



Recent Cases Show That Utilitarian Functionality Is A Serious – And Common – Impediment To Trade Dress Protection

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A product shape or package must be non-functional to qualify for trade dress protection. Yet a spate of recent cases reveals many plaintiffs who try to expand or lengthen patent protection by alleging that their product features designate source. Below is a description of recent trade dress protection attempts along with a short refresher on the reasons for the functionality doctrine and how to deal with it.

A mark is functional if it is "essential to the use or purpose of an article or affects the cost or quality of an article." *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 32 (2001). If a mark fits this test, it is functional, and not protectable. If it does not, courts may still consider whether there is a competitive necessity to use the product feature. In other words, courts may consider whether alternative product designs are available, and whether the cost or time involved in using an alternative design makes it impractical. *Id.* at 33. See also, *In re Becton, Dickinson and Co.*, 675 F.3d 1368, 1376 (Fed. Cir. 2012).

The functionality bar to trade dress protection exists to prohibit would-be trademark owners from protecting functional features in perpetuity, rather than for the limited time permitted by patent law. For this reason, the existence of a patent covering a feature claimed to constitute trade dress is the kiss of death for trademark protection.

Four factors have developed to help determine whether an alleged mark is functional. They vary by circuit, but the Federal Circuit's list is instructive. The Federal Circuit and the United States Patent and Trademark Office consider the following in determining functionality:

- (1) the existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered;



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- (2) advertising by the applicant that touts the utilitarian advantages of the design;
- (3) facts pertaining to the availability of alternative designs, and
- (4) facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

In re Morton-Norwich Products, Inc., 671 F.2d 1332, 213 USPQ 9 (CCPA 1982). See also, *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1275, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002).

Most recent trade dress claims have foundered on these factors. In particular, plaintiffs and trademark applicants have tried to argue around the existence of prior patents – to no avail. See *Seirus Innovative Accessories, Inc. v. Gordini U.S.A., Inc.*, 2012 WL 368044 (S.D. Cal. Feb. 3, 2012) (court found patent invalid but held that patent nonetheless supported finding of functionality); *Great Neck Saw Manufacturers, Inc. v. Star Asia U.S.A., LLC*, 727 F. Supp. 2d 1038 (W.D. Wash. 2010), *aff'd* 432 Fed. Appx. 963 (Fed. Cir. 2011) (utility knife shape found functional based, in part, on prior utility patent); *In re Charles N. Van Valkenburgh*, 97 USPQ2d 1757 (TTAB 2011) (refusing registration of shape of motorcycle stand: "[W]e look to the features disclosed in the patent which have been incorporated into the present product designs and the teachings of the patent with respect to these features").

It is irrelevant whether a patent is expired or current. See *Georgia-Pacific Consumer Products LP v. Kimberly-Clark Corp.*, 647 F.3d 723 (7th Cir. 2011) (factors for evaluating functionality include the "existence of a utility patent, expired or unexpired, that involves or describes the functionality of an item's design element"). Third party patents can block trademark protection. *Jay Franco & Sons, Inc. v. Franek*, 615 F.3d 855 (7th Cir. 2010) (third party utility patents are "excellent cheat sheets" for determining functionality). While parties have argued that only patent claims should bar trademark protection, courts have not been so constrained. See *In re Becton, Dickinson and Co.*, 675 F.3d 1368 (Fed. Cir. 2012) (rejecting applicant's arguments that only patent claims can evidence functionality). A patent application, even if rejected or abandoned, is evidence of functionality. *Ogosport LLC v. Maranda Enterprises LLC*, 2012 WL 683111 (E.D. Wis. March 2, 2012) (citing plaintiff's abandoned patent applications but relying on third party patents to support functionality holding); *Seirus Innovative Accessories, Inc.*, 2012 WL 368044 (same).

Similarly, a party's own advertising is often construed as an admission of functionality. See *Secalt S.A. v. Wuxi Shenxi Construction Machinery Co., Ltd.*, 668 F.3d 677 (9th Cir. 2012) (plaintiff's advertisements regarding alleged trade dress in square shape of scaffold hoist stated that the product was square so it would not roll off tables; alleged trade dress found functional); *Talking Rain Beverage Co., Inc. v. South Beach Beverage Co.*, 349 F.3d 601, 604 (9th Cir. 2003) (plaintiff's advertising encouraging consumers to "Get a Grip." on water bottle found to weigh in favor of functionality); *Poly-Am., L.P. v. Stego Indus., L.L.C.*, No. 3:08-CV-2224-G, 2011 WL 3206687, at *7 (N.D. Tex. July 27, 2011) (advertising utilitarian benefits of yellow trade dress for vapor barrier nullifies the presumption of validity bestowed on the alleged mark by registration); *Kistner Concrete Products, Inc. v. Contech Arch Technologies, Inc.*, 97 USPQ2d 1912 (TTAB 2011) (bridge culvert shape advertised as superior for shedding water held functional).

Moreover, while many plaintiffs have tried to argue that there are other ways to make products competitive to theirs, courts have rejected this "alternative designs test." See *Specialized Seating*,

Inc. v. Greenwich Industries, L.P., 616 F.3d 722 (7th Cir. 2010) (existence of many alternative designs for folding chair did not mean that the plaintiff's design was non-functional. It was not "the only way to do things" but "it represent[ed] one of many solutions to a problem.")

Many of the recent functionality cases arise from facts that seem to show that plaintiffs have tried to continue protection beyond a patent period. It is understandable that a party with a successful and unique product would view post-patent copyists as interlopers. The better way to differentiate against such competitors upon expiration of a patent may be to consider trade dress protection at the time that a patentable product is developed. If a source-differentiating feature can be added to the product upon its introduction, that feature will have time to develop secondary meaning during the patent period. When the patent expires, the source identifier will serve to identify its associated product as the original, and likely the market leader.

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