

Wal-Mart: Has Non-Genericness Been Eliminated as an Element of a Product Configuration Trade Dress Claim?

Gregory B. Wood

The law regarding protection of product configuration trade dress has changes materially in recent years. At the outset, courts recognized and gave trademark protection only to the container or packaging for a product, rejecting any protection for the configuration of the product itself. [1] However, as courts examined the reasons for protection of packaging trade dress, they also began to recognize the rationale for extending that same protection to non-functional configurations of the product itself. [2]

The extension of protection to product configurations has nevertheless raised questions. For example, courts have refused to allow a word to be exclusively appropriated to refer to an object when that word is already used as the generic name for that object because to do so would restrict the public's ability to use that word to identify the product. However, unlike words, product configurations are not generally used to identify what a product is, and imposition of a genericness analysis parallel to that imposed on words makes little sense.

Nevertheless, until the Supreme Court's *Wal-Mart* [3] decision, an owner of a product configuration had the burden of proving the negative, i.e., non-genericness, as an element of its claim before protection would be accorded. This was changed by *Wal-Mart*. Evidence of exclusive use or non-genericness is now but one element of the secondary meaning analysis and no longer stands as a separate element that trumps or permits evidence of secondary meaning to be ignored. [4]

By way of background, word marks must be distinctive to be protectable. A word mark can be either inherently distinctive if "[its] intrinsic nature serves to identify a particular source" [5] or it can acquire distinctiveness if it has developed a secondary meaning. Secondary meaning attaches to a mark when, "in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself." [6]

To assist in determining distinctiveness, words have been categorized as: (1) generic, (2) descriptive, (3) suggestive, or (4) arbitrary or fanciful. This taxonomy was first articulated by the court in *Abercrombie & Fitch Co. v. Hunting World Inc* [7]. Under this scheme, words that are arbitrary, fanciful or suggestive are held to be inherently distinctive. [8] Words that are descriptive can be distinctive only upon proof of secondary meaning. [9] Words that are found to be generic, that is, words that refer to "the genus of which the particular product is the species," can never, as a matter of law, be distinctive. [10]

This analysis had previously been applied to both word and product configuration trademarks. However, in *Wal-Mart* [11] the Supreme Court recognized the significant difference between word and product configuration marks, and rejected the *Abercrombie* taxonomy as the framework for protection of product configurations. The court replace that taxonomy with the requirement that a product configuration was protectable only upon proof of secondary meaning. At one end of the spectrum, this means that a product configuration cannot, as matter of law, be

inherently distinctive. This has been the focus of attention in most cases that have cited *Wal-Mart*. However, at the other end of the spectrum, the rejection of the *Abercrombie* taxonomy also means that non-genericness is also rejected as a separate element that a plaintiff must prove to prevail in a product configuration case.

I. *Wal-Mart*: Secondary Meaning Is Only Element Necessary to Prove Distinctiveness in Product Configuration Trade Dress Cases.

A. Court Did Not Mention Non-Genericness.

The Supreme Court in *Wal-Mart* ruled that a product design - in the *Wal-Mart* case, children's seersucker garments - can never be inherently distinctive and that, unlike a word mark, a product configuration is never, in the first instance, identified with a single source by the public. Consequently, a product configuration is never protectable as being associated with a single source (i.e. can never be distinctive) unless that distinctiveness is acquired. In other words, distinctiveness of a product configuration can only be shown by proof of secondary meaning. [12] In reaching this conclusion, the court also rejected the *Abercrombie* taxonomy as a framework for determining whether product configurations would be protectable. [13] Accordingly, *Wal-Mart* identified only three elements of a product configurations would be protectable. [13] Accordingly, *Wal-Mart* identified only three elements of a product configuration claim: (1) the configuration can be protected *only* upon a showing of secondary meaning; [14] (2) the configuration must be shown to be non-functional; and (3) the accused configuration must be likely to cause confusion. [15] Significantly, in listing these elements, the court did not include non-genericness.

The court's omission of non-genericness cannot be dismissed as an inadvertent oversight, especially after rejecting the *Abercrombie* taxonomy. Rather, the omission was a clear statement by the court that such an element was irrelevant once proof of secondary meaning was required.

B. Omission of Non-Genericness as an Element in Product Configuration Trade Dress Cases Was Purposeful.

The generic label in product configuration cases has been used to describe several quite different fact patterns of varying relevance to the issue of distinctiveness. [16] This has resulted in a lack of clarity in analysis and results. It is not surprising that some courts have concluded that the generic label as traditionally applied to word marks makes little sense when applied to product featured. [17] This is so because the product itself "cannot be said to be 'suggestive' or 'descriptive' of the product, or 'arbitrary' or 'fanciful' in relation to it." [18]

The fact is that, unlike words, we do not use product shapes to communicate ideas. Product configurations are simply not the tools or building blocks of everyday communication. Thus, the very basis for the *Abercrombie* taxonomy is unsuited for application to product configuration cases. [19] That the Supreme Court would shy away from a genericness inquiry in its *Wal-Mart* decision and analysis is understandable.

The intent of the Supreme Court to omit non-genericness as a separate element is also revealed by a careful analysis of the underlying district court and Second Circuit decisions. In the district court case, *Samara Brothers, Inc. v. Judy-Philippine Inc.*, [20] Wal-Mart argued that "Samara's trade dress is not protectable because it is amorphous and contained non-distinctive features commonly and customarily used in children's clothing." [21] Consequently, the issue of commonness (genericness) [22] was directly raised by Wal-Mart. The district court seriously considered this argument but nevertheless denied Wal-Mart's motion because of deference to the jury decision. [23]

Wal-Mart made essentially the same commonness (genericness) argument in its appeal to the Second Circuit. [24] Again, the Second Circuit considered Wal-Mart's commonness argument but ultimately sustained the district court's decision on that ground that the case was not one of those "rare occasions when there is such a complete absence of evidence supporting the verdict." [25] Even so, the Second Circuit accepted with approval earlier decisions that had rejected *Abercrombie's* generic category for product configuration trade dress cases. [26]

Consequently, both the district court and the appellate court rejected the *Abercrombie* taxonomy entirely (and thus also rejected the generic category) in cases of product configuration trade dress.

With genericness explicitly addressed by both the district court and the Second Circuit, the fact that the Supreme Court omitted a non-genericness element from its test in product configuration cases cannot be rationally interpreted to be an oversight or mistake. Rather, this omission can only be deemed to have been an intentional rejection of non-genericness as a separate element of a product configuration trade dress claim. [27]

This understanding of the *Wal-Mart* decision is also supported by the Supreme Court's citation and approval of *Knitwaves* and its recognition that Section 43(a) of the Lanham Act provided protection to product configuration trade dress. [28] *Knitwaves* had also rejected the *Abercrombie* taxonomy for determining distinctiveness in product configuration cases, explicitly stating "we do not ask whether [a product configuration] is 'generic.'" [29] In citing this case with approval, the Supreme Court did not disagree with *Knitwaves's* view of genericness in product configuration trade dress cases. [30]

In fact, the *Knitwaves* view that non-genericness is not an element is entirely consistent with the Supreme Court's decision that there are only three elements that need be proved in a product configuration trade dress case. Indeed, the court expressly held that "in an action for infringement of unregistered trade dress under 43(a) of the Lanham Act, a product's design is distinctive, and therefore protectable, *only upon a showing of secondary meaning*." [31]

A requirement to prove non-genericness would also be inconsistent with the court's holding that a product configuration can never be inherently distinctive. Specifically, until a showing of secondary meaning has been made, a product configuration is deemed to be non-distinctive. Consequently, proof that a product configuration is non-distinctive, whether by evidence of commonness or otherwise, would be superfluous before secondary meaning has been established because the law already presumes the configuration to be non-distinctive.

For each of these reasons, it seems clear that the Supreme Court's elimination of non-genericness as an element in a product configuration case was intentional and that a product configuration trade dress claim cannot be defeated merely by alleging that the trade dress is generic and then placing the burden on plaintiff to prove non-genericness. The burden of the owner of the mark is not to prove secondary meaning.

II. Requirement to Prove Distinctiveness with Evidence of Secondary Meaning Renders Non-Genericness Unnecessary as a Separate Element of a Product Configuration Claim

A. Non-Genericness Is Part of Secondary Meaning Proof

According to *Wal-Mart*, the only way to prove whether product configuration trade dress is distinctive and hence protectable is by proving secondary meaning. Evidence that would bear on whether a product design has acquired secondary meaning includes surveys; consumer testimonials; evidence bearing on the length and manner of use; the amount and manner of advertising; the amount of sales and number of customers; evidence of intentional copying and evidence of an established place in the market. [32]

Significantly, evidence previously relevant to genericness such as evidence that others were using the configuration, is also relevant to the secondary meaning element. However, under *Wal-Mart*, evidence bearing on genericness will no longer be considered in isolation but will be considered along with all the other evidence of secondary meaning. Evidence that a configuration is common therefore does not trump consideration of other evidence bearing on secondary meaning.

This conclusion has pragmatic consequences. If an owner of a configuration trade dress was required to affirmatively prove non-genericness, she would be placed in an almost impossible position of having to prove a negative. This task is made even more daunting because the configuration owner is also precluded from introducing relevant evidence bearing on secondary meaning if it cannot first establish the configuration is non-generic. The court's decision in *Wal-Mart* eliminates this impractical consequence by requiring evidence of commonness to be weighed along with all other evidence bearing on the issue of secondary meaning.

B. Requiring Proof of Non-Genericness Contradicts the Holding That Product Configuration Cannot be Source Identifying Without Secondary Meaning

After *Wal-Mart*, all product configurations are initially presumed to be non-distinctiveness need not be proven by a defendant until a prima facie case of secondary meaning has been established by the evidence. This is so because consumers are not predisposed to equate product configuration with source, and thus, as a matter of law, product configurations are not initially source identifying. The court in *Wal-Mart* observed that this is so because a product configuration almost invariably serves a purpose other than source identification. [34]

This premise also negates the possibility that non-genericness could be a separate element. Considering evidence of genericness before secondary meaning has been established is unnecessary, since the court would be examining evidence to prove something that is already assumed to be true – i.e., the non-distinctiveness of a product configuration. Indeed, entertaining or deciding the issue of genericness before secondary meaning had been established would amount an improper advisory option. [35]

The *Wal-Mart* court also acknowledged a significant difference between word marks and product configuration marks. Generic words are amenable to dictionary definition, and can never be resurrected to source identifying status, because the word must be reserved for all to use to define the product. This is not the case with a product configuration, which is rarely, if ever, used by consumers or competitors to identify source and is certainly not a building block of our way of communicating. Instead, a product configuration is intended, from the beginning, to "render the product itself more useful or more appealing." [36]

Consequently, the Supreme Court ruled that protection could be accorded only if a showing was first made that consumers had come to associate a product configuration with a source. [37] Therefore, even though a configuration was not intrinsically source identifying, it could become source identifying and only then could it be protected. In order to prove that a product configuration has become source indicating, it must be proven that the product configuration has acquired secondary meaning. [38]

Requiring a plaintiff to prove non-genericness as a separate element would therefore be inconsistent with the *Wal-Mart* decision, which requires only that secondary meaning be proven. [39]

III. The Circuit Split Is Best Resolved by Rejecting the *Abercrombie* Taxonomy.

A. Circuits Are at Odds Over *Abercrombie*.

Notwithstanding the above analysis, there is currently a split in the circuits as to whether the *Abercrombie* taxonomy applies to product configuration cases and hence whether non-genericness remains as an element of a product configuration trade dress claim. The Second and Third circuits have rejected the *Abercrombie* taxonomy for product configuration cases, [40] whereas the Sixth and Eighth circuits have not. [41]

Through their decisions in *Duraco Products*, *Landscape Forms*, and *Knitwaves*, the Second and Third circuits have rejected the use of the *Abercrombie* taxonomy in product configuration cases, explaining that it is inappropriate to apply this test to product design or configuration cases because a product configuration differs fundamentally from a product's word trademark. As a substitute for the *Abercrombie* taxonomy the sole inquiry at a court's disposal in product configuration cases is "whether the design was likely to be understood as an indicator of the product's source." [42] In other words, proof of secondary meaning alone suffices.

This would be consistent with *Wal-Mart*. However, the Sixth and Eighth circuits have taken a different direction. In *Stuart Hall Co. v. Ampad Corp.*, the Eighth Circuit disagreed with the Third Circuit's *Duraco Products* decision. The Eighth Circuit instead decided to stand by the use of the *Abercrombie* classifications in product configuration cases. [43] In so doing, the court essentially affirmed that a separate non-genericness element exists notwithstanding the *Wal-Mart* decision.

The Sixth Circuit acknowledged that the court in *Wal-Mart* did not adopt the *Abercrombie* test in product design cases. [44] However, the court nevertheless concluded that Wal-Mart "did not completely eschew the *Abercrombie* taxonomy for analyzing distinctiveness. This reasoning eventually led the court to state that the *Wal-Mart* decision "leaves in place the rule that generic product configurations are not protectable as trade dress under 43(a)," [46] which essentially added a non-genericness element to the three elements for a product configuration claim listed by Wal-Mart.

For the reasons given above, if the *Abercrombie* taxonomy remains in product configuration cases, then non-genericness remains as a distinct element that must be proved in product configuration cases. However, if the *Abercrombie* taxonomy does not apply to product configuration cases, then there is no separate non-genericness element, and distinctiveness will be established solely by proof of secondary meaning.

The singular focus of the Supreme Court on proof of secondary meaning to the exclusion of any mention of non-genericness as a separate element makes a compelling case that the Second and Third circuits are the correct view and that the Sixth and Eighth circuits' inclusion of a non-genericness element is inconsistent with *Wal-Mart*.

B. *Yurman* Does Not Require Additional Element of Non-Genericness.

Since *Wal-Mart*, there has been one Second Circuit decision, *Yurman Design Inc. v. PAJ Inc.* [47] that initially seems to be in conflict with *Wal-Mart* and *Knitwaves*. [48] However, upon careful analysis, *Yurman* cannot be taken as authority for a view contrary to *Knitwaves* which, as above noted, was cited with approval by the Supreme Court in *Wal-Mart*.

First, the discussion of genericness in *Yurman* was dicta. The court in *Yurman* had already concluded that the plaintiff had failed to articulate the trade dress and had consequently dismissed the plaintiff's claim as a matter of law. [49] Because the trade dress had not been articulated, the *Yurman* court stated: "We need not decide whether these design elements are protectable as trade dress." [50]

In essence the court found that the plaintiff had simply failed to state a claim because it failed to identify the trade dress it was seeking to protect. Therefore, any analysis by the *Yurman* court about the protectability of the trade dress, including the discussion of genericness, was entirely unnecessary to the court's holding and thus was dicta.

More significantly, *Yurman* failed to distinguish between principles applicable to word marks and principles applicable to product configuration marks. In addressing genericness, *Yurman*

stated that generic marks are "those that 'refe[r] to the genus of which a particular product is a species.'" [51] However, this note originated from *Park 'n Fly v. Dollar Park & Fly*, in which the defendant claimed that a word mark had become generic after long use. The court rejected that defense and found the term not to be generic. The actual quote was: "A generic term is one that refers to the genus of which the particular product is a species. Generic terms are not registerable" [53] The *Park 'n Fly* decision was not impacted by *Wal-Mart*, because *Park 'n Fly* was a word mark case, not a product configuration case.

Continuing with the origin of the *Yurman* quote, *Two Pesos* quoted the *Park 'n Fly* phrase, but only for the general definition of a generic word mark. Only a portion of the *Park 'n Fly* statement was quoted in *Two Pesos*, and it read: "In contrast, generic marks - those that 'refe[r] to the genus of which the particular product is a species' are not registerable as trademarks." [54]

Whether or not the subject mark was generic was not at issue in *Two Pesos*. Indeed, the word mark claimed was determined to be inherently distinctive negating any need to prove secondary meaning. Nor was product configuration at issue in that case. [55]

Later, *Milstein*, a pre-*Wal-Mart* decision, picked up the quote from *Two Pesos* as follows: "Generic dresses -those that 'refe[r] to the genus of which the particular product is a species' are never protectable." [56] The application of this quotation, originally referencing word marks, to generic dresses (product configurations), was made under the assumption (without any authority) that word marks and product configuration marks were to be treated the same and that the *Park 'n Fly* quotation applied equally to word and product configuration marks. This assumption, although likely rationale prior to *Wal-Mart*, is no longer valid in view of the decision in *Wal-Mart* which explicitly found that word marks and product configuration were different and required different analysis.

It was this quote in the *Milstein* case that *Yurman* adopted and in so doing duplicated *Milstein's* erroneous assumption that word and product configuration marks were to be treated the same. For these reasons, the quotation found in *Yurman* cannot be a basis of concluding that non-genericness remains as an element in product configuration trade dress cases.

IV. Public Policy Against Protecting Generic Terms as Trademarks Is Not Present With Product Configuration Trade Dress.

The public policy that precludes protection for generic terms as trademarks is to allow competitors the freedom to use commonly used terms to describe their goods. [57] First Amendment principles of free speech also require that terms commonly used to refer to types of goods be equally available to all competitors. [58]

Those policy considerations are not present with product configuration trade dress which is not a vehicle by which competitors commonly refer to their goods. Quite the contrary, the predisposition of consumers is almost invariably to associate product design with the usefulness or appeal of the product itself and not with a particular source. [59]

The policy concerns with product configuration are quite different, arising from concern that competitors will be deprived of the benefits of the "utilitarian and esthetic purposes that product design ordinarily serves." [60] This is a form of protection provided by patents, not trade dress. This threat is addressed by the requirement that the owner of the product configuration prove that it is non-functional, one of the three elements articulated by the *Wal-Mart* court.

The second policy issue raised by the Supreme Court was the "plausible threats of suit against new entrants based upon alleged inherent distinctiveness." [61] However, this policy concern was fully addressed by the court's holding that product configurations could never be inherently distinctive and that secondary meaning (distinctiveness) had to be proven. [62]

Since both of these policy issues were fully addressed by the requirements to prove non-functionality and secondary meaning, the additional hurdle of proving non-genericness is unnecessary for the protection of consumers and competitors and does nothing to promote the policies articulated by the court for product configurations. The stringent and objective requirement for demonstrating secondary meaning fully addresses the public policy issues.

V. Practical Considerations for Trademark Owners.

This analysis suggests several practical steps that should be undertaken by trademark owners who seek to protect product configuration trade dress. First, to the extent possible, the burden of proving secondary meaning can be avoided entirely if the product configuration can be presented as product packaging and argued to be inherently distinctive.

For product configurations, the owner should seek to register the configuration at the earliest possible time. This may mean registration on the supplemental register. If registration on the principal register is sought, the application should be accompanied by as much evidence as possible that would support a conclusion that the configuration had acquired distinctiveness. Such evidence would include length of use, advertising expenditures, advertising content that called attention to the configuration, recognition by third parties of the source identifying character of the configuration and any other evidence of acquired distinctiveness. Once registered, secondary meaning is presumed and the burden shifts to the defendant in inter-parties proceedings.

For unregistered marks, *Wal-Mart* places the burden of proving secondary meaning on the trademark owner. This can be a heavy burden particularly if there is evidence that others have at some time used similar configurations.

The trademark owner of an unregistered configuration should first take conscious and affirmative steps to create a link in the mind of consumers between the source and the trade dress. For example, advertising, promotion, and press releases that highlight the product configuration as an indicator of source are strong and perhaps even compelling evidence if continuous over a period of time.

Of course, the beginning point in protecting product configuration trade dress is the careful selection of the configuration itself. The configuration should be as arbitrary as feasible. It should also be a configuration that is not used by anyone else. Conducting a comprehensive trademark search as well as a search of the Internet and trade journals will identify other similar configurations and allow appropriate modification to insure uniqueness at the outset.

Finally, seeking advice of counsel at an early stage of the selection process will pay significant dividends. A focused effort to protect a product configuration from the outset will make litigation to protect the configuration less likely. Even if litigation is necessary, it will likely be less expensive and less complex and have a greater likelihood of success.

[1] See *Duraco Products Inc. v. Joy Plastic Enterprises Ltd.*, 40 F.3d 1431, 32 USPQ2d 1724 (3rd Cir. 1994) (49 PTCJ 69 11/24/94).

[2] *Id.*

[3] *Wal-Mart Stores Inc. v. Samara Brothers Inc.*, 529 U.S.205, 54 USPQ2d 1065 (2000) (59 PTCJ 676, 3/24/00).

[4] This conclusion is at least implicitly recognized in *Adidas-Salomon AG v. Target Corp.*, 228 F. Supp. 2d 1192, 1207 (D. Ore. 2002) and *In re Creative Beauties Inc.*, 56 USPQ2d 1203 (TTAB 2000).

[5] *Id.* at 210 (quoting *Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763, 23 USPQ2d 1081 (1992) (44 PTCJ 213, 228, 7/2/92)).

[6] *Id.* at 211 (quoting *Inwood Laboratories Inc. v. Ives Laboratories Inc.*, 456 U.S. 844, 851, n.11, 214 USPQ 1 (1982) (24 PTCJ 103, 120, 6/3/82)).

[7] See *Abercrombie & Fitch Co. v. Hunting World Inc.*, 537 F.2d 4, USPQ 759 (2d Cir. 1976) (266 PTCJ A-14, 2/19/76)).

[8] *Wal-Mart*, 529 U.S. at 210-11.

[9] *Abercrombie*, 537 F.2d at 9.

[10] *Id.*

[11] *Wal-Mart*.

[12] *Wal-Mart*, 529 U.S. at 216.

[13] As the court will not find a product design to be inherently distinctive, it is clear that the court will no longer apply the *Abercrombie* categories of suggestive, arbitrary, and fanciful, because these categories make up the inherently distinctive aspect of the *Abercrombie* spectrum.

[14] *Wal-Mart*, 529 U.S. at 216.

[15] *Id.* at 210, 216.

[16] Genericness has been used by courts to refer to situations in which a product design is common as well as to situations where the product design is overbroad, inadequately defined or simply vague.

[17] See, e.g., *Abercrombie & Fitch Stores Inc. v. American Eagle Outfitters Inc.*, 280 F.3d 619, 639, 61 USPQ2d 1769 (6th Cir. 2002) (63 PTCJ 353, 2/22/02); *Knitwaves Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1008-09, 36 USPQ2d 1737 (2d Cir. 1995) (51 PTCJ 95, 11/23/95); and *Duraco Products*, 40 F.3d at 1449.

[18] *Duraco Products*, 40 F.3d at 1440-41.

[19] See *Id.* at 1441.

[20] *Samara Brothers Inc. v. Judy-Philippine Inc.*, 969 F. Supp. 895, 897-98 (S.D.N.Y. 1997).

- [21] *Id.* at 897 (emphasis added).
- [22] See *supra* note 13.
- [23] See *Wal-Mart*, 969 F. Supp. at 898.
- [24] See *Samara Brothers Inc. v. Wal-Mart Stores Inc.*, 165 F.3d 120, 125-27, n.2 (2nd Cir. 1998).
- [25] *Id.* at 125.
- [26] *Id.* See also *Landscape Forms Inc. v. Columbia Cascade Co.*, 42 USPQ2d 1641 (2nd Cir. 1997) (54 PTCJ 65, 5/22/97) (court stated "[w]e agree with the Third Circuit that, in contrast to verbal marks, one cannot meaningfully ask whether a product's design features are generic..."); *Knitwaves*, *supra* note 14 at 1008 (court stated that "in determining whether each of Knitwaves' sweater designs can be protected as a trademark, we do not ask whether it is 'generic' 'descriptive,' 'suggestive,' or 'arbitrary or fanciful' - categorizations which we find inapplicable to product features...")/
- [27] The Supreme Court did accept that the *Abercrombie* taxonomy remained viable for word marks. However, in so doing the court clearly differentiated between the elements applicable to word marks and product configuration trade dress. See *Id.* at 210-11 ("*in the context of word marks*, courts have applied the now-classic] *Abercrombie* test...") (emphasis added); 1 J. Thomas McCarthy; *McCarthy on Trademarks and Unfair Competition* 8:13, author's cmt. (4th ed. 2004) ("The Abercrombie spectrum was developed specifically for word marks and does not translate into the world of shapes and designs.").
- [28] See *Wal-Mart*, *supra* note 3 at 209.
- [29] *Knitwaves*, 71 F.3d at 1008.
- [30] It is important to note that the Supreme Court also cited to *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 34 USPQ 2d 1428 (8th Cir. 1995) (49 PTCJ 698, 4/13/95), for that court's recognition that the Lanham Act provides protection for product configuration trade dress. The court in *Stuart Hall* chose to apply the *Abercrombie* taxonomy for product configuration cases. However, greater support is lent to the court's acceptance of the *Knitwaves* positions, rather than the *Stuart Hall* position, in that the *Wal-Mart* court explicitly rejected at least one part of the *Abercrombie* spectrum.
- [31] *Wal-Mart* at 216 (emphasis added)
- [32] Under the case law, evidence bearing on whether a product design is distinctive falls into several broad categories including: (1) whether and how the plaintiff itself used the trade dress as a source identifier; (2) whether and how competitors used the trade dress; (3) the absence of industrial references to the trade dress; (4) testimony of people knowledgeable of the trade regarding the types of products in connection with which the trade dress is used; (5) media usage in connection with the type of products in connection with which the trade dress is used; (6) the existence or absence of usage in dictionaries; (7) evidence gleaned from surveys; and (8) other evidence of secondary meaning including amount and nature of advertising, the length of exclusive use, and the intent of a defendant to copy. 2 J. Thomas McCarthy; *McCarthy on Trademarks and Unfair Competition* §§ 12:13, 15:30 (4th ed. 2004).
- [33] See *Wal-Mart*, 529 U.S. at 212, 216.
- [34] *Id.* at 213.
- [35] See *U.S. National Bank of Oregon v. Independent Insurance Agents of America Inc.*, 508 U.S. 439, 446 (1993) ("[A] federal court [lacks] the power to render advisory opinions.").
- [36] *Wal-Mart*, 529 U.S. at 213.
- [37] *Id.* at 211, 216 (held that "a product's design is distinctive, and therefore protectable, only

upon a showing of secondary meaning" which "occurs when, in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.").

[38] *Id.* at 216.

[39] *Wal-Mart*, 529 U.S. at 216.

[40] See *Knitwaves*, *supra* note 14; *Duraco Products*, *supra*

[41] See *American Eagle Outfitters Inc.*, 280 F.3d 619.

[42] *Landscape Forms*, 113 F.3d at 378 (citing *Knitwaves*, 71

[43] *Id.* at 785-788.

[44] *American Eagle Outfitters Inc.*, 280 F.3d at 637.

[45] *Id.* at 637-638.

[46] *Id.* at 438. The court acknowledged that the Supreme Court in *Wal-Mart* had not addressed the ability of generic designs to distinguish goods as "the product of a particular supplier, leaving open the conceptual possibility that generic designs bearing secondary meaning are protectable." However, the court felt that the reasoning of Judge Friendly, in denying protection to generic words marks in *Abercrombie*, applied equally well to generic product configurations. The court further posited that *Wal-Mart* left this rule in place for product configuration cases. However, it is unclear how accurate the Sixth Circuit's reasoning was in coming to such a determination. The court seemed to jump from a reference to the *Abercrombie* test and the unregistrability of generic marks contained in *Two Pesos* to the conclusion that *Wal-Mart* left in place the non-genericness element. The Sixth Circuit reached this conclusion despite the fact that the court in *Wal-Mart* had distinguished *Two Pesos* on the grounds that it was a product packaging case, rather than a product design case. Moreover, even if the Supreme Court meant to leave in place the rule that generic product configurations are not protectable, this does not mean that it intended to leave in place a separate non-genericness element rather than simply acknowledging that once secondary meaning had been established that an opponent could always pursue a genericness defense.

[47] *Yurman Design Inc. v. PAJ Inc.*, 262 F.3d 101, 59 USPQ2d 1813 (2nd Cir. 2001) (62 PTCJ 382, 8/24/01) (court held that jewelry designer failed to prove a trade dress claim because he failed to identify the elements that make up its trade dress).

[48] The court rejected the *Abercrombie* taxonomy for product features, and in doing so, it explicitly rejected a separate genericness inquiry, in favor of only a secondary meaning inquiry. The court explained, "we do not ask whether [a product] is 'generic,' 'descriptive,' 'suggestive,' or 'arbitrary or fanciful' - categorizations which we find inapplicable to product features. Rather, we ask whether it is 'likely to serve primarily as a designator of origin of the product...'; *Knitwaves*, 71 F.3d at 1008 (citations omitted).

[49] *Yurman*, 262 F.3d at 114.

[50] *Id.*

[51] *Id.* at 115 (quoting *Jeffrey Milstein Inc v. Greger, Lawlor, Roth Inc.*, 58 F.3d 27, 32-33, 35 USPQ2d 1284 (2d Cir. 1995) (50 PTCJ 241, 7/13/95)).

[52] *Park 'n Fly v. Dollar Park & Fly*, 469 U.S. 189 (1985) (29 PTCJ 239, 1/10/85).

[53] *Id.* at 194 (citations omitted) (emphasis added).

[54] *Id.* at 768 (citations omitted).

[55] See *Wal-Mart*, 529 U.S. at 215 (stating that "*Two Pesos* is in opposite to our holding here because the trade dress at issue, the decor of a restaurant, seems to us not to constitute product design. It was either product packaging...or else some *tertium quid* that is akin to product

packaging..."). [56] *Milstein*, 58 F.3d at 32.

[57] 2 McCarthy, *supra* note 34, at 12:2.

[58] *Id.* at 12:3.

[59] Wal-Mart, 120 U.S. at 213.

[60] *Id.*

[61] *Id.* at 213.

[62] *Id.* at 214.