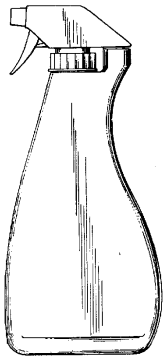
Bars to protection . . .

- Requires a careful parsing of 15 U.S.C. § 1052
- Items to be considered
  - Functionality
    - Utilitarian
    - Aesthetic
  - Deceptive marks
    - Deceptively misdescriptive
    - Geographic / non-geographic
  - Scandalous
  - Disparaging
  - Marks that falsely suggest a connection

Functionality . . .
In re Morton Norwich Products, Inc., 671 F.2d 1332 (CCPA 1982) [_NOT ASSIGNED_]

- What aspects of product design are protectable as a trademark?
- Functionality -> utility ->
  - competitors need to use the design – no necessity to copy
    - Because it is superior?
    - Because there are no other plausible alternatives?
  - No evidence product feature was dictated by functions to be performed
  - Will granting exclusive rights hinder competition?
- Distinctiveness is a separate inquiry from functionality
- Effect of patent on mechanism inside spray head?



Functionality Overview

- Utilitarian Functionality
  - *Morton-Norwich*
    - establishes 4 *Morton-Norwich* factors
    - Most important *Morton-Norwich* factor is 3d factor, availability of alternative designs
  - *Qualitex*: equates *Inwood*'s "essential to use or purpose" with competitive need
  - *TrafFix Devices*
    - emphasizes *Inwood*'s "essential to use or purpose" test and minimizes importance of availability of alternative designs
    - if product feature is "essential to use or purpose", no need to consider alternative designs
    - implies that a product feature can be "essential to use or purpose" and thus functional *even if there are alternative designs*
  - Circuit split after *TrafFix Devices*
    - *Valu Engineering:* essentially ignores *TrafFix Devices* and returns to *M-N*
    - *Eppendorf:* seeks to follow *TrafFix Devices* and focuses on "essential to use or purpose test"; if product feature is "essential to use or purpose", no need to consider whether product feature is a "competitive necessity"

Functionality Overview

- Aesthetic Functionality
  - *Wallace Int'l Silversmiths*
    - Rejects *Pagliero*'s "important ingredient in commercial success" test
    - Embraces availability of alternative designs test
  - *TrafFix Devices*:
    - Claims that *Qualitex* was an aesthetic functionality case
    - In cases of aesthetic functionality, "it is proper to inquire into a 'significant non-reputation-related disadvantage." That is, courts should apply the availability of alternative designs / competitive necessity test.

Recent History of Utilitarian Functionality Doctrine

- In re Morton-Norwich, 671 F.2d 1332 (C.C.P.A. Feb. 18, 1982)

- "[T]he question in each case is whether protection against imitation will hinder the competitor in competition" (*Fruehauf*)
- "inhibit competition in any way" (*Fotomat*)
- A design of goods is functional if it "affects their purpose, action or performance, or the facility or economy of processing, handling or using them" (*Restatement of Torts*)
  - Will protection "deprive [competitors] of something which will substantially hinder them in competition"? (*Restatement of Torts*)
- "[I]s [the design] the best or one of a few superior designs available?" (*In re Morton-Norwich*)

Recent History of Utilitarian Functionality Doctrine

- In re Morton-Norwich, 671 F.2d 1332 (C.C.P.A. Feb. 18, 1982)

- "[A] molded plastic bottle can have an infinite variety of forms or designs and still function to hold liquid. No one form is necessary or appears to be 'superior.'"
- "While that design must be accommodated to the functions performed, we see no evidence that it was dictated by them and resulted in a functionally or economically superior design of such a container."

Recent History of Utilitarian Functionality Doctrine

- In re Morton-Norwich, 671 F.2d 1332 (C.C.P.A. Feb. 18, 1982)

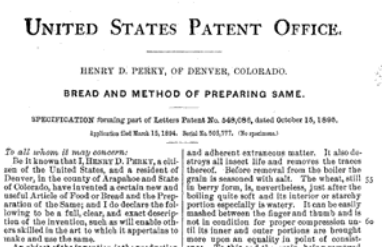
Morton-Norwich Factors

1. Existence of expired utility patent
2. Utilitarian advantages touted in advertising
3. Availability of alternative designs
4. Manufacturing advantages

Recent History of Utilitarian Functionality Doctrine

- Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 851 (June 1, 1982)

10. In general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article. See *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 232, 84 S.Ct. 784, 789, 11 L.Ed.2d 661 (1964); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 122, 59 S.Ct. 109, 115, 83 L.Ed. 73 (1938).



UNITED STATES PATENT OFFICE.

HENRY D. PERKY, OF DENVER, COLORADO.

BREAD AND METHOD OF PREPARING SAME.

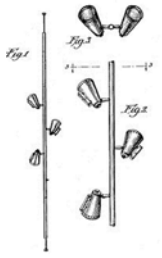
SPECIFICATION forming part of Letters Patent No. 548,086, dated October 15, 1895.

Application filed March 15, 1894. Serial No. 503,777. (No specimens.)

To all whom it may concern:

Be it known that I, HENRY D. PERKY, a citizen of the United States, and a resident of Denver, in the county of Arapahoe and State of Colorado, have invented a certain new and useful Article of Food or Bread and the Preparation of the Same; and I do declare the following to be a full, clear, and exact description of the invention, such as will enable others skilled in the art to which it appertains to make and use the same.

and adherent extraneous matter. It also destroys all insect life and removes the traces thereof. Before removal from the boiler the grain is seasoned with salt. The wheat, still in berry form, is, nevertheless, just after the boiling quite soft and its interior or starchy portion especially is watery. It can be easily mashed between the finger and thumb and is not in condition for proper compression until its inner and outer portions are brought more upon an equality in point of consist-



Recent History of Utilitarian Functionality Doctrine

- Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159, 165 (1995)
  - "This Court consequently has explained that, '[i]n general terms, a product feature is functional,' and cannot serve as a trademark, 'if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,' that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage. *Inwood*."

Recent History of Utilitarian Functionality Doctrine

- TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23 (2001)

Recent History of Utilitarian Functionality Doctrine

- TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23, 29-30 (2001)
  - "The principal question in this case is the effect of an expired patent on a claim of trade dress infringement. A prior patent, we conclude, has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device."

Recent History of Utilitarian Functionality Doctrine

- TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23, 32-33 (2001)
  - "Discussing trademarks, we have said '[i]n general terms, a product feature is functional,' and cannot serve as a trademark, 'if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.' *Qualitex* (quoting *Inwood*). Expanding upon the meaning of this phrase, we have observed that a functional feature is one the 'exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.' *Id*. The Court of Appeals in the instant case seemed to interpret this language to mean that a necessary test for functionality is 'whether the particular product configuration is a competitive necessity.' 200 F.3d, at 940. See also *Vornado*, 58 F.3d, at 1507 ('Functionality, by contrast, has been defined both by our circuit, and more recently by the Supreme Court, in terms of competitive need'). This was incorrect as a comprehensive definition. As explained in *Qualitex*, supra, and *Inwood*, supra, a feature is also functional when it is essential to the use or purpose of the device or when it affects the cost or quality of the device. The *Qualitex* decision did not purport to displace this traditional rule."

TrafFix Devices v. MDI

MDI

WindMaster

WindBuster

TrafFix Devices, Inc.

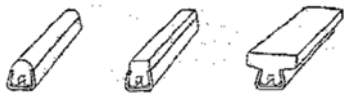
TrafFix Devices v. MDI

- What is being asserted as a mark?
  - Trade dress of the dual spring system
    - The court discusses the dual spring system as trade dress, but the dual spring system is perhaps better characterized as product design/configuration?
- Patent status of the dual spring system?
  - Patent is for dual springs spaced apart
    - Trade dress asserted has springs close together
- Impact of patent status on the trade dress question?
  - Strong evidentiary inference that the claimed utility patent functionality, when later asserted as trade dress, is functional
  - For unregistered trade dress, burden is on holder of the mark to prove nonfunctionality §43(a)(3)
- Does it matter whether it is trade dress (which can be inherently distinctive) or product design/configuration (which cannot)?
  - Neither is protectable under trademark law if functional
- Implications of "alternative designs"?

- Freedom to compete requires freedom to copy unless an item is covered by patent or copyright protection
  - Allowing trade dress protection for functional items bypasses the balance of benefits and costs in the patent system

Two Lines of Case Law

- Valu Engineering, Inc. v. Rexnord Corp., 278 F.3d 1268 (Fed. Cir. 2002)



- Eppendorf-Netheler-Hinz GmBH v. Ritter GmBH, 289 F.3d 351 (5th Cir. 2002)
  - Talking Rain Beverage v. South Beach Beverage Co., 349 F.3d 601 (9th Cir. 2003) (or a fusion of Valu Engineering and TrafFix?)
  - Antioch Co. v. Western Trimming Corp., 347 F.3d 150 (6th Cir. 2003)
  - Eco Mfg. LLC v. Honeywell Int'l Inc., 357 F.3d 649 (7th Cir. 2003) (?)

Eppendorf-Netheler-Hinz GmBH v. Ritter GmBH, 289 F.3d 351 (5th Cir. 2002)

- "Thus, the fins are design elements necessary to the operation of the product."
- The product feature is not a "competitive necessity," but is simply necessary to the operation of the product.

Apple, Inc. v. Samsung Electronics Co. Ltd. (Fed. Cir. May 18, 2015)

- "we reverse the jury's findings that the asserted trade dresses are protectable."
- "While the parties argue without distinguishing the two trade dresses, the unregistered trade dress and the registered '983 trade dress claim different details and are afforded different evidentiary presumptions under the Lanham Act. We analyze the two trade dresses separately below"

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

United States Patent and Trademark Office

Reg. No. 3,470,983

Registered July 22, 2008

TRADEMARK
PRINCIPAL REGISTER

APPLE INC. (CALIFORNIA CORPORATION)
1 INFINITE LOOP
CUPERTINO, CA 95014

FOR: HANDHELD MOBILE DIGITAL ELECTRONIC DEVICES COMPRISED OF A MOBILE PHONE, DIGITAL AUDIO AND VIDEO PLAYER, HANDHELD COMPUTER, PERSONAL DIGITAL ASSISTANT, ELECTRONIC PERSONAL ORGANIZER, POCKET COMPUTER FOR NOTE-TAKING, ELECTRONIC CALENDAR, CALCULATOR, AND CAMERA, AND CAPABLE OF PROVIDING ACCESS TO THE INTERNET AND SENDING AND RECEIVING ELECTRONIC MAIL, DIGITAL AUDIO, VIDEO, TEXT, IMAGES, GRAPHICS AND MULTIMEDIA FILES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 6-29-2007; IN COMMERCE 6-29-2007.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SMS", APART FROM THE MARK AS SHOWN.

THE COLOR(S) BLACK, BLUE, BROWN, BROWN-GRAY, GRAY-GREEN, GREEN, ORANGE, RED, SILVER, TAN, WHITE AND YELLOW IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF THE CONFIGURATION OF A RECTANGULAR HANDHELD MOBILE DIGITAL ELECTRONIC DEVICE WITH ROUNDED SILVER EDGES, A BLACK FACE, AND AN ARRAY OF 16 SQUARE ICONS WITH ROUNDED EDGES. THE TOP 12 ICONS APPEAR ON A BLACK BACKGROUND, AND THE BOTTOM 4 APPEAR ON A SILVER BACKGROUND. THE FIRST ICON DEPICTS THE LETTERS "SMS" IN GREEN INSIDE A WHITE SPEECH BUBBLE ON A GREEN BACKGROUND; THE SECOND ICON IS WHITE WITH A THIN RED STRIPE AT THE TOP; THE THIRD ICON DEPICTS A SUNFLOWER WITH YELLOW PETALS, A BROWN CENTER, AND A GREEN STEM IN FRONT OF A BLUE SKY; THE FOURTH ICON DEPICTS A CAMERA LENS WITH A BLACK BARREL AND BLUE GLASS ON A SILVER BACKGROUND; THE FIFTH ICON DEPICTS A TAN TELEVISION CONSOLE WITH BROWN KNOBS AND A GRAY-GREEN SCREEN; THE SIXTH ICON DEPICTS A WHITE GRAPH LINE ON A BLUE BACKGROUND; THE SEVENTH ICON DEPICTS A MAP WITH YELLOW AND ORANGE ROADS, A PIN WITH A RED HEAD, AND A RED-AND- BLUE ROAD SIGN WITH THE NUMERAL "280" IN WHITE; THE EIGHTH ICON DEPICTS AN ORANGE SUN ON A BLUE BACKGROUND, WITH THE TEMPERATURE IN WHITE; THE NINTH ICON DEPICTS A WHITE CLOCK WITH BLACK AND RED HANDS AND NUMERALS ON A BLACK BACKGROUND; THE TENTH ICON DEPICTS THREE BROWN-GRAY CIRCLES AND ONE ORANGE CIRCLE ON A BLACK BACKGROUND WITH A WHITE BORDER, WITH THE MATHEMATICAL SYMBOLS FOR ADDITION, SUBTRACTION, MULTIPLICATION, AND THE EQUAL SIGN DISPLAYED IN WHITE ON THE CIRCLES; THE ELEVENTH ICON DEPICTS A PORTION OF A YELLOW NOTEPAD WITH BLUE AND RED RULING, WITH BROWN BINDING AT THE TOP; THE TWELFTH ICON DEPICTS THREE SILVER GEARS OVER A THATCHED BLACK-AND-SILVER BACKGROUND; THE THIRTEENTH ICON DEPICTS A WHITE TELEPHONE RECEIVER AGAINST A GREEN BACKGROUND; THE FOURTEENTH ICON DEPICTS A WHITE ENVELOPE OVER A BLUE SKY WITH WHITE CLOUDS; THE FIFTEENTH ICON DEPICTS A WHITE COMPASS WITH A WHITE-AND-RED NEEDLE OVER A BLUE MAP; THE SIXTEENTH ICON DEPICTS THE DISTINCTIVE CONFIGURATION OF APPLICANT'S MEDIA PLAYER DEVICE IN WHITE OVER AN ORANGE BACKGROUND.

SEC. 2(F).

SER. NO. 77-303,282, FILED 10-12-2007.

SKYE YOUNG, EXAMINING ATTORNEY

Specialized Seating, Inc. v. Greenwich Industries, L.P. (7th Cir. 2010)

Int. Cl.: 20

Prior U.S. Cls.: 2, 13, 22, 25, 32 and 50

United States Patent and Trademark Office

Reg. No. 2,803,875

Registered Jan. 13, 2004

TRADEMARK
PRINCIPAL REGISTER

GREENWICH INDUSTRIES, L.P. (DELAWARE LIMITED PARTNERSHIP), DBA CLARIN
927 NORTH SHORE DRIVE
LAKE BLUFF, IL 60044

FOR: CHAIRS, IN CLASS 20 (U.S. CLS. 2, 13, 22, 25, 32 AND 50).

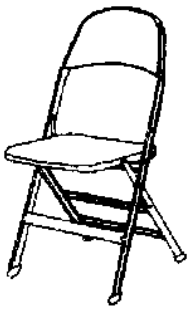
FIRST USE 6-6-1987; IN COMMERCE 6-6-1987.

THE MARK CONSISTS OF A CONFIGURATION OF A FOLDING CHAIR CONTAINING AN X-FRAME PROFILE, A FLAT CHANNEL FLANKED ON EACH SIDE BY ROLLED EDGES AROUND THE PERIMETER OF THE CHAIR, TWO CROSS BARS WITH A FLAT CHANNEL AND ROLLED EDGES AT THE BACK BOTTOM OF THE CHAIR, ONE CROSS BAR WITH A FLAT CHANNEL AND ROLLED EDGES ON THE FRONT BOTTOM, PROTRUDING FEET, AND A BACK, SUPPORT, THE OUTER SIDES OF WHICH SLANT INWARD.

SEC. 2(F).

SER. NO. 75-699,646, FILED 5-7-1999.

CHARLES JOYNER, EXAMINING ATTORNEY



Utilitarian functionality . . .

- Review: the utilitarian functionality bar to protection/registration
  - The Supreme Court and other circuits' approach: engineering need
    - *Inwood* / *TrafFix*: "essential to the use or purpose"; "It is the reason the device works")
    - *Eppendorf*: "The availability of alternative designs is irrelevant"; "The flange is necessary to connect the Combitip to the dispenser syringe…"
    - *Antioch Co.*: "The dual strap-hinge design, spine cover, padded album cover, and reinforced pages are all components that are essential to the use of Antioch's album and affect its quality."
    - *Talking Rain*: Four factors , but "Under *TrafFix*, the existence of alternative designs does not diminish these indicia of functionality".
    - *Specialized Seating* / *Franco v. Franek*: "What this says to us is that *all* the designs are functional."
    - *Louboutin*?
  - Fed. Circuit / PTO approach: competitive need
    - *Morton Norwich* / *Valu Eng'g*: four factors