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Cases of Note -- Trade Dress - Abercrombie Takes a Dressing Down or Eroticism Rules the Case

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Compendium II⁵³ notes that making an unrestricted gift of copies, giving them away on the street, or leaving them in a public place to be picked up are all sufficient to effect publication. "As with any form of publication, the key element is that the works be available to the general public, without restriction as to who may have access or what use may be made of the published material."⁵⁴

Publishing an item by making copies available to the public has many similarities with publication by library deposit. In both situations, the materials must be made available to the public without restrictions, and must be available to copy without restrictions.⁵⁵ However, it is important to avoid the problems involved with limited publication, since a limited publication does not fall within the statutory definition of "publication." According to *Nimmer*, "A limited publication has been held to be a publication 'which communicates the contents of a manuscript to a definitely selected group and for a limited purpose, without the right of diffusion, reproduction, distribution, or sale.'"⁵⁶ The most important distinction between publishing by deposit or distribution and creating a limited publication is the ability to make reproductions.

BREAKING NEWS: Copyright and the First Amendment

In my last column, I discussed the First Amendment in terms of the Fair Use doctrine. On Tuesday, February 19, 2002, the U.S. Supreme Court agreed to hear *Eldred v. Ashcroft*, a case challenging the Sonny Bono Copyright Term Extension Act.⁵⁷ This act, passed by Congress in 1998, added an additional twenty years onto the term of copyright for everything covered by the Federal copyright statute.⁵⁸ The *Eldred* case revolves around the issue of whether the Federal copyright statute is so restrictive that it violates Freedom of Speech under the First Amendment, particularly because of the long period of time during which materials are subject to copyright. In the coming months, I will be following this important case, which involves a balance between copyright law and the First Amendment.

Conclusion

The laws of copyright are currently in a state of flux. The common law copyright of unpublished manuscripts will expire on December 31, 2002. In order to obtain additional protection, manuscripts must be published before the end of 2002. Publishers, librarians, authors, historians, and archivists all need to know about the changes that are occurring at the end of 2002. The challenge to the Bono Act, which will be heard by the U.S. Supreme Court, involves a balance between copyright law and the First Amendment. In order to stay on top of the law, publishers, librarians, book distributors, authors, historians, and archivists all need to know about the changes that are taking place.

Cases of Note — Trade Dress - Abercrombie Takes a Dressing Down or Eroticism Rules the Case

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Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc., 280 F.3d 619; 2002 U.S. App. LEXIS 2407 (6th Cir. 2002).

And where better to learn about "trade dress" than at **Abercrombie's** where the models are frequently undressed and where that will be seen as very important if you can actually get to the bottom of this.

Abercrombie targets the college age market with its casual clothing. Once an esteemed sporting goods/department store founded in 1892, it was struggling with New York rents until it was bought by **The Limited, Inc.** in 1988. Then it made a remarkable turn-around expanding to 157 retail stores and a mail-order catalogue all protected under registered trademarks.

And it was a venerable old New York landmark. Multiple floors, each with a distinct theme. I once stood on the luggage floor and watched in awe as a plutocrat Sugar Daddy bought some bedazzler a matching set of zebra skin suitcases at \$10,000 each. And that was in 1972 when I was paid \$8,000 a year.

Abercrombie says its "trade dress" has "unique and inherently distinctive features" such as design logos, primary color combinations, use of natural cotton and wool, and a cool lifestyle image promoted in its catalogue.

Yes indeed. And what a lifestyle it is. Nude touch football is a game I've never been asked to play. All the Sexual Revolution got me was married.

American Eagle Outfitters has a similar line of clothes sold in 300 stores with a history dating from 1977.

Looks like AE is really pressing them. Plus my college freshman daughter says A&F is "so yesterday" which sounds like the trump of doom coming from a major-league consumer like she.

A&F sued for violation of § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) common law of trade dress protection. **A&F** claims its catalogue was copied by **AE** in its Fall

1997 Quarterly. Same styles, layout, lifestyle editorial content. And **AE** had a marketing memo instructing its execs to check out **A&F** stores and see what was happening. **AE** did not contest the claim of copying the trade dress. It admitted it for the sake of a motion for summary judgment which it won. And this is an appeal to the 6th Circuit by **A&F**. Where **AE** won once again.

To win a case of trade dress violation, you must show 1) trade dress is distinctive and shows the source of the goods; 2) dress is primarily nonfunctional; 3) competition goods are confusingly similar. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210 (2000).

So What's This Dress Business?

Trade dress is "the image and overall appearance of a product," identifying style created by packaging or whatever that makes it

distinguishable from other products. *Ferrari S.P.A. Esercizio Fabrice Automobili E Corse v. Roberts*, 944 F.2d 1235, 1238-39 (quoting *Allied Mktg. Group, Inc. v. CDL Mktg., Inc.*, 878 F.2d 806, 812 (5th Cir. 1989)). It "involves the total image of a product and may include features such as size,

shape, color or color combinations, texture, graphics, or even particular sales techniques." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992) (quoting *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983) (citing *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 831 (11th Cir. 1982)).

Ye-gads, what an exhausting citation. You'd think the Supreme Court could make up its own definition.

McCarthy on Trademarks § 8:4 says trade dress has an expansive meaning that includes book covers, magazine cover designs, the "G" shape of a Gucci watch, a fish-shaped cracker, the Marlboro Man and ... wait for it ... the look of a mail-order catalogue!

Trademarks "include any word, name, symbol, or device or any combination thereof." 15 U.S.C. § 1127. In effect, any-

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thing can carry meaning, distinguish goods and be a mark under the Lanham Act.

You Mean Everything's Dress?

The Court gets really cute here and points out that many things called "dress" are not dress and cites **Hans Christian Andersen, *The Emperor's New Clothes*** (Naomi Lewis, trans., Candlewick Press, 1997) (1837).

No, product aura or snob-appeal from ownership are not dress. Those are intangibles that grow out of the tangible dress which can be observed by the senses.

Trade dress can be different from a marketing approach. The Eighth Circuit held that "down home country cooking, in a relaxed and informal atmosphere, with a full-service bar" was merely a method employed to market its restaurant services. *Prufrock Ltd. v. Lasater*, 781 F.2d 129, 131-132 (8th Cir. 1986).

And just what would country cooking in a stiff and formal atmosphere be like? Dolly Parton eating her fried chicken with a knife and fork? The Dixie Chicks thrown out by the headwaiter for putting their elbows on the table?

Haagen-Dazs claimed a right to an exclusive use of a Scandinavian concept, but was told it failed "to appreciate the difference between an attempt to trade off the goodwill of another and the legitimate imitation of an admittedly effective marketing technique." *Haagen-Dazs v. Frusen Gladje, Ltd.*, 493 F. Supp. 73, 75 (S.D.N.Y. 1980).

Our Court scratches its head over just what **Abercrombie** is trying to protect. **A&F** claims its clothing images are "active, rugged, athletic and cool."

Or as a teenager would say, "And their point is ... ?"

The Court says don't obsess on case language that uses the word "image" because you may be confusing it with that intangible "aura" mentioned above. The **A&F** Quarterly certainly exudes an image of young studs & studettes often after shucking their **A&F** clothes. But **A&F** can't have a monopoly on that sort of lusty youth. Image is the shape of a Ferrari and not the aura of big, super-fast beast of a machine driven by someone with far more money than us.

But **A&F** can protect its catalogue (which it sells) in the same way that Reader's Digest can protect the cover design — size, shape and layout. See *Reader's Digest Assoc., Inc. v. Conservative Digest, Inc.*, 261 U.S. App. D.C. 312, 821 F.2d 800, 803-05 (D.C. Cir. 1987).

Getting Over the Distinctiveness Hurdle

A mark is inherently distinctive if you can tell its source by its very nature. Or it has

acquired distinctiveness through secondary meaning. *Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982). Marks are inherently distinctive when arbitrary ("Lucky Strike" cigs), fanciful ("Kodak" film), or suggestive ("Tide" detergent). But descriptive ("Soft Soap") or generic ("soap") do not distinguish a good by showing where it came from. See *Abercrombie & Fitch v. Hunting World, Inc.*, 537 F.2d 4, 10-11 (2d Cir. 1976).

Product design cannot be inherently distinctive because there's no reason for consumers to connect it with a source. That must come from secondary meaning. *Samara Bros., Inc.* 529 U.S. at 216.

An ancient Roman designer who whipped up a tunic that looks like today's shirt might get trade dress protection because he'd be the sole source of this "bizarre" garment. But today it would just be a generic shirt.

"[E]vidence of intentional copying shows the strong secondary meaning of [a product] because 'there is no logical reason for the precise copying save an attempt to realize upon a secondary meaning that is in existence.'" *Ferrari*, 944 F.2d at 1239 (quoting *Audio Fidelity, Inc. v. High Fidelity Recordings, Inc.*, 283 F.2d 551, 558 (9th Cir. 1960)).

And **AE** had copied. **Abercrombie** submitted letters and emails from consumers noting similarity of ads and clothes design and asking the relationship between the two companies.

So What Does A&F Want to Protect About the Catalogue?

American complained that **Abercrombie** constantly shifts words, colors, logos in an on-going quest for cool. And **A&F** wants to possess words like "water rescue," "lifeguard," "outdoor" and images of lacrosse sticks and basketballs. **AE** argued trade dress should be consistent over time. See *Regal Jewelry Co. v. Kingsbridge Int'l, Inc.*, 999 F. Supp. 477, 486 (S.D.N.Y. 1998); see also *Rose Art Indus., Inc. v. Raymond Geddes & Co.*, 31 F. Supp. 2d 367, 373 (D.N.J. 1998) holding slight variations are okay but the trade dress should convey a "single and continuing commercial expression."

So What's a Competitor to Do?

You can't own functional features like sleeves and shoelaces via trademark. The functionality doctrine "prevents trademark law which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature." See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995).

Functional features in products belong to patent law with its limited life while trademark goes on forever.

Giving **Abercrombie** the words "authentic," "genuine brand," "field jersey" would stifle the competitor from describing its own clothes. There aren't but so many words to

describe product integrity. Likewise the use of symbols like lacrosse sticks. There's not but so much sporting equipment in the world. The Court pondered deeply about what sporting gear **A&F** hadn't used and could only hit upon fencing foils.

Incredibly, **Abercrombie** was claiming the use of college kids as sales associates as part of its trade dress. By their reasoning, no one else could use them.

That got rid of clothing designs and in-store presentation. Those were functional even though distinct. Thus not protected.

Now About That Catalogue

Abercrombie uses unusual paper, shows clothes hanging from a clothesline rather than on a model, uses grainy images of young hunks & hunkettes, and has a lifestyle editorial content.

The Court said there was an issue of material fact — a jury question — as to whether competitors have enough alternate methods to pitch to young folks by mail. But that wasn't really an issue because as I promised at the beginning, eroticism controls.

Likelihood of Confusion

To win, **A&F** would have to establish likelihood of confusion as to the origin of **AE's** clothes. "[T]he general concept underlying the likelihood of confusion is that the public believe that the [mark or dress] owner sponsored or otherwise approved the use of the trademark [or dress]." *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 834 (6th Cir. 1983).

Eroticism Controls the Case

And finally we get to it. Yes, **AE** copied the clothesline display of goods. But **A&F** artfully arranges its dudes & dudettes in erotic and homoerotic poses. Plus there's all that NUDITY! "Skinny snow boarding." "Nude water polo."

Hoo-ha!

Yes, **Abercrombie's** Spring Break 2001 Issue titled "XXX" had to be kept under the counter for sale to 18 and older. And it was banned in Utah by a soft-porn law. See *Marta Murvosh, Clothier Deems its Hit Catalog Too Sexy for Utah, Salt Lake Trib.*, Apr. 12, 2001, at A1.

American Eagle has zero nudity, emphasizes family and cornball lifestyle homilies.

Meanwhile **A&F** was touting "I'll have a brew Christmas" and infuriating Mothers Against Drunk Driving with a booze-sport feature called "Drinking 101."

As if they weren't MADD enough already.

And the Court got in a final zinger. The trade dress is certainly a question of law and not of fact when the dresses are so "clearly distinguishable and would appear so to all but the most obtuse consumer." *Haagen-Dazs*, 493 F. Supp. at 75.