

**Keywords:** trade dress; product design; unitary; configuration; inherently distinctive

**General:** Issue of whether trade dress constitutes product design presents question of fact, since it is akin to factual determinations addressing whether trademark is inherently distinctive or whether mark is descriptive, in that examination of product packaging and design involves similar inquiry into consumer's ability to equate product with source, and thus Trademark Trial and Appeal Board's finding on product design issue will be affirmed if supported by substantial evidence; inquiry into whether mark is unitary is also factual determination

*In re Slokevage*

78 U.S.P.Q.2d 1395 (Fed. Cir. 2006)

**I. Facts**

Joanne Slokevage ("Joanne") filed an application to register a mark on the Principle Register. The mark was described as a "configuration" that consists of a label with the words "FLASH DARE!" in a V-shaped background and cut-out areas located on each side of the label.

The Examiner refused registration of the proposed mark because it constituted a clothing configuration that is not inherently distinctive. Further, the Examiner afforded Joanne the opportunity to submit evidence of acquired distinctiveness or to disclaim the design elements. However, Joanne merely argued that the trade dress was inherently distinctive.

Based on section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), and the decision of the U.S. Supreme Court in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000), the Examiner made his refusal to register final because the clothing configuration submitted by Joanne constitutes "product design/configuration," which cannot be inherently distinctive. Specifically, the Examiner pointed to Joanne's reference in her application to the trade dress as a "cut-away flap design" to support his decision. Also, the Examiner found that the configuration is not "unitary," for the purposes of avoiding a disclaimer.

Joanne appealed to the Board and the Board affirmed the Examiner's decision. Specifically, the Board found that the cut-out areas constitute product design and observed that, according to *Wal-Mart*, a product design "will not be regarded as a source indicator at the time of its introduction." Thus, without acquired distinctiveness, the trade dress could not be registered. Further, the Board found that the facts supported a determination that the elements of the configuration were not unitary. For example, Joanne had already registered portions of the trade dress separately (e.g., the word mark "FLASH DARE!").

Joanne appealed.

**II. Issues**

- A. Is classification of trade dress as product design a factual issue?
- B. Does Joanne's trade dress constitute product design, which cannot be inherently distinctive?
- C. Is the proposed mark unitary?

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### III. Discussion

A. Yes. The Federal Circuit applies a limited standard of review to Board decisions, reviewing legal determinations *de novo* and factual findings for substantial evidence. Substantial evidence requires the reviewing court to ask whether a reasonable person might find that the evidentiary record supports the agency's conclusion.

While Joanne argued that whether trade dress is product design or not is a legal determination, the court determined that it is a factual finding because it is akin to determining whether a trademark is inherently distinctive or descriptive, which are questions of fact. Inherent distinctiveness or descriptiveness involves consumer perception and whether consumers are predisposed towards equating a symbol with a source. Such issues are determined based on testimony, surveys, and other evidence as questions of fact. According to *Wal-Mart*, determining whether trade dress is product design or product packaging involves a similar inquiry. Accordingly, the court found that determining whether trade dress is product design is a factual issue.

B. Yes. Joanne asserted that *Wal-Mart* does not provide guidance on how to determine whether trade dress is product design and attempted to distinguish her trade dress over the trade dress at issue in *Wal-Mart*. Specifically, Joanne argued that the *Wal-Mart* trade dress implicated the overall appearance of the product and was a theme made up of many unique elements (e.g., outfits decorated with appliques of hearts, flowers, and fruits). In contrast, Joanne asserted that her trade dress involves one component of a product design, which can be used with a variety of clothing types. Further, Joanne asserted that her trade dress is located on the rear hips where consumers frequently look to identify a garments source.

The PTO noted that Joanne's trade dress application refers to her trade dress as a "configuration" including a "clothing feature," and that "product configuration" is synonymous with "product design." Further, the PTO argues that product design cannot be inherently distinctive because consumers perceive product designs as making the product more useful or desirable, rather than indicating a source. According to the PTO, the trade dress at issue here makes the product more desirable to consumers, rather than indicating a source. Finally, the PTO notes that *Wal-Mart* indicates that in "close cases," trade dress should be categorized as product design.

*Wal-Mart* provides that product design can consist of design features incorporated into a product. Joanne suggested that her trade dress is not product design because it does not alter the entire product but is more akin to a label being placed on a garment. The court found that the holes and flaps portion of Joanne's trade dress are part of the design of the clothing. Specifically, the court stated that "the cut-out area is not merely a design placed on top of a garment, but is a design incorporated into the garment itself." Further, the court found that Joanne's trade dress can serve utilitarian and aesthetic functions rendering the associated product more useful or appealing. Accordingly, the court affirmed the Board's decision.

C. No. The inquiry into whether a mark is unitary is a factual determination. The court found that the substantial evidence supports the Board's findings. For example, Joanne's earlier registration of the words "FLASH DARE!," and Joanne's design patent on the cut-out area were considered evidence that Joanne's trade dress is not unitary. Moreover, Joanne admitted that the configuration she was seeking to protect was trade dress, and the court indicated that the nature of trade dress suggests that it is not unitary. Indeed, trade dress is typically characterized as a combination of various elements to create an overall impression.