

Fiji Water Co., LLC v. Fiji Mineral Water USA, LLC

741 F.Supp.2d 1165, 1176-77 (C.D.Cal. 2010)

{The essential facts are as follows: Plaintiff produced water bottled in Fiji under the mark FIJI and with trade dress as defined and shown below. Defendant also produced water bottled in Fiji under the mark VITI and with trade dress as shown below. Plaintiff sued for trademark (and trade dress) infringement and won a preliminary injunction. Excerpted here are the court's description of the plaintiff's trade dress and the court's analysis of the inherent distinctiveness of that trade dress.}



CORMAC J. CARNEY, District Judge

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FIJI also alleges that the VITI product infringes the FIJI trade dress, which includes the following elements: the use of a bottle with a dominantly square shape, with a recessed central body portion defined by the protruding shoulders and base portions of the bottle, a blue bottle cap, a transparent outer front label

with a pink accent in the lower right hand corner, a depiction of a blue background and palm tree fronds on the inside of the back label, a three-dimensional effect created by having a transparent label on the front panel of the bottle revealing the inner side of the back label, a rainwater drop on the front label, a statement on the front label stating “From the islands of Fiji/Natural Artesian Water,” and prominent use of the four-letter, two-syllable word FIJI, in block white lettering with a metallic outline around the letters.

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The second element that FIJI must establish to succeed on the merits for its trade dress infringement claim is that its trade dress is inherently distinctive or has acquired secondary meaning. Packaging such as the FIJI bottle shape and label design is inherently distinctive if “[its] intrinsic nature serves to identify a particular source.” *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210, (2000); see also 1 *McCarthy on Trademarks* § 8:12.50 (4th ed. 2010) (bottle is packaging). To determine whether packaging is so “unique, unusual, or unexpected in this market that one can assume without proof that it will automatically be perceived by consumers as an indicator of origin,” the court may look to {the *Seabrook* factors}. *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342 (CPPA 1977). See *Wal-Mart Stores, Inc.*, 529 U.S. at 210 (noting that the *Abercrombie* spectrum of distinctiveness is properly applied to word marks); see also 1 *McCarthy on Trademarks* § 8:13 (4th ed. 2010) (commenting that *Seabrook* test is preferred for classifying inherently distinctive trade dress in packaging and containers); *DCNL, Inc. v. Almar Sales Co.*, 47 U.S.P.Q.2d 1406, 1997 WL 913941 (N.D.Cal. 1997), aff’d without opinion, 178 F.3d 1308 (9th Cir. 1998).

Although the square bottle and blue cap elements may be fairly common in the bottled water industry, the stylized hibiscus, the palm fronds and the three-dimensional effect of the transparent front label with palm fronds on the inside back label are not a common design. *Contra Paddington Corp. v. Attiki Imps. & Distrib., Inc.*, 996 F.2d 577 (2d Cir. 1993) (giving examples of designs that are not inherently distinctive in certain markets, such as packaging lime soda in green cans or showing a shining car on a bottle of car wax). The stylized white block letters with metallic outline for the word “FIJI,” together with the tropical foliage using hues of blue and green and the raindrop invites consumers to imagine fresh, clear water from a remote tropical island. Reviewing the 2008 Bottled Water Guide that FIJI submitted reveals no other brands that combine the elements of the square bottle, three-dimensional labeling effect, and tropical motif. FIJI has won international awards for print and packaging excellence and design innovation in the food packaging industry, which is strong evidence that its packaging is unique or unusual in the field and not simply a variation on existing bottled water designs. Finally, the transparent three-dimensional label distinguishes FIJI from the other

brands, and makes the trade dress recognizable even apart from the block-letter word mark FIJI, as evidenced by some of the open-ended responses consumers gave in FIJI's consumer confusion survey. Based on this evidence, the Court concludes that FIJI's trade dress is inherently distinctive.