

Visual Over Verbal: Hierarchy of Trade Dress Application Elements

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The examination of trade dress marks is complex and iterative. Generally, the first step in the prosecution of a trade dress application is for the PTO to determine the metes and bounds of an applicant's trade dress. In defining the scope of a trade dress, the entire application content, including the drawing, description of the mark, identification of goods or services, and specimen, guides the PTO's analysis.¹ However, the Trademark Trial and Appeal Board (Board) appears to assign varying degrees of importance to these components during the review of PTO decisions.

For example, in *Kohler Co. v. Honda Giken Kogyo K.K.*, the Board observed that the drawing, not the "words an applicant uses to describe" the mark, "controls what the mark is."² Echoing a similar sentiment, the Board recently observed in *In re Post Foods, LLC* that "[i]n defining the mark that Applicant seeks to register, we consider all elements, including those described in the application as well as those shown in the drawing page but we are not bound by what Applicant describes its mark to be in its application or in its brief."³

How should one reconcile the directive to "consider" all elements of a trade dress application with the assertion that the Board is not "bound" by the mark description in the application or appeal brief? The Board's refusal to consider any revised mark description in an appeal brief is appropriate, as its review is limited to the record as it existed at the time of the final refusal. Thus, the Board generally disregards changes incorporated in an appeal brief. However, it is perplexing that the Board is not bound by an applicant's description of the mark, given that the PTO's internal guidance manual, Trademark Manual of Examining Procedure (T.M.E.P.), encourages the examining attorney to

consider applicant's visual presentation as well the textual articulation of the features of their trade dress mark.⁴ In fact, the T.M.E.P. anticipates applicants will specify which elements of the drawing they claim to be the mark in the description.⁵ This tension between the directive to consider all aspects of the application and the refusal to treat the applicant's description as determinative underscores an inherent ambiguity in the doctrinal framework governing trade dress prosecution.

TRADE DRESS APPLICATIONS BEFORE THE PTO: PROCEDURAL GUIDANCE FROM THE T.M.E.P.

T.M.E.P. § 1202.02 provides that "[a] determination of whether the mark constitutes trade dress must be informed by the application content, including the drawing, the description of the mark, the identification of goods or services, and the specimen, if any." Further, the drawing and mark description must indicate the mark the applicant intends to register, describing those portions claimed as part of the mark and those that are not.⁶ The T.M.E.P. provides the following specific guidance on the different elements of a trade dress application:

Drawing⁷

- A trade dress application requires a special drawing of the claimed mark. If the mark comprises only a portion of product design or product packaging, the applicant must use solid lines in the drawing to show the parts of the product design or packaging that are claimed as part of the mark and broken/dotted lines to show the unclaimed parts.⁸
- If the broken lines make elements of a mark illegible, the applicant may use solid lines. However, the mark description must clarify that those elements are not part of the mark.

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- The drawing must be an illustrated rendering of the product design or packaging; however, the PTO may accept a photograph in appropriate cases.
- Applicants should not include purely informational content (e.g., net weight, contents, or addresses) in the drawing.

Description⁹

- The description must clearly state whether the mark is three-dimensional or two-dimensional, whether it covers a product design or packaging, and whether the applicant's claim is to goods or service-related trade dress.
- The description must explain what the broken or dotted lines represent and include a statement that those parts are not claimed as part of the mark.
- Applicants should not use disclaimer-style language because broken lines and disclaimers have different legal meanings.
- If the Examining Attorney requires the applicant to amend the mark drawing, the applicant must update the description to match the amended mark drawing.

Specimen

The T.M.E.P. does not outline any special requirements for a trade dress specimen. As with any trademark application, the specimen must show use of the mark in commerce, which may be relevant to any functionality determination. The Examining Attorney will also compare the drawing and the specimen to confirm they show the same mark.

However, applicants should not base the drawing on the appearance of the mark in the specimen. For example, in one application¹⁰ to register the shape of a beach canopy, Shibumi Shade, Inc. (Shibumi) included a wavy pattern in its drawing to capture how the canopy looked in the specimen (Figure 1). Because the drawing showed this wavy feature, the Examining Attorney instructed Shibumi to amend the mark description to match the drawing.¹¹ However, Shibumi instead submitted a revised drawing (Figure 2) that removed the wavy feature, and successfully argued that it had included the wavy pattern in the prior drawing to represent the flapping of the rectangular canopy in wind as shown in the specimen.¹² Thus, while the specimen demonstrates how a mark is used, the drawing must independently and accurately depict the elements of the mark that the applicant seeks to register.

Specimen	Fig. 1, Initial Drawing	Fig. 2, Amended Drawing

Goods and Services¹³

In the case of product design trade dress, the goods and services claimed in the application must align with the product design claimed as a trademark. The T.M.E.P. provides the following example: an application for a three-dimensional guitar design cannot claim drums and pianos. In contrast, the PTO does not impose a similar restriction on product packaging. Thus, product packaging trade dress need not resemble the goods claimed in such application. However, if the packaging shown in the mark is not typically used to package the goods claimed in the application, the PTO will request clarification. The drawing, description, and specimen are relevant to this analysis.

In sum, this procedural guidance from the T.M.E.P. suggests that the drawing, mark description, specimen, and identification of goods and services each carry equal weight in defining the scope of a trade dress, with each component complementing the others. However, as discussed below, the drawing serves as the primary reference point for determining the scope of a trade dress when the Board resolves any ambiguity or inconsistency among these application components.

BOARD PRECEDENT EMPHASIZING THE PRIMACY OF THE APPLICATION DRAWING

The following cases collectively underscore the importance the Board places on the drawing submitted with the application in determining the scope of a trade dress. Whether the issue is the failure to use dotted lines to exclude functional features, the absence of a clarifying statement in the description, or attempts to redefine the claimed features in appeal briefs, the Board consistently looks to the original drawing as the definitive representation of the mark.

*In re Becton, Dickinson and Co.*¹⁴

In this case, the PTO refused to register the configuration of the closure cap for medical collection tubes, finding the design functional. The applicant's original drawing showed the entire closure cap in solid lines. However, on appeal, the applicant submitted a numbered drawing identifying the features of the cap it intended to claim as part of the trade dress. Although the Board found this submission helpful, it noted that the mark includes all features

shown in the application's description and the drawing, except for any elements properly excluded with dotted lines. Because the applicant failed to depict many of the functional aspects of the cap in dotted lines, the Board considered those features as part of the claimed mark.

*In re Heatcon, Inc.*¹⁵

In this case, the Board upheld the refusal to register the arrangement of an equipment's user interface. The applicant depicted the individual functional components that made up the user interface in solid lines, asserting that only such representation would allow it to claim rights to the entire three-dimensional arrangement and that using dotted lines would render the drawing unclear. The Examining Attorney countered that under those circumstances, the applicant must include a statement in the mark description clarifying that elements shown in solid lines were not part of the claimed mark. The Board was not persuaded that using dotted lines would have made the drawing unclear and agreed with the Examining Attorney that, even if it had, a clarifying statement in the description was still necessary.

*In re Change Wind Corp.*¹⁶

In this case, the PTO refused to register the configuration of a wind turbine. The drawing of the applicant's mark represented a feature that served functional purposes in solid lines. Although the applicant did not specifically claim this feature as part of its mark in its written description, the Board determined the scope of the applicant's mark based on the drawing, which represented that feature in solid lines. In this regard, the Board concluded that when the written description of a product design mark does not cover everything that makes up the mark, then the full scope of the mark is determined by the drawing.

*Kohler Co.*¹⁷

The facts of this case are similar to those in *In re Becton*. The application sought to register the configuration of an engine as trade dress. Rather than depicting the claimed elements of the mark in solid lines and the unclaimed elements in dotted lines, the applicant attempted to highlight the claimed features graphically in its appeal brief. The Board observed that the "[a]pplicant's application 'drawing depicts the mark to be registered' [and] not its modified drawing

reproduced [in its brief] or the words used to describe the mark in the application.” Accordingly, the Board assessed the registrability of the mark as shown in the application drawing rather than in the alternative drawing that the applicant submitted with its brief. The Board further noted that it would consider the description of the mark only to the extent that it is consistent with the drawing.

These cases reinforce that applicants must delineate using (1) solid lines in their drawings for features that are part of the mark, and (2) dotted lines for features that are not claimed, or risk refusal for claiming functional matter. Further, while the drawing, mark description, and supporting specimen are intended to function cohesively, the Board resolves any ambiguity or inconsistency among them in favor of the drawing, which serves as the definitive representation of the mark.

WHEN PRODUCT DESIGN BECOMES A COLOR MARK: LESSONS FROM IN RE POST

Failure to appreciate how the four components discussed above operate together can lead to unintended consequences, as Post realized earlier last year when its product configuration mark with claims to colors morphed into a color mark. Post sought registration for the configuration of its colorful crispy rice cereal popularly known as Fruity Pebbles on the Principal Register based on a claim of acquired distinctiveness under Section 2(f).¹⁸ Post initially described its mark as “the product configuration of crisp cereal pieces in the colors of yellow, green, light blue, purple, orange, red and pink.” Instead of providing an illustrated rendering of the cereal pieces, Post submitted a photograph. In response to the PTO’s first Office Action (OA), which requested, among other things, a new mark drawing, Post contended that due to the relatively small size of the individual puffed rice pieces, the photograph, along with its revised mark description, satisfied the drawing requirements for a trade dress under T.M.E.P. §1202.02(c)(i).¹⁹ Post’s revised description clarified the nature of the mark by inserting the term “three-dimensional” (see Table 1 for the full revised description).²⁰

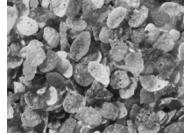
Before substantively responding to Post, the PTO issued a second OA, in which it required Post to disclaim trademark rights to the shape of

the cereal flakes separate from the mark as a whole. The PTO stated in the OA that (1) functional elements must be depicted in broken or dotted lines on the drawing, and (2) elements that are nonfunctional but capable of acquiring trademark significance but have not yet acquired distinctiveness must be disclaimed.²¹ The PTO then proposed that Post respond to the OA by disclaiming the exclusive right to use the depiction of the cereal flake’s shape, implying that the cereal flake’s shape was nonfunctional but capable of acquiring trademark significance. In addition to agreeing to the disclaimer,²² Post responded to the second OA by deleting the mention of a three-dimensional product configuration from the description.²³ After Post removed the claim to the three-dimensional product configuration, the PTO reassigned the application, which it considered a “color mark,” to a new Examining Attorney.²⁴

In a third OA, the new Examining Attorney requested that Post withdraw its previous disclaimer of the shape, submit a new drawing with broken lines around the cereal’s shape, and revise the mark description accordingly. The PTO now viewed the cereal flake’s shape as not eligible for trademark protection and limited Post’s claim to color only.²⁵ Moreover, the Examining Attorney asserted that Post’s color mark is not inherently distinctive for cereals and the evidence supporting Post’s Section 2(f) claim, including the surveys conducted on the “shape” and advertising that focused on the cereal instead of the color of the cereal, has no probative value on the issue of acquired distinctiveness of a color mark.

Although Post responded that the Examining Attorney had mischaracterized its mark and that its mark is a combination of both the shape and color, it nevertheless amended the mark drawing by placing broken lines around the shape of each cereal flake, revised its mark description accordingly (Table 1 provides the amended drawing and revised mark description), and deleted the disclaimer from the record.²⁶ Following the Examining Attorney’s final refusal, Post argued in its Request for Reconsideration that the Examining Attorney’s analysis of its evidence and arguments was flawed because she viewed its mark solely as a color mark and “not the combination of the recited colors applied to crisp cereal pieces.”²⁷

Table I. Summary of Post's Amendments to the Mark drawing and Mark Description

	Mark Drawing	Mark Description
Application		The mark consists of the product configuration of crisp cereal pieces in the colors of yellow, green, light blue, purple, orange, red and pink.
Response to 1 st OA	No change	The mark consists of a <u>three-dimensional</u> product configuration of crisp cereal pieces in the colors of yellow, green, light blue, purple, orange, red and pink.
Response to 2 nd OA	No Change	The mark consists of a <u>three-dimensional</u> product configuration of crisp cereal pieces in the colors of yellow, green, light blue, purple, orange, red and pink applied to crisp cereal pieces.
Response to 3d OA		The mark consists of the colors of yellow, green, light blue, purple, orange, red and pink applied to <u>the entire surface of</u> crisp cereal pieces. <u>The broken lines depicting the shape of the crisp cereal pieces indicate placement of the mark on the crisp cereal pieces and are not part of the mark.</u>

On appeal, the threshold question before the Board was: What, exactly, is the mark that Post seeks to register? Post explained that the second drawing submitted in response to the third OA was an enlarged detail area from the photograph it had initially submitted and that it showed the physical appearance of the crisp rice cereal pieces, including their color, surface texture, and general nature.²⁸ Further, the dotted lines in the drawing claimed only the outer portions of the cereal pieces as functional, not their physical appearance, because they remained visible. Moreover, the mark description supported Post's position that its mark was not a color mark, and changes to the description made during the prosecution of the application did not change this conclusion.²⁹ However, the Board agreed with the Examining Attorney that by placing the dotted line around the cereal pieces and amending the description accordingly, Post indicated that it was not claiming any rights to the shape of the cereal. Further, the Board observed that although the description referred to the dotted lines as "indicat[ing] placement of the mark," this language signaled to the PTO that Post did not intend to claim rights to the shape of the cereal.

Given the four Board decisions discussed above, the outcome in *In re Post* was not surprising. When viewed alongside the requirements in the T.M.E.P., one can reasonably conclude that all four components of a trade dress application are complementary and must present a cohesive picture. If not, the visual representation of the mark overrides any other intention of the applicant.

CONCLUSION

In short, these cases reinforce that applicants must carefully delineate which elements of a product design or packaging they claim as the mark. The Board consistently interprets solid-line depictions as claimed elements of the mark. If an applicant fails to exclude functional elements in the mark's drawing, the PTO will require the applicant to revise the mark's drawing to show those elements in broken or dotted lines. Further, if applicants cannot show functional elements in dotted lines due to clarity concerns, they must declare in the mark's description that these elements are not part of the mark and that they serve only to show the position of the mark on the goods. Moreover, even if a written description clarifies the intended scope, the drawing controls.

Notes

1. See T.M.E.P. § 1202.02 (Nov. 2024).
2. 125 U.S.P.Q.2d 1468, 2017 WL 6547628, at *19 (T.T.A.B. 2017) (citing *In re Change Wind Corp.*, 123 U.S.P.Q.2d 1453, 1459 n.6 (TTAB 2017)).
3. Serial No. 88/857834, 2024 WL 64681, at *3 (T.T.A.B. Jan. 4, 2024) (internal quotation omitted).
4. See T.M.E.P. § 1202.02(c).
5. See T.M.E.P. § 1202.02(c)(ii).
6. *Id.*
7. *Id.* § 1202.02(c)(i).
8. Although it is commonplace to find applicants describing the purpose of the dotted line is to show the placement of the mark (see e.g., *In re Post*), the dotted lines in a trade dress application serve a dual purpose: (1) to depict matter not claimed as part of the mark, e.g., functional matters (see e.g., application to register the exterior design feature of Best Western's Glo hotels, U.S. Registration Number 6373311, and trade dress for the packaging of a bottle, US Registration Number 6715323), and (2) to indicate the placement of the mark in reference to matters not claimed as part of the mark. *Kohler Co.*, 2017 WL 6547628, at *20. If an applicant wants to claim a particular feature as part of the mark, it must represent those features in solid lines. See the prosecution of the application to register the exterior of the fast-food chain Pal's Sudden Service, U.S. Registration Number 4117002.
9. T.M.E.P. § 1202.02(c)(ii).
10. See U.S. Trademark Application Serial Nos. 90/785780, 90/785791 (filed Jun. 21, 2021). The Board affirmed the Examining Attorney's refusal to register Shibumi's applications to register the shape of its beach canopy on functionality grounds. See *In re Shibumi Shade, Inc.*, Application Serial Nos. 90/785780, 90/785791 (T.T.A.B. May 13, 2025) (not precedential).
11. See October 25, 2021 Office Action, Application Serial No. 90/785780.
12. See March 23, 2022 Response to Office Action, Application Serial No. 90/785780.
13. See T.M.E.P. § 1202.02(f)(i)–(ii).
14. 2010 WL 3164746, *2 (T.T.A.B. July 10, 2010), aff'd, 675 F.3d 1368, 102 U.S.P.Q.2d 1372 (Fed. Cir. 2012).
15. 116 U.S.P.Q.2d 1366 (T.T.A.B. 2015).
16. 123 U.S.P.Q.2d 1453 (T.T.A.B. 2017).
17. 125 U.S.P.Q.2d 1468 (T.T.A.B. 2017).
18. See Application Serial No. 88/857834 (filed Apr. 02, 2020).
19. See July 14, 2020 Nonfinal Office Action at TSDR 1 and January 13, 2021 Response to Office Action at TSDR 10–11, Application Serial No. 88/857834.
20. *Id.*
21. See February 10, 2021 Nonfinal Office Action at TSDR 1, Application Serial No. 88/857834.
22. Post did not include the disclaimer in the mark description. Instead, it was entered as an additional statement to the record.
23. See generally April 13, 2021 Response to Office Action, Application Serial No. 88/857834.
24. See Examining Attorney's Brief at TTABVUE 2, *In re Post*, Ex Parte Appeal No. 88/857834.
25. See November 4, 2021 Nonfinal Office Action at TSDR 1, Application Serial No. 88/857834.
26. See generally April 20, 2022 Response to Nonfinal Office Action, Application Serial No. 88/857834.
27. See generally July 26, 2022 Request for Reconsideration, Application Serial No. 88/857834.
28. See Applicant Reply Brief at TTABVUE 1–4, *In re Post*, Ex Parte Appeal No. 88/857834.
29. *Id.*

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