

MANUFACTURING INFORMATION MEMO

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Trade Dress Registration – Practical Considerations for Product Manufacturers

Summary

Trade dress is a powerful intellectual property (IP) tool that can be used to protect the distinctive non-functional “look and feel” of a product’s design, shape and/or 3D configuration¹. Product manufacturers and designers can look to trade dress as a potential supplemental type of IP protection (in addition to patent or copyright protection), or as an alternative type of IP protection (where, for example, a statutory bar prevents an entity from protecting aspects of the subject product through the patent system) for their products.

Trade dress is a subcategory of trademark law², and thus is registrable at the U.S. Patent and Trademark Office (USPTO). Examples of 3D configuration trade dress registrations include:

- U.S. Reg. No. 5067689; trade dress description - design of a sole edge including longitudinal ribbing, and a dark color band over a light color; example product follows



- U.S. Reg. No. 6026577; trade dress description - three-dimensional configuration of a figure-eight-shaped razor handle; example product follows



¹ The U.S. Supreme Court recognized the definition of trade dress as including the “total image and overall appearance” of a product “and may include features such as size, shape, color or color combinations, texture, graphics.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992).

² “Trade dress constitutes a ‘symbol’ or ‘device’ within the meaning of §2 of the Trademark Act” (providing that “[t]he term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof – (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, 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.”). TMEP § 1202.

- U.S. Reg. No. 6149775; trade dress description - three-dimensional configuration of the paneling of a bomba barrel drum shell; example product follows



A U.S. trade dress registration provides a registrant with the right to prevent others from using in the U.S. and/or importing into the U.S.³ a confusingly similar trade dress design in conjunction with the same or similar goods and should prevent federal registration by others of the same. This right is potentially unlimited in time as long as the design meets certain requirements including consistent and continuous use, and periodic USPTO renewal fees are paid.

Requirements of trade dress registration include: (1) non-functionality; and (2) distinctiveness of the particular product configuration/design sought to be registered.

Non-Functionality

If the trade dress sought to be registered is “essential to the use or purpose of the article or if it affects the cost or quality of the article,” the trade dress is deemed functional and not registrable.⁴ Functionality is determined based on consideration of one or more of the following factors:

1. The existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered;
2. advertising by the applicant that touts the utilitarian advantages of the design;
3. facts pertaining to the availability of alternative designs; and
4. facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

Supporting evidence is key in a functionality determination. If the examining attorney believes that the applied for trade dress may be functional, that attorney will perform a search and may even request information from the applicant to support such a finding. Very strong and often determinative evidence of functionality includes when the product configuration/design sought to be protected by a federal trade dress registration is part of a utility patent application that describes or illustrates the utilitarian nature and/or functional advantages of the configuration (the configuration does not need to be claimed for a functional determination to be made). Another strong piece of evidence weighing in favor of a

³ Principal Register registrations only.

⁴ The main policy behind the functionality doctrine is to maintain proper separation between trademark law and patent law, which provides the opportunity for a limited-duration monopoly covering utilitarian product features.

functionality determination includes the existence of applicant advertising promoting the utilitarian nature and/or functional advantages of the configuration, i.e., the particular product configuration allows for better performance of the product. An applicant should determine whether evidence of either of these functionality supporting factors exist prior to seeking federal trade dress protection, and if either does, a business decision may need to be made against filing.

If such evidence supporting a functionality decision does not exist, or there are reasonable arguments against the weight of such evidence (e.g., the product configuration is illustrated in a patent application, but is an incidental, arbitrary or non-essential feature), the applicant should identify and gather evidence weighing against a finding of functionality prior to filing a federal trade dress application. This evidence can include, for example, the existence of a design patent directed to the features sought to be protected by trade dress, as the subject matter of a design patent is directed to ornamental and non-functional product features. Evidence weighing against a finding of functionality can also include showing the existence of alternative designs that are functionally equivalent and not more difficult or costly to manufacture or install (as may be appropriate). For example, regarding U.S. Reg. No. 6026577 referenced above, consider the multitude of existing razor handle shapes including cylindrical with a constant diameter, cylindrical with a diameter that narrows at the neck and elongated with at least one planar surface.

Distinctiveness

In order to procure a registration on the Principal Register, an applicant must also show that the product configuration/design sought to be protected by a federal trade dress registration has acquired distinctiveness (i.e., consumers think source of the product first rather than the product itself when they see the product configuration/design).⁵ Acquired distinctiveness can be supported by evidence of one or more of the following factors:

1. advertising expenditures;
2. sales success;
3. length and exclusivity of use;
4. unsolicited media coverage; and/or
5. consumer studies (linking the product configuration/design to the source).

Importantly, the evidence submitted must have a nexus to the particular product configuration/design sought to be protected by a federal trade dress registration.

An applicant may be able to meet the acquired distinctiveness requirement if the product configuration/design has been exclusively and continuously used by applicant for at least five years prior to the filing date of the application. A statement can be made by the applicant regarding the same during the initial application process and be supported by a signed declaration. However, other supporting evidence is often required to meet the burden of showing acquired distinctiveness.

⁵ "To show that a mark has acquired distinctiveness, an applicant must demonstrate that the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or service itself." *In re Steelbuilding.com*, 415 F.3d 1293, 1297 (Fed. Cir. 2005). The acquired distinctiveness requirement furthers a main function of trademark law, which is to be used as a tool to fairly distinguish the goods of one manufacturer from another.

An applicant should be prepared to at least provide advertising and sales numbers, and advertising examples (print and online, if they exist, including website and social media) prominently highlighting, focusing and directing consumers (in words and/or appearance) to the unique product configuration/design. This evidence can be supported by an employee declaration with knowledge of the same. Declarations from multiple consumers of the product providing that when they see the particular product configuration/design they think of the applicant as the source can also be very helpful in showing acquired distinctiveness.

Failure to show acquired distinctiveness to a trademark examining attorney at the USPTO may not prevent federal registration of the subject trade dress. Registration, however, will need to be sought on the Supplemental Register. The Supplemental Register does not provide the full benefit of registration on the Principal Register including the presumption of validity, ownership and exclusive rights to use. However, benefits of registration on the Supplemental Register include the right to bring a trade dress infringement lawsuit in federal court; ideally prevents registration of confusingly similar trade dress; can act as a deterrent to competitors from using a confusingly similar trade dress, as the registration is part of a publicly searchable federal trademark database; and provides support for a claim of acquired distinctiveness and reapplication on the Principal Register after five years of registration on the Supplemental Register.

For more information on trade dress registration, contact [Fred Price](#) or any attorney in Bond's [intellectual property practice](#).

