CONFIGURATION PROTECTION HARMONIZED

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I. INTRODUCTION

A trademark is defined very broadly in the Lanham Act as any "symbol" or "device" that can "distinguish...goods...from those manufactured or sold by others."1 It can consist of a shape, a sound, a scent or a single color.2 Both statutorily3 and as a matter of common law,4 it can extend to a "unique product."

Clearly, the way a product looks5—how it is perceptually interpreted—can be critical both to its marketplace success and to its creation of brand equity. Whole books have been devoted to the marketing of aesthetics.6 The new "Beetle" revitalized Volkswagen's U.S. presence.7 With the PT Cruiser, the Crossfire and now the 300 C to his credit, some would argue that Trevor Creed has been as instrumental as Dieter Zetsche in DaimlerChrysler's return to health.

The protection of configurations, however, can generate tensions. On the one hand, some consumers will refuse to purchase prestige visual symbols for which exclusivity cannot be maintained8 and, under the "lighthouse" principle,9 a single firm

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5. Look, configuration, design, appearance and shape are used synonymously herein.


7. The car was immediately dubbed "a classic for the future." Id. at 304. It was more than a collection of auto parts, it was an "integrated holistic experience." Bernd Schmitt, Experiential Marketing 32 (1999). The "Beetle" was an old friend representing a current opportunity to return to a storied past, and the initial response of everyone who viewed it was the same, they smiled. Id. at 194-97. Volkswagen advertised, "[I]f you sold your soul in the 80s, here's your chance to buy it back."

may be unwilling to sink substantial capital into the development of unique designs that its competitors may immediately utilize cost-free.\textsuperscript{10} On the other hand, shielding the appearance of a product can implicate "competitive interests."\textsuperscript{11}

The default in our economic system is competition.\textsuperscript{12} It is the purpose of this article, however, to explore how configuration protection and competition can be harmonized for the benefit of consumers. As to designs, the goal should be to preserve competition among the ordinary and to promote competition among the outstanding.

\section*{II. A BRIEF HISTORY OF CONFIGURATION PROTECTION}

Historically, efforts to protect the configuration of a product itself as a source symbol, apart from any word mark used on the product or the product's packaging, have experienced three distinct phases.\textsuperscript{13} For the first 200 years of our nation's history, even the "identical imitation of the goods of another [did] not \textit{in itself} constitute unfair competition."\textsuperscript{14} Goods often could be replicated "slavishly down to the minutest detail."\textsuperscript{15} While there were always caveats,\textsuperscript{16} and occasional proscriptions of product copying,\textsuperscript{17} cases


10. Theoretically, design patents offer one means of avoiding quick "knock-offs." Because, however, they: (a) are often "dissected" in infringement determinations, (b) are compared with an alleged infringer side-by-side, and (c) do not take into account all of the marketplace "factors" that may bear on confusion, see \textit{Elmer v. ICC Fabricating, Inc.}, 67 F.3d 1571 (Fed. Cir. 1995); compare \textit{Imagineering, Inc. v. Van Klassens, Inc.}, 53 F.3d 1260 (Fed. Cir. 1995), they can be easily evaded and they have "failed to offer adequate protection to product design." Graeme B. Dinwoodie, \textit{Reconceptualizing the Distinctiveness of Product Design Trade Dress}, 75 North. Car. L. Rev. 471, 517 (1997).


12. Dinwoodie, supra note 10, at 517.

13. This "legal" review of configuration cases is extremely truncated and assumes familiarity with basic concepts. For a fuller review, see Theodore H. Davis, Jr., \textit{Management and Protection of Brand Equity in Product Configurations}, 1998 U. of Illinois L. Rev. 59 (1998) and Dinwoodie, supra note 10.


15. \textit{Bonito Boats, Inc. v. Thunder Craft Boats, Inc.}, 489 U.S. 141, 157 (1989); see also \textit{In re Morton-Norwich Products, Inc.}, 671 F.2d 1332, 1336 (C.C.P.A. 1982) ("[T]here exists a fundamental right to compete through imitation ..., which ... can only be temporarily denied by the patent or copyright laws.").
dealing with the protection of a good’s appearance as a brand remained the rare exception, not the rule.

In 1992, the Supreme Court then decided in Two Pesos, Inc. v. Taco Cabana, Inc.\(^\text{18}\) that the “trade dress” of a restaurant could be immediately protected without a showing of secondary meaning, and actions asserting rights in product designs sharply accelerated. In that decision’s wake, some courts treated “product configuration and packaging” as equals under a “trade dress” banner,\(^\text{19}\) and others enunciated (or resuscitated) a welter of standards to assess when a product’s shape or appearance could be deemed “inherently distinctive.”\(^\text{20}\)

In seeking, however, to use Two Pesos as a springboard into a new era of product design recognition, trademark lawyers made critical mistakes. Because they failed to appreciate the perceptual and cognitive differences, discussed below, between product designs on the one hand, and words and packages on the other, they initiated a host of questionable actions. A case dealing with cable ties generated multiple opinions, without resolution.\(^\text{21}\) Other cases involved industrial corn starch washers,\(^\text{22}\) funeral flower baskets,\(^\text{23}\) inexpensive, plastic Grecian urns\(^\text{24}\) and low-end wrought

\(\text{\footnotesize 16. ‘‘Sharing in the goodwill [of the configuration] of an article unprotected by patent or trade-mark is the exercise of a right possessed by all—and in the free exercise of which the consuming public is deeply interested.’’ Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 122 (1938) (italics supplied).}\)

\(\text{\footnotesize 17. See, e.g., Truck Equip. Serv. Co. v. Fruehauf Corp., 536 F.2d 1210 (8th Cir. 1975).}\)

\(\text{\footnotesize 18. 505 U.S. 763 (1992).}\)

\(\text{\footnotesize 19. Stuart Hall Co. v. Ampad Corp., 51 F.3d 780, 787 (8th Cir. 1995).}\)

\(\text{\footnotesize 20. E.g., (a) whether a shape, analogous to a word, was coined, arbitrary, suggestive, descriptive or generic, Insty*Bit, Inc. v. Poly-Tech Indus. Inc., 95 F.3d 663, 672-73 (8th Cir. 1996); (b) whether a shape was ‘‘arbitrary’’ and ‘‘serve[d] no function either to describe the product or to assist in its effective packaging.’’ Chevron Chemical Co. v. Voluntary Purchasing Groups Inc., 659 F.2d 695, 702 (5th Cir. 1981) (focusing on the product); (c) whether a shape was ‘‘a ‘common,’ basic . . . design, whether it [was] unique or unusual in a particular field, whether it [was] a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods,’’ and whether ‘‘it [was] capable of creating a distinctive impression independent of the associated goods and services,’’ Seabrook Foods, Inc. v. Bar-Well Foods, Ltd., 568 F.2d 1342, 1344 (C.C.P.A. 1977) (focusing on the total market); (d) whether a shape was ‘‘(i) unusual and memorable; (ii) conceptually separable from the product; and (iii) likely to serve primarily as a designator of origin,’’ Duraco Prods., Inc. v. Joy Plastic Enters., Ltd., 40 F.3d 1431, 1434 (3d Cir. 1994); and (e) whether ornamentation was ‘‘likely to serve primarily as a designator of origin’’ and that was its intended purpose, Knitwheels, Inc. v. Lollytogs Ltd., 71 F.3d 996, 1008-09 (2d Cir. 1995).}\)

\(\text{\footnotesize 21. See Thomas & Betts v. Panduit Corp., 138 F.3d 277 (7th Cir. 1998).}\)

\(\text{\footnotesize 22. Dorr-Oliver, Inc. v. Fluid-Quip, Inc., 94 F.3d 376 (7th Cir. 1996).}\)

\(\text{\footnotesize 23. Syndicate Sales, Inc. v. Hampshire Paper Corp., 192 F.3d 633 (7th Cir. 1999).}\)

\(\text{\footnotesize 24. Duraco Prods., Inc. v. Joy Plastic Enters., 40 F.3d 1431 (3d Cir. 1994).}\)
iron furniture.\textsuperscript{25} Many of the cases appeared to be competitively motivated or were otherwise overreaching.

Moreover, in many of its mistakes, the legal community was abetted by a marketing community that rarely engaged in "look for" advertising to educate the public that a particular appearance was intended to do more than just enhance the appeal of goods.\textsuperscript{26} Even worse, some marketers could not resist the temptation to tout the functional benefits of features that lawyers were touting as inherently distinctive.\textsuperscript{27}

In 2000, therefore, in \textit{Wal-Mart Stores, Inc. v. Samara Brothers, Inc.},\textsuperscript{28} the Supreme Court sought to temper the proliferation of design cases, holding that:

1. \textit{Two Pesos} had involved product packaging, not product design;\textsuperscript{29}

2. With a design, there was not the same consumer "predisposition to equate \ldots feature[s] with source";\textsuperscript{30}

3. Formulations to assess whether a design was "inherently distinctive" were insufficiently precise to "provide the basis for summary disposition of \ldots anticompetitive [configuration] strike suit[s]";\textsuperscript{31} and

4. Accordingly, "in an action for infringement of unregistered trade dress under § 43(a) of the Lanham Act, a product's design is distinctive, and \ldots protectible, only upon a showing of secondary meaning."	extsuperscript{32}

Because tests of design uniqueness can be somewhat indefinite,\textsuperscript{33} the Court thus relegated configurations, like a single color, to the far left end of the protected device spectrum; and because proving

\begin{footnotesize}
\begin{enumerate}
\item \textit{See, e.g., Disc Golf Ass'n v. Champion Discs, Inc.}, 158 F.3d 1002, 1009 (9th Cir. 1998).
\item 529 U.S. 205 (2000).
\item 529 U.S. at 215.
\item 529 U.S. at 213.
\item 529 U.S. at 214.
\item 529 U.S. at 216.
\item See note 20, supra.
\end{enumerate}
\end{footnotesize}
secondary meaning can be costly, difficult and time consuming, the volume of design cases declined.34

Design protection is thus back to square one, and several questions reemerge:

1. Are there consumer benefits to be derived from the protection of a product’s configuration or appearance?
2. Under what conditions, cognitively and perceptually, can shapes and looks differentiate products?
3. If there is to be a fourth phase of design protection, how should it evolve?

Each of these questions is examined seriatim below.

III. THE THREE QUESTIONS

A. Potential Consumer Benefits

The answer to the first question is informed by a review of the evolution of brands. From the Middle Ages, a trademark denominated source:

1. a brand could serve a “liability” function by identifying an artisan responsible for defective goods;
2. a brand could serve a “preclusive” function by effectively demarking the territory of a guild’s monopoly; or
3. a brand could serve an “ownership” function, permitting merchants more easily to recover their goods from shipwrecks or piracy.35

The precise meaning of a trademark could thus vary, but in each instance, brand and source were synonymous. Under such a regime, a trademark functions only as a genus of a species. Pillsbury is a source of flour. A brand is simply a signature.

In the Lanham Act, a trademark is still defined, in part, as any “device . . . used . . . to indicate the source of goods, even if that source is unknown,”36 but in the early years of the 20th Century, a

34. The decline sharpened with the Supreme Court’s decision in Trafix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23, 32 (2001), rejecting the limitation of the (utilitarian) functionality doctrine to designs that are “competitively necessary.” Only as to “aesthetic” claims are alternative designs relevant. 532 U.S. at 33. But see Valu Engineering, Inc. v. Rexnord Corp., 278 F.3d 1268, 1276 (Fed. Cir. 2002).


gifted legal seer, Frank I. Schechter, recognized that trademarks had come to function not as mere signatures, but as quality signals,\(^{37}\) which afforded them “selling power.”\(^{38}\) He thus endeavored, \textit{inter alia}, to articulate a theory of protection that would shield the quality function of a unique brand from erosion by multiple third-party use on alien goods.\(^{39}\) While he met with little direct success, his views were largely accommodated over the decades by the growing recognition that brand owners have a separate interest in the reputation of their marks.\(^{40}\) The process was complex and protracted,\(^{41}\) but in 1928, it had an early highlight:

[I]t has of recent years been recognized that a merchant may have a sufficient economic interest in the use of his mark outside the field of his own exploitation to justify interposition by a court. His mark is his authentic seal; by it he vouches for the goods which bear it; it carries his name for good or ill. If another uses it, he borrows the owners reputation, whose quality no longer lies within his own control. This is an injury, even though the borrower does not tarnish it, or divert any sales by its use; for a reputation, like a face, is the symbol of its possessor and creator, and another can use it only as a mask.\(^{42}\)

In the simplest of terms, a trademark has become a trustmark.

Source and quality are now thus sacrosanct, but brands have continued to evolve. In the current environment, indeed, protecting the quality function of a brand may no longer be paramount: “quality and service are [now] an expectation, not a tie breaker. . . . [Q]uality is a given these days, not a difference.”\(^{43}\) Today, “[y]ou

\(^{37}\) Schechter, \textit{supra} note 35, at 166.

\(^{38}\) “[T]he true functions of the trademark are . . . to identify a product as satisfactory and thereby to stimulate further purchases by the consuming public.” Frank I. Schechter, \textit{The Rational Basis of Trademark Protection}, 40 Harv. L. Rev. 813, 818 (1927).

\(^{39}\) \textit{Id}. at 825.

\(^{40}\) \textit{See Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.}, 604 F.2d 200, 205 (2d Cir. 1979).

\(^{41}\) \textit{See Swann, supra} note 36, 834-41.

\(^{42}\) \textit{Yale Elec. Corp. v. Robertson}, 26 F.2d 972, 974 (2d Cir. 1928) (italics supplied).

\(^{43}\) Jack Trout, \textit{Differentiate or Die} 28 (2000). A trademark is still a trustmark, Larry Light, Keynote Address at the INTA Annual Meeting in Denver, Colorado (May 1, 2000), but it “signals” more than quality; it is a “symbol” generating an array of images. Thomas D. Drescher, \textit{The Transformation and Evolution of Trademarks}, 82 TMR 301, 304 (1992).
can sell the sizzle only as long as you serve the steak.”\textsuperscript{44} \textit{Ergo,} Planet Hollywood.

Beyond quality, marketers today appreciate the consumer demand for \textit{variety}, not only in sensory, but in psychological parameters as well. Many strong brands today, therefore, are “value propositions” that encompass not only functional benefits (to which quality is largely related), but also emotional and self-expressive benefits.\textsuperscript{45} Today, “the psychological response to a brand can be as important as the physiological response to the product.”\textsuperscript{46} Henry Ford could not prosper today only with black, and General Motors has learned that it cannot compete with dull.

To illustrate, consider the sometimes transformative characteristics of brand symbols:

[O]pening a Tiffany package will feel different from opening a Macy’s package—the feeling will be more intense, more special. Further, the wearing of a Tiffany bracelet may even make the wearer feel more attractive and confident. \ldots The associations of prestige and quality are hypothesized to actually change the use experience.\textsuperscript{47}

Tiffany is more than just a source of quality jewelry. It is a true \textit{symbol}, an icon, merging source, quality and positive associations to form its own singular species.\textsuperscript{48}

Brand equity now often rests on a stool with three perceptual legs:

A cook using WILLIAMS-SONOMA kitchen equipment to host a dinner will enhance his reputation among guests who value quality housewares. Not only will he garner [i] the functional, use-benefit of the cookware, and [ii] enjoy the emotional benefit of cooking well with quality equipment, but he also [iii] will express himself subtly, as someone who can afford the

\begin{itemize}
\item \textsuperscript{44} Jerre B. Swann, David A. Aaker and Matt Reback, \textit{Trademarks and Marketing,} 91 TMR 787, 802 n.59 (2001).
\item \textsuperscript{45} David A. Aaker and Erich Joachimsthaler, \textit{Brand Leadership} 48-50 (2000).
\item \textsuperscript{46} Kevin Lane Keller, \textit{Strategic Brand Management: Building, Measuring, and Managing Brand Equity} 6 (1998). “Despite almost universal experience with brands, [many] remain [incompletely] understood. When queried why they buy brands \ldots responses typically reflect little insight. \ldots ‘Coca-Cola tastes better \ldots’ some will argue. \ldots ‘Mercedes-Benz \ldots will last forever.’ These reasons may or may not be true, but few consumers can reliably distinguish between brands of soft drinks, and most consumers in the United States keep their cars for only a few short years. Rather than deriving value from the product, buyers often seek and gain much more value from the brand.” Alice M. Tybout and Gregory S. Carpenter, “Creating and Managing Brands,” in \textit{Kellogg on Marketing} 76 (2000).
\item \textsuperscript{47} David A. Aaker, \textit{Managing Brand Equity} 161 (1991).
\item \textsuperscript{48} Jerre B. Swann, \textit{Genericism Rationalized,} 89 TMR 639, 647-48 (1999).
\end{itemize}
best and who merits the admiration of his guests for his good taste and a presumed culinary aptitude. 49

The Williams-Sonoma brand’s structure is that of a pyramid with quality at its base, overlaid by a tier of warm feelings that its ownership and use can generate and crowned by self-expressive content. 50

What does this mean with respect to the potential for consumer benefits flowing from product designs? A great deal. It should be obvious, for example, that beautiful products can satisfy emotional needs. From a self-expressive standpoint, marketers have long touted that “we are known by the brands we keep.” 51

“many persons purchase branded goods for the purpose of demonstrating to others that they are consumers of the particular goods”—in other words, to impress others [and feel better]. . . . They advertise themselves (as sellers . . . advertise their goods) by wearing clothes, jewelry, or accessories that tell the world that they are people of refined (or flamboyant) taste or high income. 52

“[A] Rolex watch not only functions accurately as a high-quality time-keeping device, but may also signal that its wearer has ‘arrived.’” 53

There are, of course, those who stridently decry the addition of non-quality, experiential associations to brands, insisting that consumers are being “gulled.” 54 They argue that “an enormous number of consumers do not really want what they think they want[, but] have been duped by unscrupulous marketers [using perception advertising].” 55 In fact, consumers (particularly at the margin) are smart: e.g., “achieving perceptions of quality is usually

49. Swann, Aaker and Reback, supra note 44, at 801.

50. See, e.g., Scott M. Davis, Brand Asset Management 55-64 (2000).


53. Swann, Aaker and Reback, supra note 44, at 801.

54. See, e.g., Ronald K.L. Collins and David Skover, Commerce and Communications, 71 Texas L. Rev. 697, 698 (1993) (postulating that advertising promotes “fantasized decisions by the consumer”).

impossible unless the quality claim has substance."\textsuperscript{56} In fact, consumers use brands (including designs) as highly efficient and effective "devices" to convey information and to converse with and about themselves, and with others.\textsuperscript{57} In fact, "perception advertising provides consumers with products (mental images) that they value, and which would have been scarce in its absence."\textsuperscript{58} "A brand that today only denotes source and quality is ... lacking in added attributes and content that consumers now want, demand and need."\textsuperscript{59}

If, therefore, truly distinctive product designs can be immediately protected,\textsuperscript{60} consumers potentially will be thrice blessed. First, products perceived as attractive are more emotionally pleasing than drab products. Second, many designs have self-expressive potential. Third, as augmented by one and two, "consumers [will] benefit from the greatest number of indicia by which to distinguish [a variety of] products."\textsuperscript{61}

\textbf{B. Cognitive and Perceptual Realities}

A remarkable feature of the history of design protection is that it has evolved largely without resort to empirically verified models of how consumers react to configurations generally—it has proceeded as if there is no body of learning of how consumers perceptually encode and cognitively process design information. In fact, there is a vast amount of such learning,\textsuperscript{62} ranging from the elementary to the complex.

For example, consumers prefer the simplest valid interpretation of a configuration.\textsuperscript{63} The design below consists, technically, of two, 1.5-inch, horizontally parallel lines and two, 1.5-inch, vertically parallel lines intersecting at 90 degrees.

\begin{itemize}
\item \textsuperscript{56} David Aaker, \textit{Building Strong Brands} 19-29 (1996). \textit{See} Davis, supra note 50, at 63-64 ("functional excellence is a necessary step in maintaining emotional and self-expressive content").
\item \textsuperscript{57} \textit{See} Swann, supra note 36, at 843-47.
\item \textsuperscript{58} Nicholas S. Economides, \textit{The Economics of Trademarks}, 78 TMR 523, 535 (1988); Alice M. Tybout and Gregory S. Carpenter, "Creating and Managing Brands," in \textit{Kellogg on Marketing} (2000) ("It is the images attached to a brand that define [its] uniqueness and ... are highly valued by buyers.").
\item \textsuperscript{59} Jerre B. Swann, \textit{Dilution Redefined for the Year 2002}, 92 TMR 585, 594 (2002).
\item \textsuperscript{60} A unique design can otherwise be copied before it can be proven to have acquired secondary meaning.
\item \textsuperscript{61} Dinwoodie, supra note 10, at 561.
\item \textsuperscript{62} \textit{See} S. Pinker, \textit{How the Mind Works} (1997).
\end{itemize}
Consumers see it as a square.

Consumers have a bias to perceive objects as coherent wholes, rather than as separable parts.\textsuperscript{64} The figure below will be visualized as a circle and a square:

It will not be seen as a square and a “Pac Man.”

Consumers tend to regularize, not particularize. Rows of slightly uneven dots:

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\cdot & \cdot & \cdot & \cdot & \cdot \\
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\end{array}
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are likely to be remembered as rows of straight dots:

\[
\begin{array}{cccccc}
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\cdot & \cdot & \cdot & \cdot & \cdot \\
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\cdot & \cdot & \cdot & \cdot & \cdot \\
\end{array}
\]

Consumers typically do not carry design details in memory. For example, consumers each day are likely to encounter the appearance of a Lincoln penny:

Yet asked to draw a penny from memory, consumers will face Lincoln in the wrong direction, misplace the date or otherwise fail accurately to replicate the design.

Objects carried in memory are typically organized, moreover, into categories with prototypes; they are not delineated as specific items (or brands). For those, like the senior (in age) author, who are ornithologically challenged, they see and remember animals with feathers, wings and beaks as “birds.” If asked at the end of a day to recall “what birds,” they are unlikely to itemize; they are unlikely to refer to warblers and nuthatches. Rather, if asked to

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draw what they have seen, they will produce something akin to a sparrow or a wren, which, to them, are the prototypes of the bird category. It would take a penguin to stand out in their minds from other birds.

Different shapes may thus be variously pleasing, but they are not typically treated as having a special significance apart from their psychological category. The law has recognized, indeed, that in our highly competitive economy, consumers are accustomed to encountering many products that, to them, look alike, and they will typically resort to a label to ascertain a product's origin. In most market segments and at most price points, shapes indicate categories of goods, not brands.

Designs, moreover, are not infinitely variable: e.g., there are size and shape limitations on category recognition, and competitors should not have to make their products look so different that they assume the characteristics of a different category. There are also aesthetic limitations—in human visual processing, the more average a face, generally the more attractive it is. A new firm should not thus be forced to produce a vulture to avoid confusion with competitors in the bird design category.

Collectively, therefore, there are dangers of design depletion: (a) shapes cannot be infinitely varied and still be recognized; (b) minor differences will not serve to differentiate shapes in a category; (c) protected configurations may thus have broad reach; and (d) requiring substantial variations may impact costs as well as aesthetic acceptability. Words and packages are infinitely variable; designs are not so.

Finally, designs often exist in, not on, goods. In nature, form follows function, and most biological features have an evolutionary

68. “Costs and commercial considerations” often dictate “that similar products will come from a number of sources…” In re DC Comics, Inc., 689 F.2d 1042, 1051 (C.C.P.A. 1982); Jerre B. Swann, The Configuration Quagmire, 87 TMR 253, 259 (1997).


70. Aesthetics is used as defined in the Restatement: “A design is functional because of its aesthetic value only if it confers a significant benefit that cannot practically be duplicated by the use of alternative designs.” § 17 cmt. c. It is not used, as in Pogliero v. Wallace China Co., 198 F.2d 339 (9th Cir. 1952), to encompass any design “feature [that] is an important ingredient in the commercial success of [a] product…”


72. See, e.g., Chevron Chemical Co. v. Voluntary Purchasing Groups Inc., 659 F.2d 695, 702-03 (5th Cir. 1982) (“possible varieties of advertising display and packaging are virtually endless”); Fun-Damention Too, Ltd. v. Gemmy Industries Corp., 111 F.3d 973, 1000-01 (2d Cir. 1997) (“there may be a finite set of ways to configure a product”).

73. See Thomas & Betts Corp. v. Panduit Corp., 65 F.3d 654, 658 (7th Cir. 1995) (“product features, though they may identify the source of the product, do not really identify the product—they are the product”).
(adaptive) purpose.\textsuperscript{74} It is thus normal for consumers to assume that manufactured features have functional significance, and the assumption is exacerbated if the feature serves even a \textit{de facto} role.\textsuperscript{75}

At this juncture, the reader has likely observed that, in the process of assessing configuration protection, the law intuitively has adopted a host of cognitive principles. It has been noted in the \textit{Restatement}, for example, that "as a practical matter . . . it is less common for consumers to recognize the design of a product . . . as an indication of source."\textsuperscript{76} In \textit{Wal-Mart}, to iterate, the Court observed that, as contrasted with packaging, there was not the same "predisposition to equate . . . features with source."\textsuperscript{77} It is submitted, however, that the application of cognitive principles can simplify the analysis.

1. LEGO Building Blocks

In Canada, the owner of the LEGO brand for children's building blocks initiated litigation to protect the configuration of the toy, claiming that the size and relationship of the round nubs (2x high, 5x in diameter, spaced 8x from center to center) served to identify a single source of blocks to consumers.

From the perspective of cognitive science, there are basic imperfections in the claim:

1. Consumers perceive the blocks as a whole; they do not segregate the nubs from the underlying bricks;
2. Round nubs in a 2/5/8 relationship are not a memorable difference relative to other relationships (e.g., 4/4/8); and

\textsuperscript{74} Dawkins, \textit{The Blind Watchmaker: The Evidence of Evolution Reveals a Universe Without Design} (1986).

\textsuperscript{75} Swann, \textit{supra} note 68, at 263 ("there is an inverse relationship between a feature's utility and its ability to differentiate").

\textsuperscript{76} \textit{Restatement}, § 16 cmt. b ("Product designs are more likely to be seen as utilitarian or ornamental").

\textsuperscript{77} 529 U.S. at 213.
3. Because the nubs serve a functional purpose, they are not viewed as distinctive elements. Protecting round nubs with a 2/5/8 relationship, indeed, would effectively afford Lego a monopoly; it conceded, for example, that hexagonal nubs would be non-infringing:

but consumers in testing did not identify the difference as being source significant.

2. Inexpensive, Plastic Grecian Urns

In *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, on the other hand, the court spent twenty-four pages of the Federal Reporter formulating a test for inherent distinctiveness, and then deciding whether the shape of the below-depicted plastic Grecian urn was "(i) unusual and memorable; (ii) conceptually separable from the product; and (iii) likely to serve primarily as a designator of origin."

In a few sentences, a scientist trained in the human perception of shapes would have concluded that there is absolutely nothing about the urn to differentiate it from its category; it approaches, indeed, being a prototype—a wholly generic rendition.

78. 40 F.3d 1431 (3d Cir. 1994).

79. *Id.* at 1434.

80. The same observation applies to LEGO blocks—their shape is likewise prototypical. "Where a product . . . creates a new functional niche . . . and temporarily holds a strong, almost monopolistic position within that niche, public perception may be more closely tied to
In addition, purchasers of inexpensive plastic urns want something “like” what they have seen before. For the $5.00 cost of the product, they are not seeking an urn design that will differentiate them from their neighbors—which is well, because at that price point, Duraco could not likely produce a truly distinctive configuration.

3. Weatherend Furniture

Configuration distinctiveness is fundamentally a perceptual/psychological construct that is meaningless without reference to the cognitive abilities and biases of observers. A typical consumer, for example, might have difficulty in divining the “inherent distinctiveness” of the Weatherend furniture that was at issue in *Imagineering, Inc. v. Van Klassens, Inc.*

The furniture, however, is very expensive, and it is designated for purchase by professional designers, decorators and architects who can appreciate and carry in memory its soft curves, beveled rails and unique arms. It has been hailed in the design media as “novel” and “exclusive,” and it is featured in the Cooper-Hewitt Museum.

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the concept and function of [the category] in general rather than to the appearance of the particular trail blazing [product].” *Sunbeam Corp. v. Equity Indus.*, 635 F. Supp. 625, 630 (E.D. Va. 1986), aff’d, 811 F.2d 1505 (4th Cir. 1987).

81. 53 F.3d 1260 (Fed. Cir. 1995).

82. A single bench can cost more that $10,000.

83. They are, in the high-end furniture category, like ornithologists in the bird category. They do not view such furniture only as a category, but differentiate its host of, to them, “distinctive” entries.

84. 53 F.3d at 1264.
4. The Crossfire

And, finally, there are "perfect storm" configurations that are promoted for their appearance, that are purchased by discriminating observers in design sensitive markets, and that represent a conflux of emotional and self-expressive content:

Notwithstanding Wal-Mart, the Crossfire is an inherently distinctive vehicle.

C. The Fourth Phase

If configurations are again to become branding devices, trademark lawyers, designers and marketers must cooperate in carefully structured campaigns that, initially at least, focus on those areas where consumers possess a degree of "expertise" (or sophistication) and that offer demonstrated potential for emotional and self-expressive benefits: e.g., automobiles, very high-end furniture, wrist watches and hand bags. Given the plethora of designs that already exist in these arenas, any concerns about the possibility of triggering design monopolies would lack substance. To the contrary, a viable economic argument exists for greater protection:

Consider the case of [Ferrari v. McBurnie]. Direct purchasers [of look-alike "Spyders"] are not confused. People believe[, however,] there are more Ferraris on the road than there really are [and] Ferrari loses some of its prestige which results in a decline in demand for its cars. In addition, there

are capital losses to existing Ferrari owners (they lose the equivalent of lost prestige and their cars decline in value). These are real economic losses. 89

The first focus of any campaign, of course, must be on the generation of unusual designs that create a distinct and "memorable" impression independent of the associated good. 90 If, indeed, design elements are not sufficiently differentiating to be remembered apart from the goods, imitators are likely, factually and legally, to be participating only in the good will of the product, not of its producer.

Because the design is so critical to the goal of protection, strong consideration should be given to the retention of a cognitive scientist in its achievement. An expert trained in the perception of shapes and the development of psychological categories can supply specific input as to issues of separability, retention, distinctiveness and capacity to acquire secondary meaning. 91

The goal, in short, is "inherent distinctiveness," but given cognitive realities and the current status of the law, the emotional and self-expressive content of even highly unique features should be immediately communicated to consumers with "look for" advertising, 92 and a recognition of the design should be assiduously cultivated in consumer and industry publications. 93 Moreover, as soon as possible after use is initiated, efforts should be made to register the design on the Principal Register of the Lanham Act, both to obtain presumptions as to distinctiveness and non-functionality 94 and to manifest an intent that the configuration serves as a brand. 95

Absent such a coordinated approach, design protection efforts will likely prove futile. With an accumulation of such approaches, however, configuration protection can be put back on track in the

89. March 21, 2002 email from William M. Landes to Jerre Swann.


91. Such an expert can supply the same input at trial.


94. See Aromatique, Inc. v. Gold Seal, Inc., 28 F.3d 863, 869 (8th Cir. 1994).

95. Knitwaves, Inc. v. Lollytogs Ltd., 71 F.3d 996, 1008-09 (2d Cir. 1995). Courts react negatively to "afterthought" claims of brand significance. See Pagliero v. Wallace China Co., 198 F.2d 339 (9th Cir. 1952). Moreover, if a plaintiff uniformly registers word marks, but not configurations, a court may infer that the latter lack secondary meaning. See Krueger Int'l, Inc. v. Nightingale, Inc., 915 F. Supp. 598, 609 (S.D.N.Y. 1996); Ohio Art Co. v. Lewis Galoob Toys, Inc., 799 F. Supp. 870, 886 (N.D. Ill. 1992) ("[T]he fact that [the plaintiff] itself [had] not attribute[d] any trademark significance to the shape of its product . . . [is] added evidence that the shape is functional and does not have secondary meaning.").
limited manner that is consistent with the differences, competitively, between words and designs. The time gap between inherent distinctiveness and secondary meaning can be reduced to days, not years. The variety demand for beauty and self-expression will be met. Both producers and consumers will benefit. Both brand equity and brand value will be enhanced.

IV. WAL-MART REVISITED

An accumulation of well-chosen configuration cases may also lead, ultimately, to revisions of the Wal-Mart mandate that the proponent of a configuration, in all circumstances, must demonstrate secondary meaning. Just, however, as likelihood of confusion is not a single-factor determination based on the singularity of the allegedly infringed mark, the inherent distinctiveness of a configuration should not be a single-factor phenomenon dependent upon the singularity of the design. Rather, decisions as to the ability of a design to differentiate, inherently or otherwise, should flow from a cognitively derived and sensitive review of multiple factors, e.g.:

1. the degree of a design's uniqueness;\(^{96}\)

2. the degree to which designs have been used historically in the category to differentiate products;\(^{97}\)

3. the degree of a design's memorability\(^ {98}\) and separability from the product;\(^ {99}\)

4. the degree to which a design affords intangible benefits to consumers;\(^ {100}\)

5. the degree to which a design serves a functional purpose, *de facto* or *de jure*;\(^ {101}\)

\(^{96}\) A relevant inquiry is "whether the design, shape or combination of elements is unique, unusual or unexpected [in a particular] market...." 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 8.13 (4th ed. 1996).

\(^{97}\) "[E]normous competition depends on the body appearance of automobiles." *Chrysler Corp. v. Silva*, 118 F.3d 56, 57 (1st Cir. 1997).

\(^{98}\) See, e.g., *Swann*, *supra* note 36, at 847-50.

\(^{99}\) The concept should be familiar to those seeking to copyright portions of "useful" articles.

\(^{100}\) In *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-LeCoultre Watches, Inc.*, 221 F.2d 464, 466 (2d Cir. 1955), e.g., the court noted that some customers bought a replicated clock "for the purpose of acquiring the prestige gained by displaying ... a prestigious article."

\(^{101}\) See *Swann*, *supra* note 68, at 263.
6. the design sophistication and demands of purchasers of the product;\textsuperscript{102}

7. the advertising and promotion of the design features of the product;\textsuperscript{103} and

8. survey evidence of secondary meaning, or of likely confusion\textsuperscript{104} using a monadic, Eveready-type methodology with a rigorous control.\textsuperscript{105}

In all respects, protection must take into consideration the availability of alternative designs\textsuperscript{106} and/or the degree to which design similarity is influenced by costs or aesthetic factors.\textsuperscript{107} And, as in all intellectual property matters, courts may consider the intent of the plaintiff in creating a design\textsuperscript{108} and of a defendant in adopting it.\textsuperscript{109}

In combination, and applied with the appropriate admonition that a "plaintiff's burden as to [design] distinctiveness is not an

\textsuperscript{102} See Ferrari S.P.A. Esercizio Fabriche Automobili e Corse v. Roberts, 944 F.2d 1235 (6th Cir. 1991). In an increasingly cluttered market, the level of attention that consumers devote to a given stimuli is an increasingly important component of any trademark equation. See Wroe Anderson, Marketing Behavior and Executive Action (1957).

\textsuperscript{103} See Imagineering, Inc. v. Van Klassens, Inc., 53 F.3d 1260, 1264 (Fed. Cir. 1995).

\textsuperscript{104} As with word marks, Union Carbide Corp. v. Ever-Ready Inc., 531 F.2d 366, 381 (7th Cir. 1976), a confusion study may be interpreted to reflect secondary meaning as well. Ideal Toy Corp. v. Plawner Toy Mfg. Corp., 685 F.2d 78, 82 (3d Cir. 1982).

\textsuperscript{105} Any survey must "separate the allegedly protectible trade dress . . . from the clearly non-protectible elements." Thomas & Betts v. Panduit Corp., 65 F.3d 654, 662 (7th Cir. 1995).

\textsuperscript{106} The best evidence that there are alternative designs should come from the actual marketplace. Hypothetical alternatives, without evidence of consumer appeal or cost effectiveness, should be viewed with skepticism. See Disc Golf Ass’n v. Champion Discs, Inc., 158 F.3d 1002, 1008-09 (9th Cir. 1998); also see In re N. Am. Phillips Corp., 217 U.S.P.Q. 926 (T.T.A.B. 1983).


\textsuperscript{108} See note 95 supra.

\textsuperscript{109} See Herman Miller, Inc. v. Palazetti Imports & Exports, Inc., 270 F.3d 298, 313 (6th Cir. 2001) (copying may create an inference of secondary meaning); but see Aromatique, Inc. v. Gold Seal, Inc., 28 F.3d 863, 871 (8th Cir. 1994) (“Where there is demand for a type of product, capitalizing on that demand by copying that product does not necessarily indicate that the original product has secondary meaning.”). The question is whether copying is motivated by a consumer desire for the products made by the plaintiff or for products of the type plaintiff makes.
easy one," the listed criteria should enable courts to filter out strike suits. Of greater note, the criteria should foster more accurate distinctiveness determinations than are possible using a single standard. For example, even an outstanding configuration, in a “backwater” market populated by indifferent purchasers, may not serve to differentiate, whereas an abstractly less distinctive design, laded with emotional and self-expressive content and vended to a sophisticated audience in a design sensitive category, might immediately be assigned to a single source.

V. CONCLUSION

In Wal-Mart, the Supreme Court made certain that competition would be protected in goods mundanely designed. The Court’s reaction to the plethora of questionable configuration cases in the federal system was understandable and appropriate. Neither the Court nor trademark law, however, should ignore consumer benefits to be derived from promoting competition in uniquely designed goods.

In particular, the fact that “product designs currently are less likely to operate as source identifiers should not give rise to forms of analysis that will insure that result.” Unique configurations can be repositories of “information capital” as to quality and variety; because, however, they are often inexpensive to copy, an absence of effective protection is likely to destroy their communicative ability, as well as any “incentive” for their development. An obsessive concern with protecting competition in the mundane can thus have anticompetitive consequences among the unique.

The Court was concerned in Wal-Mart, of course, with its ability to distinguish between the mundane and the unique. The tools to make the distinction exist, and they entail not only an examination of the designs themselves, but an analysis of their promotion, the markets in which they are vended, and the consumers to whom they are sold. It is now the province of the trademark bar, working, over time, with marketers and cognitive scientists, to explicate those tools to the point that they become another set of “factors” that, in so many other areas, guide our craft.


111. Dinwoodie, supra note 10, at 605.

112. See Landes and Posner, supra note 52, at 272.