

## Syllabus

NOTE: Where it is feasible, a syllabus (headnote) will be released, as is being done in connection with this case, at the time the opinion is issued. The syllabus constitutes no part of the opinion of the Court but has been prepared by the Reporter of Decisions for the convenience of the reader. See *United States v. Detroit Timber & Lumber Co.*, 200 U. S. 321, 337.

**SUPREME COURT OF THE UNITED STATES**

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**WAL-MART STORES, INC. v. SAMARA BROTHERS,  
INC.****CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR  
THE SECOND CIRCUIT**

No. 99–150. Argued January 19, 2000– Decided March 22, 2000

Respondent Samara Brothers, Inc., designs and manufactures a line of children’s clothing. Petitioner Wal-Mart Stores, Inc., contracted with a supplier to manufacture outfits based on photographs of Samara garments. After discovering that Wal-Mart and other retailers were selling the so-called knockoffs, Samara brought this action for, *inter alia*, infringement of unregistered trade dress under §43(a) of the Trademark Act of 1946 (Lanham Act). The jury found for Samara. Wal-Mart then renewed a motion for judgment as a matter of law, claiming that there was insufficient evidence to support a conclusion that Samara’s clothing designs could be legally protected as distinctive trade dress for purposes of §43(a). The District Court denied the motion and awarded Samara relief. The Second Circuit affirmed the denial of the motion.

*Held:* In a §43(a) action for infringement of unregistered trade dress, a product’s design is distinctive, and therefore protectible, only upon a showing of secondary meaning. Pp. 3–10.

(a) In addition to protecting registered trademarks, the Lanham Act, in §43(a), gives a producer a cause of action for the use by any person of “any . . . symbo[l] or device . . . likely to cause confusion . . . as to the origin . . . of his or her goods.” The breadth of the confusion-producing elements actionable under §43(a) has been held to embrace not just word marks and symbol marks, but also “trade dress”— a category that originally included only the packaging, or “dressing,” of a product, but in recent years has been expanded by many courts of appeals to encompass the product’s design. These courts have correctly assumed that trade dress constitutes a “symbol” or “device” for Lanham Act purposes. Although §43(a) does not explicitly require a

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producer to show that its trade dress is distinctive, courts have universally imposed that requirement, since without distinctiveness the trade dress would not “cause confusion . . . as to . . . origin,” as §43(a) requires. In evaluating distinctiveness, courts have differentiated between marks that are inherently distinctive— *i.e.*, marks whose intrinsic nature serves to identify their particular source— and marks that have acquired distinctiveness through secondary meaning— *i.e.*, marks whose primary significance, in the minds of the public, is to identify the product’s source rather than the product itself. This Court has held, however, that applications of at least one category of mark— color— can *never* be inherently distinctive, although they can be protected upon a showing of secondary meaning. *Qualitex Co. v. Jacobson Products Co.*, 514 U. S. 159, 162–163. Pp. 3–6.

(b) Design, like color, is not inherently distinctive. The attribution of inherent distinctiveness to certain categories of word marks and product packaging derives from the fact that the very purpose of attaching a particular word to a product, or encasing it in a distinctive package, is most often to identify the product’s source. Where it is not reasonable to assume consumer predisposition to take an affixed word or packaging as indication of source, inherent distinctiveness will not be found. With product design, as with color, consumers are aware of the reality that, almost invariably, that feature is intended not to identify the source, but to render the product itself more useful or more appealing. Pp. 6–9.

(c) *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U. S. 763, does not foreclose the Court’s conclusion, since the trade dress there at issue was restaurant décor, which does not constitute product *design*, but rather product packaging or else some *tertium quid* that is akin to product packaging and has no bearing on the present case. While distinguishing *Two Pesos* might force courts to draw difficult lines between product-design and product-packaging trade dress, the frequency and difficulty of having to distinguish between the two will be much less than the frequency and difficulty of having to decide when a product design is inherently distinctive. To the extent there are close cases, courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning. Pp. 9–10.

165 F. 3d 120, reversed and remanded.

SCALIA, J., delivered the opinion for a unanimous Court.