

TRADEMARK SPACES AND TRADEMARK LAW'S SECRET STEP ZERO¹and²

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ABSTRACT

When is a design just a design, and when is it a trademark? Over the last several decades, courts have developed a clear framework for evaluating the distinctiveness of certain unconventional marks, especially those typically conceived of as “trade dress.” The Supreme Court has drawn a line between product packaging, on the one hand, and product design, on the other. Packaging features are treated just like any other potential trademark in the sense that we protect them automatically if they are inherently distinctive, and we require evidence of secondary meaning if they aren’t. Product

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design is different. Like color, it is incapable of being inherently distinctive and can be protected only when it has acquired secondary meaning. There's just one problem with this fundamental rule: It isn't true. Or at least, it isn't the whole truth. As we show in this Article, sometimes courts and the trademark Office don't recognize features like logos as being part of a product's design, and as a result, they ignore the categorization system and evaluate the claimed features for inherent distinctiveness. Something similar happens with certain product packaging features, except in reverse. In other words, courts are engaged in a previously unrecognized "step zero" before they classify trade dress features and apply the normal rules of distinctiveness for product packaging and product configuration. In that largely implicit step, courts and trademark examiners make their own judgments about the role of that feature, and particularly whether they believe consumers are likely to regard those features as trademarks. While courts and the Trademark Office have been slow to articulate rules for step zero – or even to acknowledge that it exists – we show in this article that in practice they are recognizing what we call "trademark spaces": locations that consumers are likely to assume are serving as trademarks. When they apply this implicit step zero, courts and the Trademark Office frequently treat the location of a claimed feature on the product or package as an important determinant of trademark status. As we describe in detail, some locations are special. Use in those spaces goes a long way to convincing a court or trademark examiner that the design is a trademark. The recognition of trademark spaces offers a way to rationalize the step zero analysis and to begin thinking more systematically about the relationship between distinctiveness and use as a mark. Courts can and should evaluate use in a trademark space as part of the broader step zero inquiry. But they should do so explicitly and based on evidence, not instinct. Bringing step zero out into the open will help us better understand when and why consumers react to certain designs as trademarks. And it will pave the way for us to reject claims to own things that either do not or should not function as trademarks.

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INTRODUCTION

Trademark law was created with words and logos in mind, but it has more recently expanded to include other kinds of designs – particularly those courts generally refer to as “trade dress.”⁵ That expansion has raised difficult conceptual and doctrinal questions because design features, even more than words, can serve many different purposes. When is a design just a design, and when is it a trademark?

Over the last several decades, courts have developed a clear framework for evaluating the distinctiveness of trade dress. The rules that comprise this framework are, as an initial matter, categorical: The Supreme Court has drawn a line between product packaging, on the one hand, and product design, on the other (*See Wal-Mart*, 529 U.S. at 213-215). Packaging features are treated just like any other potential trademark. They are immediately protectable if they are inherently distinctive; if they’re not inherently distinctive, then they’re only protectable if they have secondary meaning (*See Wal-Mart*, 529 U.S. at 214-215).⁶ Product design is different. Like color, it is inca-

⁵ *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209 (2000). “Trade dress” has never been defined particularly well, but it consists at least of product packaging and product design. *See id.* The lack of a clear definition of trade dress is a consequence of the fact that trademark law used to define a narrow class of signs *into* trademark law (so-called “technical trademarks”); everything else (including but not limited to what we now call “trade dress”) was subject to unfair competition rules. Because unfair competition remedies were defined by conduct rather than by ownership interest, there was no “subject matter” of unfair competition – and therefore no need to define categories, if that were even possible to do. For a more complete description of the distinction between property-based and conduct-based rules, see generally McKenna (2019).

Much of our discussion here also distinguishes between product packaging and the shape or attributes of the product itself, which trademark law refers to as “product configuration” or “product design.” We think there are often good reasons to treat those types of trade dress differently, but we also challenge the idea that all designs can be assigned to one of those categories.

⁶ “Secondary meaning” is a trademark term of art referring to a new, source-indicating meaning that develops over time and supplements, but does not necessarily replace, the word or design’s original (“primary”) meaning. (*See Wal-Mart*, 529 U.S. at 211) (defining secondary meaning as existing when “in the minds of the public, the primary significance of a [mark] is to identify the source of

pable of being inherently distinctive and can be protected *only* when it has acquired secondary meaning (Wal-Mart, 529 U.S. at 212).

To be sure, it's not always easy to distinguish packaging and design – categories the Supreme Court has never defined. Still, even if the task is sometimes difficult, the basic doctrinal structure is clear and now fundamental to the way we teach trademark law: To determine eligibility for protection, we first have to classify the claimed subject matter as either packaging or product design, because we apply different rules to each.⁷

There's just one problem with this fundamental rule: It isn't true. Or at least, it isn't the whole truth. As we show in this Article, sometimes courts and the Trademark Office⁸ don't recognize features like logos as being part of a product's design, and as a result, they ignore the categorization system and evaluate the claimed features for inherent distinctiveness.⁹ Something similar happens with certain product packaging features, except in reverse: Even though they are capable of being inherently distinctive (Wal-Mart, 529 U.S. at

the product rather than the product itself") (quoting *Inwood Lab's, Inc. v. Ives Lab's, Inc.*, 456 U.S. 844, 851 n.11 (1982)). Thus, "fish fry" is descriptive of batter for frying fish, so that term is not inherently distinctive. The term "Fish-Fri" was deemed protectable as a trademark, however, because it had acquired secondary meaning identifying a particular producer. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790-96 (5th Cir. 1983).

⁷ Or, in some cases, we must determine whether the claim is to color "alone" or color as a feature of packaging or design. We discuss that distinction further below. *See infra* notes 48-52 and accompanying text.

⁸ The Trademark Office is part of the United States Patent & Trademark Office. It is the unit responsible for determining, at least in the first instance, whether trademarks can be federally registered. *See Trademarks*, U.S. PAT. & TRADEMARK OFF. Available in: <<https://perma.cc/CY8Q-JA3F>>. (last updated Nov. 14, 2022, 8:48 AM EST).

⁹ *See, e.g., Adidas-Am., Inc. v. Payless Shoesource, Inc.*, 546 F. Supp. 2d 1029, 1056 (D. Or.2008) (evaluating inherent distinctiveness and secondary meaning, without ever acknowledging Adidas's three-stripe design as a product design feature); *see also Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 383 (2d Cir. 2005) and *infra* notes 83 and accompanying text discussing and providing examples of cases in which courts evaluated the inherent distinctiveness of product design features).

212), they are sometimes refused protection without consideration of distinctiveness at all.¹⁰

Most courts and the Trademark Office evaluate inherent distinctiveness of product packaging and other non-word marks by asking whether the claimed feature is:

A 'common' basic shape or design, whether it [is] unique or unusual in a particular field, whether it [is] 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 [is] capable of creating a commercial impression distinct from the accompanying words.¹¹

But sometimes courts or the Trademark Office conclude that packaging features are merely decorative or ornamental. When they do, they don't just find that the features aren't inherently distinctive; they often bypass distinctiveness altogether and find the features unprotectable because they don't function as trademarks.¹²

In other words, the framework for determining the eligibility of trade dress features has a previously unrecognized "step zero" – a step that comes before classification of trade dress features as product packaging or product configuration.¹³ In that largely implicit

¹⁰ See 843 F. Supp. 2d 1134, 1146 (D. Or. 2011); *In re Lululemon Athletica Can. Inc.*, 105 U.S.P.Q.2d (BL) 1684, 1689 (T.T.A.B. 2013) and accompanying text (discussing examples).

¹¹ *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977). Not every circuit uses this approach. Some, including the Second Circuit, insist on using the *Abercrombie* framework that courts use to classify word marks based on their meaning, though they do so at a higher level of generality for designs – distinguishing between features that automatically indicate source (inherently distinctive) and those that don't (requiring secondary meaning). See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-11 (2d Cir. 1976); see also, e.g., *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 1000-04 (2d Cir. 1997).

¹² For discussions of the failure to function doctrine, see generally Roberts (2019); Ramsey (2020); Cuatrecasas (2021); and Grynberg (2015).

¹³ This is a nod to *Chevron* deference in administrative law, where the well-known twostep test turns out to have an antecedent "step zero" that determines whether the test even applies at all. Cass R. Sunstein, *Chevron Step Zero*, 92 VA. L. REV. 187, 191 (2006).

step, courts and trademark examiners make their own judgments about the role of the claimed features, particularly whether they believe consumers are likely to regard those features as trademarks. Depending on the role they believe those features are playing, courts and examining attorneys will depart from the doctrinal structure created by the Supreme Court, sometimes treating product design features as potentially inherently distinctive, and sometimes refusing automatic protection (and perhaps protection at all) to unique or unusual features of product packaging.

Because the prevailing structure focuses overwhelmingly on distinctiveness, there is very little doctrine associated with deciding whether a design functions as a mark. As a result, this unacknowledged step zero is generally ad hoc. It also has a strong “know it when you see it” character. The lack of conceptual or doctrinal clarity about the relationship between distinctiveness and use as a mark is not unique to the trade dress context, or even to designs.¹⁴ But the problems are more pervasive and difficult in the design context, because there the distinctiveness questions are more complicated and the meaning of use as a mark is less clear.

While courts and the Trademark Office have been slow to articulate rules for step zero – or even to acknowledge that it exists – we show in this Article that in practice they are recognizing what we call “trademark spaces.” Specifically, they frequently treat the location of a claimed feature on the product or package as an important determinant of trademark status. As we describe in detail below, some locations are special: Use in those spaces goes a long way to convincing a court or trademark examiner that the design is a trademark (*See* LEE; DeROSIA; CHRISTENSEN, 2009, p. 1.076-1.078).¹⁵ The reverse is true as well: A design that is not located in a

¹⁴ Alex Roberts has thoroughly described the Trademark Office’s somewhat routine practice of rejecting trademark applications on the ground that the claimed marks fail to function. *See* Roberts (2019, p. 2.202-2010), *supra* note 12. We elaborate on these broader trends and their relationship to the design context in Part II below.

¹⁵ (arguing that consumers are more likely to interpret words or symbols as trademarks if they are placed in areas where trademarks are commonly located).

traditional trademark space may not be considered a trademark even if it's a recognizable logo that would clearly be treated as a trademark if it were located elsewhere.¹⁶ The implicit emphasis on trademark spaces aims to reflect consumer understanding of branding at a sort of Goldilocks level: less categorical than the distinction between product packaging and product design, but more general than mark-specific secondary meaning rules.

Trademark spaces often serve a preliminary framing function, determining whether courts recognize the features as trade dress that therefore must be categorized as product design or as packaging. They also play a substantive role in determining trademark status. Courts and the Trademark Office assume that images in trademark spaces will be understood by consumers as trademarks, while images outside a traditional trademark space won't be. For example, courts and the Trademark Office may treat a new image as a trademark if it is placed over the left breast of a shirt or on the tongue of a sneaker, but not if the same image is put in a different location.¹⁷ That assumption affects the distinctiveness analysis, making courts more likely to treat the design as having secondary meaning when it is located in a trademark space. It also often influences their judgments as to whether the design functions as a mark rather than being merely informational or ornamental.

The recognition of trademark spaces offers a way to rationalize the step zero analysis and to begin thinking more systematically about the relationship between distinctiveness and use as a mark. Courts can and should evaluate use in a trademark space as part of the broader step zero inquiry. But they should do so explicitly and based on evidence, not instinct. Bringing step zero out into the open will help us better understand when and why consumers react to certain designs as trademarks. And it will pave the way for us to

¹⁶ See *In re Lululemon Athletica Can. Inc.*, 105 U.S.P.Q.2d (BL) 1684, 1686-87, 1689 (T.T.A.B. 2013) (rejecting an application to register a design resembling the Lululemon logo when presented in large format on a sweatshirt).

¹⁷ See Roberts (2019, p. 1.983, n. 23, see note 12) *infra* note 63 and accompanying text.

reject claims to own things that either do not or should not function as trademarks. Specifically, we argue that efforts to claim trademarks in designs outside a recognized trademark space should face a higher burden of proof whether the design is on a product or on packaging.

At the same time, greater emphasis on trademark spaces comes with its own risk of circularity. Trademark spaces are simply a tool for determining whether a claimed design functions as a mark, and the question remains how a court is to know that a particular space should be treated as a trademark space – what evidence the court should rely on and what standard it should use. We offer some ways to prevent the runaway recognition of trademark spaces, which is essential because the logic of trademark spaces demands that they be rare. If everything is a trademark space, the concept is useless as a tool for discerning consumer understanding.

In Part I we discuss the basic rules that (supposedly) govern protection of trade dress. In Part II we explore the problem of ornamentation and introduce the implicit step zero analysis courts are engaged in to decide whether and how to apply the basic rules of Part I. In Part III we discuss the implications of how courts treat ornamentation, including what to do about courts' implicit use of step zero and how a recognition of trademark spaces can help the law respond to the problem of ubiquitous branding.

I. THE (WRITTEN) LAW OF TRADE DRESS

A. INHERENT VS. ACQUIRED DISTINCTIVENESS

To be eligible for trademark protection, a word, name, symbol, or device must identify the source of the goods or services with which it's used.¹⁸ Signs that indicate source are called “distinctive,” and we evaluate the distinctiveness of claimed words by categorizing them

¹⁸ 15 U.S.C. § 1127 (“The term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof [...] used by a person [...] to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”).

along the famous *Abercrombie* spectrum.¹⁹ That doctrinal structure treats terms differently depending on their relationship to the products or services with which they're used. Arbitrary terms (ones with existing meaning that is unrelated to the goods) and fanciful (made-up) terms are considered "inherently distinctive." Those terms are deemed trademarks just by virtue of that classification, with no further evidence necessary.²⁰ For example, we assume that consumers will automatically treat "Apple" as a trademark when applied to computers because the word apple has no semantic connection to those goods. The same assumption applies with respect to "suggestive" terms, which give sufficiently indirect information about the goods that consumers must use some imagination to make the connection between the term and the goods or services.²¹

Giving trademark protection to other words that convey more direct information comes at greater cost. Words that name the relevant category (computer, for instance) are considered generic.

¹⁹ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) ("Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful."); *see also* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (approving of the *Abercrombie* spectrum as the "classic formulation" of distinctiveness).

²⁰ *Abercrombie*, 537 F.2d at 11 ("It need hardly be added that fanciful or arbitrary terms enjoy all the rights accorded to suggestive terms as marks – without the need of debating whether the term is 'merely descriptive' and with ease of establishing infringement.").

²¹ *See Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 792 (5th Cir. 1983) ("If a term 'requires imagination, thought and perception to reach a conclusion as to the nature of goods,' it is considered a suggestive term." (quoting *Stix Prods., Inc. v. United Merchs. & Mfrs.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968))). Igloo is a good example of a suggestive term when used for coolers – coolers aren't igloos, and they're not made in the Arctic, but they are meant to keep their contents cold. *See Buccafusco, Masur & McKenna* (2022). Some have questioned whether suggestive marks should be treated as inherently distinctive. *See, e.g.,* Jake Linford (2017, p. 1.371-1.373 and 1.413-1.415). For an argument that the distinction between suggestive and descriptive terms is overdrawn, and that it should be more difficult to protect suggestive terms, *see Buccafusco et al., supra*, at 19-24. *See also* Fromer (2022, p. 215) (arguing for greater focus on primary meaning and reduced reliance on secondary meaning as a means of establishing trademark rights).

Generic terms don't identify a single source, and the competitive costs of granting exclusive rights in those terms are extremely high. As a result, generic terms are categorically unprotectable.²² Descriptive terms, which may also be in relatively short supply, may communicate information about the product rather than signaling that it comes from the trademark owner.²³ Unlike inherently distinctive terms, which can get protection as soon as the trademark owner starts using them, descriptive terms are protected only when consumers have come to understand those terms primarily as trademarks. Trademark law calls that acquired trademark meaning "secondary meaning," and developing it usually requires extensive use by the trademark owner to brand their goods.²⁴ "American Airlines" would just have described attributes of the company when it was founded ("It's an airline. In America."), but today consumers have come to associate that name with a particular company.

Overall, the process of determining the distinctiveness of words is a categorization exercise, where the categories reflect the extent to which the claimed term gives information about the goods. The primary legal distinction is between terms that are inherently distinctive (fanciful, arbitrary, and suggestive terms), and those that are not (*Abercrombie*, 537 F.2d at 9-11). Inherently distinctive terms are automatically treated as trademarks; some non-inherently distinctive terms (descriptive terms, geographic terms, surnames) can earn their way into trademark status by developing secondary meaning. Generic terms are disqualified.

²² *Zatarains*, 698 F.2d at 790 ("Generic terms can never attain trademark protection."). At least that used to be the rule until 2020, when the Supreme Court raised the possibility that a generic term can become a trademark if you simply tack ".com" onto it and that a once-generic term can later become protectable. *U.S. Pat. & Trademark Off. v. Booking.com B.V.*, 140 S. Ct. 2298, 2308 (2020).

²³ It turns out that arbitrary marks may also be in short supply, as Barton Beebe and Jeanne C. Fromer (2018, p. 977-1.041) have shown. And even fanciful marks may be more constrained than we assume. Jake Linford (2017, p. 734).

²⁴ *Zatarains*, 698 F.2d at 795; *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 213-15 (2000).

While the Abercrombie spectrum is built around words that serve as brand names (Apple), trademark law has long recognized that images can serve a source-identifying function too. Indeed, they often do so more effectively than mere words. “Apple” can be a fruit as well as a device maker, but there is no question what this is²⁵:

Figure 1: Apple Logo



The challenge with these marks is that the Abercrombie framework is based on the semantic meaning of words, which images (at least the nonrepresentational ones) don't have. As a result, while the Second Circuit sometimes still tries to wedge images and package shapes into those word mark categories,²⁶ other circuits rely primarily on a test originally developed by the Federal Circuit's predecessor in *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*²⁷ That case required the

²⁵ Though Apple seems to think people are a little unclear on what its logo looks like. It recently sued a company that offers recipes over this logo, shown to the left of Apple's in case you can't tell which one is which:



²⁶ The Second Circuit's practice with respect to product packaging is inconsistent. *Compare* *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 1000-02 (2d Cir. 1997) (holding that the distinctiveness of trade dress should be evaluated under the *Abercrombie* framework), *with* *Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 381-82 (2d Cir. 2005) (evaluating the distinctiveness of packaging features under *Seabrook*).

²⁷ 568 F.2d 1342, 1344 (C.C.P.A. 1977). *See* McCarthy, 2022, § 8:13) (“By the 21st Century, it became clear that most courts were moving to a new test that was

court to evaluate whether the “stylized leaf design” that Seabrook used on its packaging functioned as a trademark separately from the words contained in the design:

Figure 2: *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, Stylized Leaf Design



Under the majority Seabrook test, to determine whether a claimed feature is inherently distinctive, courts consider:

[1] whether it [is] a ‘common’ basic shape or design, [2] whether it [is] unique or unusual in a particular field, [3] whether it [is] 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 [4] whether it [is] capable of creating a commercial impression distinct from the accompanying words (*Seabrook Foods*, 568 F.2d at 1.344).

While the details differ, Seabrook attempts to ask the same fundamental question as *Abercrombie*: Is the claimed feature something that consumers are likely to automatically view as a

specifically created to solve the puzzle of the inherent distinctiveness of shapes and designs: the *Seabrook* test.”).

trademark because of its unique or unusual nature, or is it something that might have another, non-trademark-related explanation and therefore requires evidence that consumers would think of it as a trademark? Applying *Seabrook*, the Fifth Circuit found this star design not inherently distinctive for self-storage services because it was a common basic shape that was not unique or unusual, especially for businesses operating in Texas (the “Lone Star State”)²⁸:

Figure 3: *Amazing Spaces* Star Design



The court found that Abercrombie “fail[ed] to illuminate the fundamental inquiry in this case” and therefore applied *Seabrook*.²⁹ Having found the star design not inherently distinctive, the court then also found that it lacked secondary meaning.³⁰

B. TRADE DRESS

Things get even more complicated in the context of trade dress. As we previously noted, that category has never been particularly well-defined, in large part because it wasn’t a legally relevant category until fairly recently (*See supra* note 5, and accompanying text). As the Supreme Court noted, “trade dress” originally included

²⁸ *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 243 (5th Cir. 2010).

²⁹ *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 243 (5th Cir. 2010).

³⁰ *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 243 (5th Cir. 2010) at 247, 249-50.

only a product's packaging (its "dressing"), but over time it expanded to include the design of a product itself (*Wal-Mart*, 529 U.S. at 209). Given their potentially different functions, it might be useful to distinguish "product configuration" (referring to the overall shape of a product) from "product design" (referring to designs on parts of products).³¹ But the law doesn't currently make that distinction – at least not explicitly. It instead uses product configuration and product design essentially interchangeably.

In *Two Pesos, Inc. v. Taco Cabana, Inc.*, a case about the design of a Mexican restaurant, the Supreme Court held that inherently distinctive, nonfunctional trade dress is protectable without evidence of secondary meaning (505 U.S. 763, 765, 776 [1992]).

Figure 4: Taco Cabana Restaurant Design



Because the defendant conceded in that case that the claimed restaurant design was both inherently distinctive and nonfunctional, the Court didn't consider the conditions under which trade dress could be inherently distinctive, or the rules that would apply to evaluate trade dress distinctiveness (505 U.S. 770 [1992]). When forced to consider those rules, the Court has twice drawn categorical distinctions.

³¹ This is akin to what Sarah Burstein is working on with dotted-line design patent claiming. See Burstein (2019, p. 562-563) (suggesting that dotted lines distinguish between articles and portions thereof).

First, *Qualitex* limited the *Two Pesos* holding by declaring that “color alone is incapable of being inherently distinctive and is protectable only with secondary meaning.”³² *Qualitex* claimed a particular green-gold color in connection with dry-cleaning press pads (*Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 161 [1995]). Like insulation, there is no reason a dry-cleaning press pad needs to be any particular color. *Qualitex* chose an unusual (and unusually ugly) color, and it used that color for all its drycleaning pads:

Figure 5: *Qualitex* Dry-Cleaning Pad



The Court held that colors are capable of serving as trademarks (meaning they are not categorically excluded from protection).³³ Importantly, though, it held that color is not inherently distinctive:

³² *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163 (1995). “Color alone” is to be distinguished from color (or a combination of colors) as a feature of a trademark or trade dress (though, as we describe below, that distinction isn’t always a clear one). Obviously *Qualitex* was using the green-gold color not in the abstract but in connection with dry-cleaning press pads, so the Court didn’t refer to color “alone” in the sense of color in the abstract. What it meant to distinguish were claims to colors as features of more complex trade dress – perhaps like the use of red in the overall trade dress of the Coca-Cola can. *See id.* at 173-74 (rejecting the argument that color “alone” need not be recognized as trademark subject matter because parties can always claim broader trade dress of which color is one feature).

³³ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 166 (1995) (noting that color is capable of serving as a mark).

A product's color is unlike "fanciful," "arbitrary," or "suggestive" words or designs, which almost automatically tell a customer that they refer to a brand. The imaginary word "Suntost," or the words "Suntost Marmalade," on a jar of orange jam immediately would signal a brand or a product "source"; the jam's orange color does not do so. But, over time, customers may come to treat a particular color on a product or its packaging (say, a color that in context seems unusual, such as pink on a firm's insulating material or red on the head of a large industrial bolt) as signifying a brand. And, if so, that color would have come to identify and distinguish the goods [...].³⁴

Color, then, can be protected as a trademark only when it has secondary meaning.

In *Wal-Mart Stores, Inc. v. Samara Bros.*, the Supreme Court added product configuration to the list of things that would get that special legal treatment. In *Wal-Mart*, Samara claimed the design of "a line of spring/summer one-piece seersucker outfits decorated with appliqués of hearts, flowers, fruits, and the like"³⁵:

Figure 6: Samara Brothers Clothing Design



³⁴ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 162-163 (1995) (emphasis omitted) (citations omitted).

³⁵ *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 212-213 (2000).

Drawing on *Qualitex*, the Court rightly noted that the appearance of a dress wasn't the sort of thing that people would automatically assume identified the source of the goods. Samara might be known for designing children's dresses, but its dresses don't all look like this one; meanwhile, many other companies also made dresses that fell under Samara's broad description. Consumers therefore were unlikely to think that all one-piece-seersucker dresses with heart appliqués came from a single source.³⁶ Indeed, one might be skeptical even of claims that the designs of Samara's clothing had secondary meaning. The fact that a party has sold a particular product for a long time doesn't mean people think the design of that product identifies the party as its source; consumers might simply like the product.³⁷

The Court went further in *Wal-Mart*. The problem, it noted, is not just that people aren't likely to immediately assume that the design or shape of a product identifies the source of that product. It is that people normally buy products because of how they look and how they function, and recognizing trademark rights in those things would deprive competitors of the ability to compete effectively:

The fact that product design almost invariably serves purposes other than source identification not only renders inherent distinctiveness problematic; it also renders application of an inherent-distinctiveness principle more harmful to other consumer interests. Consumers should not be deprived of the benefits of competition with regard to

³⁶ *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 213 (2000). ("In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs – such as a cocktail shaker shaped like a penguin – is intended not to identify the source, but to render the product itself more useful or more appealing.").

³⁷ See *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 44 (1st Cir. 2001) (finding that the desirability of scented candles wasn't evidence the design of their labels served a trademark function); *In re David Crystal, Inc.*, 296 F.2d 771, 773-74 (C.C.P.A. 1961) (reasoning that because protecting blue-and-red stripes on white ribbed socks was broad, better evidence was needed that consumers treated these stripes as source-identifying).

the utilitarian and esthetic purposes that product design ordinarily serves by a rule of law that facilitates plausible threats of suit against new entrants based upon alleged inherent distinctiveness (*Wal-Mart*, 529 U.S. at 213).

Thus, there is little reason to think automatic protection of product configuration is necessary, and good reason to think that such treatment would be costly.³⁸

For those reasons, the Court in *Wal-Mart* concluded that product configuration, like color but unlike product packaging, cannot be inherently distinctive (*Wal-Mart*, 529 U.S. at 212-213). Notably, features that are not inherently distinctive can still be protected; they just need to have secondary meaning (*Wal-Mart*, 529 U.S. at 215).

Putting these rules together, notwithstanding broad claims that trademark subject matter can include “almost anything at all that is capable of carrying meaning,” (*Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 [1995]) distinctiveness doctrine demands categorization of the claimed matter. If a party claims color alone or product design features, that party must prove the claimed features have acquired distinctiveness; those features cannot be inherently distinctive. If, on the other hand, a party claims product packaging, then inherent distinctiveness is potentially in play.³⁹

In assessing whether the claimed feature of product packaging is inherently distinctive, courts and the Trademark Office use the Seabrook test (or, in the Second Circuit, sometimes a modified version of the Abercrombie spectrum) to determine whether consumers would automatically treat the claimed features as trademarks. Sometimes that does actually seem likely. Consider

³⁸ Given the availability of design patents for these features, “the game of allowing suit based upon alleged inherent distinctiveness seems [...] not worth the candle.” *Wal-Mart*, 529 U.S. at 214.

³⁹ *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 41 (1st Cir. 2001) (“Detachable labels are a classic case of product packaging, and therefore may be inherently distinctive.”).

erstwhile computer company Gateway 2000, which shipped its computers in boxes with cow spots (SANDLER, 2022):

Figure 7: Gateway Computer Boxes (FAGEOL, 2015)



Nothing about those boxes says “computers”; Gateway’s decision to package its computers this way served to brand its goods and distinguish them from its competitors’. And the boxes were certainly unique and unusual.⁴⁰ In other cases where the claimed features do not qualify as inherently distinctive, courts or the Trademark Office must determine whether the features have secondary meaning.

This doctrinal structure leaves difficult classification questions. Sometimes those questions are about the distinction between packaging and design.⁴¹ As the law has evolved, courts mostly recognize that packaging can include things like bottles

⁴⁰ When its distinctiveness was litigated, one court found the packaging to have secondary meaning and so did not consider whether it was inherently distinctive. *Gateway, Inc. v. Companion Prods., Inc.*, 384 F.3d 503, 508 (8th Cir. 2004) (“We agree with the district court that the evidence produced at trial established that Gateway’s trade dress acquired distinctiveness through secondary meaning.”). But we don’t think it needed to go to that trouble.

⁴¹ For a discussion of this problem even before *Wal-Mart*, see Dinwoodie (1997, p. 568-606).

holding liquids, even though the liquid and the bottle generally aren't separated upon purchase,⁴² but that a bumper sticker isn't packaging because its content is the product, even though the sticker may be attached to something else.⁴³

Still, sometimes courts struggle to distinguish the two. For example, is the design on the back pocket of a pair of jeans packaging or design?⁴⁴

⁴² *Globefill Inc. v. Elements Spirits, Inc.*, N.º 10-cv-02034, 2013 WL 12109779, at *2 (C.D. Cal. Oct. 15, 2013) (“Plaintiff’s skull-shaped bottle is packaging, and the trade dress is not product design.”); *Fiji Water Co. v. Fiji Min. Water U.S.A., LLC*, 741 F. Supp. 2d 1165, 1174-76 (C.D. Cal. 2010) (finding the Fiji water bottle to be packaging); *Moroccanoil, Inc. v. Marc Anthony Cosms., Inc.*, 57 F. Supp. 3d 1203, 1222 (C.D. Cal. 2014) (“Moroccanoil’s trade dress is inherently distinctive because, like a Tide bottle and colors, its function is identification.”); *In re Mogen David Wine Corp.*, 328 F.2d 925, 931-32 (C.C.P.A. 1964) (finding that the design of the defendant’s decanter bottle could “acquire the attributes of a registrable trademark”); *accord id.* at 932-33 (Rich, J., concurring) (emphasizing the arbitrariness of the shape of the wine bottle depicted below):



⁴³ *McKernan v. Burek*, 118 F. Supp. 2d 119, 123-24 (D. Mass. 2000) (treating a bumper sticker as a product).

⁴⁴ *See In re Slokevege*, 441 F.3d 957, 958, 961 (Fed. Cir. 2006) (determining that this design for the rear of “pants, overalls, shorts, culottes, dresses, [or] skirts” was product design, not ornamentation).



In her argument, Slokevege emphasized that her “trade dress is located on the rear hips of garments, which is a location that consumers frequently recognize as identifying the source of the garment.” *Id.* at 960. There is no question that some jean stitching has become source-identifying. *See Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 871 (2d Cir. 1986) (holding that the pocket stitching on Levi’s jeans was a trademark). *Lois Sportswear* was decided well before *Wal-Mart*, so the court didn’t consider whether the design, which had long been registered, was product packaging or design. But the court in

Figure 8: Blue Jeans Pocket Design

Part of the classification challenge is that the Supreme Court didn't define "packaging" or "design" and instead simply illustrated the categories by reference to the prototypical examples of the Tide detergent bottle (packaging) and the penguin-shaped cocktail shaker (design) (Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 212-213 [2000]):

Figure 9: Prototypical Packaging and Design Examples

The Court acknowledged that some items would be hard to categorize – like the Coca-Cola bottle, which serves as packaging when used as a container for soda but constitutes the product itself when bought and sold as a collector's item or for consumers who

Slokevage applied the Supreme Court's default rule and categorized the claimed mark as product design. *In re Slokevage*, 441 F.3d at 961.

“buy Coke in the classic glass bottle, rather than a can, because they think it more stylish to drink from the former.” (Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 215 [2000]). Still, the best the Court could offer was a default rule: In hard cases, courts should err on the side of classifying trade dress as product design and require secondary meaning (Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 215 [2000]).

Classification is also difficult because it's not clear that all trade dress fits in one of the two categories of “packaging” and “design.” Indeed, the Court couldn't classify the design of the Mexican restaurant at issue in *Two Pesos* as either one. It called that design “*tertium quid*” that was more “akin” to product packaging, but it failed to explain why restaurant décor was more like packaging (presumably of the food products sold there) than design of the relevant product (restaurant services).⁴⁵ Not only did that treatment undermine the Court's default rule, under which hard cases were to be treated as design, but it raised the prospect that other forms of trade dress might also be “*tertium quid*.”⁴⁶

The Court's Coca-Cola bottle example also gestures at a bigger problem with categorizing claimed designs as product packaging or product design – specifically, the question of whether “products” should be understood in physical or economic terms. The Court, by acknowledging that the bottle's classification depends on the context of its use, recognized that economic significance matters, and particularly that packaging can sometimes be the thing that drives purchases. Most importantly, the Court recognized that the distinction between packaging and design might not always be an either/or proposition. In some cases, such as when consumers prefer Coca-Cola in glass bottles because those bottles are more stylish (*Wal-Mart*, 529 U.S. at 215), packaging and product are inseparable. Method hand soap is another example:

⁴⁵ Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 215 (2000). We note here that no one goes to Rainforest Cafe for the food.

⁴⁶ Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 215 (2000) “*Tertium quid*” is Latin for “a third thing” – iterally, something that does not fit into either category. *Tertium Quid*, BLACK'S LAW DICTIONARY (11th ed. 2019).

Figure 10: Method Hand Soap Design

In a physical sense, the shape of that container is a classic example of product packaging – it holds and dispenses the soap. And yet, many consumers buy Method soap in part because they like the shape of that bottle, which will sit next to their sink and convey a design aesthetic. They may buy a bottle of wine for the same reason – say, if it has a cute animal on the label. In those cases, classification may be impossible, because the design serves both as packaging and product at the same time.⁴⁷

Color also presents classification challenges. One issue is whether a claimed feature should be treated as color (alone), or as part of a broader trade dress of which color is one feature. There's not much riding on the distinction between color and product design, since both categories require secondary meaning (*See supra* Part 1.A). But the stakes are higher when the question is whether the claimed features should be considered color alone (thus requiring secondary meaning) or product packaging (thus capable of being

⁴⁷ Other courts have overdrawn the packaging/product distinction in circumstances in which the shape of the package was an essential part of the product. *See, e.g., In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1336 (C.C.P.A. 1982) (saying, in the course of allowing Morton-Norwich to register as a trademark an innovative no-drip spray bottle that had previously been patented, “it should be borne in mind that this is not a ‘configuration of goods’ case but a ‘configuration of the container for the goods’ case”).

inherently distinctive). In *re* Forney, for example, the question was whether this mark was registrable without secondary meaning:

Figure 11: Claimed Mark in *In re Forney*



The examining attorney and the Trademark Trial and Appeal Board (TTAB) treated the mark like color, requiring secondary meaning. They did so despite the applicant's claim that the "color mark" was "located on the packaging and or labels" and that "the dotted lines merely depict[ed] placement of the mark on the packing backer card."⁴⁸ Even if the color mark was properly understood as part of packaging, the TTAB concluded, product packaging marks that employ color "cannot be inherently distinctive in the absence of an association with a well-defined peripheral shape or border." (*In re* Forney Indus., Inc., 944 [Fed. Cir. 2020]).

The Federal Circuit rejected that approach, at least for combinations of colors, holding that color marks can be inherently distinctive when used on product packaging, and apparently taking the applicant's word for it that the mark was for packaging (despite the fact that the claimed mark had no discernable shape or boundary) (*In re* Forney Indus., Inc., 947 [Fed. Cir. 2020]).⁴⁹ In that respect the

⁴⁸ *In re* Forney Indus., Inc., 955 F.3d 940, 943 (Fed. Cir. 2020) (quoting Brief of Appellant and Appendix, app. at 8, *In re Forney*, 955 F.3d 940 [N.º. 19-1073]).

⁴⁹ ("Forney's proposed mark comprises the color red fading into yellow in a gradient, with a horizontal black bar at the end of the gradient. It is possible that such a mark can be perceived by consumers to suggest the source of the goods in that type of packaging."). Remarkably, the Federal Circuit suggested that the

Federal Circuit disagreed with the Tenth Circuit, which held in a case involving the same trademark claimant that:

In light of the Supreme Court's directive that a product's color cannot be inherently distinctive and its concern that inherent distinctiveness not be the subject of excessive litigation [...] the use of color in product packaging can be inherently distinctive (so that it is unnecessary to show secondary meaning) only if specific colors are used in combination with a well-defined shape, pattern, or other distinctive design.⁵⁰

As the color versus packaging cases suggest, there is plenty of ambiguity as to what counts as trade dress at all,⁵¹ a problem attributable both to lack of category definitions and lack of clear claiming rules.⁵² Relatedly, courts sometimes have struggled with the question of whether designs used for services should be considered

Supreme Court had not, in fact, held that color alone couldn't be inherently distinctive. *Id.* at 946 ("Although *Qualitex* implied that a showing of acquired distinctiveness may be required before a trade dress mark based on color alone can be protectable, it did not expressly so hold."). The Supreme Court would be surprised to hear that. See *Wal-Mart*, 529 U.S. at 211 ("Indeed, with respect to at least one category of mark – colors – we have held that no mark can ever be inherently distinctive.").

⁵⁰ *Forney Indus., Inc. v. Daco of Mo., Inc.*, 835 F.3d 1238, 1248 (10th Cir. 2016). In that case, the Tenth Circuit accepted the plaintiff's description of its trademark as: A combination and arrangement of colors defined by a red into yellow background with a black banner/header that includes white letters. More specifically, the Forney Color Mark includes red and yellow as the dominate [sic] background colors. Red typically starts at the bottom of the packaging, continues up the packaging and may form borders. Red may also be used in accents including but not limited to lettering. Yellow typically begins higher than the red and continues up the packaging. Yellow may also provide borders and be used in accents including but not limited to lettering. A black banner is positioned toward the top of the package label or backer card. Black may also be used in accents including but not limited to lettering. White is used in lettering and accents.

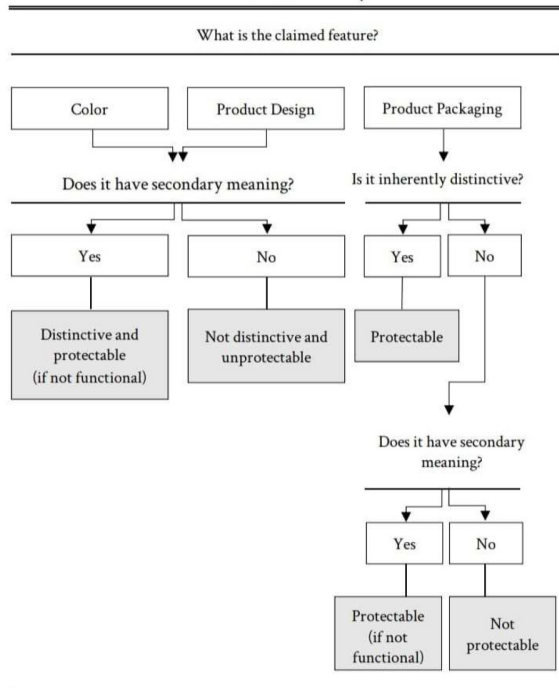
Forney Indus., Inc. v. Daco of Mo., Inc., 835 F.3d 1241 (10th Cir. 2016).

⁵¹ See *Fair Wind Sailing, Inc. v. Dempster*, 764 F.3d 303, 305 (3d Cir. 2014) (holding that Fair Wind failed to adequately explain what "dress" it sought to protect).

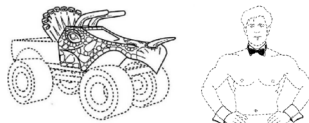
⁵² On the fact that trademark, unlike utility and design patents, doesn't have clear claiming rules, see generally Fromer & McKenna (2018); Tushnet (2017); and Mark A. Lemley & McKenna (2018, p. 2.197).

“packaging” for those services.⁵³ Despite these complications, trademark law seems to have established a clear, and mostly sensible, framework for evaluating the distinctiveness of trade dress:

Figure 12: Trade Dress Classification System



⁵³ See *In re Frankish Enters.*, 113 U.S.P.Q.2d (BL) 1964, 1970 (T.T.A.B. 2015) (finding that a dinosaur-shaped monster truck was packaging rather than configuration because the plaintiff was not selling the truck, but selling services of using the truck in competitions); *In re Chippendales U.S.A., Inc.*, 622 F.3d 1346, 1351, 1356 (Fed. Cir. 2010) (finding that the “Cuffs & Collars” worn by male nude dancers was “part of the ‘packaging’ of the product, which is ‘adult entertainment services, namely exotic dancing for women,’ ” but was nonetheless not inherently distinctive under *Seabrook* [quoting U.S. Trademark Application Serial n.º 77/666,598 (filed Nov. 27, 2000)]).



This is black-letter law. It's established in unanimous Supreme Court cases. It's in all the treatises. It's what we teach our students. But as we will see in the next part, that's not all there is to it.

2 THE SECRET STEP ZERO

In fact, as we show in this Part, closer evaluation of the cases reveals an important, if frequently implicit, “step zero” that courts engage in before applying the distinctiveness rules. In that implicit step, courts and the Trademark Office decide whether the nature and placement of a particular symbol is such that it would likely be viewed as a trademark. They deviate from the settled doctrinal structure when they believe the feature is likely to be viewed as a mark – and sometimes when they don't think it's a mark. When they deviate, they may treat the feature at issue as inherently distinctive even if it is a part of the configuration of the product and therefore supposed to be protectable only with secondary meaning.⁵⁴ Conversely, they may refuse a claimed mark that they determine to be only ornamental even if it would otherwise qualify as inherently distinctive.⁵⁵

⁵⁴ See *infra* Parts 2.B.-C. In some cases, step zero is a question of separability: Courts are determining whether they believe the symbol stands apart from the product or package of which it is a feature. In other cases, the question is whether the feature is likely to serve as a mark or not (the latter often because the feature is regarded as mere ornamentation). These are not entirely distinct issues, since courts' views about ornamentality sometimes affect their sense of whether the symbol stands apart from the rest of the product design. As we discuss below, courts and the TTAB have different instincts about claims to own the entirety of a product or package than they do about images applied to part of that package. As we noted above, we see a parallel problem with design patents on portions of a product. See generally Burstein (2019), *supra* note 31 (critiquing dotted-line claiming in design patents); Burstein (2018a) (arguing that design patents should cover entire products, not fragments of products).

⁵⁵ See *infra* Part 2.B. Other IP rights, notably design patents and copyrights, protect ornamental features directly. See Burstein (2018b, p. 621-624) (concluding that Federal Circuit case law makes it “incredibly difficult” for the Trademark Office to reject *any* designs for a lack of ornamentality); Menell & Corren (2021) (discussing how Congress intended design patents to protect ornamentality); McKenna (2021, p. 197-203; 206-210) (explaining the problems caused by the Federal Circuit's reduction of the ornamentality requirement to nonfunctionality and its nearly exclusive focus on alternative designs to determine functionality); Magliocca (2003, p. 850-856).

Step zero, then, can be determinative of trademark status. Yet that step is largely implicit and lacks any doctrinal structure. That doesn't mean it is random. As we describe in more detail below, especially in the context of product design, whether courts view a particular feature as a trademark often depends in part on whether the image exists in what we call a "trademark space."

A. Trademark Spaces on Products

What we call a trademark space is a place, on a package or a product itself, where courts or the Trademark Office believe consumers expect to find a brand name or logo. There are many examples of trademark spaces on products. An image on the front of a T-shirt usually isn't treated as a trademark; the image is presumptively there because it looks attractive or because it communicates a message (*See* ROBERTS, 2019, p. 1.983, n. 23, *see* note 12). But put the very same image on a tag hanging inside the collar of the shirt or above the left breast on a polo shirt, and consumers (and courts) are likely to immediately assume that the image is a logo even if they have never seen that logo before⁵⁶:

Figure 13: Polo Shirt Logo



⁵⁶ *See* Roberts, 2019, p. 1.983, n. 23; Dinwoodie (1997, p. 605) *supra* note 41, (arguing that courts analyzing trade dress should ask whether consumers will likely identify the product by reference to the features claimed as trade dress).

According to Wal-Mart, a claim to the Polo logo in this context should be understood as a product design claim, which means the feature cannot be inherently distinctive and is only protectable with evidence of secondary meaning.⁵⁷ But that's often not the way this sort of feature is addressed. Courts and the Trademark Office frequently don't treat a logo in this location as product design at all and instead consider the distinctiveness of the logo by itself (*See infra* Part 3.C).

It's true that this particular logo of a Polo player has plenty of secondary meaning by now, so following the appropriate doctrinal structure would undoubtedly lead to its recognition as a mark. But substitute another, lesser-known symbol used in the same location, and both courts and the Trademark Office are still likely to ignore the fact that it's a design feature and assume it's a trademark.⁵⁸

Figure 14: Llama Shirt Design



⁵⁷ *See* Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 207, 216 (2000); *In re* Slokevage, 441 F.3d 957, 959-60, 962 (Fed. Cir. 2006) (concluding that a “cut-away flap design” on the rear hips of garments, a location consumers recognize as source-identifying, nevertheless constituted product design and therefore required a showing of acquired distinctiveness).

⁵⁸ *See infra* Part 3.C. By contrast, a much better known and more detailed llama – the Loot Llama from the video game *Fortnite* – was deemed not to be a trademark because it merely appeared in the game as a character, and consumers therefore wouldn't assume it was a trademark. *In re* Epic Games, Inc., n.º 88233723, at 16-21 (T.T.A.B. May 26, 2021).

In part because of marks like the Polo logo, courts and the Trademark Office have concluded that consumers are conditioned to expect that symbols located on a shirt above the left breast are trademarks.⁵⁹ That is hardly unreasonable, at least at this point. So powerful is the assumption that symbols in this location will be brands that print-on-demand shirt companies routinely offer that space with empty placeholders, as shown here:

Figure 15: Logo Placeholder for Custom Shirt Printing Site



Images placed on the side or on the tongue of a sneaker are also commonly treated as presumptive marks. Everyone recognizes Nike's swoosh or Adidas's three stripes when they are used in those locations. Adidas has used its three-stripe logo on the side of shoes since 1952, and Nike has used its swoosh in that location since 1971.⁶⁰ Both of those companies have long since established secondary meaning in those particular logos:

⁵⁹ See TMEP § 1202.16(b)(i)(C) (July 2021) (“The display of a proposed mark in a prominent location on the goods themselves [...] is a factor that may contribute to finding that it serves as a trademark.”).

⁶⁰ See Registration N.º 3,029,135 (claiming first use of the three-stripe logo on the side of a shoe in 1952); Registration N.º 1,323,342 (claiming first use of the swoosh logo on the side of a shoe in 1971).

Figure 16: Nike Logo on Shoe Tongue



Figure 17: Adidas Three-Stripe Trademark
Adidas Three-Stripe Trademark

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 3,029,135

United States Patent and Trademark Office

Registered Dec. 13, 2005

TRADEMARK
PRINCIPAL REGISTER



Figure 18: Nike and Adidas Logo Placement



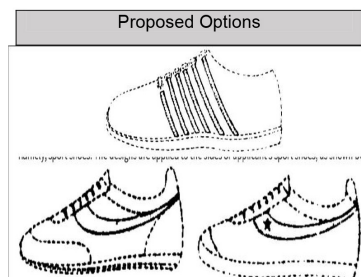
But those companies' uses have done more than that. By conditioning consumers to look for logos on the tongue or the side of the shoe, Nike and Adidas have created trademark spaces. Consumers are now likely to assume that any image located in either of those places is a logo, because they are used to seeing famous logos there. Companies respond to this expectation and try to place their own new logos in the same spots⁶¹:

Figure 19: Shoe Logo Placement



Because consumers have become accustomed to treating these types of markings as trademarks, competitors, courts, and the

⁶¹ Or maybe not so new. See *In re Chung, Jeanne & Kim Co.*, 226 U.S.P.Q. (BL) 938, 942 (T.T.A.B. 1985) (allowing the mark with the star to be registered but rejecting the others as mere ornamentation, without commenting on the similarity between these proposed marks and the Adidas and Nike marks):



Trademark Office have done the same.⁶² Indeed, the recognition is so ingrained that guerrilla brands like Off-White play with the presumption, repurposing a trademark space as a place to communicate information (and to engage in its own subtle form of branding)⁶³:

Figure 20: Off-White Shoe Design Placement

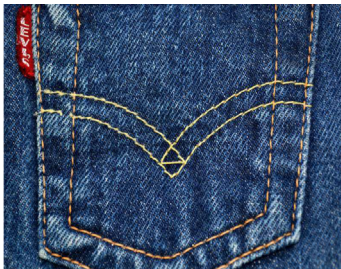


The back pocket of blue jeans is now also a trademark space. Levi's created an iconic stitch pattern in that location, and it spent years developing consumer recognition (BARBARO; CRESWELL, 2007)⁶⁴:

⁶² By contrast, design elements on other parts of a shoe are generally not assumed to be source-identifying. See *LVL XIII Brands, Inc. v. Louis Vuitton Malletier S.A.*, 209 F. Supp. 3d 612, 632, 649, 652 (S.D.N.Y. 2016) (holding that a metal toe plate on the front of a sneaker was not understood to be in a trademark space, despite Louis Vuitton having placed its brand on a toe plate on one style of shoe), *aff' d sub nom.* *LVL XIII Brands, Inc. v. Louis Vuitton Malletier SA*, 720 F. App'x 24 (2d Cir. 2017).

⁶³ For a discussion of the legality of these aftermarket customizations, see generally Lemley & Mazzurco (2023).

⁶⁴ (to locate, select “View the live page”) (describing Levi's stitch pattern as “signature” and noting the company's efforts to prevent competitors from using similar patterns).

Figure 21: Levi's Pocket Stitch Pattern

Levi's achieved recognition of its particular stitching pattern, but the effects extended beyond that one mark. Blue jean companies everywhere now seek to distinguish themselves by the stitching on their back pockets.⁶⁵ Here is just one example:

Figure 22: Blue Jean Stitch Pattern

⁶⁵ Or, occasionally, the absence of stitching. See *In re Slokevage*, 441 F.3d 957, 958, 961-62 (Fed. Cir. 2006) (holding that the cutaway section of a jean pocket showing underwear was product design that could not be inherently distinctive).



Nor are trademark spaces just about clothing. Hood ornaments started out as a way to personalize cars, akin to the front of classic sailing ships (TATE, 2016). But companies soon started treating those spaces as an opportunity to signal who made the car (Ciara Torres-Spelliscy, Political Brands 5, 2019). Car companies such as Rolls-Royce, Mercedes, and Jaguar still use hood ornaments to identify their cars. And virtually all cars use the center-rear trunk as a trademark space for their logos:

Figure 23: Center-Rear-Trunk Logos



Even if you haven't heard of a particular car brand, it's a pretty good bet that if you see a name or symbol in that location, you'll treat it like a trademark:

Figure 24: Center-Rear Trunk Rivian Logo on Truck



The same is true of images placed in the center-back of a laptop. The apple with a bite out of it and the word Dell with a circle around it are well-known logos, but even if you have never heard of MSI⁶⁶ you can be pretty sure that this dragon represents a logo for a laptop computer company. Why? It's in a trademark space.

Figure 25: Center-Back of Laptop Design



According to Wal-Mart, these are all product design features, so none of them should be protectable unless they have secondary meaning. In fact, however, courts are unlikely to treat features in these locations as product design at all, which means they won't necessarily require secondary meaning. If a name or logo appears in a trademark space, courts are likely to treat it as capable of being inherently distinctive, perhaps evaluating it in ways that resemble the Seabrook inquiry.

To be clear, that's not only true of marks that were already known through use in other contexts. In those cases, the preexisting trademark significance of the features might simply carry over to new uses, such that it's not really the location of the use that matters. But use in certain places – trademark spaces – often affects courts'

⁶⁶ Excellent high-end gaming laptops.

evaluation of the uses even when the putative marks are entirely new.⁶⁷

By contrast, words on the front of a T-shirt that communicate a message are treated as presumptively not trademarks (*See* RAMSEY, 2020, p. 85, *see* note 12). *Bobosky v. Adidas AG* illustrated this distinction when it contrasted phrases on the front of shirts that “were prominent and integral parts of the aesthetic ornamentation of the shirts” with “the phrase WE NOT ME,” which appeared “in small print on one sleeve of Bobosky’s shirt without any corresponding imagery.” (843 F. Supp. 2d 1.134, 1.146 [D. Or. 2011]). With respect to WE NOT ME, “other than a medium-size logo over the breast, there [was] no other design on the shirt whatsoever, reinforcing the notion that WE NOT ME [was] more likely to function as source identification than aesthetic ornamentation.” (843 F. Supp. 2d 1.134, 1.146 [D. Or. 2011]).

The court distinguished a second product, however, where the same phrase seemed to be ornamentation, not branding:

Bobosky’s flip-flops are somewhat different. There, the phrase WE NOT ME prominently adorns one of two straps on one sandal, while the WE NOT ME logo appears on the other strap, albeit much smaller. No other markings of any kind appear on the sandals. Since the phrase takes up a significant amount of the visible display space on the flip-flops and is the only decoration on an otherwise plain sandal, it appears to function merely as ornamentation (843 F. Supp. 2d 1134, 1146 [D. Or. 2011]).

Thus, the same mark was held protectable where it appeared in small letters in a trademark space, but not protectable where it appeared in larger letters in a less-established space. Importantly, there was no reason to think that “WE NOT ME” had developed secondary meaning among the purchasing public. Rather, the court

⁶⁷ *See* 843 F. Supp. 2d 1134, 1146 (D. Or. 2011) and *Teal Bay*, 2015 WL 401251, at *4.

treated it as a trademark when it was used in a trademark space without even considering distinctiveness. The location of the words was determinative of ornamentality; that was the only issue of protectability the court considered (843 F. Supp. 2d 1.146-1.147 [D. Or. 2011]).

Location was also determinative in the *Lululemon* case. Lululemon had an established logo in the shape of the Greek letter omega:

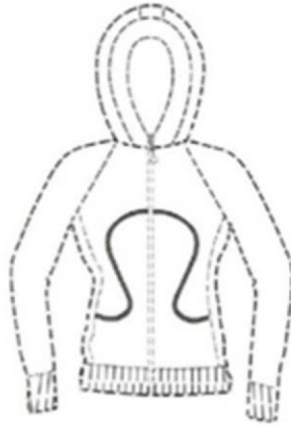
Figure 26: Lululemon Logo



When the company applied to register a version of that logo that appeared across the front of a sweatshirt, however, the TTAB rejected it:

We find that applicant's wave design is rather simple and looks like piping, which, unlike the highly stylized marks depicted above, is likely to be perceived by the public merely as ornamental. Accordingly, the overriding commercial impression of this large-size applied-for design is that of ornamentation (*In re Lululemon Athletica Can. Inc.*, 105 U.S.P.Q.2d [BL] 1.684, 1.689 [T.T.A.B. 2013]).

Figure 27: Lululemon's Rejected Design Applied to Sweatshirt



While the design was meant to evoke an established logo, the size and placement of the design, coupled with the fact that it was not identical to the logo, suggested to the TTAB that consumers would treat it as decorative, not source-identifying (*In re Lululemon Athletica Can. Inc.*, 105 U.S.P.Q.2d [BL] 1.689-1.891 [T.T.A.B. 2013]). Again, the TTAB made that specific determination without any consideration of distinctiveness – despite the fact that the underlying logo was probably already a well-known trademark when used in other contexts (*In re Lululemon Athletica Can. Inc.*, 105 U.S.P.Q.2d [BL] 1.689 [T.T.A.B. 2013]).⁶⁸

There is further evidence that size, like location, matters. In *Teal Bay Alliances, LLC v. Southbound One, Inc.*, the plaintiff filed an intent-to-use (ITU) application for the word “shorebilly” for use on clothing. The application was accompanied by a standard T-shirt specimen (N.º MJG-13-2180, 2015 WL 401251, at *3 [D. Md. Jan. 26, 2015]):

⁶⁸ While it's true that the design on the sweatshirt was not identical to the logo, we are confident that the small differences wouldn't be enough to avoid infringement if a third party were to use that design.

Figure 28: Shorebilly T-Shirt Specimen



The applicant had a phone call with the examiner and:

The applicant was informed of the distinction between ornamental use and trademark use of a brand name. The examiner specifically referred to the use of the Polo and Izod trademarks on shirts as illustrative of trademark rather than ornamental use [...]. The applicant, after his discussion with the PTO examiner, placed an order with Vistaprint, an online supplier of print-on-demand products, for three sample t-shirts using the proffered “Shorebilly” mark in the Polo and Izod fashion that the examiner had told him was illustrative of a proper trademark use (N.º MJG-13-2180, 2015 WL 401251, at *3-4 [D. Md. Jan. 26, 2015]).

Figure 29: Shorebilly Amended T-Shirt Specimen



Def.'s Ex. 7.

The amended application was accepted (N.º MJG-13-2180, 2015 WL 401251, at *4 [D. Md. Jan. 26, 2015]).⁶⁹

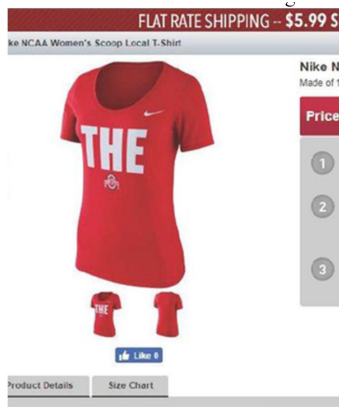
That result can't be explained by secondary meaning; indeed, the application was based merely on an intent to use the mark in the future, so the mark couldn't have acquired meaning by the time of filing. In fact, the examiner approved the application without evaluating distinctiveness at all, even though the claimed mark was a product design feature for which secondary meaning is supposed to be required (*Teal Bay*, 2015 WL 401251, at *4). They did so because the design was in a trademark space.

A more high-profile example is the Ohio State University's registration of the word "The" for clothing.⁷⁰ It originally submitted as a specimen a shirt with the word "The" appearing on the front of it (which doubtless corresponds to what it really intended to own rights to), but the examiner rejected that application⁷¹:

⁶⁹ *Accord Lululemon*, 105 U.S.P.Q.2d (BL) at 1689 (discussing size as a consideration in the registrability of a mark); *In re Greater Anchorage, Inc.*, 2011 WL 810198, at *2 (T.T.A.B. Feb. 14, 2011) ("The larger the display relative to the size of the goods, the more likely it is that consumers will not view the ornamental matter as a mark."); *In re LS&S Retail, Inc.*, 2010 WL 4036046, at *8 (T.T.A.B. Sept. 30, 2010) ("The specimen shows the proposed mark prominently displayed in the upper center portion of the tshirt. [...] In a manner that immediately catches the eye. [...] support[ing] the conclusion that the proposed mark would serve an ornamental rather than a source-identifying function."); see also *Tovey v. Nike, Inc.*, N.º 12-cv-00448, 2014 WL 3510975, at *9 (N.D. Ohio July 24, 2014) ("Plaintiff did not use the Boom Yo! mark to identify the source of his goods. Rather, Tovey used the mark – which consists of a common word – in different fonts, font sizes, designs, colors and locations on his goods. He did not place his mark on hang tags or labels, and he did not designate the phrase Boom Yo! as a trademark on the goods. Accordingly, Plaintiff's use of Boom Yo! lacked the 'consistent and repetitive use of a designation as an indicator of source' that is 'the hallmark of a trademark.' " (quoting *Rock & Roll Hall of Fame & Museum Inc. v. Gentile Prods.*, 134 F.3d 749, 755 (6th Cir. 1998))).

⁷⁰ THE, Registration N.º 6,763,118, Specimen (Aug. 8, 2019), <https://perma.cc/7UBGMS4H>.

⁷¹ THE, Registration N.º 6,763,118, Off. Action Outgoing (Sep. 11, 2019). Available in: <<https://perma.cc/FXK3-4RMT>>.

Figure 30: Ohio State “The” Shirt Design

Ohio State got its registration only when it changed its specimen to show use on a shirt hang tag:

Figure 31: Ohio State Amended Specimen

It's tempting to say that these are just examples of courts or the Trademark Office implicitly distinguishing between claims to the shape of the goods themselves and claims to design features that merely appear on the goods.⁷² It is certainly the case that courts'

⁷² In many of the cases involving words on the front of T-shirts, courts have implicitly recognized that what people are buying is the message, not a branded T-shirt. The same is true of other purported marks that seem designed to communicate a message, like a bracelet that says, "I love you." See *In re Peace Love World Live, LLC*, 127 U.S.P.Q.2d (BL) 1400, 1403-04 (T.T.A.B. 2018).

and the Trademark Office's intuitions about whether consumers are likely to treat certain features as trademarks determines whether they treat those features as product design or evaluate the claimed features separately. But recognition of trademark spaces is not just a distinction between "design on" and "overall design of" a product.⁷³

For one thing, that distinction ignores the doctrinal structure of Wal-Mart and the facts of the case, which was about floral appliqué designs on children's clothes, not the configuration of the clothing.⁷⁴ But it's also not really true that the courts in these cases have evaluated the claimed marks separately from the design of the products. Rather, treatment of these features depends significantly on their location – specifically, whether they are in trademark spaces.⁷⁵ Finally, and perhaps most importantly, courts' determinations that features are used in a trademark space aren't just relevant to which distinctiveness rules should apply. When they believe that a feature is used in a trademark space, courts often effectively declare the feature to be a trademark without considering distinctiveness directly.⁷⁶ In that regard, trademark spaces sometimes turn out to be two for the price of one.

None of this is to say that trademarks must always stay in their place. Race cars and sports jerseys are increasingly covered with third-party logos on every inch of their visible surfaces. Luxury handbag makers commonly plaster their logo repeatedly across their products in an effort to get practical anticounterfeiting protection

⁷³ However, that may well be a relevant distinction for purposes of copyright separability after *Star Athletica, LLC v. Varsity Brands, Inc.*, 580 U.S. 405 (2017). See McKenna (2017, p. 131).

⁷⁴ *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 207 (2000). To be fair, the Supreme Court's description of Samara's claimed trade dress was hardly a model of clarity, so there is some ambiguity about what was included.

⁷⁵ Additional evidence of the fact that location clearly does matter comes from the fact that all these companies own registrations for the logos themselves separately from the registrations showing the logos in those particular locations. If location did not matter, those registrations would be redundant.

⁷⁶ See, e.g., *Teal Bay Alls., LLC v. Southbound One, Inc.*, N.º MJG-13-2180, 2015 WL 401251, at *4 (D. Md. Jan. 26, 2015).

against the copying of the item itself.⁷⁷

These weren't places anyone thought you'd find trademarks – until someone put enough time and money into making those locations matter.⁷⁸ But most of those examples involve marks that were already well known, even if not previously used in those locations. To make the location matter specifically, someone has to blaze the trail.

There are some exceptions, of course, like the red undersole of a Christian Louboutin shoe.⁷⁹ That's not a place one would generally look for a trademark, but the red sole has become an iconic trademark through widespread use (*See* AYRES; TANG, 2020, p. 1.191)⁸⁰:

⁷⁷ *See, e.g.*, *Louis Vuitton Malletier, S.A. v. Hyundai Motor Am.*, N.º 10 Civ. 1611, 2012 WL 1022247, at *1, *27 (S.D.N.Y. Mar. 22, 2012) (granting summary judgment to Louis Vuitton on a dilution claim because Hyundai's airing of a thirty-second commercial titled "Luxury" included a four-second scene of an imitation Louis Vuitton basketball). *But see* *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007) (concluding that " 'Chewy Vuiton' dog toys convey[ed] 'just enough of the original design to allow the consumer to appreciate the point of parody,' but stop[ped] well short of appropriating the entire [Louis Vuitton Malletier] marks") (quoting *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001)). These cases are arguably not as much about efforts to expand trademark spaces as they are efforts to make sure that any copying of the unprotectable product also copies the protectable logo. For a broader discussion of this issue, see generally Sheff (2012) (criticizing post-sale confusion and brand owners' manipulations to include marks as part of product designs).

⁷⁸ While auto racing has been around since the nineteenth century, sponsorship and branding of cars by third parties became popular only in the 1960s and 1970s. *See, e.g.*, Grant-Braham & Britton (2012, p. 530); Wright (2014, p. 18-19).

⁷⁹ *See* *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding*, 696 F.3d 206, 228 (2d Cir. 2012) (holding that the distinctive red undersole qualified for trademark protection, but only to the extent it contrasted with the remainder of the shoe).

⁸⁰ (noting and studying the iconic status of Louboutin's red soles). Some would argue that a single color in this context should be considered aesthetically functional and denied trademark protection regardless of secondary meaning. Others would say, as the court ultimately did, that limiting the scope of the mark (to contrasting red soles) sufficiently limits the competitive consequences of recognizing the rights. *Louboutin*, 696 F.3d at 222, 228.

Figure 32: Louboutin Shoes with Contrasting Red Soles



Still, recognition of a particular company's mark in one of those unusual places only rarely translates into consumer or judicial recognition that anything in that space is likely to be a trademark. That seems to have happened with the left breast of polo shirts after Izod and Ralph Lauren made it popular.⁸¹ But there is no reason to think that just because one company put a lot of effort into creating a brand, consumers think of the undersole of any high-heeled shoe – much less the fabric of every purse or the color of every product – as a brand.

That leaves open the question of when something becomes a trademark space, and how courts and trademark owners are to tell. We explore those questions in more detail in Part 3. But first, we turn to the flip side of product design – the role of step zero in product packaging cases.

B. STEP ZERO FOR PACKAGING

While the Wal-Mart framework says that packaging, unlike configuration, is capable of being inherently distinctive and therefore potentially protectable without secondary meaning, step zero impacts evaluation of packaging too. Courts sometimes deny protection for packaging features without considering inherent distinctiveness at

⁸¹See *supra* notes 58-59, and accompanying text; and N.º MJG-13-2180, 2015 WL 401251, at *3-4 (D. Md. Jan. 26, 2015) and Teal Bay, 2015 WL 401251, at *4.

all. As with product design, that can happen because a court concludes the feature is merely ornamental and therefore doesn't (and can't) serve as a trademark. In fact, courts sometimes find a feature to be ornamental even though it is unique or unusual and therefore the kind of thing the Seabrook test would suggest is inherently distinctive.

Seabrook is different than the Abercrombie framework in that it purports to evaluate both distinctiveness and whether the claimed feature functions as a mark separate from other matter.⁸² Indeed, the court in Seabrook itself concluded that the shape wasn't inherently distinctive standing alone because it wasn't particularly unique and was similar to decorative panels used by competitors.⁸³ The court also concluded that the leaf design didn't have secondary meaning, as none of the relevant evidence could be associated specifically with the leaf design (as opposed to the package as a whole) (*Seabrook*, 568 F.2d at 1.345-1.346). There, separability and secondary meaning converged. In that way, ornamentality ended up being a predicate to the question of distinctiveness.

⁸²See 843 F. Supp. 2d 1134, 1146 (D. Or. 2011); *In re Lululemon Athletica Can. Inc.*, 105 U.S.P.Q.2d (BL) 1684, 1689 (T.T.A.B. 2013) and note 68 and accompanying text. The determination of whether a particular feature functions as a trademark is bound up with the question of what a party claims a mark to be. Product configuration claims are often to the shape of the whole product. That sometimes happens with package – think of the cow-themed Gateway Computer boxes – but the packaging cases that consider separability usually are focused on the separability of the claimed feature from other trademark features, all of which are located on a label. That was the issue in *Seabrook*, for example, where the court was trying to determine if the claimed stylized leaf design could stand alone from the other label material. *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977). Trademark spaces are naturally less important where the entirety of a product or package is claimed to be the mark.

⁸³*Seabrook*, 568 F.2d at 1343-45. The reason the court focused on that specific aspect of the design is that only the stylized leaf design bore any similarity to any portion of the mark that Bar-Well Foods sought to register:



Star Industries, Inc. v. Bacardi & Co. is similar, though with the opposite result. There, the Second Circuit found the stylized “O” design in this Georgi vodka label to be inherently distinctive (*Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 383 [2d Cir. 2005]):

Figure 33: Georgi Stylized “O” Design



According to the court, the “O” was not a common, basic shape because it was stylized and therefore not simply an “unshaded linear representation.” (*Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 383 [2d Cir. 2005]). In that court’s view, a shape can be inherently distinctive so long as the stylization differentiates it from the shape’s platonic form and the particular claimed design was unique in the market when it was adopted (*Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 383 [2d Cir. 2005]).⁸⁴ On the question of separability, the

⁸⁴ Other courts have disagreed with the Second Circuit’s view that “the issue of stylization revolves around comparing a design’s actual appearance to its corresponding platonic form” and instead have compared the claimed mark to other designs in the market. *See Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 245 (5th Cir. 2010). Taking that approach, the Fifth Circuit found this stylized star symbol not to be inherently distinctive in light of the many other (differently stylized) star designs used by companies doing business in Texas:



court's analysis left much to be desired, as it stated in conclusory fashion that the "O" created a separate commercial impression from the rest of the label because the "O" was inherently distinctive (*Star Indus.*, 412 F.3d at 383). But, of course, the "O"s distinctiveness (its uniqueness, standing alone, as compared to other "O" designs) doesn't tell us whether the "O" creates a commercial impression that is separate from the rest of the label design features. Having separated out the "O" and deemed it unique, the court then concluded that it was, in fact, separate.

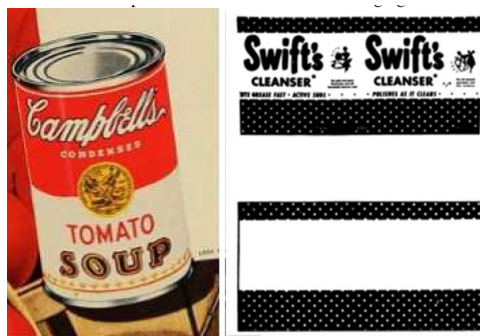
These cases suggest that it's not only courts in product configuration cases that understand that trademark status has more than one dimension. In product packaging cases, we also see considerations of separability and ornamentality.⁸⁵ The Seabrook test makes some effort to combine separability and distinctiveness into a single inquiry, and those cases have the virtue of putting both questions into explicit consideration. But Seabrook has no distinct outlet for concerns about ornamentality, so the packaging cases also reflect a step zero where courts make their own judgments about whether consumers are likely to see a feature as ornamental or as a mark. Some packaging features never get to the "inherently distinctive" analysis because the court concludes that the features are likely to be viewed by consumers as mere decoration, not as branding at all.⁸⁶

⁸⁵ Though *Amazing Spaces* was not exactly a packaging case (it involved the ornamentation of a building, not a product), that court did use *Seabrook* to evaluate the claimed star design, and it also combined notions of distinctiveness and ornamentality. Specifically, the court viewed the star symbol, when used by businesses in Texas, as merely decorative and communicative of pride in Texas. *Amazing Spaces*, 608 F.3d at 247; see also TMEP § 1202.03 (July 2021) (listing various administrative decisions in which ornamental matter was found not to function as a mark).

⁸⁶ Alex Roberts also describes situations in which courts deny trademark status on the grounds that a mark is merely decorative. Roberts (2019, p. 2.001 & nn. 99-106, *supra* note 12) (citing *J.M. Hollister, LLC v. Am. Eagle Outfitters, Inc.*, N.º 203-cv-00703, 2005 WL 1076246, at *2-3 (S.D. Ohio May 5, 2005); and *In re Frankish Enters.*, 113 U.S.P.Q.2d (BL) 1964, 1972-73 (T.T.A.B. 2015)). By contrast, other courts ignore ornamentation once they find the packaging to be distinctive. See, e.g., *In re Proctor & Gamble Co.*, 2012 WL 6064533, at *8 (T.T.A.B. Nov. 16, 2012).

Courts have long tried to distinguish between ornamental features and features that identify source. In one case, *In re Swift & Co.*, the court held that a series of polka-dot stripes on packaging was a trademark, not ornamentation,⁸⁷ while in another case a court found that the simple red-and-white background on a Campbell's soup can was viewed as mere ornamentation not intended to signal source⁸⁸:

Figure 34: Campbell's and Swift's Product Packaging



As the *Swift* court put it:

A merely attractive dress [...] although it be distinctive [...] and sometimes recognized by purchasers as an indication of origin, does not have, as its primary function, an origin-authenticating purpose, and is hence not a trade-mark [...]. Since the line distinguishing between mere ornamentation and ornamentation which is merely an

⁸⁷ *In re Swift & Co.*, 223 F.2d 950, 954-55 (C.C.P.A. 1955).

⁸⁸ *Campbell Soup Co. v. Armour & Co.*, 175 F.2d 795, 797-799 (3d Cir. 1949), *abrogated by* *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995); *see also* *James Heddon's Sons v. Millsite Steel & Wire Works, Inc.*, 128 F.2d 6, 9 (6th Cir. 1942) (holding that "the narrow red stripe applied to [common fishermen's] boxes and containers [was] not a trademark and cannot be exclusively appropriated" because it was not used in a "sufficiently complex combination of other things as to make the combination unique," so there was "nothing peculiar about the trademark in question"). The *Campbell Soup* reasoning depended in part on the fact that the simple design was merely color; that holding was *abrogated by* *Qualitex*, 514 U.S. at 161.

incidental quality of a trade-mark is not always clearly ascertainable, the application of legal principles to fit one situation or the other requires proper reflection upon the impression likely to govern the ordinary purchaser [...]. The significant question is was the symbol or device put on this object to enable the purchaser to pick it out and distinguish it from the goods of others, and is the purchaser able to so identify the object by means of this symbol or Device (*Swift*, 223 F.2d at 954).

Despite *Swift*'s focus on the reasons particular features were used, most courts understand that the issue is consumers' likely reaction, not the putative trademark owner's intent.⁸⁹ For that reason, the court in *In re Burgess Battery Co.* viewed a vertical black-and-white stripe pattern used on packaging for batteries as unprotectable ornamentation despite evidence that salespeople told customers to "look for the black and white stripes" and the advertising included the stripes.⁹⁰

Figure 35: Burgess Black-and-White Stripe Pattern



⁸⁹ See, e.g., *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1345 (C.C.P.A. 1977) (“Seabrook contends that it ‘intentionally selected this mark because its distinctiveness would enable the design to distinguish its products from those of others.’ However, regardless of Seabrook’s intentions, it is the association, by the consumer, of the ‘oval’ design with Seabrook as the source that is determinative.”).

⁹⁰ *In re Burgess Battery Co.*, 112 F.2d 820, 821-22 (C.C.P.A. 1940). In *Swift*, by contrast, the court viewed extensive advertising that told customers to “Pick the Polka Dot package” as evidence that the design was a trademark. 223 F.2d at 953.

Courts have found other packaging, like the Klondike bar's silver-and-blue colored foil package with a polar bear, to be inherently distinctive (*AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1.531, 1.533, 1.536-1.537 (11th Cir. 1986]). The court called those packaging features arbitrary, though images of snow and a polar bear seem at best suggestive of a frozen dessert.⁹¹

Figure 36: Klondike Packaging



Trademark spaces also play a role in the packaging context. For example, the Trademark Office puts significant weight on the location of the claimed mark on the specimen when identifying whether the claimed mark fails to function as a mark. A phrase like “drink more beer” on the inside of a bottle cap doesn't function as a mark in part because it's not located in a place one would expect to find a trademark.⁹² Trademark spaces help courts distinguish designs

⁹¹ *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1.537 (11th Cir. 1986). The defendant's package also featured a polar bear and a similar color scheme, but otherwise appeared rather different. *Id.* at 1533-34.



See Illustration of Klondike Bar Packaging, in @ericladler, TWITTER (Oct. 11, 2014, 11:28 AM), <https://perma.cc/G5LE-2B2C>.

⁹² See *In re Maugus Mfg., Inc.*, 2021 WL 5206090, at *3-4 (T.T.A.B. Nov. 8, 2021) (citing location as one of several factors that are relevant to whether the phrase functioned as a mark); Roberts (2019, p. 2.006-2.007, see note 12) (discussing how the TTAB assesses location when deciding whether, for instance, “1-800-TIRE-911” or a toilet icon on a button of a nurse-paging system acts as a trademark).

that function as marks from things that perform informational or ornamental functions. In this sense, location plays a similar role as prominence, as courts routinely find that words that are deemphasized on product labels (especially relative to other brand names) are not likely to be viewed by consumers as trademarks.⁹³

That emphasis corresponds with the available empirical evidence, which suggests that trademark spaces on packaging can matter tremendously to consumers. Thomas Lee and his co-authors have shown empirically that whatever word you put in the central branding position on a package of cookies will be read by many consumers as the brand name – even if it is a descriptive term like “chocolate” or the generic term “cookie” itself.⁹⁴ In their survey, “fudge covered cookies” was viewed as a trademark by more than a quarter of respondents when it was placed in a trademark space (*See* LEE; DeROSIA; CHRISTENSEN, 2009, p. 1.087, 1.089, 1.090-1.090, 1.087 fig. 1, 1.089 fig. 2).

Figure 37: “Fudge Covered Cookies” in a Trademark Space



⁹³ *See, e.g.,* SportFuel, Inc. v. PepsiCo, Inc., 932 F.3d 589, 596-98 (7th Cir. 2019) (finding that Gatorade did not use “Sports Fuel” as a mark because it wasn’t prominent on the packaging); Jaymo’s Sauces LLC v. Wendy’s Co., N.º 19-cv-01026, 2021 WL 4712685, slip op. at *7, *9 (C.D. Ill. Oct. 8, 2021) (holding that “S’Awesome” was not a mark for a barbeque sauce where the word “awesome” was in small font above the word “Sauce”).

⁹⁴ Lee; DeRosia; Christensen (2009, p. 1.076-1.078 and p. 1.089-1.090, arguing that consumers are more likely to interpret words or symbols as trademarks if they are placed in areas where trademarks are commonly located.). Lee and his co-authors called this the “trademark spot.” Lee; DeRosia; Christensen (2009, p. 1.076). We prefer the term “trademark spaces” because experience has shown that a single product or package may have multiple trademark spaces.

Consumers look for brands on packaging using placement, size, font, and other cues. Thus, placement and prominence of the same word can determine whether consumers think that word is a trademark or not. While more than a quarter of the survey respondents viewed a descriptive term like “wonderful” as a mark even when it wasn’t in a trademark space, that number rose to more than 75% when it was given prominence and located in a trademark space (See LEE; DeROSIA; CHRISTENSEN, 2009, p. 1.097-1.099).

Figure 38: Examples of Different Locations and Prominence

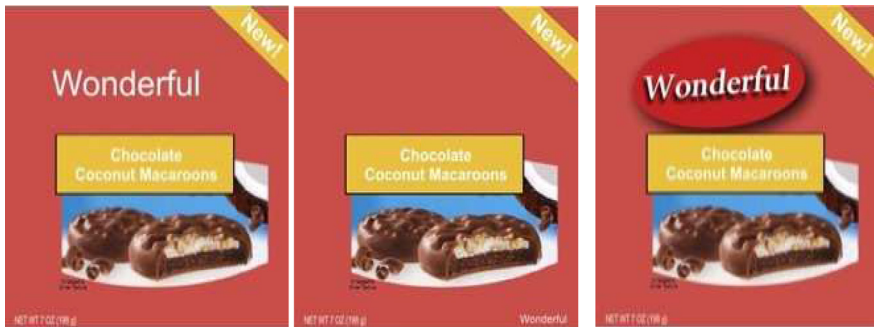
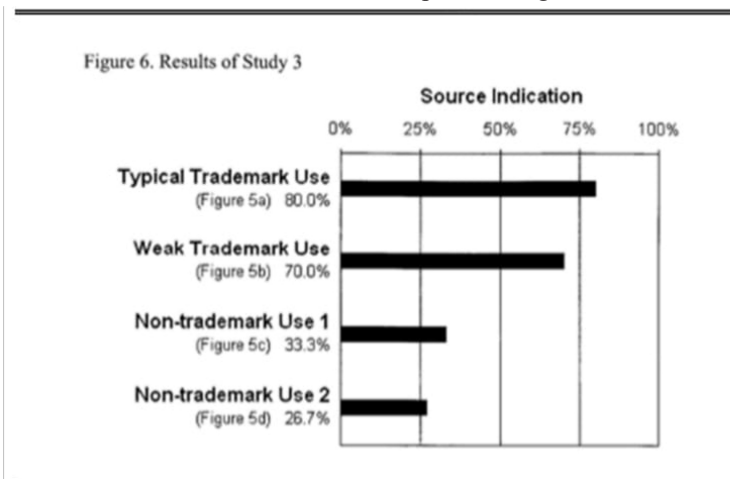


Figure 39: Results of Lee; DeRosia; Christensen Study (See LEE; DeROSIA; CHRISTENSEN, 2009, p. 1.098, fig. 6.



C. HOW DOES STEP ZERO WORK IN PRACTICE?

These cases demonstrate that trademark status is multidimensional: It consists not only of a feature's distinctiveness (its capacity to indicate source) but also of its function as a trademark (the nature of its use and the way it is received by consumers). These dimensions are distinct, but also clearly interrelated.⁹⁵ Where a feature is located can influence both.

The problem is that we have spent decades building a doctrinal structure for only one of those dimensions. Formally, trademark status is dominated by distinctiveness, especially outside the registration context (*Cf.* ROBERTS, 2019, p. 1.982-1983, *see* note 12).⁹⁶ Specifically, doctrinal law instructs courts first to determine whether the claimed features are packaging or design (or, perhaps, color), and then to evaluate distinctiveness using rules that depend on the initial categorization.⁹⁷ But as we have seen, there is an implicit step zero that precedes the categorization. In this step, courts and the Trademark Office determine whether a particular feature – on packaging or configuration – will be viewed by consumers as a trademark because of the place it is used. If the court or Trademark Office concludes that it will be viewed as a trademark, that feature may be automatically protected if it meets the test for inherent distinctiveness. That is true even when the feature at issue is part of the product's design. If courts or the Trademark Office conclude that it won't be viewed as a trademark, then the feature won't be protected at all, even if it is part of the packaging rather than the product itself, and even if it is unique or unusual.

⁹⁵ For one thing, secondary meaning runs these two concepts together by treating the nature of a use as evidence of the purported mark's distinctiveness. More specifically, secondary meaning requires not just use of the claimed mark, but use of it in a particular way, and courts often emphasize prominence and other indicia of trademark use in assessing secondary meaning. *See* Restatement (Third) of Unfair Competition § 13 (American Law Institute, 1995) (emphasizing the role of prominence of use in evaluating secondary meaning).

⁹⁶ (describing how the distinctiveness dimension has received the "lion's share of attention," but arguing that "use as a mark" deserves more attention).

⁹⁷ *See supra* Figure 12; *supra* note 51 and accompanying text, and Fageol (2015).

But how do we know whether a particular feature is or is not likely to be viewed as a trademark? How do we apply this unwritten step zero?

The Trademark Office does better here than courts do. The Trademark Manual of Examining Procedure (TMEP) explicitly instructs examining attorneys to consider commercial impression, and particularly the relevant practices of the trade, in evaluating whether a feature functions as a mark or is merely ornamental.⁹⁸ More specifically, the TMEP emphasizes the importance of the “size, location, and dominance of the proposed mark, as applied to the goods.” (See TMEP § 1202.03[a] [July 2022]). It seems clear that the Trademark Office makes judgments about locations in fairly categorical terms: A small design of an animal over a pocket or breast portion of a shirt is likely a trademark, while a larger rendition of the same matter emblazoned across the front of a garment is ornamentation.⁹⁹

In this respect, the Trademark Office seems to be focusing on a kind of generalized secondary meaning – evaluating whether a particular use is a trademark use based on consumer understanding, acquired over time and experience, of the type of use. The Trademark Office claims to require evidence of that generalized consumer understanding, but once satisfied in the context of a particular party’s use, it adopts a sort of rule: Use above the breast pocket counts.¹⁰⁰

Courts, by contrast, make this determination by the seat of their pants. Because the question falls outside the structure of the formal rules for evaluating distinctiveness, and because courts have much less vocabulary for “use as a mark” in the litigation context,¹⁰¹

⁹⁸ See TMEP § 1202.03(a) (July 2022) (“The examining attorney must determine whether the overall commercial impression of the proposed mark is that of a trademark. Matter that is purely ornamental or decorative does not function as a trademark.”).

⁹⁹ See TMEP § 1202.03(a) (July 2022) (citing *In re Lululemon Athletica Can. Inc.*, 105 U.S.P.Q.2d (BL) 1684, 1687-89 (T.T.A.B. 2013)).

¹⁰⁰ We say “claims to require evidence” because it is not really clear what goes into the Trademark Office’s determinations that certain locations qualify.

¹⁰¹ The Trademark Office regularly has to decide whether a plaintiff is using a claimed trademark as a mark, but the issue arises less frequently in courts.

there is no real mechanism for considering evidence that bears on that question. As a result, courts' implicit judgments lead them to bypass categories and consequently avoid evidentiary requirements. Their instincts may well be correct;¹⁰² we think they were in many of the examples we gave above, for instance. But the ad hockery comes at the expense of the coherence of the law, and it creates an odd divergence between registration and litigation (*See* BROWN, p. 1.380, 1987).¹⁰³

Courts in many packaging cases also bypass parts of the formal structure because the features at issue already have secondary meaning. The court in *Maker's Mark Distillery, Inc. v. Diageo North America, Inc.*, for example, didn't need to decide whether dripping red wax on a whisky bottle was the sort of thing consumers would automatically view as a trademark even though it wasn't in a space traditionally reserved for trademarks (we think it unlikely that they would), because the court believed the dripping wax seal had secondary meaning for *Maker's Mark* as a result of long use and advertising.¹⁰⁴

¹⁰² *See, e.g.*, *LTTB, LLC v. Redbubble, Inc.*, 385 F. Supp. 3d 916, 919 (N.D. Cal. 2019) (holding that the phrase "Lettuce Turnip the Beet" could not be enforced against use on the front of T-shirts, even if it could be enforced in other contexts, and noting that the Trademark Office had registered the phrase only when LTTB submitted a specimen showing use on a hang tag (a classic trademark space)), *aff'd sub nom. LTTB LLC v. Redbubble, Inc.*, 840 F. App'x 148 (9th Cir. 2021).

¹⁰³ ("To say that the overall design of a useful article is 'inherently distinctive' of a particular source just by examining it and perhaps dissecting it, seems to me an impermissible exercise of intuitive judging. [...] Such a short-cut subordinates the functionality inquiry, which is indispensable in appraising a design.")

¹⁰⁴ 703 F. Supp. 2d 671, 683 n.9 (W.D. Ky. 2010) (finding that *Maker's Mark's* red dripping wax seal is either inherently distinctive or has attained secondary meaning through fifty years of consistent use, advertising, and an extremely strong association between the mark and the product).

Figure 40: Red Dripping Wax Seal

But just as with product configuration, the legal doctrine on the books – decide distinctiveness and require secondary meaning only if the packaging is not inherently distinctive – misses an important preliminary step: step zero.

3 IMPLICATIONS

A major doctrine that powerfully influences protectability should not operate behind the scenes, without observable standards or evidence, based on the gut feel of courts and trademark examiners. But that is a fair description of step zero today. There are two possible responses: Do away with trademark's step zero or, alternatively, set rules and build it into the normal legal process.

We are inclined to take the latter approach. We think step zero, properly understood and articulated, serves an important purpose. Indeed, the discussion above highlights that trademark status is and must be multidimensional. Step zero adds a necessary piece to that puzzle. Determining up front whether a design is functioning as a trademark has the same advantages that the late, lamented (by some) doctrine of trademark use had – it enables us to distinguish strong from weak cases at the outset, before wading into a fact-spe-

cific inquiry.¹⁰⁵ It also provides a tool for small defendants to fight baseless claims to features that serve non-source-related purposes like ornamentation.¹⁰⁶ At the same time, a proper application of step zero can protect new trademark owners with distinctive logos that are actually serving to brand their goods, even though those logos are on the product itself rather than on a package.

We also think that the emerging practice of trademark spaces offers an encouraging possibility for finding a middle level of generality that takes into account the realities of how consumers think about trademarks. An analysis of trademark spaces is neither as coarse as a distinction between packaging and design nor as fine-grained as requiring each case to be decided anew on its own facts. Trademark spaces also offer an opportunity to bring use as a mark and distinctiveness into conversation with each other.

¹⁰⁵ For the debate over trademark use, which is still the law in many circuits but has effectively been rejected in the most important circuits, compare Dogan & Lemley (2004, p. 785) (arguing that defendants shouldn't be liable unless they use the claimed trademark as a mark), with Dinwoodie & Janis (2007, p. 1.602-1.603) (arguing the opposite). Cf. McKenna (2009, p. 775-776) (noting the difficulty of defining trademark use except by reference to consumer understanding). For cases turning away from the doctrine, see, for example, *Rescuecom Corp. v. Google Inc.*, 562 F.3d 123, 129 (2d Cir. 2009) (refusing to apply the doctrine in the context of keyword advertising); and *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1145 (9th Cir. 2011) (refusing to apply the doctrine). In the wake of *Rescuecom*, the Second Circuit has held that a defendant need not use content as a mark at all to be liable for trademark infringement. See *Kelly-Brown v. Winfrey*, 717 F.3d 295, 306-07 (2d Cir. 2013) ("Defendants are therefore incorrect that our case law requires plaintiffs to demonstrate they have used Own Your Power 'as a mark' in order to adequately allege a cause of action for trademark infringement."). Notably, these cases contradict prior Second and Ninth Circuit cases adopting the trademark use doctrine. See *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 677 (9th Cir. 2005) (adopting the doctrine); *1-800 Contacts, Inc. v. WhenU.com, Inc.*, 414 F.3d 400, 403, 407, 411 (2d Cir. 2005) (same). So their status as precedent is suspect; settled law treats earlier cases as binding unless they are overruled en banc. But the Second Circuit signaled in *Rescuecom* that the full court didn't object to reversal on that issue, and the trend in these important circuits is to deny that there is any such thing as a trademark use doctrine, at least in the sense of trademark use being a threshold question.

¹⁰⁶ Many defendants with meritorious claims cannot afford to litigate them. (GRINVALD, 2011, p. 646-648).

In this part, we offer ways to regularize the step zero analysis, make it evidence-based, and prevent it from swallowing trademark law's sensible limiting doctrines and rendering them useless.

A. WHAT IS TO BE DONE?

One problem the step zero cases highlight is that the rules requiring categorization as packaging or design don't contain principles for determining when features should be evaluated as part of a broader trade dress, as opposed to standing apart as separable marks. That is in part because trademark law doesn't require a claimant to define exactly what they think of as their mark (*See FROMER; McKENNA, 2018, p. 129, see note 52*), but it is also because the distinctiveness rules do not address the related but distinct issue of use as a mark.

Trademark spaces can help here in several respects. First, trademark spaces can help in determining whether a claimed feature stands apart from other packaging or design features. That will be easier when the claimed feature comprises the entire trademark space than when a party claims only one aspect of the design in the trademark space.¹⁰⁷ We think that features comprising an entire trademark space should presumptively be deemed to function as a mark if they are distinctive. Features that comprise less than the entirety of a trademark space shouldn't benefit from this presumption. When, for example, Nike claims the swoosh on the side of a shoe, it would be sensible to evaluate the swoosh's distinctiveness itself and not as part of an overall product design, notwithstanding the logo's incorporation into the design of a shoe. The placement of the swoosh in a trademark space would make it separable. By contrast, the fact that some design element is part of an overall image in a trademark space doesn't tell us whether that element standing alone

¹⁰⁷ By definition, a trademark space must be a subset of the product design or packaging. A claim to the overall configuration of a product therefore doesn't implicate a trademark space under our definition, and the proponent of that claim would have to prove secondary meaning under *Wal-Mart*.

functions as a trademark. For example, the fact that the Georgi “O” design was included on a label (presumably a trademark space on a bottle of vodka) doesn’t offer much insight as to the separability of the “O” design from the rest of the label design (*See Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 382 [2d Cir. 2005]). In those kinds of cases, Seabrook’s consideration of whether the feature makes a separate commercial impression is a necessary addition in determining separability.

Importantly, the presumption that features that comprise the entire trademark space are separable and function as marks as long as they are distinctive only works if the opposite is also true. Specifically, a feature that is not used in a recognized trademark space should be presumed not to function as a mark regardless of its distinctiveness. Companies that come up with a new and innovative form of branding – whether it’s coloring the bottom of their shoes red¹⁰⁸ or starting baseball games at 7:11 PM (WHITE, 2006) – aren’t completely barred from protecting that branding effort as a trademark. But those claimants should have to prove that the claimed feature is, in fact, functioning as a mark, as used in that context.

Use in a trademark space also matters because some purported marks will be protectable only because of their location in the trademark space. In the registration context specifically, the location and orientation of a mark may be the only things that distinguish a claimed mark from versions of the same symbol that were previously registered. Accordingly, the location in that space ought to act as an important scope limitation. When the claimant seeks to enforce the mark against uses outside the trademark space, it denies the significance of the trademark space and shouldn’t benefit from it in proving distinctiveness.¹⁰⁹

¹⁰⁸ *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 212 (2d Cir. 2012).

¹⁰⁹ On the role of scope limitations in trademark law, see, for example, Lemley & McKenna (2016, p. 2.200-2.203, *see* note 52); Ramsey (2020, p. 95, n. 135, *see* note 12).

The twin presumptions – that signs placed in trademark spaces are at least potentially serving as marks and that signs outside of trademark spaces generally are not – more closely approximate the ways consumers react to logos in those places. And they are more finely calibrated than Wal-Mart's coarse distinction between packaging and product configuration. Like all presumptions, however, these will be both over – and underinclusive.¹¹⁰ Some things in trademark spaces won't actually function as trademarks, and some things outside of those spaces will nonetheless be instantly recognizable as trademarks. So the presumptions should be rebuttable.

Importantly, while trademark spaces play a helpful framing role and help create presumptions regarding use as a mark, they don't resolve every dimension of protectability. As Thomas Lee has shown, a significant number of people think the term "cookies" is a trademark for cookies if you put it in a trademark space (LEE; DeROSIA; CHRISTENSEN, 2009, p. 1.092, arguing that consumers are more likely to interpret words or symbols as trademarks if they are placed in areas where trademarks are commonly located).

But that doesn't mean the law should give anyone exclusive rights in the word "cookie." Marks must still meet the normal criteria for trademark protection – using the Abercrombie distinctiveness spectrum for word marks, and some version of the Seabrook test for visual images (*See supra* Part 1, discussing these tests). Secondary meaning should be required for marks that don't qualify as inherently distinctive standing alone, even if they are in a trademark space.¹¹¹

For example, a common design like a peace sign shouldn't be considered inherently distinctive even if it is placed in a trademark space:

¹¹⁰ See Louis Kaplow, *Rules Versus Standards: An Economic Analysis*, 42 DUKE L.J. 557, 586-96 (1992) (discussing the over- and underinclusiveness of rules relative to standards).

¹¹¹ That approach is compatible with *Wal-Mart* in that courts can declare that the use in a trademark space of a feature that would be inherently distinctive standing alone creates a presumption of secondary meaning (where we're basically imputing faster secondary meaning to a feature because of its location).

Figure 41: Peace Sign in a Trademark Space

To qualify as a trademark, under our approach the image must still be either inherently distinctive or have acquired secondary meaning. But if the feature is distinctive under the traditional tests, and if it is used in a trademark space, the feature is eligible for automatic protection. The important point here is that use as a mark and distinctiveness must both be evaluated explicitly.

What about claimed marks that are features of products or packaging but that aren't in a trademark space? As we suggested, we think those features should not benefit from any presumption that they are being used as a mark, which means they should be protectable only on proof that consumers, in fact, regard the features as marks.¹¹² That is already the rule for product configuration, and it may effectively be the rule in the courts that apply *Seabrook*. But other courts, notably the Second Circuit, may declare an image on

¹¹² See *LVL XIII Brands, Inc. v. Louis Vuitton Malletier S.A.*, 209 F. Supp. 3d 612, 651-54 (S.D.N.Y. 2016) (holding that a metal toe plate on a sneaker was not presumptively sourceidentifying), *aff'd sub nom.* *LVL XIII Brands, Inc. v. Louis Vuitton Malletier SA*, 720 F. App'x 24 (2d Cir. 2017). We note that current doctrine has no real use as a mark doctrine for product designs, though that is perhaps work that aesthetic-functionality doctrine could do. See, e.g., *LTTB, LLC v. Redbubble, Inc.*, 385 F. Supp. 3d 916, 920 (N.D. Cal. 2019) (“Redbubble’s defense on this point may be characterized as either implicating the rule that ‘decorative or ornamental’ features are not subject to trademark protection or the exclusion for ‘aesthetic functionality.’ Case law has not always clearly distinguished between the two concepts, which undoubtedly are related and overlap.”), *aff'd sub nom.* *LTTB LLC v. Redbubble, Inc.*, 840 F. App'x 148 (9th Cir. 2021).

product packaging to be inherently distinctive and so entitled to automatic protection even if consumers are unlikely to think it is a trademark at all.¹¹³ That may be what happened in *Star Industries*, for instance, where the court found that the plaintiff's very slightly stylized "O" made a separate commercial impression simply because the mark, considered alone, was inherently distinctive.¹¹⁴

We think that is a mistake. Trademark owners like to push the boundaries of what can constitute branding.¹¹⁵ And they are entitled to do so. But they shouldn't be entitled to a presumption that consumers will respond when they go beyond common branding techniques. Giving automatic protection to images or designs on packaging regardless of where they are located or how they are presented is unlikely to reflect what consumers actually think. And it opens too much room for unscrupulous operators to try to claim rights in popular slogans or images like "Black Lives Matter" or "I Love My Wife" or "God Bless the USA."¹¹⁶

Figure 42: Non-Distinctive Slogan in a Trademark Space



As the "TM" symbol indicates, the maker of this shirt presumably thinks it is a trademark. It is not.

¹¹³ See *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 997-1001 (2d Cir. 1997).

¹¹⁴ *Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 383 (2d Cir. 2005).

¹¹⁵ For a discussion and examples of trademark overreach, see, for example, Grinvald (2011, p. 641-642, *see note 106*, at 641-42; Roberts (2019, p. 2.010-2.015, *see note 12*; Lemley (2019, p. 2).

¹¹⁶ See *In re Greenwood*, 2020 WL 7074687, at *2-5 (T.T.A.B. Dec. 1, 2020) (holding that "God Bless the USA" as a slogan on T-shirts and other items did not constitute use as a mark); Calboli (2021, p. 403) (discussing numerous efforts by trademark applicants to capitalize on popular terms and phrases).

Indeed, once we make room for designs that are placed in trademark spaces and therefore are likely to be understood as attempts to signal source, we could quite reasonably refuse protection altogether in other product configuration cases. It is extremely unlikely that the actual shape of a product will signal source, and there are good policy reasons to prevent plaintiffs from twisting trademark law to give them effective control over the making of products.¹¹⁷ That would help avoid ridiculous results like a German court's conclusion that Ritter Sport is the exclusive owner of square chocolate bars (*See* HITTI, 2020).

It bears repeating that, for trademark spaces to play these roles in identifying use as a mark and in assessing distinctiveness, those spaces must be rare. The idea of a trademark space is that it stands out to consumers because of its location. If everything became a trademark space, nothing would stand out, and there would be no reason to give use in those spaces any special status.

B. PROVING TRADEMARK SPACES

Trademark spaces aren't determinative, then, but they are important under current law, and will be even more important under our rule. But how are we to decide whether something is a trademark space? As we have seen, courts and the TTAB generally do so implicitly and on an ad hoc basis (*See supra* Part 2.C). Sometimes they talk about whether something is merely ornamental and unlikely to be perceived as a trademark. But they do so based on instincts, not evidence (*See supra* Part 2.C). Even if those instincts are often

¹¹⁷ *See* McKenna (2019, p. 133-134, *see* note 5) (“Product configuration [...] is particularly ill-suited to trademark treatment. A number of the most serious and difficult problems in trademark law are a result of trying to accommodate this subject matter.”). McKenna concludes that “we would better respect the boundaries with other areas of intellectual property by returning to a system that denied protection for product features as such” outside of narrow cases. *Id.* at 134. The Supreme Court in *Wal-Mart* instructed courts to “err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning.” *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 215 (2000). In our view, once we account for trademark spaces, we can take that presumption even further.

correct, bringing step zero into the light will allow us to regularize this process and make it evidence-based.

The Trademark Office can take the lead by making findings on the administrative record about what constitutes a trademark space on various forms of consumer goods. One way to do that would be in a rulemaking proceeding in which the agency takes evidence and issues findings. But the issue will also likely come up before examiners and in litigation before the TTAB. A trademark applicant that cannot or does not want to show secondary meaning can instead seek to show that the nature and placement of their design means that it will be taken by the public as a mark because it is in a recognized trademark space. Courts may also face the same issue if a trademark plaintiff can't show secondary meaning for a design.

Evidence that a space is a trademark space can include consumer surveys, the frequent use of famous marks in that space, the way competitors treat the space, the nature of the goods or packaging in the industry and whether they are typically ornamented, and the general topography of the product (where the space is located, how large and prominent it is). Importantly, while the use of a famous logo in a new space may be the impetus that creates a new trademark space, evidence that a single brand – even a famous one – uses a space for its logo shouldn't make something a trademark space. For instance, Doc Martens boots may well have established consumer recognition of their contrast stitching through long-standing use:

Figure 43: Doc Martens Boots Stitching



But it does not follow that stitching on shoes has become a trademark space more generally. It is only long-standing, well-established use by multiple companies that should lead to recognition as a trademark space. The factfinders should also consider the need for others to use the space to communicate information or to decorate products, the existence of other trademark spaces on the same type of products, and the proportion of the product or package that is proposed to be designated as a trademark space.

C. LIMITING TRADEMARK SPACES

There is a natural tendency among brand owners to turn everything possible into an advertisement for their goods. One worrisome aspect of trademark spaces is the possibility of “trademark creep.” Things that were not trademark spaces may become trademark spaces as companies start to put logos wherever they can.

The problem of trademark creep is real.¹¹⁸ And it can undermine the value of trademark spaces. If everything becomes a trademark space, nothing is. The space will no longer signal to consumers that a design placed there is likely to serve as a trademark. As a result, trademark spaces should be rare, and creating a new one should be even rarer. The evidence required to establish that something is a trademark space should be correspondingly strong.¹¹⁹

Recognizing certain trademark spaces may also open the door to acknowledging that consumers look to other spaces for descriptive information about the product. Thus, just as there are trademark spaces on products and packaging, there are also non-trademark spaces. Think of the nutrition information or ingredients

¹¹⁸ For a discussion of the expansion of trademark law, see generally Lemley (1999); and Lunney, Jr. (1999).

¹¹⁹ In theory, at least, the Trademark Office can and should make findings in appropriate cases that an existing trademark space has ceased to function as a signal that designs placed there are trademarks. As consumer expectations shift, we should expect the role of trademark spaces to shift with it. In practice, however, brands seem to occupy more and more of our attention, and it is hard to think of something that was once a trademark space but no longer is.

list on the label of a food product or the warning label on a bottle of wine. Just as consumers may expect words or logos in certain places to signal source, they expect works or symbols in other places not to signal source. The Trademark Office could perform a valuable service by recognizing some spaces as non-trademark spaces, keeping those spaces off-limits to branding efforts. For instance, the nutritional information on a package of food shouldn't be a trademark, regardless of how much effort the company puts into making it one. Courts and the Trademark Office should refuse to treat designs in such a space as trademarks at all.

Further, the presumptions associated with uses in trademark spaces should be rebuttable. Putting something in a trademark space means it's likely to function as a mark.¹²⁰ But some designs might still be basic enough that they merely ornament the goods regardless of their location.¹²¹ And some words and phrases – like “Black Lives Matter” on a T-shirt – might merely be communicating information regardless of their location (RAMSEY, 2020, p. 74, *see note 12*).¹²² Thus, the fact that some design element is part of an overall image in a trademark space may influence how consumers perceive it, but it doesn't tell us whether that element standing alone is serving as a trademark.

¹²⁰ As a corollary, putting something in a non-trademark space means it is likely not to function as a mark, and the burden should be on the proponent to prove that it has acquired distinctiveness despite that non-trademark signal.

¹²¹ *See* Brooks Shoe Mfg. Co. v. Suave Shoe Corp., 716 F.2d 854, 858-61 (11th Cir. 1983) (finding that a simple arrow or V shape on the side of a shoe was likely to be understood as ornamentation, not branding); Roberts, (2019, p. 2005-2007, *see note 12*); Ramsey (2020, p. 87-89, *see note 12*); Tushnet (2017, p. 924-925; *see note 52*).

¹²² (“Arguably the term I Love You inherently fails to function as a mark for jewelry *regardless of whether this common phrase is displayed on the product or on tags or boxes for the jewelry*. However, for other types of products, such as computers, I Love You might function as a mark if that term is used as a mark in a manner similar to how Samsung, Dell, Apple's logo, and other brand names and symbols are displayed on products or their packaging.” (emphasis added)); *id.* at 87 (mentioning “Black Lives Matter” as an example of a phrase that fails due to the “inherent nature” of the mark).

Courts and the Trademark Office also need to keep in mind that identifying trademark spaces won't resolve all problems. As we have said, trademark status is multidimensional. The claimed feature must also meet the normal test for distinctiveness (*See* notes 19-21 and accompanying text). Descriptive words and standard features shouldn't be made into trademarks just because of their location, since we can't be confident those marks will be given appropriate scope (that is, that their location will be considered an essential feature).¹²³ And the claimed features must not be functional.¹²⁴

Finally, even if a design is protected as a mark, that doesn't mean it should be considered a strong mark or a broad one. As we have discussed elsewhere, the scope of a trademark – not just whether it is valid at all but how much it forbids others from doing – is critical (*See* LEMLEY; McKENNA, 2016, p. 2.202-2.203, *see* note 52). Courts should treat marks that are on the ornamental/source-identifying line as weak, entitled at most to protection against exact duplication. And they should limit the rights to logos recognized as such only because they exist in a trademark space to use in that space. Without secondary meaning, the unknown logo won't signal source when divorced from its use in a trademark space, so the trademark owner shouldn't have control over use outside that space unless and until they establish secondary meaning.

Courts have the power to limit the harm trademarks cause by appropriately restricting the scope of those marks. They don't always do that effectively, unfortunately, which is why we need some bright-line rules. As step zero relaxes those rules, it becomes more important that trademark owners not be permitted to take the opportunity to over-claim, for example by asserting ownership over current memes or slogans.¹²⁵

¹²³ According to the Trademark Manual of Examining Procedure, the location of a mark can "occasionally" be a part of the mark, TMEP § 807.08 (July 2022), but that is not commonly enforced as a limitation.

¹²⁴ 15 U.S.C. § 1052(e)(5) ("No trademark [...] shall be refused registration [...] unless it [...] comprises any matter that, as a whole, is functional.")

¹²⁵ *See, e.g., In re Greenwood*, 2020 WL 7074687, at *2 (T.T.A.B. Dec. 1, 2020) (denying an attempt to register "God Bless the USA"); Calboli (2021, p. 404 and 475, *see* note 116) (noting a wave of trademark applications for common

D. CONSUMER SOVEREIGNTY AND LAW IN ACTION

Understanding how step zero works helps illuminate some larger issues that underlie trademark law.

Trademark and unfair competition law have long struggled with the balance between categorical rules, on the one hand, and doctrinal structures that purport to track consumer understanding of the particular use on the other. Until the middle of the twentieth century, one way the law struck that balance was by defining the subject matter of trademark law narrowly – extending protection only to words and logos that unambiguously indicated source and excluding descriptive terms, geographic terms, and, most relevantly here, most of what we now call trade dress (McKENNA, 2019, p. 119-123, *see* note 5). Those rules were categorical in the sense that they determined trademark subject matter in terms of what type of thing was claimed. Only certain things counted. Parties that didn't own trademarks could seek more limited remedies against passing off under the law of unfair competition (McKENNA, 2019, p. 120). Unfair competition served as an equitable backdrop to trademark law – a more flexible, case-specific doctrine designed to give relief to plaintiffs injured by defendants' conduct even if those plaintiffs did not own technical trademarks (McKENNA, 2019, p. 126).

That changed over the latter half of the century, as courts increasingly rejected categorical constraints on trademark subject matter, defining trademarks instead in terms of an indicator's capacity to indicate source (McKENNA, 2019, p. 123-125; *see also* LUNNEY JUNIOR, 2018, p. 217). So complete was that shift that the Supreme Court could declare in *Qualitex* that “almost anything at all that is capable of carrying meaning” can be a trademark.¹²⁶

But even if anything can be a trademark, there are plenty of reasons to think different types of indicators raise different issues. As a result, having rejected one set of categorical distinctions in

COVID-era phrases); (LINCE, 2020) (finding over fifty applications to register Black Lives Matter marks).

¹²⁶ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

defining trademarks, the Court proceeded to create new categorical distinctions, particularly in the trade dress context. Product packaging gets one set of legal rules; product design another set of rules.

The persistence of an implicit step zero suggests courts aren't really willing to be altogether categorical at the expense of consumer perception. Step zero reflects a judgment that the bright-line rule the Supreme Court created to prevent abuse of product configuration trade dress¹²⁷ is itself imperfect. Courts and the Trademark Office are creating ad hoc exceptions in recognition of the fact that sometimes aspects of a product's design signal branding and sometimes they don't. Step zero is playing some of the "safety valve" role that unfair competition law played during a time when trademarks were much narrower.

As a general matter, trademark law follows consumer beliefs and behavior because it is designed to prevent those consumers from being confused. Step zero is consistent with that approach, modifying a bright-line rule to conform it more closely to how consumers actually think in order to promote the purposes of trademark law.¹²⁸ In other words, trademark law is acting as a norm follower, conforming the law to how people think about it (or at least, in current practice, how factfinders guess people will think about it) (*See* DOGAN; LEMLEY, 2004, p. 784 and p. 811, *see* note 105; DINWOODIE; JANIS, 2007, p. 1.604-1.605 and p. 1.662-1.667, *see* note 105).¹²⁹ Often that is a good thing, and we think it mostly is here.

Sometimes, however, there is a disconnect between how consumers think about something and important competition values.¹³⁰ We discussed earlier Thomas Lee's studies finding that more

¹²⁷ Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 216 (2000) (requiring evidence of secondary meaning for all product configuration).

¹²⁸ As the TTAB has noted, "the critical inquiry in determining whether a proposed mark functions as a trademark is how the relevant public perceives it." Univ. of Ky. v. 40-0, LLC, 2021 WL 839189, at *13 (T.T.A.B. Mar. 4, 2021).

¹²⁹ (discussing "proactive" trademark doctrines that set legal norms and "reactive" ones that follow consumer beliefs).

¹³⁰ *See generally* Lemley & McKenna, 2012 (noting the ways that trademark law implicitly makes competition judgments); Dogan & Lemley (2007, p. 1.242-1.243) (noting that trademark law declares existing marks generic and free for all to use even though many consumers still view them as signifying source).

than 25% of consumers treat a word placed prominently on a package as a brand regardless of the term's genericness (LEE; DeROSIA; CHRISTENSEN, 2009, p. 1.088-1.090, arguing that consumers are more likely to interpret words or symbols as trademarks if they are placed in areas where trademarks are commonly located).

But we don't want to give a company ownership over a generic term just because they put it in a trademark space; doing so would have serious consequences for competition, and we have little confidence courts could manage those consequences by scope constraints (*See* LEMLEY; McKENNA, 2016, p. 2.201-2.202, *supra* note 52).

Similarly, there may be circumstances in which we want trademark law to act as a norm entrepreneur at step zero, shaping consumer perceptions rather than merely responding to them, in order to protect the core concept of distinguishing branding from ornamentation. Basic designs, like generic words, should be free for all to use, even if they appear in a trademark space. That's why it's important that trademark spaces are not all there is to the step zero inquiry. Being in a trademark space may predispose consumers and the law to think something is serving as a trademark. But they don't eliminate the need for the putative trademark owner to show that their mark is nonfunctional and distinctive.

Finally, the issue we discuss here may not be the only place in trademark law where there is an implicit step zero. Other doctrines, including functionality¹³¹ and *Rogers v. Grimaldi*, which limits enforcement of trademark rights against uses in expressive works¹³², turn out to require difficult antecedent determinations. Are the features of a product utilitarian or aesthetic? When has the defendant's use been in the context of an "expressive work"?¹³³ Understanding those

¹³¹ 15 U.S.C. § 1052(e) (trademark protection does not extend to functional aspects of products).

¹³² 875 F.2d 994, 1000 (2d Cir. 1989) (creating an exception to the normal likelihood of confusion test when the plaintiff alleges infringement by an expressive work such as a book or movie).

¹³³ *See, e.g.,* *VIP Prods., LLC v. Jack Daniel's Props., Inc.*, 953 F.3d 1170, 1175 (9th Cir. 2020) (finding defendant's Bad Spaniels dog toy to be an expressive work and therefore evaluating the name and shape of the toy under *Rogers*), *cert.*

categorization questions to be part of an implicit step zero may help pave the way toward more systematic answers to those questions as well.

CONCLUSION

Trademark law purports to draw a sharp line between packaging and product configuration, favoring protection for the former over the latter. But as we have shown, the truth is more complicated. Courts and the Trademark Office are engaged in a largely implicit step zero in which they decide whether to apply the ordinary rules of trademark law or to depart from those rules. That step zero depends heavily on whether the plaintiff's use of a design is in a trademark space. We think that approach makes sense in most circumstances, but it needs to be made explicit and backed up with evidence. And once that is done, it will pave the way to limiting claims to trademark rights that don't in fact occur in a trademark space.

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