToo, Ltd.*, 111 F.3d at 1000

<sup>107</sup> 187 F.3d 363, (4th Cir. 1999)

<sup>108</sup> *Id.* at 370

<sup>109</sup> *Id.*, at 371

But, the court didn't consider that all product configurations are not such recognizable by analogizing to the things which are readily *imaginable*. In many cases, a trade dress is related to some *abstract* images which are more complicated than that could be easily defined by words. Maybe that point made the court convinced to contend that "difficulties in applying *Abercrombie* to product configuration can often be mitigated by considering the principles in *Seabrook*."<sup>110</sup>

***E. Abercrombie withdrawal; employed just for analogizing:***

In the context in which the proponent courts endeavored to translate the *Abercrombie* spectrum into trade dress cases, the Supreme Court in *Qualitex* has employed this test not for the purpose of distinctiveness assessment but simply for the purpose of reaching its desired conclusion (requiring secondary meaning). By means of comparison with the *Abercrombie* premises the Court was to determine that if a color alone (green-gold used for dry cleaning press pad) could inherently or by acquiring secondary meaning act as a distinctive source indicator? By comparing them based upon the *Abercrombie* classification it tried to exclude the colors' status from the other kinds of trademarks or even other trade dress's examples. It held that "a product's color is unlike "fanciful", "arbitrary" or "suggestive" words or designs, which almost *automatically* tell a consumer that they refer to brand"<sup>111</sup>, a particular color on a product or a packaging could be considered as signifier of a specific brand provided that shows that has acquired a secondary meaning, over time. Also, the court tried to determine the status of the case at issue by analogy with the descriptive word marks without taking them as the same things. It argued that "a color that in context seems *unusual* such as pink on a firm's insulating... would have come to identify and distinguish the goods... much *in the way* that descriptive words on a product can come to indicate a product's origin."<sup>112</sup> Although, by requiring the term "*unusual*" for trade dresses that over time have acquired distinctiveness, the Court showed that it wasn't apt to employ the *Abercrombie* spectrum as the conclusive test.

Finally, the Supreme Court in the *Wal-Mart Stores v. Samara Bros*<sup>113</sup> made a touchstone in determining the status of trade dress's distinctiveness. The Court

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<sup>110</sup>*Id.*

<sup>111</sup> *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 162-63 (1995).

<sup>112</sup>*Ibid.*

<sup>113</sup> 529 U.S. 205 (2000)

contemplating the prior Supreme Courts’ decisions made a division in trade dress’s subject-matters i.e. product design and packaging. The Court found that product design like colors could not be inherently distinctive.<sup>114</sup> In this concern, Justice *Scalia* admitted this difficulty with his *tertium quid* discussion. He conceded that *Two Pesos* “unquestionably” presumed that trade dress can be inherently distinctive and to solve this contradiction *Scalia* described the restaurant service trade dress as being “either product packaging—which... normally is taken by the consumer to indicate origin—or else some *tertium quid* that is akin to product packaging and has no bearing on the present case.”<sup>115</sup> He wrote for a unanimous Court, noting that Lanham Act section 43(a) provides little guidance on how unregistered trade dress should be analyzed.<sup>116</sup> He reasoned that product’s designs like product’s colors and unlike the word marks or product’s packaging which could, in some categories, “almost automatically tell a consumer that they refer to a brand”, almost “invariably serve purposes other than source identification.”<sup>117</sup> The Court by endorsing the *Qualitex Inc.* presumed the producers’ subjective intent of employing the word marks and packages for the purpose of identifying a product’s source.<sup>118</sup> On the other side, it also presumed the consumers’ predisposition in taking the word marks or product’s packages as a source indicator.<sup>119</sup> He went on to found that application of an inherent distinctiveness would be more harmful to other consumers’ interests. In this context, Justice *Scalia* tried to ratiocinate based upon considering the consumers’ benefits of competition in utilitarian and esthetic purposes that product design serves and reserving the commercial order by preventing threats of plausible suits upon alleged inherent distinctiveness.<sup>120</sup> Due to resemblance of the case with the subject of the *Qualitex Inc.* the Court’s position on the subject of *Abercrombie* application for product design, was almost entirely

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<sup>114</sup> Wal-Mart Stores, Inc., 529 U.S. at 212

<sup>115</sup> *Id.* at 215

<sup>116</sup> *Id.*, at 210

<sup>117</sup> *Id.*, at 212, quoting *Qualitex Inc.*, 514 U.S. at 162-63

<sup>118</sup> Some scholars have criticized this accentuation on the manufacturer’s intention. Professor Dinwoodie has observed that the producers’ intent assessment misconstrues the concept of a trademark and this would be an improper focus of test and tendency to lead to self-serving testimony. Graeme B. Dinwoodie, *supra* note 77, at 545-549

<sup>119</sup> Wal-Mart Stores, Inc., 529 U.S. at 212. *See also* *Landscape Forms, v. Columbia Cascade Co.*, 113 F.3d 373, 378-79, (2d Cir. 1997)

<sup>120</sup> Wal-Mart Stores, Inc., 529 U.S. at 215, (Stating “The very closeness will suggest the existence of relatively small utility in adopting an inherent distinctiveness principle, and relatively great consumer benefit in requiring a demonstration of secondary meaning”)

some quotations from the *Qualitex Inc.*<sup>121</sup> Actually, because of the Courts' intention to require secondary meaning for product's colors and product design in general, the *Abercrombie* spectrum just was employed in an analogous argument which was used to resemble the product's designs to the descriptive words. Moreover, the court didn't accept the applicability of *Seabrook* test stating that "such a test would rarely provide the basis for summary disposition of an anticompetitive strike suit".<sup>122</sup>

We believe the real incentive behind these presumptions is not about the question of if a product feature could convey a message so that might immediately be perceived directly as a signifier of a specific source. It is also not about other consumer-centered superficial rational which invariably have been used to require secondary meaning for product features. Trademark distinctiveness is an independent external reality which nothing except the interaction between trademark and consumers has no role in its constitution. As a matter of law, trademark law should protect the meaning that is in practice attributed by consumers to symbols not the meaning that the producers<sup>123</sup> or even courts intent or presume to be taken by consumers. The producers' intention in using a product feature (whether for the indicative or esthetic purposes) or consumers' reactions on quality of taking a design (as an indicative or esthetic) are the matter of fact which may not be changed by begging the question.<sup>124</sup> Consumers perceive what their minds circumstantially prone to take. The "critical question[s] of fact . . . [are] whether the public is moved in any degree to buy the article because of its source and what are the features by which it distinguishes that source."<sup>125</sup> It is true that trade dress traditionally has focused on labeling and packaging and not the products' own visual feature,<sup>126</sup> however it does not necessarily mean that product

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<sup>121</sup> *Id.* at 212-13

<sup>122</sup> *Id.* at 214

<sup>123</sup> Graeme B. Dinwoodie, *supra* note 77 at 546.

<sup>124</sup> *Thompson Medical Company, Inc. v. Pfizer, Inc.*, 753 F.2d 208, 213 (2d Cir. 1985) ("[T]he determination whether a mark is descriptive or suggestive cannot be made in a vacuum; it is necessary to surmise the mental process of those in the marketplace at whom the mark is directed")

<sup>125</sup> *Crescent Tool Co. v. Kilborn & Bishop Co.*, 247 F. 299, 300 (2d Cir. 1917)

<sup>126</sup> RESTATEMENT, *supra* note 5, § 16 cmt.

"Trade dress" traditionally includes the appearance of labels, wrappers, and containers used in packaging a product as well as displays and other materials used in presenting the product to prospective purchasers. The design features of the product itself are also sometimes included within the meaning of "trade dress," although the substantive rules applicable to the protection of product designs differ in some respects from those applicable to packaging and related subject matter."

designs could not primarily be applied and inherently could serve as a source designator.<sup>127</sup>

Furthermore, stating that “product design *almost* invariably serves purposes other than source identification”<sup>128</sup> shows that Justice Scalia was not very determined in requiring that product design could never inherently direct consumers’ minds to the source of the product. In other words, there might be a possibility of proving that in potential commercial context producers or consumers employ a product’s feature just for the sake of source indicating. Therefore, when a design is supposed to be examined as an isolated thing from its objective commercial context no one could predict that consumers will perceive it as which one of ornamental or source indicative feature. Where a medium of communicating could simultaneously have various roles in one specific field it would be impossible for the sender to select only one of these functions in isolation. As the matter of fact, “Consumers generally purchase a particular product for a variety of interrelated reasons...it is thus naive to assume that a product’s significant features and overall design can serve only *one* of two polar opposite goals [i.e. esthetic and indicative].”<sup>129</sup>

Accordingly, in addition to the less important goal of prevention of depriving consumers of utilitarian and esthetic purposes which designs serve, the main policy underlying to not consider the product designs inherently distinctive in both *Qualitex Inc.* and *Wal-Mart Stores* is the matter of *appropriation* and the *exclusionary effect of trademarks* which presumably leads to undesirable competitive effects. This is why a product feature could not qualified as inherently distinctive even it is proved that *ab initio* it is devised to be a source indicator. Trademark law has always been scrupulous regarding the common materials which are supposed to be monopolized through using as trademark.

Accordingly, finiteness of useable designs and its harmful competitive effect<sup>130</sup> could be posed with analogizing to the same rational behind the protection of descriptive word marks. It has traditionally “imposed restrictions on the right to

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<sup>127</sup> Though, justice white does not agree with that suggestion. He opined ““Consumers are aware of the reality that, almost invariably, even the most unusual of product designs . . . is intended not to identify the source, but to render the product itself more useful or more appealing.

<sup>128</sup> *Wal-Mart Stores, Inc.*, 529 U.S. at 213

<sup>129</sup> Unikel, *supra* note 82, at 335.

<sup>130</sup> Barrett, *supra* note 105 477-78. (Arguing that the extent of usable product features is much limited than the unlimited combination of product packaging trade dress. Therefore, conferring the trade dress protection to product features might have a negative effect on competition).

exclude others from using certain ‘descriptive’ symbols to ensure that the opportunity for all to associate such symbols with their common referents remains unencumbered”.<sup>131</sup> Comparatively, in the case of products’ designs, it is supposed that there should be a sufficient amount of common materials to be applied by other competitors to be able to maintain in a competitive state.<sup>132</sup> In this point, the *informational value* of trade dress as a trademark will be ignored in favor of competitive considerations that spring from other competitors’ freedom of action. This kind of treatment should not be viewed as a new judiciary treatment which developed lately. It is rooted in some historical and theoretical views over protection of trade dress.

As a matter of fact, prior to the Lanham Act 1946 common law and other relevant federal law were reluctant to confer the same protection of trademark to trade dress. Over time, since nineteenth century as of yet courts invariably have been concerned about the competitive consequences of conferring trademark protection to product design.<sup>133</sup> In its early and less protected condition, designs were considered as common materials which no one could appropriate as a private property. Hence, copying others’ unpatented visual features of productions was mere competition.<sup>134</sup> Presuming the finiteness of products’ designs,<sup>135</sup> the courts were and are trying to prevent that exercising a trademark right does not effectuate that others would unduly be deprived from the chance of expressing themselves freely. Requiring proof of secondary meaning is one of the reliable tools to assure that the producers who are seeking to a trademark protection for their products’ dress did not appropriate common materials which are essential for other rivals to self-presentation and competition.<sup>136</sup>

Upon that presumption, once it is proved that there is a considerable association between consumers’ mind and a design the court would be sure that the producer

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<sup>131</sup> In re DC Comics, Inc. 589 F.2d 1042, 1044 (Cust. & Pat. App. 1982)

<sup>132</sup> McCarthy, *supra* note 6, § 1:28. observing that “[I]n the absence of legally defined exclusive rights, imitation and copying is permitted and in fact, encouraged, as an essential element of free competition: “Imitation is the life blood of competition. It is the unimpeded availability of substantially equivalent units that permits the normal operation of supply and demand to yield the fair price society must pay for a given commodity.”

<sup>133</sup> Mohr, *supra* note 87.

<sup>134</sup> *Id.*

<sup>135</sup> Sicilia Di R. Biebow & Co., v. Ronald C. Cox and Sales U.S.A., Inc. 732 F.2d 417, 426 (5th Cir. 1984). Suggesting that “[T]he wide range of available packaging and design options allows a producer to appropriate a distinctive identity without unduly hindering his competitors' ability to compete.”

<sup>136</sup> See, e.g., Crescent Tool Co. 247 F. at 300, (arguing that “[I]t is an absolute condition to any relief whatever that the plaintiff . . . show that the appearance of his wares has in fact come to mean that some particular person . . . makes them, and that the public cares who does make them, and not merely for their appearance and structure.”)

through his commercial activities (trademark use) has transformed a design's status from a common material to a private one which has been consecrated to a particular commodity. Therefore, in this sense, requiring secondary meaning should not be analyzed with reference to the products' designs or packaging's innate ability or characteristic of making distinctiveness as a matter of law. A trade dress or trademark's distinctiveness is an uninvented external reality which occurs as the result of dynamic interaction between a mark and consumers and no one even courts have no authority over its existence, ways of composition and kinds of indication.<sup>137</sup> Trademarks automatically do their intrinsic function when they are placed in the proper commercial position and our premises just designed to help us to predict their prospective, potential efficacy not to change their external reality. Accordingly, in reality, there might be cases of product designs that in contradiction with the rule of requiring secondary meaning could primarily and without any need of proving consumers' acquired association indicate a product's origin. Hence, presuming that consumers do certainly rely on the product's encasements rather than products' designs to understand a good's origin is a stupendous presumption which is not always coincident with what is going on in the real market. Such presumptions are reflecting some kind of contradiction in the Supreme Courts' methods of analyzing trade dress distinctiveness. For instance, in *Two Pesos, Inc.* the Court through taking a non-discriminatory position toward all trade dress examples' ability to be inherently distinctive shows its pragmatic and realistic approach in treating product designs and packaging. In contrast, the Courts in *Qualitex Inc.* and *Wal-Mart Stores* tried to formalistically modify that realistic approach through deducing rules of distinctiveness mechanically from general principles which traditionally have been invoked in relevant precedents.

Furthermore, proof of secondary meaning does not essentially guarantee that there would be no competitive harm in applying visual materials as trademark. In other words, a mere legitimate appropriation will not able a man to use his own property as to injury property of another.<sup>138</sup> Once all factors which are involving in constituting an exclusive trademark right converge the only thing could limit and

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<sup>137</sup>*In re Trade-Mark Cases*, 100 U.S. 82, 94 (1879). (stating "the ordinary trademark has no necessary relation to invention or discovery. The trademark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of *accident*, rather than design...")

<sup>138</sup> *Avery & Sons*, 4 Ky. L. Rptr. at 762



condition this right is the counterpart right of others who should not be made worse off than what they already have been.

These kinds of endeavors to establish equilibrium between public and private interests are historically rooted in US courts' tendency to strongly protect producers' benefits which is theoretically defined within a natural right structure.<sup>139</sup> In its special theorized version, that condition has succinctly been emerged in two polar opposite concepts i.e. fair and unfair competition which are the most exceptional provisos could arguably neutralize the effect of possessory power of a right proprietor and engender the concept of "right to copy".<sup>140</sup> As Justice Kennedy remarked in *TrafFix Devices, Inc. v. Mktg. Displays*:

Trade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products. In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying... [C]opying is not always discouraged or disfavored by the laws which preserve our competitive economy.<sup>141</sup>

I believe that fashion of analyzing trade dress especially in case of product designs is indubitably beyond the consumer's protection goal. It would be more stupendous when it has been posed within a capitalized economic context such as what has been dominant in the United States. As Chronopoulos observes,

"It is hard to believe that the assertion of trademark rights on the outer appearance of products takes place because the trademark holder is concerned about the consumer not being able to immediately and without delay find his product without being confused with regard to its source. In making a trade dress claim, his main goal is to obtain protection against imitative competition from his competitors...The fact that trademarks are a part of unfair competition law leads to the thought that

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<sup>139</sup> Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 *Notre Dame L. Rev.* 1839,1909 (2007)

<sup>140</sup>*Id.* at 1879 (quoting from *Mogul S.S. Co. v. McGregor, Gow & Co.* (1889) 23 Q.B.D. 598 aff'd [1892] A.C. 25. "Competition exists when two or more persons seek to possess or to enjoy this same thing: it follows that the success of one must be the failure of another, and no principle of law enables us to interfere with or to moderate that success or that failure so long as it is due to mere competition.")

<sup>141</sup> *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001)

the interests of the trademark holder have to be taken into account on equal terms with those of competitors and consumers.”<sup>142</sup>

### ***III. An Analysis through Semiotics***

Both groups of courts whether with ontological or traditional approach have strived to show that *only* they found the structural relation which governs trade dress’s way of making the distinction and communicating messages. Although, no one has offered a significant guidance on the way of assessment the trade dress’s distinctiveness.<sup>143</sup> The courts with ontological approach want to extrospectively solve the dilemma of inherent distinctiveness based on elaborating the outer relation between the signifier and other signifiers. By incorporating the element of *comparison* they firmly intend to emphasize on the trade dress’s ability of differentiating. They also believe that measuring a trademark’s horizontal intersign relation among other signs in the field will guarantee the required signification for distinctiveness. In contrast, the courts with traditional standpoint, unlike the ontological court’s objective approach, wanted to subjectively describe the trade dress distinctiveness upon its inner, vertical relation between signifier and signified without taking outer relations into consideration.<sup>144</sup> Distinctiveness within its legal meaning is a compound concept which consists of two fundamental concepts i.e. “identifying” as *positive* part and “distinguishing”, as *negative* part. Without those elements, the process of producing the meaningful messages (trademark’s function) would be defected and flawed.<sup>145</sup> Each of those groups of courts has imperfectly developed its own approach only upon *one* of those constitutional parts of distinctiveness as a twofold identity. The courts with traditional approach have developed their idea of distinctiveness based on the trade dress’s ability to make “identification”. They have specifically sought to assess the potentiality of trade dress to signify the source upon an internal structure within which trade dress’s

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<sup>142</sup>Apostolos Chronopoulos, Trade Dress Rights as Instruments of Monopolistic Competition: Towards a Rejuvenation of the Misappropriation Doctrine in Unfair Competition Law and a Property, 16 Marq. Intell. Prop. L. Rev. 128 (2012).

<sup>143</sup> Graeme B. Dinwoodie, *supra* note 77 at, 480. (stating that Two Pesos and Qualitex have not proposed a "significant guidance" on the distinctiveness inquiry.)

<sup>144</sup> Barton Beebe, *supra* note 47, at 52, (observing that “In brief, signification describes the vertical, intrasign relation between signifier and signified. Value describes the horizontal, intersign relations among signifiers, signifieds...”)

<sup>145</sup>McCarthy, *supra* note 6 at §3:1, stating that one of “[t]he requirements for qualification of a word or symbol as a trademark [is]... the function: to *identify* and *distinguish* the seller’s goods from goods made or sold by others.

distinctiveness is examined based on the “semiotic relation of signification”<sup>146</sup> that by which a trademark could *positively identify* its subject-matter. In contrast, the ontologist courts have developed their tests following that proposition that when trade dress as a signifier could properly make distinctiveness that it functions as a differentiator by which a good could be “distinguished” from other pre-existing products. Accordingly, the ontologist courts at least in the case of product configuration have emphasized on assessing the trade dress’s potentiality of signifying upon an external structure within which trademarks’ distinctiveness is examined based on “semiotic relation of value”<sup>147</sup> that through which a trademark could *negatively distinguish* products from the others in the field. Each of those approaches has been exerted despite the fact that distinctiveness without any of its dual elements would be frustrated.

Now, the main question concerns the way through which a trade dress is made significant. From a semiotics point of view, is there any structure upon which we could ascertain the rout through which a trade dress made distinctive?

#### ***A. Visual semiotics & distinctiveness***

When Ferdinand de Saussure developed his model of signs, he was not to refer to the “sign” as a singular *thing*. He articulated the signs’ structure of being as a conceptual matter which its components i.e. signifier and signified are the psychological *concepts*.<sup>148</sup> Hence, in his opinion, semiology is not particularly intended to investigate the nature of linguistic signs and the laws which governing them. Rather, “linguistic is one branch of this general science.”<sup>149</sup> He defines the “sign” as “[t]he whole that results from the association of the signifier with the signified.”<sup>150</sup> In a broad sense, as Umberto Eco observes, “Semiotics is concerned with everything that can be taken as a sign.”<sup>151</sup> From that point of view, anything

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<sup>146</sup> Barton Beebe, *supra* note 47, at 54-6,

<sup>147</sup>*Ibid.*

<sup>148</sup> Ferdinand de Saussure, *Course in General Linguistics* 15-16 ( Roy Harris trans. 1983) (1916). (“It is... possible to conceive of a science which studies the role of signs as part of social life. It would-form part of social psychology, and hence of general psychology. We shall call it semiology (from the Greek semeïon, 'sign')”).

<sup>149</sup>*Ibid.*

<sup>150</sup> Ferdinand de Saussure, *Course in General Linguistics* 67 (Wade Baskin trans. 1974) (1916).

<sup>151</sup> Umberto Eco, *A Theory of Semiotics*. Bloomington, 7 (Indiana University Press Macmillan 1976). Also as Sturrock observes while semantics focuses on what words mean, semiotic more generally focuses on modality of signs’ production of meaning. John Sturrock, *Structuralism* 22 (Paladin 1986) That kind of instrumentalistic approach could also be found in *Qualitex Co. v. Jacobson Prods.*, 514 U.S. 159, 163-64 (1995), stating that: “Since human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning this language read literally in not restrictive”.

including *images* which could “stands to somebody for something in some respect or capacity”<sup>152</sup> will fall into the scope of the sign’s definition.<sup>153</sup> In the case of trade dress of which the primary constitutional factor is “overall appearance” the interactive relation between a good/service’s overall images as a signifier and its signified will shape the element of distinctiveness.

When a trade dress stands for a particular source it plays the role of a channel through which a process of coding has occurred. A trade dress as a medium carries a message which is encoded by the source to be decoded by the receiver. That is the point where a sign is interpreted, meaning is produced, and a trade dress makes distinction. However, how a trade dress functions within that structure of coding? From visual semiotics<sup>154</sup> point of view, signs are not just appeared as verbal and meanings are not necessarily produced via lingual conventions. Images could intuitively express meanings which lingual mediums could not.

According to the Charles Sanders Peirce’s visual sign system, a sign [*Representamen*] is something which stands to somebody for something in some respect or capacity. It addresses somebody, that is, creates in the mind of that person an equivalent sign, or perhaps a more developed sign. That sign which it creates [he] call[s] the *interpretant* of the first sign... [which] stands for its *object*.<sup>155</sup> Within that triadic model, the interaction between representamen, interpretant and object make a sign able to convey a meaningful message.

He has categorized the patterns of meanings as *iconic*, *symbolic* and *indexical*. He also defines iconic signs as elements which carry information which comprise some feature of the signified. In other words, there is some likeness or resemblance between an iconic sign and the signified. For instance, there is a conceptual approximation between the picture of a horse and the horse in the external world. An indexical sign is *directly* connected to the signified. That connection could be inferred or observed. For example smoke is a sign of fire or a footprint indicates

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<sup>152</sup> 8, Charles Sanders Peirce, *Collected Writings* 2.224, (Charles Hartshorne, Paul Weiss & Arthur W Burks eds. 1958).

<sup>153</sup> Paul Martin Lester, *Visual Communication: Images with Messages* 52 (2nd ed., Belmont, Wadsworth/Thomson Learning 2000), “[A]lmost any action, object or image will mean something to someone somewhere. Any physical representation is a sign if it has meaning beyond the object itself.

<sup>154</sup> Gunther Kress & Theo van Leeuwen, *Reading Images: The Grammar of Visual Design*1, (1996). (Visual semiotics is a newfound and sub-category of semiotics which focuses on studying the way that visual objects produce meaning and communicate a messages. “[It is] Intend[ed] to provide inventories of the major compositional structures which have become established as conventions in the course of the history of visual semiotics, and to analyze how they are used to produce meaning by contemporary image-makers.”)

<sup>155</sup> Peirce, *supra* note 152, at 2.228.

that somebody walked. A symbolic sign unlike the former kinds of signs has no linkage with the signified. It *arbitrarily* and *conventionally* indicates a pre-intended concept. For instance, language (in general whether as written or unwritten), a picture of a rose as a sign of love, national flags, etc. are symbolic signs. Due to the arbitrariness in using materials and conventionality which governs the structure of symbolic signs the relational process between a symbol and the concept for which it has stood should be learned by receivers.<sup>156</sup> For example a native speaker of Persian \_ presuming that he/she is not familiar with the English language\_ has no idea about letters J.U.S.T.I.C.E. while as a social contractual thing, those letters with that kind of pattern indicates the “quality of being just, impartial and fair”<sup>157</sup> for an English speaker.

Simultaneously, there is no resemblance or direct physical relationship between a symbol and the elements by which a symbol is materialized; they are *arbitrarily* selected, materialized as an external symbol and subsequently internalized socially. For example, in the last scenario, there is no resemblance or direct physical relationship between the patterns of letters of the word “justice” and the concept for which it stands.<sup>158</sup>

To act as an indicator, iconic and indexical signs have like symbolic sign followed the rule of conventionality (social pre-agreed conventions). However, they are all varied in their required degree of conventionality. Symbols are the most conventionalized among other kinds of signs. The arbitrariness and conventionality which strongly govern symbolic signs make them be less subject to idiosyncratic interpretations.<sup>159</sup> However, each of those categories is varied in terms of conventionality within their own structure. Within the scope of symbolic signs’ system, “stop” means “stop” but a picture of a “Jaguar” may indicate “Jaguar” in the external world, a specific kind of cars and concepts like “Wildness” or “Speed.” *That is the point where the language as the most conventionalized system*

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<sup>156</sup> Charles Sanders Peirce, Peirce on Signs 239 (James Hoopes, ed. 1991)

<sup>157</sup> "Justice." Merriam-Webster.com. Accessed August 11, 2016. <http://www.merriam-webster.com/dictionary/justice>.

<sup>158</sup> Also, among the trade dress examples, product designs’ process of signifying is performed while the object and representamen are merged into the same thing so that signifier and referent are the one.

<sup>159</sup> Iconic signs need a lower level of conventionality in comparison to symbolics. Because, in spite of that they could be employed in a society to indicate one or more concepts, they are mainly based upon our past logical and personal experiences. Indexical signs also, “direct the attention to their objects by blind compulsion.” Peirce, Charles Sanders, *supra* note 156, at 2.306

*and visual signs as the most interpretative and indeterminate structure, both as symbolic elements, begin to diverge.*<sup>160</sup>

In the case of trade dress which is potentially formed of visual elements there is no requirement of existence any *direct connection* (like indexical signs) or *resemblance/likeness* (like iconic signs) to the *interpretant*. In fact, to be significant, visual based definition of trade dress does not comprise any necessity on selecting only conventionalized visual signs. In other words, to stand for a specific origin a trade dress's visual elements might arbitrarily be selected from the visual signs which had already been internalized and symbolized in consumers' mind or made by visual elements which are not conventionalized (symbolized) or are in the process of conventionalization. That is the point upon which one could describe a trade dress inherently distinctive or dependent on showing secondary meaning.

As a matter of fact, and regardless of different types of trade dress, there are three possible positions in which a trade dress might have appeared. First, when features are extracted from the visual materials which have been internalized and subsequently conventionalized (symbolized) in the consumers' mind. For instance, in *Wal-Mart* the Court speculates that “[c]onsumers are ... *predisposed* to regard [such] symbols as an indication of the producer.” It proceeds to conclude that “such symbols ‘almost automatically tell a customer that they refer to a brand,’” and “‘immediately ... signal a brand or a product ‘source.’”<sup>161</sup>

Second, when the exerted visual feature is selected from visual materials which have no fixed meaning in the public's visual memory. For example, when it is formed of the arbitrary and abstract images which do not recall any special meaning in the viewer's mind. Finally, when a conventionalized visual feature is metaphorically employed for a meaning which is different from its conventionalized concept. Now, if those aforementioned cases are examined in terms of distinctiveness the first case would be considered as an inherently distinctive, the second instance would be fallen into the cases which must show a secondary meaning and finally the third's status varies based on the factor of

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<sup>160</sup> In a general sense lingual signs could be categorized as visual symbols but, from semiotic point of view visual signs' system is defined independently or even oppositely in relation to lingual signs.

<sup>161</sup> *Wal-Mart Stores supra* note 9, quoting *Qualitex*, 514 U.S. at 162 – 63. However, the court did not explain the modality of process by which consumers are predisposed to regard a trade dress as a conventionalized visual sign. *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1117 (5th Cir. 1991) “Distinctiveness is a term used to indicate that a trade dress serves as a *symbol* of origin”

“relevancy” between the signifier and the signified; namely the less relevancy the more potentiality of inherently making a distinction and vice versa.

But, there is an essential question which remains unanswered. How could it be ascertained that a trade dress as a visual sign has or has not been conventionalized? The triple above-mentioned cases just hypothetically illustrate the possible positions in which a trade dress could appear but do not show *how* in practice those cases should be recognized and differentiated from each other. In terms of the element of distinctiveness, how can we initially predict and presume that one specific visual sign will inherently be able to make distinction and one another needs to prove a secondary meaning?

It ultimately pertains to the existence of a socially pre-agreed “referential source of conventions” which in connection with a symbol could produce a perceptible meaning. But, is there such shared referential source that *exhaustively*<sup>162</sup> covers all conventions through which visual symbols are made significant? As of yet, unlike the lingual communications, we have not constructed any exhaustive contractual source of visual meanings upon which we could *conclusively* interpret the visual signs. We just know they are utilized to communicate messages, continually connoting meanings and are expanding very quicker than lingual signs. That is the reason “the meaning of visual syntax becomes fluid, indeterminate, and more subject to the viewer’s interpretational predispositions.”<sup>163</sup> Looking closely, “Images *say* nothing, they are mute; they make no propositions about the world... [I]mages, like texts, has rhetoric of arrangements which signify, but there is no syntax that articulates their parts and binds them into a whole.”<sup>164</sup>

In their first use, due to lack of a shared source of meaning we are at best able to *distinguish* them from each other. But, that kind of distinguishability only makes us able to determine what a trade dress *denotatively* indicates not what it *connotatively* stands for, beforehand.<sup>165</sup> That is the point which the courts with

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<sup>162</sup> There is just a small group of visual symbols which most culturally and variably indicate some inconclusive meaning. For e.g. “circle” may indicate the concepts such as “unity”, “wholeness”, “infinity”, “womb” and some other concepts. Therefore, even that small group of symbols suffers from indeterminacy and could not conclusively be interpreted.

<sup>163</sup> Paul Messaris, *Visual Persuasion, The Role of Images in Advertising*, (1997).

<sup>164</sup> Georg Dillon, *Art and the Semiotics of Images: Three Questions About Visual Meaning*, (1999). Online at <http://faculty.washington.edu/dillon/rhethhtml/signifiers/signsave.html>, accessed April, 18, 2016.

<sup>165</sup> In semiotics meanings include both denotation and connotation. Those terms refer to the two types of relationships which a signifier has with its signified. As Seppanen expounds: “Denotation refer to obvious meanings. The rabbit in the photograph is recognized as a rabbit. However, a rabbit is no merely s rabbit but also a disarming

ontological approach have ignored in their proposed tests. The mere proof of being “unique” or “unusual” in the respective field does not suffice to determine the interpretant (the source) which a trade dress creates in consumers’ mind. What the ontological tests have solely focused on is falsely extraction of what a trade dress connotes (element of identifying) from what it denotes (element of distinguishing). It is just like the situation where you are searching to find person X and then find someone who you are sure that is different from the person X; but concurrently do not know the identity of the person who you have found. Knowing that that person is not person X will not make you able to figure out who is the late person.

Hence, as the most contextualized and indeterminate and polysemous tool of communication, trade dress’s status of conventionalization (symbolization) could not be predictably ascertained in its inception. Unlike, lingual system of communication, we do not access to any reliable source of meaning that like dictionaries upon which we could examine and predict the receivers’ semantic reactions to a trade dress. Therefore, in the context of distinctiveness, unlike word marks, we could not initially determine whether a trade dress has certainly been conventionalized so that inherently symbolizes its origin or needs to secondarily be conventionalized for a specific concept or reconventionalized for a new notion which is different from its prior meaning. As professor Moriarty argues:

In terms of complexity, visual interpretation can be seen as being more complex than verbal interpretation, primarily because of the lack of a *conventionalized sign system* and a *formalized training protocol*. ...[V]isual communication is neither derivative, nor peripheral to language, and therefore the designation of "secondary," "tertiary" or a "superstructure" built on language is inappropriate.<sup>166</sup>

Therefore, interpret visual signs upon the syntax which governs lingual signs is an immaterial method of analyzing. Because, as a perceptual matter we do not percept “visual information by means of language like learning of an arbitrary visual language”. Rather, we understand them "by means of some ecological conventions, not by means of totally cultural conventions."<sup>167</sup> As Langer articulates:

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and soft creature. Connotation is formed of these “surpluses” of meaning. Connotation therefore arouses emotions, impressions, and cultural meaning in the viewer of the photograph. The photographer can influence the connotation of a photograph by changing the camera angle or lighting, for example”. JanneSeppanen, *The Power of Gaze: An Introduction to Visual Literacy*, (AhonenAijaleena, & Clarke Kris 2006).

<sup>166</sup> Moriarty, Sandra, *supra* note 3.

<sup>167</sup>Grodal, Torben. "Visual Communication as Textsigns and as Embodied Mental Processes," Nordic



Visual forms — lines, colors, proportions, etc., — are just as capable of articulation, i.e. of complex combination, as words. But the laws that govern this sort of articulation are altogether different from the laws of syntax that govern language. The most radical difference is that visual forms are not discursive. They do not present their constituents successively, but simultaneously, so the relations determining a visual structure are grasped in one act of vision.<sup>168</sup>

Every sign systems are constrained by routs they utilize to communicate the messages. The same experiences \_in our case visuals and verbal\_ would not be synonymous if they are posed within different semiotic systems.<sup>169</sup> Therefore, incorporating the terms like “descriptive”, “suggestive”, “arbitrary” and “fanciful” in the framework in which trade dress communicates is inapposite and insignificant.

On that account, using the rules of our linguistic understanding to illuminate the structure of our visual understanding of trade dress will just deviate and terminate the accurate explanation of what is going on in the real market of trade dress.<sup>170</sup> All that *Abercrombie* test of distinctiveness is founded on revolves around “*semanticrelevancy*” between a mark and its object and “*semanticpresume-ability*” of outcome which most likely will emerge as distinctiveness in the future. According to that structure, there is an inverse relationship between relevancy and presume-ability. As much as the semantic relevancy between a word mark and the good/service to which the mark is employed (referent) gets strength, e.g. when it is descriptive, the semantic presume-ability of *inherent* capability of the mark to indicate to the goodwill upon which it is enclosed (signified) will be dropped. Simultaneously, as less as the relevancy decreased, e.g. down to the point that a term is coined, the semantic presume-ability of likelihood of inherently indicating the source will be mounted up. As elaborated, the most contributive factor in assessment the relevancy is existence of a socially shared source of meanings. Regarding word marks due to their semantic quiddity and in particular existence of

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Visual Communication Conference, Oslo. (1994). Quoted from Moriarty, Sandra, *Abduction: a Theory of Visual Interpretation*, *Communication Theory*, 173 (1996).

<sup>168</sup> Susanne, K. Langer, *Philosophy in a New Key: A Study In the Symbolism of Reason, Rite, And Art* 95 (2009).

<sup>169</sup> Innis, Robert E (Ed.) (1986), p.235“*Semiotics: An Introductory Reader*”, London: Hutchinson

<sup>170</sup> Graeme B. Dinwoodie, *supra* note 46 at 641.

dictionaries we have accessed to a reliable source of past application and position of using the words. But, regarding trade dress, without any comprehensive reliable source of visual meaning we will not be able to determine how a trade dress might describe or suggest its referent or what it would be like if it is generic or coined as a fanciful trade dress. Hence, it would be a vain transplantation if we engraft the *Abercrombie* test's elements onto the context of trade dress distinctiveness. Lack of any reliable source of visual conventions has put trade dress like other visual signs, in a most interpretative situation in which a trade dress's communicational character is to a large degree dependent on the consumers' reaction. The same reason leads to those producers as senders of codes within that triadic interaction (i.e. between producer, trade dress and consumers) have the less impact on the kind of produced meanings. This is the consumers that under the influence of very variable, uncountable, and contextual parameters have their own interpretations and give their own meaning to a trade dress.<sup>171</sup> That is regardless of whether a trade dress embedded as packaging or product designs. It does not affect the people's way of interpreting the visual signs they might encounter. The fact that people routinely rely on products encasement rather products' designs is the matter of no importance in assessing trade dress distinctiveness. In reality there might be numerous of cases that products' designs comprised of visual signs which might be interpreted by consumers as conventionalized sign that could inherently make a distinction and simultaneously there might be a significant number of packaging which have no trace in consumers' visual memory. Consumers use signs which more easily and effectively help them to make a proper decision. They do not have to find the inherent distinctive signs only in products' encasements.

### ***Conclusion:***

Trademark system is fundamentally defined in an informative context. Modern trademark law's instrumentalism going to employ any material which could potentially promote the quality of information within the framework which

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<sup>171</sup> Robert G. Bone, *supra* note 8, at 554, ("Theoretically, any symbol can serve as a source-identifier depending on the meaning given it by consumers. Thus, phrases and sounds have been protected as marks. So too have elements of a product's trade dress, including packaging and even readily discernible features of the product itself such as the color of wire fencing, the décor of a restaurant, the design of furniture, and even an artist's unusual style. If consumers believe that all items bearing the symbol come from the same source, the symbol has acquired the source-identifying property of a trademark.")

trademarks supposed to communicate source information. Trade dress as a newly employed material could effectively provide the modern visualized society with a high quality of most retrievable information. However, the element of “distinctiveness” as the trade dress’s functional arm to communicate information has suffered from being treated like word marks. This is despite the fact that the trade dress’s way of signifying is most interpretative in comparison word marks that is principally internalized upon the pre-agreed source of meaning. That being so, in terms of distinctiveness trade dress should be treated as a *pre-occurred explore-able event* in relation to consumers not as a “*presume-able*” matter in relation to a trade dress itself. Put differently, the dilemma of trade dress distinctiveness should as a matter of fact be resolved by *surveying* the consumers whose passive interpretations determinatively would establish or frustrate a trade dress’s character of distinctiveness.