

Aesthetic functionality

- Under *TrafFix*, the test to determine whether a product feature is aesthetically functional is not the *Inwood* test. Instead, courts should ask whether there are more than a limited range of alternative designs available to competitors such that exclusive rights in the product feature would not put competitors at a significant non-reputation-related competitive disadvantage.

Black for outboard motor	Black for boxes containing flowers and floral arrangements	John Deere green for loaders used on farm tractors	Pink for surgical bandages
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- 5th circuit does not recognize aesthetic functionality

In re Florists' Transworld Delivery, Inc., Serial No. 77590475 (T.T.A.B. Mar. 28, 2013) (precedential)

THIS OPINION IS A
PRECEDENT OF THE TTAB

Mailed: March 28, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE
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Trademark Trial and Appeal Board
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In re Florists' Transworld Delivery, Inc.
—
Serial No. 77590475

Scott J. Major of Millen, White, Zelano & Branigan, PC,
for Florists' Transworld Delivery, Inc.
Hanno Rittner, Trademark Examining Attorney, Law Office 117,
J. Brett Golden, Managing Attorney.

Before Seeherman, Bucher and Zervas,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Florists' Transworld Delivery, Inc. appealed from the final refusal of the trademark examining attorney to register the proposed mark shown below for "flowers and live cut floral arrangements".¹



¹ Application Serial No. 77590475 was filed on October 10, 2008, based on applicant's asserted intent to use the proposed mark. Applicant subsequently filed an Amendment to Allege Use in which it claimed first use and first use in commerce on December 8, 2008.

Serial No. 77590475

The description of the mark is:

The mark consists of the color black as applied to a substantial portion of the outside surface of a box which serves as a container or packaging for the goods and in part forms a background to design and literal elements applied thereto. The dotted lines show placement of the mark and form no part of the mark.

The specimen of use is reproduced below:



Applicant seeks registration on the Principal Register under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

The examining attorney refused registration on two bases: the color black (i) is functional as applied to packaging for floral arrangements, pursuant to Trademark Act § 2(e)(5), 15 U.S.C. § 1152(e)(5), and (ii) is ornamental or decorative and would not be perceived as a trademark pursuant to Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052 and 1127, and applicant has not established that its proposed mark has acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

The appeal has been fully briefed. We affirm both refusals to register.

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When we consider the evidence in the record, we find that the examining attorney has demonstrated *prima facie* that there is a competitive need for others in the industry to use the color black in connection with floral arrangements and flowers. Competitors who, for example, want to offer flowers for bereavement purposes, Halloween or to imbue an element of elegance or luxury to their presentations through packaging therefor will be disadvantaged if they must avoid using the color black in such packaging. As the examining attorney stated, "competitors will need to use black packaging to convey an appropriate message or sentiment, whether that is elegance, style, festivity, grief or sympathy" and

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Pagliero v. Wallace China Co. (9th Cir. 1952)

- It seems clear that these designs are not merely indicia of source, as that one who copies them can have no real purpose other than to trade on his competitor's reputation. On the contrary, to imitate is to compete in this type of situation. Of course, Tepco can also compete by developing designs even more aesthetically satisfying, but the possibility that an alternative product might be developed has never been considered a barrier to permitting imitation competition in other types of cases. The law encourages competition not only in creativeness but in economy of manufacture and distribution as well. Hence, the design being a functional feature of the china, we find it unnecessary to inquire into the adequacy of the showing made as to secondary meaning of the designs.

Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co. (2d Cir. 1990)

- “Although we agree with Judge Haight’s decision, we do not endorse his reliance upon *Pagliero*. . . . Our rejection of *Pagliero*, however, does not call for reversal. Quite unlike *Pagliero*, Judge Haight found in the instant matter that there is a substantial market for baroque silverware and that effective competition in that market requires “use [of] essentially the same scrolls and flowers” as are found on Wallace’s silverware.”
- “whatever secondary meaning Wallace’s baroque silverware pattern may have acquired, Wallace may not exclude competitors from using those baroque design elements necessary to compete in the market for baroque silverware.”



Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc. 696 F.3d 206 (2d Cir. 2012)

- As set forth below, the test for aesthetic functionality is threefold: At the start, we address the two prongs of the *Inwood* test, asking whether the design feature is either “essential to the use or purpose” or “affects the cost or quality” of the product at issue. Next, if necessary, we turn to a third prong, which is the competition inquiry set forth in *Qualitex*. In other words, if a design feature would, from a traditional utilitarian perspective, be considered “essential to the use or purpose” of the article, or to affect its cost or quality, then the design feature is functional under *Inwood* and our inquiry ends. But if the design feature is not “functional” from a traditional perspective, it must still pass the fact-intensive *Qualitex* test and be shown not to have a significant effect on competition in order to receive trademark protection. See, e.g., *Industria Arredamenti Fratelli Saporiti v. Charles Craig, Ltd.*, 725 F.2d 18, 19 (2d Cir.1984) (interlocking design of couch cushions was a visual “label” but served a utilitarian purpose by keeping cushions in place and was therefore functional).



Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc. 696 F.3d 206 (2d Cir. 2012)

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 3,361,597

United States Patent and Trademark Office Registered Jan. 1, 2008

TRADEMARK
PRINCIPAL REGISTER



CHRISTIAN LOUBOUTIN (FRANCE INDIVIDUAL)
24 RUE VICTOR MASSE
PARIS, FRANCE 75009

FOR: WOMEN'S HIGH FASHION DESIGNER
FOOTWEAR, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 0-6-1992; IN COMMERCE 0-6-1992.

THE COLOR(S) RED IS/ARE CLAIMED AS A
FEATURE OF THE MARK.

THE MARK CONSISTS OF A LACQUERED RED
SOLE ON FOOTWEAR. THE DOTTED LINES ARE
NOT PART OF THE MARK BUT ARE INTENDED
ONLY TO SHOW PLACEMENT OF THE MARK.

SEC. 2(F).

SER. NO. 77-141,789, FILED 3-27-2007.

NORA BUCHANAN WILL, EXAMINING ATTORNEY

Deceptive and Deceptively Misdescriptive Marks

- Non-geographically deceptive marks
- Non-geographically deceptive marks may not be registered (or protected) regardless of any showing of secondary meaning
- Non-geographically deceptively misdescriptive marks may be registered upon a showing of secondary meaning
- The test for deceptive or deceptive misdescriptiveness with respect to non-geographic marks:
 - In re Budge Manufacturing Co., Inc., 857 F.2d 773 (Fed. Cir. 1988)
 1. Is the term misdescriptive of the character quality, function, or composition or use of the goods?
 - If no, the term is descriptive and requires a showing of secondary meaning
 2. Are prospective purchasers likely to believe that the misdescription actually describes the goods?
 - If no, the term is likely inherently distinctive (e.g., "Diamond" brand ice cream)
 3. Is the misdescription likely to affect the decision to purchase?
 - If no, the term is deceptively misdescriptive and requires a showing of secondary meaning.
 - If yes, the term is deceptive

In re Budge Manufacturing Co., Inc., 857 F.2d 773 (Fed. Cir. 1988)

- (1) Is the term misdescriptive of the character, quality, function, composition or use of the goods?
- (2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?
- (3) If so, is the misdescription likely to affect the decision to purchase?
- What evidence makes the prima facie case?



In re California Innovations Inc., 329 F.3d 1334 (Fed. Cir. 2003)

Due to the NAFTA changes in the Lanham Act, the PTO must deny registration under § 1052(e)(3) if

- (1) the primary significance of the mark is a generally known geographic location,
- (2) the consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark, when in fact the goods do not come from that place, and
- (3) the misrepresentation was a material factor in the consumer's decision.



Review . . .

- Deceptively misdescriptive vs. deceptive marks

	Deceptively Misdescriptive	Deceptive
Non-Geographic Marks	May be registered upon a showing of secondary meaning	May not be registered
Geographic Marks	May not be registered	May not be registered

- Materiality:
 - For non-geographic marks, materiality marks the difference between misdescriptive and deceptive marks.
 - For geographic marks, materiality must be shown for a mark to be either geographically misdescriptive or geographically deceptive.
 - See TMEP 1210.05(c)

Diagram for geographic marks . . .

