

Insights: Publications

3 Key Takeaways | Second Circuit Clarifies "Blurry" Issue Between Articulation and Distinctiveness of Trade Dress at Pleading Stage

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On February 6, 2025, the United States Court of Appeals for the Second Circuit issued its decision in *Cardinal Motors, Inc. v. H&H Sports Protection USA, Inc.*, Docket No. 23-7586-cv, wherein the Court clarified a “blurry” issue in trade-dress litigation, namely, whether a plaintiff’s articulation of the protectable elements of its asserted product-design trade dress at the pleading stage is a part of, or is separate and distinct from, the issue of whether the trade dress is plausibly distinctive and protectable. The Court held it is the latter.

Below are key takeaways from the Court’s opinion that federal-court litigants and brand owners should keep in mind when protecting and enforcing product-design trade dress:

1. Secondary Meaning is Required for Product-Design Trade Dress to be Protectable. Trademark protection can cover more than words. It can include, for example, color, as well as a product’s trade dress, i.e., its “design or configuration.” Like a word mark, a product’s design or configuration must be “distinctive” to receive protection under trademark law. In *Cardinal Motors*, the Second Circuit reiterated the long-held tenet of trademark law that product-design trade dress is never “inherently” distinctive and, thus, must acquire distinctiveness (often referred to as “secondary meaning”) to be protectable. Secondary meaning occurs when, “in the minds of the public, the primary significance of a mark is to identify the source of the product rather than the product itself.”

2. Articulating Trade-Dress Elements Is Separate from Establishing Secondary Meaning. Three elements are required to prove a product-design trade dress claim: (i) distinctiveness; (ii) likelihood of confusion; and (iii) non-functionality. Apart from these elements, a Plaintiff must “separate out and clearly identify in a list the discrete components that make up its trade dress.” As the Court explained in *Cardinal Motors*, this articulation is necessary because, among other things, it “provides a crucial guidepost for courts and juries to evaluate the merits of an infringement claim.” As the Court also noted, though, courts often conflate this articulation pleading requirement with the distinctiveness element of the claim. To clarify the “blurry” line between distinctiveness and articulation, the Court held “that distinctiveness is independent of the articulation requirement. Distinctiveness is an *element* of a trade dress infringement claim to be pleaded in a complaint and shown at trial. The articulation requirement, by contrast, is a pleading requirement under which plaintiffs must articulate precisely the *components* that compose their claimed trade dress.” (emphasis in original). And with that distinction, the Court reversed the trial court’s decision, which dismissed the Plaintiff’s trade-dress claim based on “incorporating a distinctiveness requirement into its articulation analysis.”

3. Articulation of Trade-Dress Should Be Consistent with Other Protection and Enforcement Efforts.

When assessing secondary meaning in federal-court litigation, one issue that often arises is whether the plaintiff has continuously used its asserted trade dress in commerce. Specifically, courts assess whether consistent use has developed an association in consumers' minds between the asserted trade dress and the plaintiff or its brand. To attempt to show a lack of secondary meaning, Defendants will look for inconsistencies in how the plaintiff has articulated its trade-dress elements in settings outside of federal court, e.g., in trademark applications and demand letters. Anticipating this defense strategy, brand owners should work closely with their trademark prosecution and trademark litigation teams to ensure consistency when articulating trade-dress elements in trademark applications, demand letters, and lawsuits.

For more information, please contact:

Jonathan Thomas, jwthomas@ktslaw.com

Nicki Chollet, nchollet@ktslaw.com

Related People



Nichole Davis Chollet

t 404.815.6010

nchollet@ktslaw.com