

## Brand Matters: Dressing for Trade

### What you can (and can't) protect in cosmetic package design.

By Kristina Rosette, Associate, Covington & Burling  
Have you heard of the term trade dress? Even if you have not, you undoubtedly recall packaging that has struck you as attention getting, distinctive, and memorable.



Photo of Sephora's Bath and Body Products  
courtesy of Eastman Chemical Co.

Used correctly, the size, shape, texture, graphics, color or color combinations, and other features of a product's packaging can serve as a trademark, or trade dress. Such dress can be protected against third-party uses of confusingly similar trade dress.



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Trade dress usually refers to the total image of all elements in which a product or service is packaged or presented. It includes the product, its packaging, and its advertising. It must function as a trademark. Does the packaging identify and distinguish the product from other companies' products? If it does not, it cannot be protected as trade dress.

Trade dress that is functional or utilitarian cannot be protected. The U.S. Supreme Court has said that a shape or feature is considered functional "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." A court is likely to find that trade dress is functional and therefore unprotectable if a utility patent covers the same features claimed as trade dress, if the

owner of the claimed trade dress has promoted the functional or utilitarian aspects of the packaging design, or if the design represents a better, cheaper, or safer way to package a product. On the other hand, if there are plenty of other designs that could be used without any functional disadvantage, a court will likely find that it is protectable.

Trade dress protection for black cosmetic compacts has been denied on the grounds that black is "as common a color for makeup cases as is brown for paper bags." Also, a lipstick tube tab that shows lipstick color would likely be considered functional.

Even if nonfunctional, trade dress cannot be protected if it is likely to cause confusion with the trade dress another company began using first. Trade dress that is likely to cause such confusion should be avoided.

If trade dress is not functional or not likely to be confused with the previously used trade dress of another product, it can be protected as a mark. However, it must either be inherently distinctive or have acquired distinctiveness. To be deemed inherently distinctive, trade dress must be unique or unusual in the particular product field. But even if your trade dress is not inherently distinctive, it can acquire distinctiveness over time if consumers come to associate it with the source of the packaged product. "Look for" ads, which call attention to particular features claimed as trade dress, can be used to acquire distinctiveness.

For example, the United States Patent and Trademark Office (PTO) found the Sephora concave-convex bath and body product containers to be inherently distinctive.

Nonfunctional packaging trade dress can be federally registered as a trademark. Distinctive, nonfunctional packaging can be registered on the Principal Register. Not surprisingly, numerous cosmetic companies have obtained Principal Register registration of their product packaging trade dress. Containers for Givenchy and Christian Dior lipsticks, the pink-and-green container for Maybelline mascara, the faceted bottle stopper for Chanel fragrances, the bottles for Obsession fragrance, and the bottles of J'Adore fragrance are all the subject of Principal Register registrations.

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