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TAMALE SALES AND CARBURETOR TUNE-UPS: THE IMPLICATIONS FOR COMPUTER SOFTWARE DEVELOPERS AND OWNERS -- A TRADE DRESS ANALYSIS[d1]

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I. Introduction

A strange title? Strange indeed! What could such seemingly diverse matters as tamales[1] and carburetors imply for computer software? Amazing as it may seem, there may be implications. Tamale sales[2] and carburetor tune-ups[3] were just some of the subjects reviewed in recent court ***10** decisions involving the legal doctrine of trade dress.[4] The decisions indicate that the applicability of the trade dress legal doctrine is widespread and includes the computer software trade.[5]

II. What is "Trade Dress?"

Trade dress has been defined as the overall image and commercial impression of products or services.[6] Characteristics of products and services which have a trade dress can include color, size, shape, position, and design, as well as other visual characteristics.[7] In addition, non-visual characteristics have been the subject of trade dress in certain instances.[8]

***11** An examination of currently available computer software indicates that software may be designed with significant variations in visual and other aspects.[9] For example, Windows™ software provides a menu-driven operating system that presents user selections in the form of icons contained within layered picture-frame formats.[10] The Lotus 1-2-3® software

provides a spreadsheet system presenting to the user a horizontal index along the top of a monitor and a vertical index along the left-hand side of the monitor, within which characters and mathematical formulas may be input and read at desired locations.[11] Other available software utilizes even more varied operation and presentation to users.[12] Given the possible variation in appearance and "feel" characteristics of computer software, can software be considered as having protectable trade dress?

The recent court decisions do not directly hold that computer software may be protected trade dress.[13] Nonetheless, they can be applied to support the proposition that a variety of characteristics of software can be considered protectable trade dress.

III. Requirements for Protectable Trade Dress

The requirements which must be met for a finding of protectable trade dress are relatively uniform throughout the Circuits.[14] The Fifth Circuit, however, is one of the few Circuits that has received U.S. Supreme Court endorsement of a statement of its requirements.[15] In *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.,* the court held that trade dress qualifies for protection if it is not wholly functional and is either distinctive or has acquired secondary meaning.[16]

***12** *Taco Cabana* involved two competing Mexican food restaurant chains, Taco Cabana and Two Pesos.[17] Taco Cabana was the first of the two restaurant chains to enter the "upscale Mexican fast-food market." Each Taco Cabana chain restaurant maintained substantially similar color schemes, menus, and layouts.[18] Two Pesos later entered the same market and employed substantially identical color schemes, menus, and layouts in its restaurants.[19] Taco Cabana sued Two Pesos, claiming that Two Pesos' copying of its restaurant's color schemes, menus, and layouts amounted to infringement of the Taco Cabana trade dress.[20]

In considering whether Taco Cabana restaurants were protected trade dress, the Fifth Circuit analyzed the requirements of non-functionality, distinctiveness, and secondary meaning.[21] These requirements are hereinafter discussed and then applied to computer software.

A. Non-Functionality

The law is clear that if trade dress is wholly functional, then that dress is not protected trade dress.[22] However, a design that merely assists in a product's or configuration's utility is not wholly functional and may be protected.[23] In determining whether dress is wholly functional, a significant consideration is the issue of whether protecting the dress will "hinder competition or impinge upon the rights of others to compete effectively in the sale of goods."[24]

*13 B. Distinctiveness

In addition to being non-functional, dress must be distinctive in order to qualify for protection.[25] It has been stated that "[i]f . . . dress serves as a symbol of origin it is considered distinctive and protectable."[26] Further, some courts have ruled that "[a] distinctive trade dress that is neither descriptive nor functional is ipso facto inherently distinctive."[27] Other courts have not necessarily been so decisive.[28] In any event, "inherently distinctive" trade dress, that is, trade dress that is arbitrary or fanciful as those terms are used in the trademark context, is always protectable.[29]

C. Secondary Meaning

Secondary meaning is an association in a consumer's mind of a particular trade dress with a provider of products or services having that dress.[30] Although secondary meaning has been identified as a requirement for protectable trade dress, the U.S. Supreme Court has concluded that "trade dress which is inherently distinctive is protectable . . . without a showing that it has acquired secondary meaning."[31] Even when it is necessary to show secondary meaning to prove protectable trade dress, the burden of proof is not hard to meet. Typically, secondary meaning of a trade dress can be shown by the copyrighting of the trade dress; a competitor's copying of the trade dress; advertising employing the trade dress; and length, consistency, and extent of use of the trade dress.[32]

*14 IV. Status of Trade Dress Doctrine in Application to Computer Software

A. The *Computer Care* Case

The three requirements of non-functionality, distinctiveness, and secondary meaning have been applied in analyzing trade dress in a case related to computer software and its generated output.[33] *Computer Care* involved letter reports generated by a particular computer software. In the case, the U.S. Court of Appeals for the Seventh Circuit upheld a trade dress infringement claim regarding the computer-generated letters.[34]

In *Computer Care,* the plaintiff and the defendant were engaged in the business of sending computer-generated automobile service "reminder letters" on behalf of car dealers and repair garages.[35] The reminder letters served to notify car owners when their cars were due for service. The plaintiff was first in time to provide the service to consumers.[36] The defendant followed the plaintiff into the market, primarily by utilizing computer-generated letters and advertising materials substantially similar to those used by the plaintiff.[37] The defendant's materials had substantially the same appearance, organization, and substance as those of the plaintiff.[38]

In its analysis of the trade dress infringement claims, the Seventh Circuit first identified the dress components of the plaintiff's and the defendant's computer-generated letters and other materials.[39] The court observed both the details of the computer-generated letters, including information contained in the letters and the placement of that information on the page, and the letters as a whole, including the layout and general appearance of the documents.[40] Having identified the components of dress of the plaintiff's computer-generated letters, the court turned its attention to consideration of whether the letters satisfied the requirements for protectable trade dress.[41]

In considering the requirements of non-functionality, distinctiveness, and secondary meaning, the Seventh Circuit determined that all three were met by the plaintiff's computer-generated letters.[42] As for non-functionality, the court observed that, though some elements of the plaintiff's dress were functional because competitors would find it necessary to incorporate the elements to compete, the particular combination of the elements and the overall arrangement were non-functional because competitors would not have to incorporate the particular combination and ***15** arrangement.[43] In considering the distinctiveness requirement, the court again considered particular components of the plaintiff's dress and then focused on the combination of all the components.[44] With respect to the particular components, the court found some to be generic or descriptive, but found a greater number to be arbitrary, and with respect to the combination, found it to be "largely arbitrary, and therefore inherently distinctive."[45] Based on *Taco Cabana,* the Seventh Circuit determined that a showing of secondary meaning was not necessary because the overall trade dress was inherently distinctive.[46] Because all three requirements were satisfied by the plaintiff's computer-generated letters, the court concluded that the letters were protectable by trade dress.[47]

Having reached that conclusion, the Seventh Circuit then compared the computer-generated letters of the plaintiff and the defendant to determine whether the similarity of the defendant's trade dress to that of the plaintiff created a "likelihood of confusion" on the part of consumers.[48] The court observed that the lower court found that the defendant's and the plaintiff's letters were virtually identical, almost to the point that "any suggestion. . . that [the defendant] had developed its materials independently, rather than by copying them from [the plaintiff] virtually lock, stock and barrel, [was] rejected as incredible."[49] The court approvingly adopted the district court's determination that there existed a likelihood of confusion because such a determination is a finding of fact reversible only if clearly erroneous.[50] The defendant had argued that, notwithstanding the close similarity between the parties' trade dresses, there was no evidence of confusion, customers of the parties were "sophisticated," and marketing was done in such a fashion that during a sales pitch the particular vendor's name was repeatedly disclosed.[51] However, the court did not find those arguments persuasive to show that the lower court's decision was clearly erroneous, and it affirmed the lower court's finding that the defendant committed trade dress infringement.[52]

B. The *Engineering Dynamics* Case

Following the *Computer Care* appellate decision, the Fifth Circuit law of trade dress of computer software was tested in *Engineering Dynamics, Inc. v. Structural Software, Inc.*[53] In that case,[54] the U.S. Court of Appeals for the Fifth Circuit was presented with the issue of whether a structural analysis computer program could comprise a trade dress infringed by a competitor's ***16** program that had a similar input and output interface.[55] In the court's published opinion written by Circuit Judge Edith H. Jones and joined by Circuit Judges Sam D. Johnson and E. Grady Jolly, the court concluded that there was no trade dress infringement because the district court held that "there was little likelihood of confusion among the relevant users of the computer programs at issue."[56]

Though the Fifth Circuit ruled in that manner in this particular case, the *Engineering Dynamics* panel's position with respect to the feasibility and likelihood of successful computer software trade dress claims in future cases may be predicted from the opinion. It is notable, for example, that the Fifth Circuit's decision turned upon the fact that "there was little likelihood of confusion."[57] The court reiterated the *Taco Cabana* standard for trade dress infringement analysis as follows:

> In this circuit, there are two elements of a trade dress infringement claim. First, the trade dress of a

> product may be protected as an unregistered trademark if it is nonfunctional, distinctive, and has acquired a secondary meaning. Second, a finding of infringement requires a consideration of the likelihood of confusion.[58]

Thus, in the Fifth Circuit, consideration of "likelihood of confusion" need only be undertaken once the first consideration of whether "the trade dress of [the] product may be protected" indicates a protected trade dress.[59] By finding no infringement due to a lack of likelihood of confusion, it appears that the court found that the computer software input and output formats at issue had protected trade dress, but then concluded that the second step was not satisfied by the factual scenario presented.[60]

The conclusion drawn from the *Engineering Dynamics* case is appropriate, particularly given the arguments made by the claimant-appellant in its briefs on appeal there.[61] In those briefs, the trade dress claimant-appellant argued that the district court's decision regarding the trade dress issues in *Engineering Dynamics* appeared to confuse the steps of the analysis prescribed by the Fifth Circuit.[62] The claimant-appellant argued that the district court erred in its analysis of the trade dress issue because the district court "based its conclusion that 'protectable trade dress does not reside in the input protocols, output reports, manuals, or look and feel of [a computer program]' on a determination that there was a lack of likelihood of confusion," and that "conclusion, based on that determination, does not comply with the [two step] trade dress infringement analysis" of the ***17** Fifth Circuit.[63] The claimant-appellant's brief argued that likelihood of confusion was not a consideration in the determination of whether a dress was protectable, but was instead a consideration only in determining whether a protected dress is infringed, under the second step of the trade dress analysis.[64]

In making its trade dress decision, the district court in *Engineering Dynamics* stated that there was little likelihood of confusion between the input and output formats of the two computer programs at issue because both products were targeted at a fairly limited and sophisticated market.[65] Because of that conclusion, the district court held there was no protected trade dress in the software input and output formats.[66] In its briefs to the Court of Appeals, the claimant-appellant stated that the only possible way to reconcile the district court's decision was to conclude either (i) that the district court found that the computer software dress qualified for protection but that there was no infringement because of a lack of likelihood of confusion without expressly stating so, or (ii) that the district court misapplied the law by failing to follow the two step analysis of *Taco Cabana*.[67] In its opinion, the Fifth Circuit did not state its approach in reconciling the district court's result.[68] Instead, the Fifth Circuit stated that it would not reverse relevant findings of fact, such as the district court's determination that there was little likelihood of confusion between the two programs, unless there was clear error in the lower court's holding.[69] The Fifth Circuit did not find such clear error and did not require the district court to explain its analysis.[70] However, based on its conclusions, it can be presumed that the Fifth Circuit, though it did not address it in its opinion, was itself able to reconcile the district court's result.[71] Assuming that presumption is accurate, the only logical conclusion which one can draw from the Fifth Circuit's decision is that it must have found that the district court correctly followed the two step analysis and concluded that there was a protectable trade dress of the computer software formats but not a likelihood of confusion of that dress.[72]

***18** One important qualification of the inference being drawn from the Fifth Circuit's opinion in *Engineering Dynamics* is expressed in a footnote.[73] The footnote states that "[i]t is an interesting question, unnecessary to reach here, whether computer input formats and output reports involving highly technical factual reports of engineering data are so inherently functional as not to be protectable."[74] Because the Fifth Circuit made such a statement, it seems necessary and appropriate to consider that question in order to reach a conclusion about computer software and trade dress protection.

C. Inherent Functionality and Protectability

Though the particular question of whether computer software input formats and output reports are so inherently functional as not to be protectable has not yet been addressed by any court other than the Seventh Circuit in *Computer Care,*[75] the general issues of functionality and trade dress protectability have been addressed in a number of cases.[76] The principle recognized in the Fifth Circuit and most other jurisdictions is that if a trade dress is wholly functional, then the dress is not entitled to protection, but a designation that "merely assists in a product or configuration's utility" is not necessarily functional and may be protected.[77] It has been stated that the "ultimate inquiry" in determining whether a feature is functional and not protectable trade dress is whether or not protection of the feature will "hinder competition or impinge upon the rights of others to compete effectively in the sale of goods."[78] If protection of the feature as trade dress would hinder competition or impinge rights to compete effectively, then the feature is probably not protected.[79]

Whether in any particular instance a feature will be considered functional for purposes of trade dress analysis is not entirely straightforward.[80] If the feature is necessary for the relevant product to perform its intended function, and if limiting others' use of the feature would limit competition in connection with the product, the feature is likely to be considered functional,

and ***19** trade dress protection will not be afforded.[81] On the other hand, a product that has functional features may nevertheless be protected trade dress if the features indicate the source of the product.[82] The legal concept of functionality in connection with trade dress analysis is not necessarily the same as the common usage concept of functionality.[83] It has been explained, for example, that a feature of a trade dress is "functional" and thus, not protectable, if it is "one which competitors would have to spend money not to copy but to design around. . . . It is something costly to do without (like the hood [of a car]), rather than costly to have (like the statue of Mercury [on the hood of a Rolls Royce])."[84] Using another example, a "functional" feature is one "that competitors would find necessary to incorporate into their product in order to be able to compete effectively,"[85] such as the oval shape of a football.

The dividing line between a functional feature not entitled to trade dress protection and a feature that is non-functional and entitled to trade dress protection is not always a clear one.[86] At the ends of the spectrum of functionality and non-functionality, features that are significant to the commercial success of a product are generally found to be functional, and features that are merely "arbitrary embellishments" employed to distinguish a product or identify its source are generally found to be non-functional.[87] As features begin to have some of both characteristics, the line between functional and non-functional becomes hazy, and the courts tend to place greater emphasis on an analysis of what effect trade dress protection of the feature will have on competition.[88] The determination will often vary according to jurisdiction and the particular product for which protection is claimed.[89]

In *Computer Care,* for example, the Seventh Circuit was fairly liberal towards trade dress protection in its analysis of the functionality of the features of the computer-generated letters.[90] The Seventh Circuit agreed with the district court that focusing only on individual elements was inappropriate because the "particular combination and arrangement" of the individual elements ***20** could be the source of non-functionality.[91] Other courts have not necessarily appeared quite so liberal in their views.[92]

Because the Fifth Circuit refrained from addressing the functionality of the computer software input and output formats at issue in the *Engineering Dynamics* case,[93] we have only the *Computer Care* case to turn to for guidance with respect to analyzing the functionality of computer software and its aspects, such as input and output formats.[94] In this respect, however, it may be of importance that the Fifth Circuit expressly referred to "highly technical factual reports of engineering data" in formulating the question of inherent functionality of computer input formats and output reports, rather than leaving the inquiry open with respect to all computer software and all input and output formats thereof, generally.[95] It remains to be seen how the Fifth Circuit will handle the functionality question in other instances of computer software trade dress claims. In any event, it is relatively unquestionable that trade dress protection of computer software will be claimed in greater and increasing frequency, and that insight alone should alert computer software developers and owners to the potential for protection of software trade dress and to the possibility of being subjected to those types of claims.

V. Trade Dress of Computer Software

The analysis and law of *Taco Cabana, Computer Care, Engineering Dynamics* and other cases[96] provides a template for analysis of computer software for protectable trade dress. As trade dress law is applied to computer software, it becomes convincing that computer software can have trade dress that is protected.[97] The analysis proceeds by consideration of the various aspects of software that are apparent to users of the software, such as its visual characteristics.[98]

The aspects of computer software that are generally most apparent to users in connection with purchasing decisions are the inputs and outputs and, if applicable, sales packaging and advertising.[99] The inputs and outputs generated by software can take a variety of forms. Most software today employs computer monitor prompts and keyboard inputs in response to those prompts as inputs to the software. Outputs of today's software are generally in the form of monitor ***21** displays or printed reports. Computer monitor prompts for input may vary in a number of respects including color, size, design, shape, and location. Likewise, keyboard inputs required by software can vary according to software design by character, key, alternatives to keyboards such as a mouse, and other variations. Because of these varied possibilities, the design of both the particular components of inputs and outputs and the overall arrangement of those components can be quite varied.[100] It follows, then, that if the particular components and overall arrangement in any instance satisfy the three requirements for protectable trade dress, trade dress law should protect the software.[101]

In addition to the commercial impression presented to users by the inputs and outputs of software, some software, particularly over-the-counter software sold to individuals for mostly personal applications, may also present consumers with certain commercial impressions based on packaging and advertising associated with the software.[102] In this instance, the analysis of software trade dress for protectability will probably depend on the weight that consumers give the matters presented to them.[103] Protectable trade dress has been found in product packaging, sales brochures, advertising, and sales techniques for a variety of products and services.[104] When substantial similarity exists between competitors with regard to those matters, trade

dress is often protectable.[105]

*22 VI. Conclusion

It appears that there is merit in the argument for trade dress protection of computer software, particularly in those cases where consumer impression of the software is derived from competitors' substantially similar inputs, outputs, packaging or advertising. It is likely that significant legal developments will soon occur with respect to the impact of trade dress law in computer software development and distribution. For those interested in protecting software rights, an understanding of trade dress law and a close watch of the pending cases will undoubtedly prove to be beneficial.

Footnotes

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a1 Johnson & Wortley, P.C., Austin, Texas. The author is co-counsel, together with Thomas L. Cantrell and Roger L. Maxwell of the same firm, in a case styled *Engineering Dynamics, Inc. v. Structural Software, Inc.* The case involves computer software issues, including trade dress infringement. Engineering Dynamics, Inc., the plaintiff represented by the author, prevailed on certain copyright claims in the U.S. District Court, Eastern District of Louisiana. The district court decision, found at 785 F. Supp. 576 (E.D. La. 1991), was then appealed by Engineering Dynamics, Inc. to the U.S. Court of Appeals for the Fifth Circuit on certain computer software copyright and trade dress issues. The Court of Appeals rendered its decision in the case on July 13, 1994. The opinion of the Court of Appeals is found at 26 F.3d 1335 (5th Cir. 1994). The views expressed herein are solely the author's and are not necessarily those of the author's firm or his co-counsel.

1 For the benefit of anyone reading this article who is not familiar with "Tex-Mex" food, a tamale is meat (often taken from a hog's head, although other meat is sometimes used) rolled in cornmeal and wrapped in a corn husk, which is steamed and eaten.

2 Two Pesos, Inc. v. Taco Cabana, Inc., 112 S. Ct. 2753 (1992) (Mexican food restaurant trade dress).

3 Computer Care v. Serv. Sys. Enters., Inc., 982 F.2d 1063 (7th Cir. 1992) (automobile repair service computer-generated reminder letters trade dress).

4 *E.g.,* Conopco, Inc. d/b/a Cheeseborough-Pond's USA Co. v. May Dep't Stores Co., Nos. 92-1412, 92-1413, 92-1414, 92-1415, 92-1416, 1994 U.S. App. LEXIS 26390 (Fed. Cir. September 21, 1994) (Vaseline container and labeling trade dress); Meriam-Webster, Inc. v. Random House, Inc., Nos. 93-7276, 93-7362, 93-7728, 93-7776, 1994 U.S. App. LEXIS 24401 (2d Cir. September 9, 1994) (dictionary dust jacket trade dress); Tone Bros., Inc. v. Sysco Corp., 28 F.3d 1192 (Fed. Cir. 1994) (spice container trade dress); Brown Bag Software v. Symantec Corp., 29 F.3d 630 (9th Cir. 1994) (software program trade dress issues avoided on procedural grounds); Badger Meter, Inc. v. Grinnell Corp., 13 F.3d 1145 (7th Cir. 1994) (trade dress of small water meters); Qualitex Co. v. Jacobson Prod. Co., Inc., 13 F.3d 1297 (9th Cir. 1994) (trade dress of dry cleaning and laundry press pads); Great American Audio Corp. v. Metacom, Inc., No. 91 CIV 2007 (TPG), 1994 U.S. Dist. LEXIS 13260 (S.D.N.Y. 1994) (toy school bus trade dress); Dow Brands, L.P. v. Helene Curtis, Inc., No. 3-93-440, 1994 U.S. Dist. LEXIS 13929 (D.C. Minn. May 31, 1994) (trade dress of hair styling product).

5 *See supra* note 3, *especially Brown Bag Software,* 29 F.3d at 630. *See also Computer Care,* 982 F.2d at 1063; Engineering Dynamics, Inc. v. Structural Software, Inc. et al., 26 F.3d 1335 (5th Cir. 1994).

6 *E.g., Taco Cabana,* 112 S. Ct. at 2755, n.1; *Computer Care,* 982 F.2d at 1067; Roulo v. Russ Benie & Co., Inc., 886 F.2d 931, 935 (7th Cir. 1989), *reh. denied,* 1989 U.S. App. LEXIS 19156 (7th Cir. 1989) *ad cert. denied,* 493 U.S. 1075 (1990); Hartford House, Ltd. v. Hallmark Cards, Inc., 846 F.2d 1268, 1271 (10th Cir. 1988), *cert. denied,* 488 U.S. 908 (1988); Le Sportsac, Inc. v. K-Mart Corp., 754 F.2d 71, 75 (2d Cir. 1985), *later proceeding,* 617 F. Supp. 316 (E.D.N.Y. 1985), on reconsideration, motion denied, 227 U.S.P.Q. 151 (E.D.N.Y. 1985); Sun-Fun Prods., Inc. v. Suntan Research & Dev., Inc., 656 F.2d 186, 192 (5th Cir. 1981); John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 980 (11th Cir. 1983); Freddie Fuddruckers, Inc. v. Ridgeline, Inc., 589 F. Supp. 72, 75 (N.D. Tex. 1984), *aff'd,* 783 F.2d 1062 (5th Cir. 1986).

7 *E.g.,* Aromatique, Inc. v. Gold Seal, Inc., Nos. 93-3260, 93-3482, 28 F.3d 863, 869-870 (8th Cir. 1994), *reh. denied,* 1994 U.S. App. LEXIS 26010 (September 20, 1994) (physical features of potpourri packaging); *Badger Meter,* 13 F.3d at 1149-50 (dual

physical elements of small water meters); *Qualitex Co.,* 13 F.3d at 1300-01 (color of press pads); AmBrit, Inc. v. Kraft, Inc., 812 F.2d 1531, 1536-37 (11th Cir. 1986), *cert. denied,* 107 S. Ct. 1983 (1987) (ice cream treats); Sno-Wizard Mfg., Inc. v. Eisemann Prods. Co., 791 F.2d 423, 424-25 (5th Cir. 1986) (snowball machine); Taco Cabana Int'l, Inc. v. Two Pesos, Inc., 932 F.2d 1113, 1117 (5th Cir. 1991), *aff'd,* 112 S. Ct. 2753 (1992) (restaurant decor, menu and layout as trade dress); *Le Sportsac,* 754 F.2d at 74; (features of line of sports and travel bags); Sicilia Di R. Biebow & Co. v. Cox, 732 F.2d 417, 423 (5th Cir. 1984) (shape and label of lemon juice bottle); Ideal Toy Corp. v. Plawner Toy Mfg. Corp., 685 F.2d 78, 80, n.2 (3d Cir. 1982) (trade dress refers to the appearance of the product, a puzzle, as well as its packaging); Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc., 659 F.2d 695, 696 (5th Cir. 1981), *cert. denied,* 102 S. Ct. 2947 (1982) (lawn and garden products packaging); Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 204 (2d Cir. 1979) (adornment of cheerleader uniforms); Kentucky Fried Chicken Corp. v. Diversified Packaging Corp., 549 F.2d 368, 373-74 (5th Cir. 1977) (container for food); Franzia Winery L.P. v. Almaden Vineyards, Inc., No. C-94-3186-VRW, 1994 U.S. Dist. LEXIS 13963 (N.D. Cal. September 30, 1994) (box, colors and layout thereof, of wine); Nelson/Weather-Rite, Inc. v. Leatherman Tool Group, Inc., No. 93 C 2274, 1994 U.S. Dist. LEXIS 10996 (N.D. Ill. September 9, 1994) (features of compact, multi-purpose tools); Munsingwear, Inc. v. Jockey Int'l, Inc., 31 U.S.P.Q.2d 1146 (D.C. Minn. 1994) (slit design appearance of men's underwear); Reebok Int'l Ltd. v. K-Mart Corp., 849 F. Supp. 252, 266, 271 (S.D.N.Y. 1994) (casual shoe features); Imagineering, Inc. v. Van Klassens, Inc., 851 F. Supp. 532, 535 (S.D.N.Y. 1994) (garden furniture styles).

[8] *E.g.,* Dirk Laureyssens v. Idea Group, Inc., 964 F.2d 131, 133-35 (2d Cir. 1992) (shape and form of toy puzzle); *Roulo,* 886 F.2d at 936-937 (7th Cir. 1989) (combination of elements of greeting card); *John H. Harland Co.,* 711 F.2d at 980 (sales techniques); Original Appalachian Artworks, Inc. v. Toy Loft, Inc., 684 F.2d 821, 831 (11th Cir. 1982) ("adoption procedures used by [plaintiff] in the sale of its dolls qualify as protectable [sic] trade dress"); Great Am. Audio, 1994 U.S. Dist. LEXIS 13260 (sounds of toy school bus); Specialty Surgical Instrumentation, Inc. v. Phillips, 844 F. Supp. 1211, 1214 (M.D. Tenn. 1994) (surgical instruments design features); Source Perrier, S.A. v. Waters of Saratoga Springs, Inc., 217 U.S.P.Q. (BNA) 617 (S.D.N.Y. 1982).

[9] *E.g.,* PC MAGAZINE, October 25, 1994, passim; MAC USER, November 1994, passim.

[10] D. Miller, *Windows Tips,* PC WORLD, July 1994, at 152.

[11] C. Stinson, *Lotus Maps Out Future of Spreadsheets with 1-2-3,* PC MAGAZINE, September 27, 1994, at 37.

[12] *See supra* note 8. The types and applications of available software are virtually unlimited. Most persons are familiar with several commercially available computer software packages, such as WordPerfect™ and DBase™ and may find it helpful to consider the aspects of such familiar software when reading this article.

[13] *Taco Cabana,* 112 S. Ct. 2753; Engineering Dynamics, Inc., v. Structural Software, Inc., 26 F.3d 1335 (5th Cir. 1994); *Computer Care,* 982 F.2d at 1063. These cases generally form the basis for the discussion that follows.

[14] *Computer Care,* 982 F.2d at 1067-68; Abbott Labs. v. Mead Johnson & Co., 971 F. 2d 6, 20 (7th Cir. 1992); *Taco Cabana,* 932 F.2d at 1118-20; Vision Sports, Inc. v. Melville Corp., 888 F.2d 609, 613 (9th Cir. 1989); *Roulo,* 886 F.2d at 935; M. Kramer Mfg. Co., Inc. v. Andrews, 783 F.2d 421, 448-49 (4th Cir. 1986); *John H. Harland Co.,* 711 F.2d at 980; John Wright, Inc. v. Casper Corp., 419 F. Supp 292 (E.D. Pa. 1976), *aff'd in part and rev'd in part,* 587 F. 2d 602 (3d Cir. 1978); Ye Olde Tavern Cheese Products, Inc. v. Planters Peanuts Div., 261 F. Supp 200 (N.D. Ill. 1966), *aff'd,* 394 F.2d 833 (7th Cir. 1967).

[15] *Taco Cabana,* 112 S. Ct. at 2753.

[16] *Taco Cabana,* 932 F.2d at 1118-21.

[17] *Id.* at 1117.

[18] *Id.* at 1117-18.

[19] *Id.*

[20] *Id.* at 1117.

[21] *Id.* at 1117-20.

[22] *Taco Cabana,* 112 S. Ct. at 2758; Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 863 (1982); Coach Leatherware Co. v. Ann Taylor, Inc., 933 F.2d 162, 168 (2d Cir. 1991); Schwinn Bicycle Co. v. Ross Bicycles, Inc., 870 F.2d 1176, 1188 (7th Cir. 1989), *reh. denied, en banc,* 1989 U.S. App. LEXIS 4778; Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 520 (10th Cir. 1987); Standard Terry Mills, Inc. v. Shen Mfg. Co., 803 F.2d 778 (3d Cir. 1986); *Sicilia,* 732 F.2d at 425; John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 980 (11th Cir. 1983); Vuitton et Fils, S.A. v. J. Young Enterprises, Inc., 644 F.2d 769, 775 (9th Cir. 1981); Fisher Stoves, Inc. v. All Nighter Stove Works, Inc., 626 F.2d 193, 195 (1st Cir. 1980); Chemlawn Servs. Corp. v. GNC Pumps, Inc., 652 F. Supp. 1382 (S.D. Tex. 1987), *rev'd on other grounds,* 823 F.2d 515 (Fed. Cir. 1987), *on remand,* 690 F. Supp. 1560, 1570-71 (S.D. Tex. 1988). Although the circuits are in general agreement that wholly functional features are not protected by trade dress, they differ as to whether non-functionality must be shown by the plaintiff seeking protection or whether functionality is a defense provable by the defendant. *See e.g., Fisher Stoves,* 626 F.2d at 195 (non-functionality must be proved by trade dress claimant) and *Schwinn* 870 F.2d at 1188 (functionality is a defense to trade dress infringement and must be shown by the defendant infringer). The circuits also differ in their tests for functionality. *See infra* notes 23, 77, 83, 89.

[23] *Taco Cabana,* 932 F.2d at 1119; Brandir Int'l, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142, 1148 (2d Cir. 1987); *Chemlawn,* 690 F. Supp. at 1570-71; Fuddrucker's, Inc. v. Doc's B.R. Others, Inc., 826 F.2d 837, 842 (9th Cir. 1987); *Sicilia,* 732 F.2d at 429; Freddie Fuddruckers, Inc. v. Ridgeline, Inc., 589 F. Supp. 72, 76 N.D. Tex. 1984), *aff'd without opinion,* 783 F.2d 1062 (5th Cir. 1986).

[24] *Sicilia,* 732 F.2d at 429. *See also Coach Leatherware,* 933 F.2d at 162; *Schwinn* 870 F.2d at 1189; *Brandir,* 834 F.2d at 1148; *Vuitton Et Fils, S.A.,* 644 F.2d at 769; University of Pittsburgh v. Champion Products, Inc., 566 F. Supp. 711, 720-21 (W.D. Pa. 1983); Midway Mfg. Co. v. Dirkschneider, 543 F. Supp. 466, 484-85 (D.C. Neb. 1981); *But see* Keene Corp. v. Paraflex Industries, Inc., 653 F.2d 822, 825-26 (3d Cir. 1981) (rejecting standard articulated in Pagliero v. Wallace China Co, 198 F.2d 339, 343 (9th Cir. 1952) under which features were considered functional if an "important ingredient in commercial success" of the relevant product). The Fifth Circuit has apparently also rejected the absolute test of *Pagliero. See Sicilia,* 732 F.2d at 429 ("too broad a view of functionality disserves the Lanham Act's purpose of protecting product distinguishability").

[25] Park 'N Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189, 194-96 (1985); *Taco Cabana,* 932 F.2d at 1117-18; *Sicilia,* 732 F.2d at 425.

[26] *Taco Cabana,* 932 F.2d at 1119-20 (citing *Sno-Wizard,* 791 F.2d at 425, n.2.) *Accord, Taco Cabana,* 112 S. Ct. at 2757; *Park 'N Fly,* 469 U.S. at 194, 196; *Inwood Labs,* 456 U.S. at 851, n.11; Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 118 (1938).

[27] *Taco Cabana,* 932 F.2d at 1120; *Accord,* Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc., 781 F.2d 604, 608 (7th Cir. 1986); *AmBrit,* 805 F.2d at 980; Robarb Inc. v. Pool Builders Supply of the Carolinas, Inc., 696 F. Supp. 621, 624 (N.D. Ga. 1988); *Ruolo,* 886 F.2d at 931; RESTATEMENT (THIRD) OF UNFAIR COMPETITION §16, cmt. b.

[28] Murphy v. Provident Mut. Life Ins. Co., 923 F.2d 923, 927 (2d Cir. 1990) ("nonverbal marks that are unregistered always require proof of secondary meaning"); In re D.C. Comics, Inc., 689 F.2d 1042, 1050-51 (C.C.P.A. 1982) (Nies, J., concurring: There is no precedent for finding trade dress in a product design absent proof of acquired distinctiveness.).

[29] *Taco Cabana,* 112 S. Ct. at 2761.

[30] *E.g., Inwood Labs.,* 456 U.S. at 851 n.11; John Wright, Inc. v. Casper Corp., 419 F. Supp. 292, 318 (E.D. Pa. 1976), *aff'd in part and rev'd in part,* 587 F.2d 602 (3d Cir. 1978); Marion Laboratories, Inc. v. Michigan Pharmacal Corp., 338 F. Supp. 762 (E.D. Mich. 1972), *aff'd without op.,* 473 F.2d 910 (6th Cir. 1973); Chun King Sales, Inc. v. Oriental Foods, Inc., 136 F. Supp. 659, 662 (D.C. Cal. 1955), *aff'd in part and rev'd in part,* 244 F.2d 909 (9th Cir. 1957).

[31] *Taco Cabana,* 112 S. Ct. at 2754.

[32] *E.g., Coach Leatherware,* 933 F.2d at 168; Vision Sports, Inc. v. Melville Corp., 888 F.2d 609, 615 (9th Cir. 1989); *Chemlawn,*

690 F. Supp. at 1571; First Brands Corp. v. Fred Meyer, Inc., 809 F.2d 1378, 1383 (9th Cir. 1987); Brooks Shoe Mfg. Co. v. Suave Shoe Co., 716 F.2d 854, 859-60 (11th Cir. 1983); Ideal Toy Corp. v. Plawner Toy Mfg. Corp., 685 F.2d 78, 82 (3d Cir. 1982); Truck Equip. Serv. Co. v. Fruehauf Corp., 536 F.2d 1210, 1219 (8th Cir. 1976), *cert. denied,* 429 U.S. 861 (1976); CPC Int'l, Inc. v. Caribe Food Dist., Inc., 731 F. Supp. 660, 666 n.9 (D. N.J. 1990); Prints Plus, Inc. v. Classic Graphics, Ltd., 225 U.S.P.Q. 679, 680-81 (N.D. Cal. 1985).

[33] *Computer Care v. Serv. Sys. Enters., Inc.,* 982 F.2d 1063, 1067-71 (7th Cir. 1992).

[34] *Id.* at 1071.

[35] *Id.* at 1066.

[36] *Id.*

[37] *Id.* at 1066-67.

[38] *Id.* at 1068-70.

[39] *Id.* at 1068-69.

[40] *Id.* at 1069.

[41] *Id.*

[42] *Id.* at 1067-71.

[43] *Id.* at 1071.

[44] *Id.* at 1069.

[45] *Id.* at 1068-69.

[46] *Id.* at 1069.

[47] *Id.* at 1067-71.

[48] *Id.* at 1069-71.

[49] *Id.* at 1069.

[50] *Id.* at 1071.

[51] *Id.* at 1070.

[52] *Id.* at 1069-71.

[53] 26 F.3d 1335 (5th Cir. 1994).

[54] The author served as co-counsel on behalf of the trade dress claimant-appellant in the case.

[55] *Engineering Dynamics,* 26 F.3d at 1340.

[56] *Id.* at 1350.

[57] *Id.*

[58] *Id.*

[59] *Id.*

[60] *See id.;* Engineering Dynamics, Inc. v. Structural Software, Inc., 785 F. Supp. 576, 580, 583-84 (E.D. La. 1991).

[61] Brief for Plaintiff/Appellant/Cross-Appellee Engineering Dynamics, Inc. at 27-35, Engineering Dynamics (No. 92-3444); Reply and Answering Brief for Plaintiff-Appellant/Cross-Appellee Engineering Dynamics, Inc. at 24-30, Engineering Dynamics (No. 92-3444).

[62] Brief for Plaintiff/Appellant/Cross-Appellee Engineering Dynamics, Inc. at 28; Reply and Answering Brief for Plaintiff-Appellant/Cross-Appellee Engineering Dynamics, Inc. at 24.

[63] *Engineering Dynamics,* 785 F. Supp. at 583-84; Brief for Plaintiff/Appellant/Cross-Appellee Engineering Dynamics, Inc. at 28.

[64] Brief for Plaintiff/Appellant/Cross-Appellee Engineering Dynamics, Inc. at 28.

[65] *Engineering Dynamics,* 785 F. Supp. at 584.

[66] *Id.*

[67] Brief for Plaintiff/Appellant/Cross-Appellee Engineering Dynamics, Inc. at 28.

[68] *Engineering Dynamics,* 26 F.3d at 1350.

[69] *Id.*

[70] *Id.*

[71] *See Engineering Dynamics,* 26 F.3d at 1350 (The Court stated that "[t] he district court's rejection of [Engineering Dynamics, Inc.]'s trade dress claim was based on the second stage of the test through its finding that there was no likelihood of confusion between the two programs" (emphasis added)). Because Engineering Dynamics's argument on appeal was that the two stage test, established by the Fifth Circuit Court of Appeals, and approved by the U.S. Supreme Court [in the *Taco Cabana* case], was either

(i) not followed by the district court or (ii) the district court concluded, without expressly stating so in its opinion, that the trade dress of the software was protectable but not infringed, the Court of Appeals, in making such statement about the district court's rejection, must have decided that the district court correctly applied the two stage test and found protectable trade dress in the first step of the test. Further, in footnote 16 of the Appellate Court's opinion, the Court, in a "Cf." cite, cited *Computer Care* for the proposition of "finding trade dress violation in copied format of highly expressive computer form letters dealing with automobile repair business." The footnote is discussed later in the article in greater detail.

72 *Engineering Dynamics,* 26 F.3d at 1350.

73 *Id.* at 1350 n.16.

74 *Id.*

75 *Computer Care,* 982 F.2d at 1071.

76 *E.g., Inwood Labs.,* 456 U.S. at 850; *Coach Leatherware,* 933 F.2d at 168, 171; *Chemlawn,* 690 F. Supp. at 1570; *Brunswick,* 832 F.2d at 520; *Ambrit,* 805 F.2d at 978; *Sicilia,* 732 F.2d at 429; *Fuddrucker's,* 826 F.2d at 842. In *Sicilia,* the court noted three different standards of functionality, which are utilitarian functionality and two types of aesthetic functionality. *See Inwood Labs.,* 456 U.S. at 863, 850 n.10 (concurring); *Sicilia,* 732 F.2 at 427; *Vuitton et Fils, S.A.,* 644 F.2d at 774-75.

77 *E.g.,* Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 109 S. Ct. 971, 985 (1989); *Sicilia,* 732 F.2d at 429; In re Morton-Norwich Products, Inc., 671 F.2d 1332, 1342 (C.C.P.A. 1982); *Vuitton et Fils, S.A.,* 644 F.2d at 773-75; *Dallas Cowboys Cheerleaders,* 604 F.2d at 203-04; *Truck Equip. Serv. Co.,* 536 F.2d at 1215, 1218.

78 *E.g., Sicilia,* 732 F.2d at 429; In re Keene Corp. v. Panaflex Indus. Inc., 653 F.2d 822, 827 (3d Cir. 1981); *See In re Morton-Norwich,* 671 F.2d at 1342; Colleen R. Courtade, Annotation, *Application of Functionality Doctrine Under §43(a) of Lanham Act,* 78 A.L.R. 712 (1993).

79 *E.g., Sicilia,* 732 F.2d at 429; *Ridgeline,* 589 F. Supp. at 77; *Truck Equip. Serv. Co.,* 536 F.2d at 1217; *Schwinn,* 870 F.2d at 1189; Wallace Int'l Silversmiths, Inc., v. Godinger Silver Art Co., 916 F.2d 76, 81 (Fed. Cir. 1990); *Brunswick,* 832 F.2d at 519.

80 *John H. Harland Co.,* 711 F.2d at 983. *Compare Pagliero,* 198 F.2d at 343-44, *with Sicilia,* 732 F.2d at 429; *Wallace* 916 F.2d at 81; *In re Morton-Norwich,* 671 F.2d at 1342, *and with Schwinn,* 870 F.2d at 1189.

81 *E.g., Doc's B.R.,* 826 F.2d at 842; *Brunswick,* 832 F.2d at 519; *Sicilia,* 732 F.2d at 428-30; *In re Morton-Norwich,* 671 F.2d at 1342.

82 *E.g., Sicilia,* 732 F.2d at 428-30; *In re Morton-Norwich,* 671 F.2d at 1342; *Vuitton et Fils, S.A.,* 644 F.2d at 775; *Dallas Cowboys Cheerleaders,* 604 F.2d at 203-04; In re Mogen David Wine Corp., 328 F.2d 925, 932-33 (C.C.P.A. 1964).

83 *In re Morton-Norwich,* 671 F.2d at 1337.

84 W. T. Rogers Co., Inc. v. Keene, 778 F.2d 334, 339 (7th Cir. 1985).

85 Vaughan Mfg. Co. v. Brikam Int'l, Inc., 814 F.2d 346, 349 (7th Cir. 1987).

86 *Sicilia,* 732 F.2d at 426-30. A comparison of the views of the various courts and commentators is given. Notwithstanding the various views, the functionality determination is in each instance a fact specific matter. *See also John H. Harland Co.,* 711 F.2d at 983; *Truck Equip. Serv. Co.,* 536 F.2d at 1218; *Midway Mfg. Co.,* 543 F. Supp. at 484.

[87] *E.g., Taco Cabana,* 932 F.2d at 1119; *Chemlawn,* 690 F. Supp. at 1570-71; *Brunswick,* 832 F.2d at 519-20; *Sicilia,* 732 F.2d at 427; *John H. Harland Co.,* 711 F.2d at 983.

[88] *E.g., In re Morton-Norwich,* 671 F.2d at 1342; *Vuitton et Fils, S.A.,* 644 F.2d at 777; *Keene Corp.,* 653 F.2d at 827; *Truck Equip. Serv. Co.,* 536 F.2d at 1218.

[89] *In re Morton-Norwich,* 671 F.2d at 1342.

[90] *Computer Care,* 982 F.2d at 1071.

[91] *Id.*

[92] *Pagliero,* 198 F.2d at 343. *But see Sicilia,* 732 F.2d at 429; *John H. Harland Co.,* 711 F.2d at 982-83, n.27; *Vuitton et Fils, S.A.,* 644 F.2d at 773-75; *Keene Corp.,* 653 F.2d at 825.

[93] *Engineering Dynamics,* 26 F.3d at 1350 n.16.

[94] *Computer Care,* 982 F.2d at 1071 ("particular combination and arrangement of information" in computer-generated reports protected by trade dress because others, but not defendant, used reports with little or no resemblance to plaintiff's reports and plaintiff's and defendant's reports were virtually identical).

[95] *Engineering Dynamics,* 26 F.3d at 1350 n.16 ("It is an interesting question, unnecessary to reach here, whether computer input formats and output reports involving highly technical factual reports of engineering data are so inherently functional as not to be protectable.").

[96] *Taco Cabana,* 112 S. Ct. at 2753; *Engineering Dynamics,* 26 F.3d at 1335; *Computer Care,* 982 F.2d at 1063. *See supra* notes 3-7.

[97] *Engineering Dynamics,* 26 F.3d at 1350; *Computer Care,* 982 F.2d at 1067-71. *See* Brown Bag, 29 F.3d at 630.

[98] *Engineering Dynamics,* 932 F.2d at 1350; *Computer Care,* 982 F.2d 1067-69.

[99] *Computer Care,* 982 F.2d at 1068-69; PC MAGAZINE, October 25, 1994, passim.

[100] PC MAGAZINE, October 25, 1994, passim.

[101] *Computer Care,* 982 F.2d at 1067-71; *Taco Cabana,* 932 F.2d at 1120; *Vision Sports,* 888 F.2d at 613-16; *Roulo,* 886 F.2d at 935.

[102] *Computer Care,* 982 F.2d at 1069; PC MAGAZINE, October 25, 1994, passim. Packaging as the subject of trade dress is discussed generally at J.T. MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 8.01, 8.06 91992). It is worth noting that:
Traditionally, "trade dress" was thought to consist only of the appearance of labels, wrappers and containers used in packaging of the product. However, in modern parlance, "trade dress" includes the total look of a product and its packaging and even includes the design and shape of the product itself.
MCCARTHY §8.01[2] (citing, *e.g., John H. Harland Co.,* 711 F.2d at 980-84; *Vision Sports,* 888 F.2d at 613; *Roulo,* 886 F.2d at 935; *Le Sportsac,* 754 F.2d at 75; *Ideal Toy Corp.,* 685 F.2d at 80, n.2.) RESTATEMENT (THIRD) OF UNFAIR COMPETITION, §16, cmt a.

[103] The Fifth Circuit and others employ a digits-of confusion test in analyzing the issue of likelihood of confusion. The indicia considered in such test include:

the strength of the trade dress at issue;
the defendant's intent;
the similarity of design;
instances of actual confusion;
the similarity of products or services;
the similarity of retail outlets and purchasers; and
the similarity of advertising media used.
Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc., 659 F.2d 695, 703 (5th Cir. 1981), *cert. denied,* 457 U.S. 1126 (1982). For other matters the Fifth Circuit considers relevant, *see* Sun-Fun Prods., Inc. v. Suntan Research & Dev., Inc., 656 F.2d 186, 189 (5th Cir. 1981); Roto-Rooter Corp. v. O'Neal, 513 F.2d 44, 45 (5th Cir. 1975).

104 *See supra* notes 3-4, 6-7.

105 *Taco Cabana,* 112 S. Ct. at 2756, n.1; *Computer Care,* 982 F.2d at 1069; *Roulo,* 886 F.2d at 936; *Hartford House,* 846 F.2d at 1271; *John H. Harland Co.,* 711 F.2d at 981.