

IN THE
United States Court of Appeals
FOR THE FOURTH CIRCUIT

TBL LICENSING, LLC,

Plaintiff-Appellant,

v.

KATHERINE K. VIDAL, in her official capacity as
Director of the United States Patent & Trademark Office;
UNITED STATES PATENT & TRADEMARK OFFICE,
Defendants-Appellees,

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA AT ALEXANDRIA

PAGE-PROOF
OPENING BRIEF OF PLAINTIFF-APPELLANT

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UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

DISCLOSURE STATEMENT

- In civil, agency, bankruptcy, and mandamus cases, a disclosure statement must be filed by **all** parties, with the following exceptions: (1) the United States is not required to file a disclosure statement; (2) an indigent party is not required to file a disclosure statement; and (3) a state or local government is not required to file a disclosure statement in pro se cases. (All parties to the action in the district court are considered parties to a mandamus case.)
- In criminal and post-conviction cases, a corporate defendant must file a disclosure statement.
- In criminal cases, the United States must file a disclosure statement if there was an organizational victim of the alleged criminal activity. (See question 7.)
- Any corporate amicus curiae must file a disclosure statement.
- Counsel has a continuing duty to update the disclosure statement.

No. 23-1150 Caption: TBL Licensing, LLC v. KATHERINE K. VIDAL

Pursuant to FRAP 26.1 and Local Rule 26.1,

TBL Licensing, LLC
(name of party/amicus)

who is _____ the Appellant _____, makes the following disclosure:
(appellant/appellee/petitioner/respondent/amicus/intervenor)

1. Is party/amicus a publicly held corporation or other publicly held entity? YES NO

2. Does party/amicus have any parent corporations? YES NO
If yes, identify all parent corporations, including all generations of parent corporations:

TBL Licensing, LLC is 100% owned by VF International Holding GmbH, a private Swiss company. VF International Holding GmbH is 100% owned (along with other intermediaries) by ultimate parent company VF Corporation, a publicly-held company (NYSE: VFC).

3. Is 10% or more of the stock of a party/amicus owned by a publicly held corporation or other publicly held entity? YES NO
If yes, identify all such owners:

Yes: TBL Licensing, LLC is 100% owned by VF International Holding GmbH, a private Swiss company. VF International Holding GmbH is 100% owned (along with other intermediaries) by ultimate parent company VF Corporation, a publicly-held company (NYSE: VFC).

4. Is there any other publicly held corporation or other publicly held entity that has a direct financial interest in the outcome of the litigation? YES NO
If yes, identify entity and nature of interest:

5. Is party a trade association? (amici curiae do not complete this question) YES NO
If yes, identify any publicly held member whose stock or equity value could be affected substantially by the outcome of the proceeding or whose claims the trade association is pursuing in a representative capacity, or state that there is no such member:

6. Does this case arise out of a bankruptcy proceeding? YES NO
If yes, the debtor, the trustee, or the appellant (if neither the debtor nor the trustee is a party) must list (1) the members of any creditors' committee, (2) each debtor (if not in the caption), and (3) if a debtor is a corporation, the parent corporation and any publicly held corporation that owns 10% or more of the stock of the debtor.

7. Is this a criminal case in which there was an organizational victim? YES NO
If yes, the United States, absent good cause shown, must list (1) each organizational victim of the criminal activity and (2) if an organizational victim is a corporation, the parent corporation and any publicly held corporation that owns 10% or more of the stock of victim, to the extent that information can be obtained through due diligence.

Signature: Elizabeth D. Ferrill

Date: 5/1/2023

Counsel for: TBL Licensing, LLC

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I. JURISDICTIONAL STATEMENT

The U.S. District Court for the Eastern District of Virginia had subject-matter jurisdiction over TBL Licensing LLC's (referred to, with its associated company, as "TBL" or "Timberland") claim under 15 U.S.C. § 1071(b), which provides that a party may challenge a final decision of the Trademark Trial and Appeal Board ("TTAB") by instituting a new civil action in a federal district court. [Dkt.1.] The court also had subject-matter jurisdiction under 37 C.F.R. § 2.145(d)(1) and 28 U.S.C. § 1331. [Dkt.1.]

On December 8, 2022, the district court issued a Memorandum Opinion ("Op."), accompanied by its final judgment, denying TBL's motion for summary judgment [Dkts.49-50] and granting Defendants' motion for summary judgment. [Dkts.55-56, 74-75.] On February 6, 2023, TBL timely filed its Notice of Appeal. [Dkt.76.]

The U.S. Court of Appeals for the Fourth Circuit has jurisdiction over this appeal pursuant to 28 U.S.C. § 1291 because TBL is appealing from a final decision of the district court that disposes of all parties' claims.

II. STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

1. Whether the district court erred in finding the Icon Boot Design (defined below) functional by analyzing its individual elements one-by-one, rather than examining the design in its entirety, as required by Fourth Circuit law.

2. Whether the district court erred in finding the Icon Boot Design functional under the *Morton-Norwich* factors because the court analyzed only two of the four factors and, on the two factors it did analyze, it could not identify a single patent covering, or advertisement touting, any utilitarian benefit of the whole boot design, let alone its individual elements (half of which the PTO conceded are nonfunctional during prosecution and before the TTAB).

3. Whether the district court erred in its secondary-meaning analysis by: (a) effectively holding, incorrectly, that “look-for” advertising is required to show secondary meaning; (b) failing to examine whether the third-party boots relied upon by the court had any marketplace impact; (c) finding that other branding elements diminish TBL’s evidence of secondary meaning; and (d) failing to consider all relevant evidence, including potent direct evidence of consumer association.

III. STATEMENT OF THE CASE

A. The history of the “Icon Boot” and its commercial success.

Almost five decades ago, the Abington Shoe Company introduced a 6” waterproof boot, called the “Timberland” boot, that would leave an indelible footprint on American fashion. [JA5352.] The boot stood apart from competitor offerings due to its alluring appearance, featuring a 6” silhouette with a bulbous toe box, a decorative bubble of padding around the exterior of the ankle collar, an

hourglass-shaped backstay, quad-stitched patterns, and hexagon-embossed eyelets.

[JA3662, JA3664.]



[JA15-JA16.] Each of these decorative elements was selected for its appearance and, when combined, resulted in a visually appealing design that was not used by any known competitor. [JA3661-JA3662, JA7726.]

The Timberland boot’s eye-catching blend of shapes and patterns resonated with American customers and retailers, and the demand for the boot skyrocketed almost immediately following its release. [JA3664.] Unlike the heavier and austere looking 8” waterproof boots available at the time, the Timberland boot’s fresh look appealed to a broader audience, including college students, urbanites, hip-hop artists, and other “lifestyle customer[s].” [JA3664.] The Timberland boot became so popular that within five years of its release, Abington renamed its company “Timberland” after its marque boot. [JA5352-JA5353.] By the end of the 1970s,

the Timberland boot accounted for approximately 80% of company sales.

[JA5353.] And the boot’s popularity continued to soar. By the late 1980s, it was so sought after in Italy that American flight attendants began buying the boots in bulk to resell to European customers for higher prices, and wearers were being robbed in the streets for their boots. [JA5353-JA5354.] By the early 1990s, the Timberland boot dethroned Nike’s Air Jordan basketball sneakers as the most popular shoe in America. [JA5355.] The Timberland boot had become a fashion icon, aptly earning the nickname “Icon Boot.” [JA5352-JA5353.] Today, the Icon Boot is so well known among consumers, it is often referred to by nicknames (“Timbs,” “Tims,” and “Timberlands”) that are acknowledged in colloquial dictionaries. [JA5355-JA5357.]

The Icon Boot has been released in hundreds of limited-edition colors and patterns—all employing the signature Icon Boot design—including over 400 collaborations with celebrities, artists, social-activist groups, and haute-couture brands like Jimmy Choo, Don Cheadle, and Liberty London, e.g.:



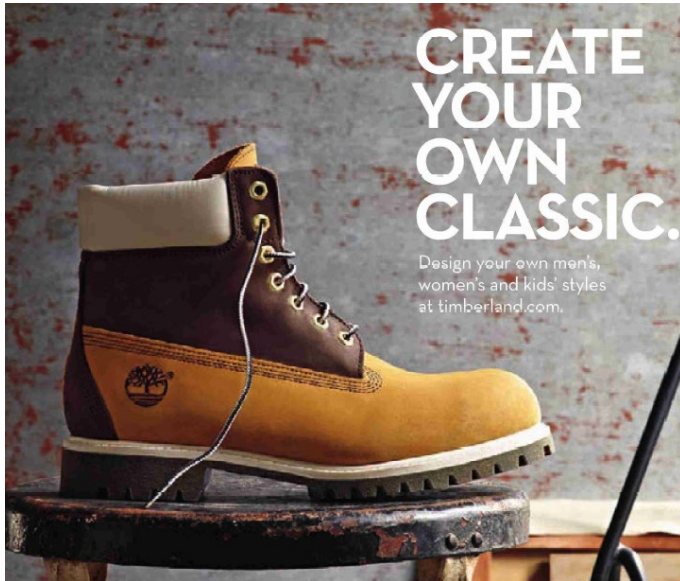


THE BOROUGHS PROJECT

Converting the boot to a canvas was the core of the Boroughs Project in New York City. In doing so, people recreated two celebrated icon artists, one from each of the New York City boroughs: Madhatter's The Bronx, Brooklyn, Queens, Manhattan and Queens. Each of the submissions featured interpretations of the yellow boot. In the ultimate expression of authenticity, each of these artists designed a boot that best represented their neighborhood and their artistic medium. The result was a stunning collection of 6 boots that are uniquely New York.



[JA5925, JA5992, JA5564, JA5542, JA7498, JA6449, JA6494, JA6503, JA5362, JA5364, JA6836, JA5357-JA5370, JA5501-JA6565.] For years, TBL has even encouraged consumers to customize their Icon Boots to create one-of-a-kind models, as shown by these examples:



[JA6761, JA6799, JA6803, JA6600, JA6013 JA5357-JA5406, JA5501-JA6565, JA6568-JA7338.]

With the surge in sales following the Icon Boot’s debut, TBL capitalized on its appeal to “lifestyle consumers” by selling it at a premium price point and positioning the boot as a fashion item in upmarket retailers like *Saks Fifth Avenue* and *Bloomingdales*. [JA5353.] This was particularly unusual for waterproof footwear in the 1970s and 1980s. [JA5353.] Today, the Icon Boot is promoted, offered, and sold nationwide through a variety of online and brick-and-mortar retailers, including TBL’s website and physical stores, along with other national

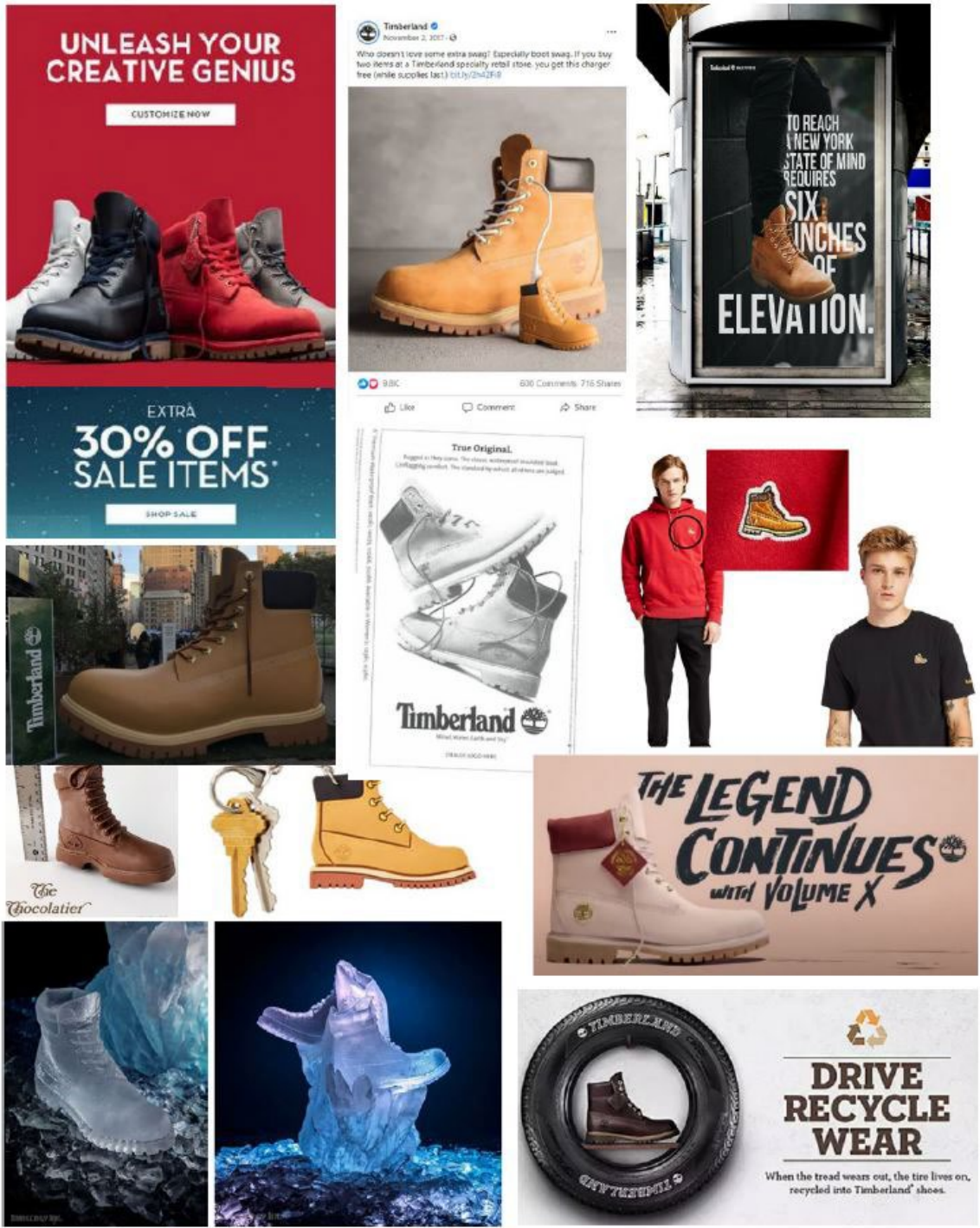
retailers like *Amazon, Journeys, Foot Locker, Dick's Sporting Goods, DSW, Zappos.com, Saks Fifth Ave, Nordstrom, and Macy's*. [JA5428.]

The Icon Boot's success continues; it remains TBL's most popular boot. [JA5353.] Since 2000, TBL has sold tens of millions of pairs of Icon Boots in the United States. [JA5428-JA5429.] Between just 2013 and 2021, TBL sold over 1.3 billion dollars' worth of Icon Boots in the United States, achieving sales of well over \$100 million most years. [JA5428-JA5429.]

B. Advertising and promotion of the Icon Boot.

Since the launch of its first formal campaign in 1976, TBL has spent many millions of dollars to advertise and promote the Icon Boot—\$81,270,000 *from 2015-2021 alone*. [JA5372-JA5373.] And it has done so in virtually every conceivable manner, expanding its advertising channels and tailoring its promotional strategies to maximize brand engagement amid new and emerging forms of media over the decades. [JA5372-JA5437, JA6442-JA6565, JA6568-JA7348, JA7350-JA7395, JA7398-JA7527.] All the while, the Icon Boot has been a focal point in TBL's advertising, appearing front-and-center in print ads, magazines and various other publications, mailings, brochures, sales banners, in-person store displays, television commercials, the Internet (on TBL's own website, retailer websites, banner ads, and social media), promotional items, and even clothing items featuring the boot as a logo. [JA5372-JA5437, JA6442-JA6565,

JA6568-JA7348, JA7350-JA7395, JA7398-JA7527.] Just a few representative examples of TBL's successful advertising and promotional efforts are shown below:



[JA5518, JA6685, JA7385, JA7386, JA6578, JA5418, JA5421, JA7395, JA5389, JA7341, JA5372-JA5437.]

C. The Icon Boot remains a fashion staple for consumers across demographics, garnering significant unsolicited media attention.

The Icon Boot is worn by young people and adults in virtually every kind of environment, from the suburbs to city streets, to the red carpet, and everywhere in between. [JA3255, JA3258, JA3664, JA5429-JA5437, JA7398-JA7527.] The Icon Boot is routinely sported as a fashion statement by scores of celebrities,¹ as shown by the representative examples below and others at Dkts.50-1 to 50-7.

¹ These include, among *many* others, actors/actresses, musicians, models, and athletes like Jennifer Lopez, Julianne Moore, Mark Wahlberg, Lady Gaga, Jake Gyllenhaal, Jay-Z, Rihanna, Beyoncé, Chris Pratt, Channing Tatum, Bella Thorne, Pharrell Williams, Gigi Hadid, Gwen Stefani, Ellie Goulding, David Beckham, Kris Jenner, Khloe Kardashian, Kanye West, Dakota Johnson, The Notorious B.I.G., The Weeknd, Drake, Nas, Pharrell Williams, Chance the Rapper, and Usher. [JA5430-JA5437, JA7398-JA7527.]



Kanye West (singer, designer, etc.)



Khloe Kardashian (actress, designer, etc.)

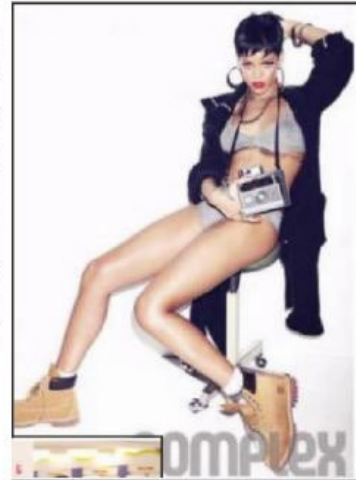


Jennifer Lopez (actress, designer, etc.)

[JA7410, JA7492, JA7439.]

For decades, the Icon Boot has been featured as a fashion must-have in major websites, magazines, and newspapers, including *TIME*, *Rolling Stone*, *The New York Times*, *The Boston Globe*, *New York Post*, *The Boston Herald*, *The Philadelphia Inquirer*, *Glamour*, *Cosmopolitan*, *Sports Illustrated*, *Esquire*, *Elle*, *Ebony*, *Women's Health*, *Men's Health*, *Living*, *Forbes*, *Men's Fitness*, *Vogue*, *Footwear News*, *People*, *Playboy*, *The Guardian*, and *GQ*. [JA5437-JA5442, JA7528-JA7627.] Today, the Icon Boot is lauded as “one of the most recognizable shoes of all time.” [JA5355.] A few examples of the many thousands of third-party

media mentions that have been published over the past several decades are shown below and others at Dkts.50-8 to 50-13:



[JA7530, JA7583, JA7622, JA546, JA6641, JA7582, JA7547 JA5437-JA5442, JA7528-JA7627.]

Fashion designers routinely praise the Icon Boot for its aesthetics and “iconic silhouette[.]” [JA7544] (““Timberland is the most iconic boot company in the world – I have been wearing Timberland product since childhood and continue to do so today,’ said Jace Lipstein, founder and designer of Grungy Gentleman. ‘Being able to work with such iconic silhouettes mainly the 6-inch boot in black and wheat nubuck is a dream come true. Applying our six-stripe signature to the collar of the 6-inch boot is a fresh take on a classic.’”); [JA5371] (“[F]ashion designer jeffstaple has referred to the Icon Boot as ‘a blank canvas . . . beyond fashion. It’s a work of art.’”). In July 2021, the Icon Boot took center stage at the most celebrated fashion event in the world—*Paris Fashion Week*—when acclaimed designer Stéphane Ashpool used custom-colored Icon Boots for each ensemble in his “Freedom” exhibition, e.g.:



[JA5442-JA5446, JA7628-JA7632.]

As a result of its mass popularity and appeal, the Icon Boot is often invoked in popular culture, showcasing the widespread recognizability of its design.

[JA5446-JA5468, JA7634-JA7685.] Acclaimed musicians have honored the boot in hit songs and on the covers of top single albums. [JA5446-JA5447.] The Icon Boot was even a plotline in *Seinfeld*—one of the most famous sitcoms of all time. In “The Betrayal”—which reached an estimated 20 million viewers when it aired in 1997—lead character George Costanza refuses to wear any other shoes but his Icon Boots, going as far as to spray paint them black to wear to a wedding in hopes of no one noticing. Despite his effort, a guest immediately recognizes the boot from its design and asks, “Are those Timberlands?” [JA5447-JA5449.]



The Icon Boot has also made recurring appearances in myriad popular movies and television shows, including *The Shining*, *Men In Black*, *Scary Movie*,

Grey's Anatomy, *Saved By The Bell*, *The Bachelorette*, and *Keeping Up With The Kardashians*, and in top-hit music videos by Beyoncé, Drake, Ed Sheeran, and Rihanna. [JA5446-JA5467, JA7634-JA7685.]

The Icon Boot is routinely the subject of memes, social-media fan groups, and YouTube videos, including the examples shown below:



Class and timb omg

DO NOT let a New York
dude get all the Infinity Timbs.



Snap my fingers and bring back
Biggie





[JA5468-JA5481, JA7686-JA7704.]

D. People associate the Icon Boot, absent any branding, with one source: Timberland.

Across social media, well-known celebrities, athletes, and others are frequently photographed wearing Icon Boots—often with the Timberland name and/or tree logo not visible. From viewing just the boots’ design, well over 1,000 people have spontaneously identified them as “Timberlands” (or synonymous names, like “Tims” or “Timbs”) without any prompting, e.g.:



badgalriri • Follow



barolinne Sis already knows we don't tie our Timbs

245w 1 like Reply



1,691,413 likes

JANUARY 22, 2017



Add a comment...

Post



dmx • Follow



york51_ Dmx got red tims too @zainabj_

308w Reply



speer_jp Cool picture @dmx



308w Reply



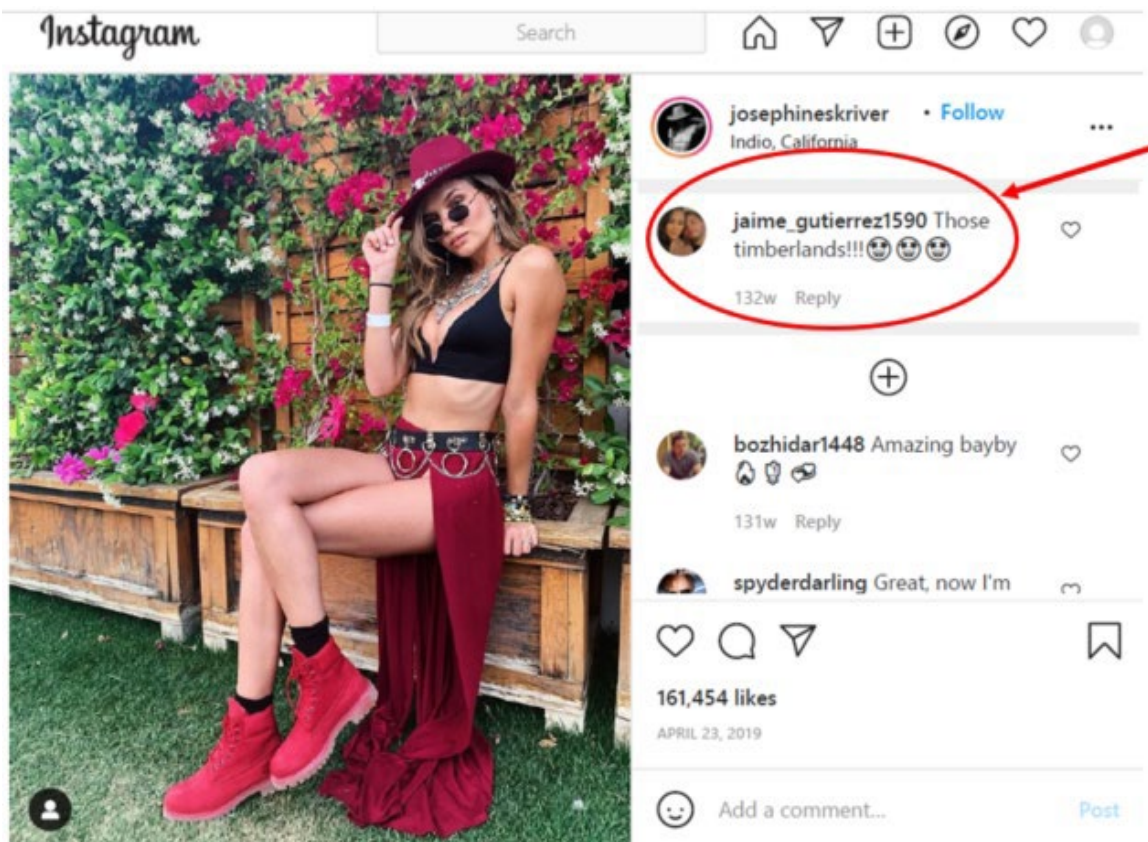
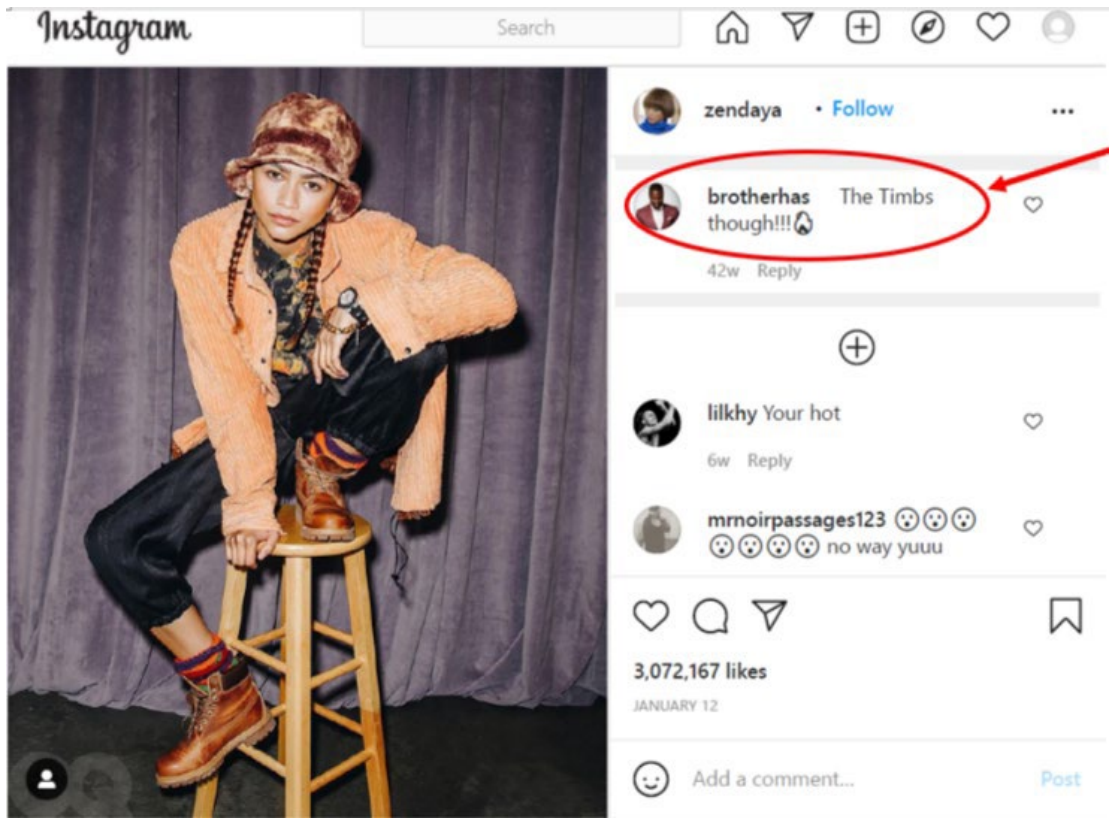
4,521 likes

DECEMBER 6, 2015



Add a comment...

Post



[JA3705, JA4424, JA4829, JA3851 JA3670-JA4860.]

E. The Icon Boot is one of many alternative boot designs.

There are thousands, if not tens of thousands of boot designs, including competitive waterproof boots, on the market in the United States at any given time that use completely different elements and composite designs. [JA3262-JA3264, JA3668, JA3370-JA3656, JA5311-JA5327, JA7715-JA7728, JA7730-JA7763, JA7767-JA7780, JA7782-JA7783.] These include boots made by TBL. [JA5311-JA5320, JA7715-JA7724.] Searches of major shoe retailers, including *Amazon*, *Zappos*, *Boot Barn*, and *Journeys*, confirm this. [JA3262-JA3264, JA3370-JA3656.]

F. The Icon Boot is not a “work boot.”

In the past, some have referred to the Icon Boot as a “work boot.” [JA3255-JA3256.] But by today’s standards, it is anything but that. [JA3255-JA3257.] This is apparent from advertising like this:



[JA3243.]

The Icon Boot is not structurally appropriate for any environment that requires safety protection and it does not meet the appropriate OSHA standard.

[JA3243-JA3256, JA7724, JA7789-JA7790, JA22093-JA22094.] TBL has a different line of safety footwear for that: its Timberland PRO® line, which features specialized safety toe boxes with steel toe caps that meet industry safety standards, and which do not employ the Icon Boot Design. [JA3243-JA3256, JA7724, JA7756-JA7759, JA7789-JA7790, JA7793-JA7797.] The structural differences between TBL's Timberland PRO® and Icon boots are evident from standard industry compression and impact-resistance tests. [JA3243-JA3256, JA7724, JA7789-JA7790, JA7793-JA7797.] One test shows, for example, that the

Timberland PRO® Direct Attach Soft Toe boot, which uses a toe box made of 1.2±0.1mm thick material, can withstand a collapsing load of 13.5 lbs before crushing—*three times* as much weight as the Icon Boot’s toe box. [JA3243-JA3245, JA7789-JA7790, JA7793-JA7797.] Unsurprisingly, the Icon Boot’s thin plastic liner and toe box do not provide any meaningful safety protection. [JA3251-JA3253, JA7789-JA7790.]

G. The Icon Boot is more expensive and harder to make.

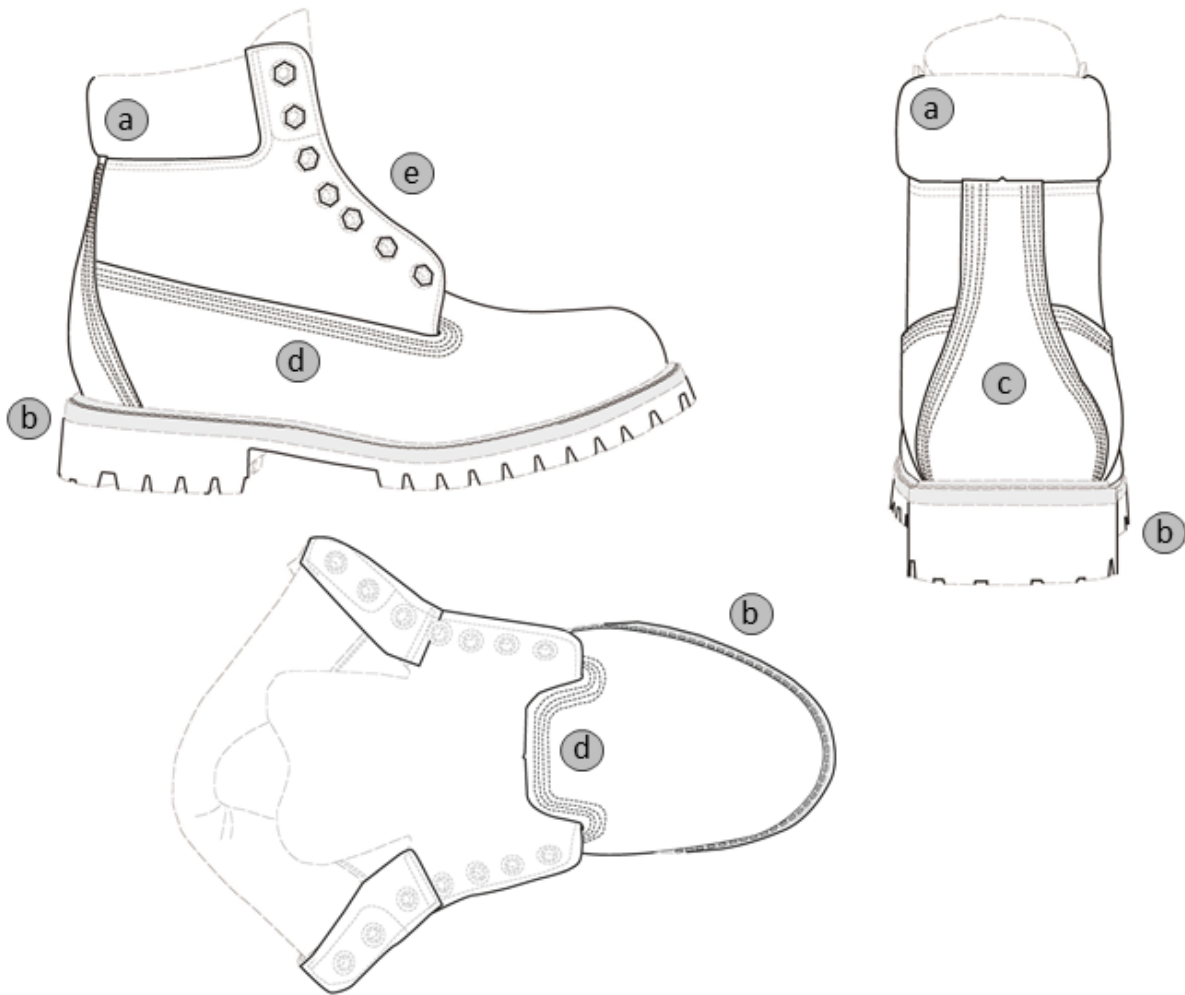
The Icon Boot is more expensive, complex, and time consuming to make because many of its elements require additional material and labor. [JA3134, JA3171, JA3176-JA3177, JA3188-3189, JA3202, JA3214, JA3218, JA3222-JA3225, JA7726, JA7730, JA7738, JA7742, JA7754, JA7767, JA7782-JA7783, JA7785-JA7786, JA7792.]

First, the boot’s hourglass-shaped backstay requires additional material (compared to other shapes) and production time, and involves a more complex manufacturing method due to the necessary measuring, cutting, and skiving processes. [JA3222-JA3225, JA7742, JA7785-JA7786.] Second, the quad-stitching pattern requires substantially more thread than other stitching patterns. [JA3224-JA3225, JA7730.] Third, the boot’s exterior padding on the ankle collar requires additional material and time. [JA3171, JA3176-JA3177, JA7767.] Fourth, the color specification and color tolerance testing used to create the Icon Boot’s two-tone

outsole incurs additional manufacturing time and expense. [JA3201-JA3204, JA7790-JA7792.] Finally, the appearance of the eyelets' superficial hexagonal decoration requires the use of a round-flanged eyelet, which—even without the added embossed decoration—is more costly and less efficient to produce than other eyelet shapes. [JA3188-JA3189, JA7754.]

H. TBL's trademark application for the Icon Boot Design.

On May 19, 2015, TBL filed U.S. Trademark Application No. 86/634,819 (the "Application") for the configuration of design elements that together create the unique appearance of the Icon Boot (the "Icon Boot Design"), shown and described in the Application's drawings and description of elements (alphabetical annotations added):



- a) the external appearance of a tube-shaped ankle collar on the outside surface of the product running from one eyelet panel to the other eyelet panel around the sides and rear of the boot and protruding over the upper side and rear panels of the boot (material on the inside of the ankle collar not being claimed);
- b) outsoles having two color tones divided horizontally and extending around the circumference of the boot, and visibly showing inverted tooth shaped cuts on each side of the heel of the outsole and around the sides and front of the forward portion of the outsole;
- c) an hourglass-shaped rear heel panel, defined by four vertical stitching lines from the top of the outsole to the rear collar;

- d) quad-stitching forming an inverted “U” shape around the vamp line in front of the boot at the bottom of the tongue and curving around to the left and right sides and ending at the cinched portion of the hourglass stitching of the rear heel panel; and
- e) eyelets shaped hexagonally on the exterior-facing outside surface.

[JA1349, JA1615.]

The Examining Attorney refused registration, alleging that the Icon Boot Design lacks secondary meaning and is functional. [*See, e.g.*, JA34-JA35.] In doing so, however, the Examining Attorney conceded that four elements of the Icon Boot Design²—namely the two-toned outsole (in (b) above), heel panel (c), quad stitching (d), and “U” shaped vamp line (d)—are nonfunctional:

“[T]he following claimed features are considered non-functional elements, capable of registration: . . .

the two-toned shading of the outsoles as depicted on the boot welt and sole,

the hourglass-shaped rear heel panel defined by vertical quad stitching from the top of the outsoles to the rear collar, and

the quad-stitched inverted “U” shape around the front of the boot and curving around the sides to the cinched portion of the hourglass stitching on the rear heel panel.

[JA1715.]

² The Examining Attorney identified these as three elements before the TTAB, but under the district court’s analysis, which divided the Icon Boot Design into “eight” elements, the Examining Attorney’s concession actually relates to four elements.

The TTAB affirmed the refusal based on a purported lack of secondary meaning, without substantively addressing functionality. [JA1766, JA1762- JA1794.]

I. Procedural History

On June 4, 2021, TBL appealed the TTAB’s decision under 15 U.S.C. § 1071(b) and 37 C.F.R. § 2.145, seeking a finding that the Icon Boot Design is protectible. [Dkt.1.] The district court agreed to adjudicate the merits and resolve any factual disputes without the need for a trial. [Dkts.47-48.]

Ruling on the parties’ cross-motions for summary judgment [Dkts.49-50; Dkts.55-56], the court issued a Memorandum Opinion, denying TBL’s motion, granting the USPTO’s motion, and finding that TBL failed to prove that: (1) the “eight features” of the Icon Boot Design are nonfunctional³ and (2) consumers recognize the “eight features” as a unique indicator of the source of the Icon Boot Design. [Dkt.74.] This timely appeal ensued. [Dkt.76.]

³ Although TBL raised below the Examining Attorney’s concession [JA1715] of nonfunctionality regarding half of “eight” elements (as identified by the court), the court did not substantively address the Examining Attorney’s concession and instead deemed all “eight” elements functional. It was clear error for the district court to completely disregard the USPTO’s assessment of nonfunctionality with respect to these four elements. *See Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1533 (4th Cir. 1984) (giving “great weight” to USPTO determinations).

IV. SUMMARY OF ARGUMENT

Trademark law protects a product’s “trade dress”—i.e., its “total image and overall appearance,” which “may include features such as size, shape, color or color combinations, texture, graphics”—if the trade dress is nonfunctional and distinctive. TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1202; *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992). One important form of trade dress is footwear. For many years, the U.S. Patent and Trademark Office (“PTO”) has registered various footwear designs (Dkt.50-22) and courts have enforced rights in such designs.

This case involves a footwear design for “one of the most recognizable shoes of all time.” It has been on the market for nearly half a century, featuring the same immediately recognizable and eye-catching appearance, formed by its 6” silhouette with a bulbous toe box, decorative bubble of padding around the exterior of the ankle collar, hourglass-shaped backstay, quad-stitching patterns, and hexagon-embossed eyelets. Beyond its commercial success, the boot has made an indelible footprint on American fashion and is frequently lauded as “iconic” and a “status symbol in the U.S. and abroad.”

Despite this, the district court refused to register the entirety of decorative design elements that create the Icon Boot’s iconic appearance on the grounds that it

is functional and has not acquired secondary meaning. In so doing, the court made multiple significant legal and factual errors.

First, the court's functionality analysis was based on an examination of the trade dress' *individual* elements. This was legally wrong. "[T]he critical functionality inquiry is not whether each individual component of the trade dress is functional [which is not fatal to protection], but rather whether the trade dress *as a whole* is functional." *Tools USA & Equip. Co. v. Champ Frame Straightening Equip. Inc.*, 87 F.3d 654, 658 (4th Cir. 1996). Here, the whole Icon Boot Design is driven by aesthetics, not function. The Icon Boot Design as a whole is not covered by any utility patents; is not touted as useful in advertising; and, indeed, does not make the boot stronger, waterproof, or more comfortable. Nor is there a need for competitors to use the Icon Boot Design, evidenced by at least tens of thousands of alternative designs available. In fact, producing a boot with the asserted design is more difficult and expensive. The Icon Boot Design's role is to make the boot look good and to signal to consumers that it is the genuine iconic boot made and backed by the Timberland company.

The court's secondary-meaning analysis is similarly flawed and erroneous. Effectively requiring so-called "look-for" advertising for secondary meaning, which is neither legally warranted nor justified, the court ignored an impressive and diverse array of evidence, including advertising and other materials, that call

attention to the boot’s iconic design. The court also discredited TBL’s extensive advertising evidence due to the presence of “traditional trademarks” like the TIMBERLAND house mark and/or tree logo. This too was legally wrong, as courts have consistently found that the presence of a house mark or other branding in ads does not undermine the effectiveness of those ads in creating secondary meaning (and, to the contrary, can even reinforce the connection between a brand and its trade dress). Finally, the court faulted TBL for look-alikes on the market, but completely failed to assess whether any of these purported look-alikes were commercially significant, as is required.

TBL’s secondary-meaning evidence readily surpasses the evidence this Court and others have deemed sufficient to establish secondary meaning—so much so that if this record is deemed insufficient, it will be the death knell for the protection of footwear designs. Simply put, if “one of the most recognizable shoes of all time” is not protectable, then nothing is.

Having legally erred in its functionality and secondary-meaning analyses, the district court’s decision should be reversed.

V. ARGUMENT

A. Standard of review.

This Court reviews *de novo* the district court’s legal determinations and findings of facts for clear error. *Int’l Bancorp, LLC v. Societe des Bains de Mer et*

du Cercle des Etrangers a Monaco, 329 F.3d 359, 362 (4th Cir. 2003). While a district court’s factual findings on functionality and secondary meaning are generally reviewed under the clearly-erroneous standard,⁴ the Court owes no deference to those findings “if they are derived as a result of the court’s misapplication of the law.” *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 460 (4th Cir. 1996); *Pizzeria Uno Corp.*, 747 F.2d at 1526 (“[T]he clearly erroneous rule [will not] protect findings which have been made on the basis of the application of incorrect legal standards or made in disregard of applicable legal standards.”). *See also United States v. Singer Mfg. Co.*, 374 U.S. 174, 194 n.9 (1963) (“[A] conclusion derived from the court’s application of an improper standard to the facts . . . *may be corrected as a matter of law.*”) (emphasis added).

Moreover, a factual “finding is clearly erroneous when there is no evidence in the record supportive of it and also, when, even though there is some evidence to support the finding” the appellate court “is left with a definite and firm conviction that a mistake has been made in the finding.” *Pizzeria Uno Corp.*, 747 F.2d at 1526.

⁴ *See Clamp Mfg. Co. v. Enco Mfg. Co.*, 870 F.2d 512, 514 (9th Cir. 1989) (functionality); *Dayton Progress Corp. v. Lane Punch Corp.*, 917 F.2d 836, 839 (4th Cir. 1990) (secondary meaning).

B. Trade dress is protectable so long as it is nonfunctional and has secondary meaning.

Trade dress “involves the total image of a product, and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.” *Tools USA*, 87 F.3d at 657 (quoting *Two Pesos*, 505 U.S. at 764 n.1.). “It is well established that trade dress can be protected under federal law.” *TrafFix Devices, Inc. v. Mktg. Displays*, 532 U.S. 23, 28 (2001). The purpose of trade dress protection is to “secure to the owner of the [trade dress] the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.” *Two Pesos*, 505 U.S. at 774 (citation omitted). To be protectable, product-design trade dress must be nonfunctional and have acquired distinctiveness, i.e., secondary meaning. *Wal-Mart Stores v. Samara Bros., Inc.*, 529 U.S. 205, 214-216 (2000).

C. The district court erred in finding the Icon Boot Design functional.

1. The legal standard for functionality.

“A product feature is functional—and therefore not protectable as a trademark or trade dress—if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *McAirlaids, Inc. v. Kimberly-Clark Corp.*, 756 F.3d 307, 310 (4th Cir. 2014) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)). Expanding on the meaning of this phrase, the Supreme Court observed that “a functional feature is one the ‘exclusive use of [which] would put

competitors at a significant non-reputation-related disadvantage.” *TraFFix Devices*, 532 U.S. at 33 (quoting *Qualitex*, 514 U.S. at 165 (internal annotations omitted)).

To determine if trade dress is functional, the Fourth Circuit considers the following four factors (referred to as the *Morton-Norwich* factors):

- 1) the existence of a utility patent covering the utilitarian advantages of the design;
- 2) the existence of advertising or promotional materials in which the originator of the design touts the design’s utilitarian advantages;
- 3) the availability to competitors of functionally equivalent alternative designs; and
- 4) whether or not the design results from a comparatively simple, cheap, or superior method of manufacturing the device.

Valu Eng’g, Inc. v. Rexnord Corp., 278 F.3d 1268, 1274 (Fed. Cir. 2002) (setting forth the factors from *Morton-Norwich*) (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41 (CCPA 1982); *McAirlaids*, 756 F.3d at 313 (applying the *Morton-Norwich* factors). Like other courts that use the *Morton-Norwich* factors to assess functionality,⁵ courts in the Fourth Circuit typically consider all four factors.

⁵ 1 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:73 (5th ed. 2022) (“These four factors have often been used by courts across the nation as a practical framework with which to evaluate the evidence in determining functionality.”). See also *Valu Eng’g*, 278 F.3d at 1276 (considering all four *Morton-Norwich* factors); *Ezaki Glico Kabushiki Kaisha v. Lotte Int’l Am. Corp.*, 986 F.3d 250, 258 (3d Cir. 2021) (same); *Fuji Kogyo Co. v. Pac. Bay Int’l*,

McAirlaids, 756 F.3d at 312 (considering all four factors); *Tenax Corp. v. Tensar Corp.*, Civ. No. H-89-424, 1991 WL 218508, at *11-12 (D. Md. 1991) (holding that the four *Morton-Norwich* factors “are to be considered by a court in determining functionality”) (emphasis added), *aff’d sub nom. Tenax Corp. v. RBD Plastotecnica S.p.A.* 975 F.2d 868 (Fed. Cir. 1992).

As discussed below (*see* Sections C.5.c-d), among its other errors, the district court erroneously failed to consider the third and fourth *Morton-Norwich* factors.

2. Trade dress must be examined as a whole and not dissected into parts.

In applying the *Morton-Norwich* factors, “the critical functionality inquiry is not whether each individual component of the trade dress is functional, but rather whether the trade dress *as a whole* is functional.” *See CTB, Inc. v. Hog Slat, Inc.*, 954 F.3d 647, 665 (4th Cir. 2020) (emphasis in original) (quoting *Tools USA*, 87 F.3d at 658-59). This follows from the language of the Lanham Act, which prohibits registration of “any matter that, *as a whole*, is functional.” 15 U.S.C. § 1052(e) (emphasis added). As one appeals court warned, “it is crucial that we focus not on the individual elements, but rather on the overall visual impression

Inc., 461 F.3d 675, 685 (6th Cir. 2006) (same); *Georgia-Pac. Consumer Prods. LP v. Kimberly-Clark Corp.*, 647 F.3d 723, 727-28 (7th Cir. 2011) (same); *Clamp Mfg.*, 870 F.2d at 516 (same).

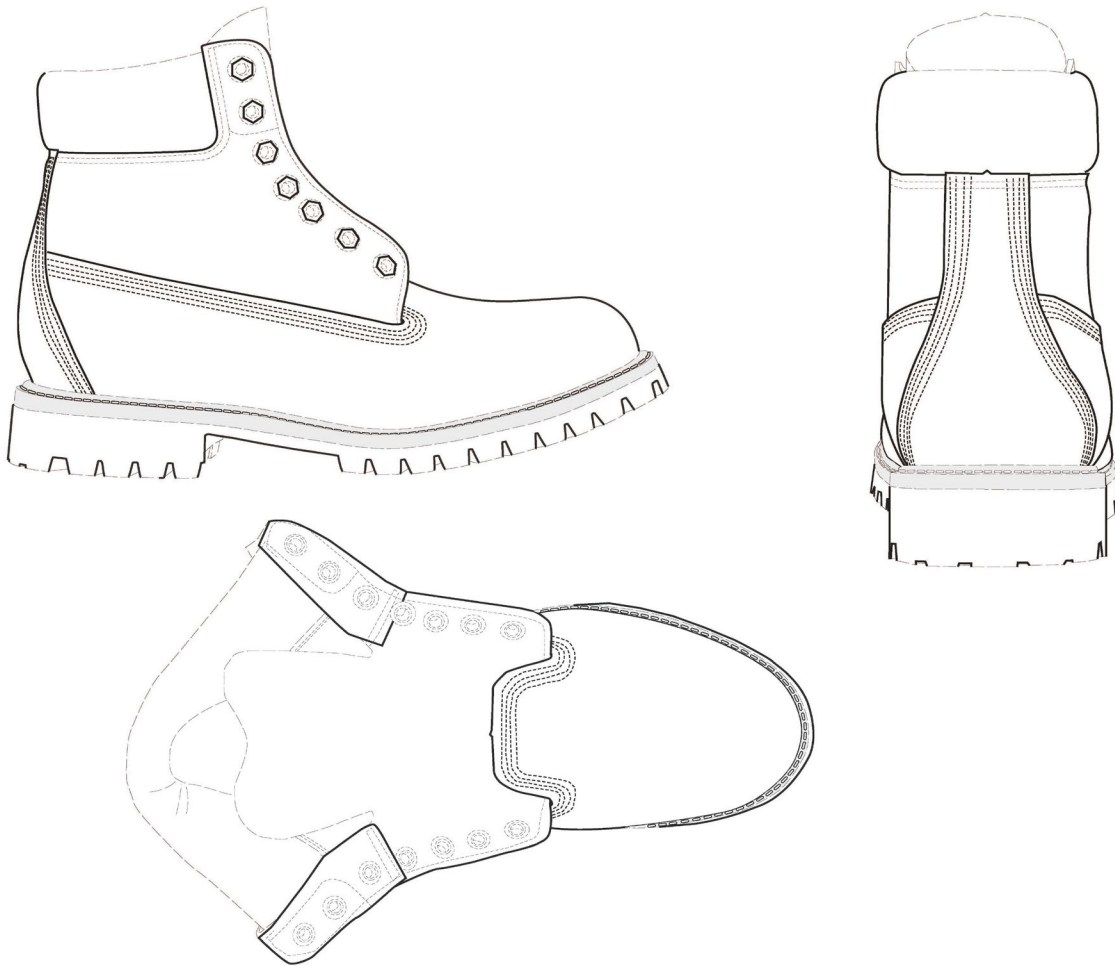
that the combination and arrangement of those elements create.” *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1259 (9th Cir. 2001).

This bedrock principle of considering trade dress as a whole “has been the rule for close to a century,” McCarthy, § 8:2 (citing *O. & W. Thum Co. v. Dickinson*, 245 F. 609, 619 (6th Cir. 1917)), and is applied across the circuits. *See, e.g., LeSportsac, Inc. v. K mart Corp.*, 754 F.2d 71, 76 (2d Cir. 1985) (“[B]y breaking Lesportsac’s trade dress into its individual elements and then attacking certain of those elements as functional, K mart misconceives the scope of the appropriate inquiry.”); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1538 (11th Cir. 1986) (finding that “[i]ndividual elements of packaging are functional does not, however, render the package as a whole unprotectible”).

3. In finding functionality, the district court misapplied the law by failing to consider the Icon Boot Design as a whole.

Disregarding this golden rule of trade dress law, the district court analyzed the “eight features” of the Icon Boot Design individually and in isolation. [*See Op. _3-12.*] The die was cast when, in the second paragraph of its opinion, the court framed TBL’s application as “seeking registration of eight specified features.” [*Op. _1.*] The court then analyzed patents by focusing on individual elements, not the whole design. [*Op. _3-12.*] Repeating this mistake, the court analyzed third-party advertising by focusing on individual elements, not the whole design. [*Op. _14*] (“The record is replete with materials published by

Timberland . . . extolling the functional benefits *of each element* of the applied for design.”) (emphasis added). The casualty of this analysis was the very thing at issue: the design formed by the particular styling and combination of those various individual elements that *together* make up the Icon Boot Design, shown in the Application’s drawing⁶:



[JA1349.]

⁶ For three-dimensional trade-dress applications, an applicant must submit a drawing (or drawings) that “depict a single rendition of the mark.” TMEP § 807.10.

In myopically focusing on the individual elements, the court lost sight of this complete visual of the Icon Boot Design. And without considering the whole design, as specifically depicted above, the individual elements mean little. Moreover, the written description of the elements, considered alone or together, do not convey the *overall* visual appearance of the Icon Boot Design. The drawing and description must be considered together as a whole. TMEP § 1202.02 (“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.”) The adage that “the whole is greater than the sum of its parts” could not be more apt. *See Taco Cabana Int’l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1120 (5th Cir. 1991) (noting “[t]he whole, in trademark law, is often greater than the sum of its parts”) (citation omitted), *aff’d*, 505 U.S. 763 (1992). This misapplication of the law, disregarding the whole for the parts, infected the court’s entire analysis under *Morton-Norwich* and is entitled to no deference. *Sara Lee*, 81 F.3d at 460.

Looking at the whole, as a court must, changes the result completely. Not a single ad touts the advantages of the *combination* of trade dress elements exemplified by the Icon Boot Design as a whole. And there is no patent that centrally advances any of the individual “eight features,” let alone the whole. Nor is there any evidence that it is cheaper or easier to make the Icon Boot Design than

without its design (the evidence shows otherwise) or needed by competitors to knock-off given the many thousands of alternative designs that flood the marketplace.

4. The functionality of individual footwear elements does not preclude trade dress protection for the design as a whole.

The court's piecemeal analysis ignored another fundamental trademark rule: even if individual elements of the Icon Boot Design are functional, the design as a whole still may be deemed nonfunctional. This principle accommodates the reality that "virtually every product is a combination of functional and non-functional features" *Am. Greetings Corp. v. Dan-Dee Imps., Inc.*, 807 F.2d 1136, 1143 (3d Cir. 1986); *Clicks Billiards*, 251 F.3d at 1259-61 ("To be sure, many of these elements, considered in isolation, may be functional. The issue, however, is whether, taken as a whole, the overall look and feel of the establishment is functional."). To hold otherwise "would wipe out trademark protection for all, or at least virtually all, consumer products' overall appearances." *Blumenthal Distrib., Inc. v. Herman Miller, Inc.*, 963 F.3d 859, 867 (9th Cir. 2020) (noting that "every chair's appearance is affected by having a backrest, as opposed to having no backrest, which serves the utilitarian function of providing back support. But that does not mean that every chair's overall appearance is functional as a matter of

law”). “Almost all courts adhere to this view. There is little dissent from this position.” McCarthy § 7:76.⁷

Applying this principle to footwear trade dress, courts have deemed various designs nonfunctional—even if their individual elements impart utilitarian or functional benefits. *See e.g., adidas Am., Inc. v. Skechers USA, Inc.*, No. 15-cv-01741, 2017 WL 3319190, at *14-15 (D. Or. Aug. 3, 2017) (reiterating prohibition against “divide and conquer” approach of adidas’ trade dress for its Stan Smith shoe and granting summary judgment in favor of adidas on Skechers’ functionality defense); *Asics Corp. v. Skechers U.S.A.*, No. SACV 07-0103AG, 2007 WL 1424670, at *7 (C.D. Cal. Apr. 26, 2007) (finding “shapes and designs” of Asics’ trade dress elements for its Ultimate 81 shoes, when viewed as a whole, nonfunctional). So too here. As explained by TBL’s footwear expert, “the elements of the Icon Boot Design are aesthetic, diverse, and located in different areas of the shoe. Their physical separation alone precludes any suggestion that one or more of them combine mechanically to create a functional advantage.” [JA3133.]

⁷ *Tools USA*, 87 F.3d at 658; *Taco Cabana*, 932 F.2d at 1119; *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1373-74 (Fed. Cir. 2012); *Computer Care v. Serv. Sys. Enters., Inc.*, 982 F.2d 1063, 1075 (7th Cir. 1992); *Hartford House, Ltd. v. Hallmark Cards, Inc.*, 846 F.2d 1268, 1272 (10th Cir. 1988); *LeSportsac*, 754 F.2d at 79; *In re Chesebrough-Pond’s, Inc.*, 224 USPQ 967, 1984 WL 63177, at *2 (TTAB Oct. 31, 1984).

Applying the district court’s reasoning, protection would have been improperly denied in the above cases simply because each element served a purpose within the larger shoe design, e.g., “the seams as seams, the two-piece sole as a two-piece sole, the bulbous toe as a roomy toe, the eyelets as eyelets, the ankle collar as an ankle collar, and so on.” [Op. _14.] And the many footwear designs the PTO has registered as trade dress [*see, e.g.*, Dkt.50-22] would likewise fall.

5. Applying the *Morton-Norwich* factors properly, the Icon Boot Design as a whole is nonfunctional.

Had the court viewed the Icon Boot Design through the proper legal lens—analyzing it as a whole and not as eight individual elements—a different result necessarily follows.⁸

a. *Morton-Norwich* Factor No. 1: The Icon Boot Design, as a whole, is not the central advance of any utility patent.

Under the first *Morton-Norwich* factor, a “utility patent is strong evidence that the features therein claimed are functional.” *McAirlaids*, 756 F.3d at 311 (citation omitted). For this to apply, the trade dress must reflect the “central advance” of a utility patent—not an arbitrary or incidental feature. *Compare McAirlaids*, 756 F.3d at 312 (vacating and remanding district court’s holding that trade dress pattern was functional because the claimed “pattern is not the ‘central

⁸ As noted above, the district court also failed to even mention, let alone consider, that the Examining Attorney conceded that *half* of the eight elements identified by the district court were, in fact, nonfunctional. [JA1715.]

advance’ of any utility patent” (citing *TrafFix Devices*, 532 U.S. at 30)), with *CTB*, 954 F.3d at 661-662 (affirming district court’s finding of functionality, in part, because a portion of the applied-for trade dress was the central advance of a patent and plaintiff conceded “that the profile of the feeder in the [patent] is ‘virtually identical’ to that of the [trade dress]”).

As noted, the district court relied on twelve different patents (and one patent application) purportedly covering each of the “eight elements” individually (which TBL vigorously contests as erroneous) to deem the whole design functional. [Op._3-12.] But nowhere did the court point to a single utility patent being the “central advance” of, or even disclosing, the entire Icon Boot Design as required to satisfy this factor. [Op._3-12.] It couldn’t, as no such patent exists. Accordingly, the court legally and clearly erred in finding this factor shows functionality.

b. *Morton-Norwich* Factor No. 2: TBL’s advertising does not tout any functional benefit of the Icon Boot Design as a whole.

An applicant’s advertising or promotional materials that “tout[] the design’s utilitarian advantages” may favor a finding of functionality under the second *Morton-Norwich* factor. *McAirlaids*, 756 F.3d at 313 (citation omitted). Although these materials may “provide insight into the functionality calculus, they are not, in and of themselves, determinative.” *Rothy’s, Inc. v. JKM Techs., LLC*, 360 F. Supp. 3d 373, 385 (W.D. Va. 2018). In *Rothy’s*, the court rejected the argument that a

third-party article that “mention[s] a functional advantage of a seamless 3D knitted upper” is fatal to trade dress protection for a ballet shoe. *Rothy’s*, 360 F. Supp. 3d at 385. Although the article mentioned “a functional advantage,” the court noted the claimed trade dress was *more than* just the knitted upper, and the article failed to mention the functionality of the “other aspects of the trade dress.” *Id.* at 387.

Here, the court found that “TBL’s own advertising touts the functional benefits [of] the features” and the “record is replete with materials published by Timberland and third parties extolling the functional benefits *of each element* of the applied-for design”—specifically pointing to advertisements about the hardness of the sole, the waterproof quality of the stitching, and the origin of the Icon Boot for work. [Op. _13-14] (emphasis added). Apart from ads discussing individual features (tenuously at best), none extoll any utilitarian benefits of the design *as a whole*. Indeed, the virtues of waterproofing, warmth, comfort, and other benefits are not the byproduct of the way the Icon Boot Design looks. [JA3136-JA3167, JA3171-JA3176.] Finding otherwise was both legal and clear error.

The court also erred in characterizing the Icon Boot a “work boot.” [Op. _12.] As noted, testing shows that by today’s standards, the Icon Boot is *not* appropriate, and is in fact quite unsafe, for use as a work boot—just as “combat boots” that are worn as a fashion statement are not suitable for use in actual

combat.⁹ [JA3243-JA3256, JA7793-JA7796.] *See Adidas-Salomon AG v. Target Corp.*, 228 F. Supp. 2d 1192, 1204-05 (D. Or. 2002) (determining that although plaintiff advertised shoes bearing its Superstar trade dress as performance basketball shoes, this did not dictate whether the trade dress was functional by today’s standards). To accommodate the need for real work boots, TBL has a separate line of Timberland PRO® safety footwear that does not employ or embody the Icon Boot Design.

Far from extolling any utilitarian advantage of the Icon Boot Design, TBL’s advertising has, for decades, actually touted its style and originality. *See* Dkts.50-24 through 50-63. Like adidas’ Stan Smith ads in *Skechers*, which supported a finding of nonfunctionality, TBL frequently promotes and markets the Icon Boot as a fashion item, without discussing any utilitarian advantage (e.g., touting the boot as appropriate “For urban exploration” and encouraging consumers to “Master the look of you. Stand out this fall with #Timberland”). Dkts.50-24

⁹ To that end, the court clearly erred in finding that the bulbous shape of the Icon Boot’s toe box—lined with just a thin plastic insert—provides extra safety, like the crumple zone of a car. [Op. _12.] Science dictates that it is the material, not the specific bulbous shape, of a boot that provides durability—demonstrated by both TBL’s impact testing and the variety of different toe boxes (including non-bulbous ones) used across safety footwear. *See* Section III.F. The court’s automotive crumple zone analogy is thus incomplete and imperfect. Like a boot, the shape of a car bumper with a “crumple zone” makes a car safer only if it contains strong material, like steel. A crumple zone made just of thin plastic would be useless and nonfunctional. So too with a boot, like the Icon Boot.

through 50-63; [JA5372-JA5437, JA6442-JA6565, JA6568-JA7348, JA7350-JA7395, JA7398-JA7527.]; *see adidas Am.*, 2017 WL 3319190, at *15 (“The Stan Smith shoe is advertised as a clean, simple shoe and it has been described as a ‘style staple.’ . . . The majority of Stan Smith related advertising heavily focuses on the shoe’s iconic style rather than any utilitarian advantages. Accordingly, this factor favors a finding of non-functionality.”). Thus, when properly considered with respect to the Icon Boot Design as a whole, the district court legally and clearly erred in finding that this factor shows functionality.

c. *Morton-Norwich* Factor No. 3: The district court failed to consider the myriad alternative design combinations available to competitors.

The court erred in failing to consider this factor, which looks at “the availability to competitors of functionally equivalent alternative designs.” *McAirlaids*, 756 F.3d at 312 (noting that “*TrafFix* did not alter our precedents that look to the availability of alternative designs when considering, as an initial matter, whether a design affects product quality or is merely ornamental”); *Valu Eng’g*, 278 F.3d at 1276 (noting that “[n]othing in *TrafFix* suggests that consideration of alternative designs is not properly part of the overall mix, and we do not read the Court’s observations in *TrafFix* as rendering the availability of alternative designs irrelevant”).

Applying this factor to footwear, the Federal Circuit affirmed a finding of nonfunctionality for Converse’s All Star shoe design because “[a]ny functional benefit is derived from the presence of toe caps and bumpers generally, not the particular design of [Converse’s design], and there are numerous commercial alternatives to that design.” *Converse, Inc. v. Int’l Trade Commission Skechers U.S.A., Inc.*, 909 F.3d 1110, 1124 (Fed. Cir. 2018). *See also K-Swiss, Inc. v. USA AISIQI Shoes Inc.*, 291 F. Supp. 2d 1116, 1122 (C.D. Cal. 2003) (“As competitors routinely use alternative designs, this fact weighs in favor of K–Swiss’ contention that [its trade dress] is cosmetic and non-functional.”); *Steven Madden, Ltd. v. Yves Saint Laurent*, No. 18-cv-7592, 2019 WL 2023766, at *9 (S.D.N.Y. May 8, 2019) (“[T]here are countless other means of assembling a shoe design”); *L.A. Gear Inc. v. Thom McAn Shoe Co.*, No. 88 Civ. 6444, 1989 WL 282850, at *18 (S.D.N.Y. Apr. 20, 1989) (finding “a number of shoe varieties compete with” trade dress for women’s athletic shoes), *aff’d in part, rev’d in part*, 988 F.2d 1117 (Fed. Cir. 1993).

The Icon Boot Design is one of a considerable number of boot designs. The record before the district court was replete with *thousands*—if not *tens of thousands*—of boots using completely different elements and overall designs, including waterproof boots, directly showing there is no competitive need to use the Icon Boot Design. [JA3262-JA3264, JA3668, JA3370-JA3656, JA5311-

JA5327, JA7715-JA7728, JA7730-JA7763, JA7767-JA7780, JA7782-JA7783.]

Failing to consider this factor, which plainly supports a finding of nonfunctionality, was both legal and clear error.

d. *Morton-Norwich* Factor No. 4: The district court failed to consider that the Icon Boot does not result from a cheaper, simpler, or superior method of manufacture.

The last *Morton-Norwich* factor favors a finding of functionality if “the design results from a comparatively simple, cheap, or superior method of manufacturing the device.” *Valu Eng’g*, 278 F.3d at 1274 (citing *Morton-Norwich*, 671 F.2d at 1340-41). *See also McAirloads*, 756 F.3d at 313. Footwear trade dress has been found nonfunctional when its features “do not make the shoe work better or cost less than other similar sneakers in the current marketplace,” *adidas Am., Inc. v. Skechers USA, Inc.*, 149 F. Supp. 3d 1222, 1238 (D. Or. 2016), *aff’d in part, rev’d in part*, 890 F.3d 747 (9th Cir. 2018), or when the trade dress features are more expensive. *K-Swiss*, 291 F. Supp. 2d at 1123.

The court likewise failed to consider this factor, which decisively favors nonfunctionality. The Icon Boot Design is *more* expensive, complex, and time consuming to make because many of its elements require additional material and labor. [JA363, JA3134, JA3171, JA3176-JA3177, JA3188-3189, JA3202, JA3214, JA3218, JA3222-JA3225, JA7726, JA7730, JA7738, JA7742, JA7754, JA7767, JA7782-JA7783, JA7785-JA7786, JA7792.] *See K-Swiss*, 291 F. Supp. at 1122

(noting uncontroverted evidence that “the five stripe design adds significantly to the cost of K-Swiss shoes” and thus finding that this factor weighed in favor of nonfunctionality); *Adidas-Salomon AG v. Target Corp.*, No. CV-01-1582, 2002 WL 31971831, at *9 (D. Or. July 31, 2002) (“[R]ather than simplifying manufacture or decreasing production costs, the Original Superstar Trade Dress increases the production cost. Thus, to the extent that [Target’s] [summary judgment] motion rests on an argument that the . . . Original Superstar Trade Dress [is] functional, it should be rejected.”). Failing to consider this factor, which plainly supports a finding of nonfunctionality, was legal and clear error.

D. The district court erred in concluding that the Icon Boot Design has not acquired secondary meaning.

1. The district court legally erred in effectively holding that look-for advertising is required to demonstrate secondary meaning.

Without any supporting authority, the district court held that look-for advertising (i.e., advertising that literally tells customers to “look for” a trade dress) is “critical” in product-design trade dress cases, categorically ruling that “[s]econdary meaning *cannot* be proven by advertisements that merely picture the claimed trade dress and do nothing to emphasize or call attention to it.” [Op. _16-17] (emphasis added).¹⁰ In so holding, the court effectively *required* look-for

¹⁰ As discussed below, the conclusion that TBL’s ads somehow did not call attention to the Icon Boot Design is unsupported and incorrect.

advertising to establish secondary meaning. As this is a legal determination, it must be reviewed *de novo*. *Int'l Bancorp*, 329 F.3d at 362.

The district court cited no authority for its holding because there is none. The Fourth Circuit assesses six factors to determine whether a design has achieved secondary meaning, and look-for advertising is not among them: “(1) advertising expenditures; (2) consumer studies linking the mark to a source; (3) sales success; (4) unsolicited media coverage of the product; (5) attempts to plagiarize the mark; and (6) the length and exclusivity of the mark’s use.” *Perini Corp. v. Perini Const., Inc.*, 915 F.2d 121, 125 (4th Cir. 1990) (the “*Perini* factors”).¹¹ No single factor is dispositive, and each need not favor the brand owner to demonstrate secondary meaning. *See Perini*, 915 F.2d at 125.

Consistent with the absence of “look-for” advertising in the *Perini* factors, Fourth Circuit courts have not found look-for advertising to be “critical” to establish secondary meaning. *See, e.g., Black & Decker (U.S.) Inc. v. Pro-Tech Power*, 26 F. Supp. 2d 834, 851 (E.D. Va. 1998) (finding that plaintiffs “conclusively demonstrated” secondary meaning in a yellow-and-black color scheme for power tools based on demonstrations at construction sites and retail stores across the country, media coverage and marketing awards that generated

¹¹ These factors have been followed in subsequent Fourth Circuit decisions. *See, e.g., Int'l Bancorp*, 329 F.3d at 370; *U.S. Search, LLC. v. U.S. Search.com Inc.*, 300 F.3d 517, 525 (4th Cir. 2002).

widespread publicity about the look of the product, customer comments regarding the same, and \$24 to \$25 million in sales).

Indeed, both the TTAB and its primary reviewing court have specifically held that look-for advertising is *not* required to establish secondary meaning. *See Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1583 (Fed. Cir. 1988) (finding ads probative of secondary meaning in guitar head shapes absent efforts to explicitly stress and promote the shapes, noting “[a]lthough the peg head designs were not the sole or primary focus of the advertising . . . the constant promotional display of the product pictures did contribute to the recognition of the peg head designs as source indicators”); *In re Black & Decker Corp.*, 81 USPQ2d 1841, 2006 WL 3825183, at *3 (TTAB Dec. 28, 2006) (finding secondary meaning in a key-head design without “look for” promotion, noting “the absence of ‘look for’ advertising or promotion does not mean that consumers do not recognize the design as applicant’s trademark”).

Other courts have similarly held that “look-for” advertising is not needed to establish secondary meaning. *See, e.g., McNeil Nutritionals, LLC v. Heartland Sweeteners LLC*, 566 F. Supp. 2d 378, 391 (E.D. Pa. 2008) (“The Third Circuit has not held that only ‘look for’ advertising can be considered when analyzing whether a trademark or trade dress has acquired secondary meaning.”); *Vital Pharms., Inc. v. Monster Energy Co.*, 472 F. Supp. 3d 1237, 1258 (S.D. Fla. 2020) (“While an

advertisement that explicitly directs consumers to a product’s trade dress may *help* to foster secondary meaning, it is not *necessary* to do so.”) (emphasis in original); *Givenchy S.A. v. BCBG Max Azria Grp., Inc.*, No. CV 10-8394, 2012 WL 3072327, at *5 (C.D. Cal. Apr. 25, 2012) (finding ads that “portray . . . handbags, with the design features prominently visible . . . and the word ‘Givenchy’ . . . reinforce the connection consumers draw between the design features of the handbags and its source—Givenchy”).

Even when considering secondary meaning specifically for shoe designs, courts have found look-for advertising unnecessary. *See e.g., Asics Corp.*, 2007 WL 1424670, at *8 (“The Court does not find that the advertisements need to have [look-for] language to engender consumer identification with the recognizable features of the shoe.”); *Target*, 228 F. Supp. 2d at 1208 (“[T]rade dress can be recognizable without advertising specifically telling a consumer to look for it,” noting that “the Coca–Cola Company does not say in its advertising to ‘look for the hourglass-shaped bottle,’ and yet it is one of the most recognizable trade dresses in the world.”)

In sum, while “look-for” advertising can be strong evidence of secondary meaning, it is certainly not a prerequisite. The district court’s ruling effectively requiring such advertising to prove secondary meaning caused the court to disregard TBL’s other powerful evidence of secondary meaning (discussed further

below), represents a substantial departure from the prevailing view on this issue and is legally erroneous.

2. The district court clearly erred in disregarding ads that called attention to the overall look of the Icon Boot Design.

Even though look-for advertising is not required, the record was in fact replete with promotions that called attention to the overall look of the Icon Boot Design—like the installation shown below of a giant Icon boot in New York City’s Flatiron Plaza in 2018:



[JA5427, JA7386]

If a promotion like this does not call attention to the overall look of the trade dress, nothing can. And the record contained numerous other similar examples of

the Icon Boot Design being featured as a branding centerpiece that are tantamount to look-for advertising—including ads specifically telling consumers to focus on “the looks” of the boot, ads and public displays featuring nothing else but the boot or with phrases like “What Makes an Icon?”, and other promotions and collateral merchandise highlighting the standalone value of the design:

SHOP THE LOOKS



Men's 6-Inch Premium
Waterproof Boots -
Wheat Nubuck



Women's 6-Inch Premium
Waterproof Boots -
Wheat Nubuck

[JA7237]



[JA8862]



[JA7361]



[JA5407]

[See also JA6795, JA7015, JA7258, JA5416-JA5419, and JA7611.] Few footwear designs have this type of brand power, but the Icon Boot does. The district court clearly erred in disregarding this potent evidence.

3. The district court erred as a matter of law in failing to examine the impact of third-party designs in the marketplace.

The district court’s finding of no secondary meaning also rests on what it called a “saturation” of the market with look-alike boots. [Op. _ 19.] Yet the court completely failed to assess the commercial impact these purported look-alikes have had in the marketplace, as is required. When evaluating the impact of third-party uses, courts look at the following: (1) substantial similarity of the third-party marks/designs; (2) evidence of consumer awareness, particularly based on sales and advertising figures; and (3) whether the third-party use is commercially significant in the context of the relevant market. See e.g., *Combe Inc. v. Dr. Aug. Wolff GmbH & Co. KG Arzneimittel*, 382 F. Supp. 3d 429, 453 (E.D. Va. 2019), *aff’d*, 851 F. App’x 357 (4th Cir. 2021); *Converse*, 909 F.3d at 1122.

Because the court did not identify *any* of the third-party uses it considered, it is impossible to assess whether they are substantially similar to the Icon Boot Design (most in the record were not, as best can be ascertained).¹² Regardless, the

¹² Additionally, even if the cited examples incorporate the elements of the Icon Boot Design, they would then be considered imitators and support the claim that

record was devoid of any associated sales or advertising expenditures that could shed light on whether consumers were actually aware of the designs offered by the Government. Without that evidence, it is “unlikely that consumers are familiar with” the uses. *Combe*, 382 F. Supp. at 452 (“If third-party marks are not in use in the market or have meager sales and advertising figures, it is unlikely that consumers are familiar with the marks, which renders them irrelevant to the question whether consumers associate the plaintiff’s mark with a unique source.”). *See also L.D. Kichler Co. v. Davoil*, 192 F.3d 1349, 1352 (Fed. Cir. 1999) (holding that inconsequential or infringing use by others does not undermine plaintiff’s claim of substantially exclusive use because “there was no analysis of the extent of [third-party] sales”).

In *Combe*, the defendant cited 66 similar third-party marks to argue that plaintiff’s mark was commercially weak. *Combe* at 382 F. Supp. at 452-453. The same district court as the one here held that the evidence “is entitled to minimal weight and certainly does not diminish . . . VAGISIL’s commercial strength” because (1) “[d]efendant presented no evidence to establish that the majority of the sixty-six third-party ‘vagi-’ prefix marks submitted by defendant have ever been

the Icon Boot Design has acquired secondary meaning. *See Lopez v. Gap, Inc.*, 883 F. Supp. 2d 400, 428 (S.D.N.Y. 2012) (“Evidence that a mark has been widely copied is persuasive evidence of secondary meaning because it demonstrates that the mark has become a strong source identifier in the eyes of the purchasing public.” (citation omitted)).

sold or promoted in the United States,” and (2) “fourteen of the fifteen marks that defendant established are used by third parties in commerce appear to have achieved extremely limited sales, promotion, and recognition by consumers” and therefore were too small and/or sparse to undermine Combe’s rights. *Combe*, 382 F. Supp. at 452-453. This Court affirmed. *See Combe Inc. v. Dr. Aug. Wolff GmbH & Co. KG Arzneimittel*, 851 F. App’x 357 (4th Cir. 2021). The record evidence here is even weaker than in *Combe* because, there, in addition to producing website printouts for a number of third-party uses, the defendant actually bought and produced products and (through subpoenas) obtained sales figures and advertising expenses. *Combe*, 382 F. Supp. at 441-442. With only website printouts in the record here and nothing more,¹³ the PTO’s evidence does not show that any of the third-party boots were actually sold in the United States, how long they have been offered for sale, the extent of any sales, if they have been advertised (and how), or that any consumers have been aware of them (let alone a meaningful number).

The reasoning in *Combe* has been applied in shoe design cases. In *Walmart*, Walmart provided images of 49 *third-party shoes* that allegedly incorporated one or more of the claimed features of Vans’ asserted trade dresses. *Exhibit 2 to Def.*

¹³ Even for the website printouts the PTO submitted [JA22066-JA22083], TBL showed that many of the third-party boots were no longer offered for sale. [JA3261-JA3264.]

Walmart Inc.’s Mem. of Points & Authorities in Opp. to Plaintiffs’ Mot. for Prelim. Inj., No. 21-cv-01876 (C.D. Ca. Nov. 15, 2021), ECF No. 40-2. The court determined that this evidence did not undermine Vans’ substantially exclusive use because “Walmart provide[d] no evidence to indicate the *extent* of any of the alleged third-party uses of Vans’ claimed trade dress.” *Walmart*, ECF No. 65 at 13 (emphasis added). Other courts agree that “merely providing a list of third-party uses is not sufficient to establish a lack of secondary meaning.” *Id.* See also *Select Auto Imps. Inc. v. Yates Select Auto Sales, LLC*, 195 F. Supp. 3d 818, 833 (E.D. Va. 2016) (“Without evidence as to the extent of actual day-to-day use of such marks, the probative value of [third-party] evidence is minimal.”) (citing *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1338 (Fed. Cir. 2001)); *Adidas Am.*, 149 F. Supp. 3d at 1236 (asserting that, in the context of evaluating exclusive use, “standing alone, a list of third party shoes that use parts of the Stan Smith trade dress are not sufficient to undermine adidas’s trademark rights”).

Finally, although the district court found the market to be “saturated” by similar third-party designs, it failed to examine the third-party evidence against the size of the relevant boot market. When considered against the tens of thousands of boots offered for sale at any given time, the Government’s paltry evidence of third-party designs amounts to a drop in the bucket. [JA3262-JA3264, JA3370-JA3656,

JA3668.] *See Combe*, 382 F. Supp. at 452 (determining that “the [66] third-party marks relied upon by defendant are commercially insignificant”).

4. The district court erred in finding that other branding diminishes TBL’s evidence of secondary meaning.

The court discredited TBL’s extensive advertising evidence because a number of ads for the Icon Boot Design included the TIMBERLAND mark and/or Timberland Tree Logo. [Op. _18] (noting “TBL’s comprehensive use of traditional trademarks cannot be overstated” in assessing whether the Icon Boot Design has secondary meaning). This was unsupported by authority and is clearly erroneous, as the mere presence of other TBL branding in an advertisement does not diminish evidence of secondary meaning.

Courts consistently find that the presence of a house logo or other branding in ads for an applied-for mark does not undermine the ad’s effectiveness in building rights and secondary meaning. *See Bridgestone Am. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 1336-37 (Fed. Cir. 2012) (finding the presence of BRIDGESTONE with the applied-for tire marks in ads did not diminish the strength of those marks and reversing the TTAB on this issue); *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1374-75 (Fed. Cir. 2002) (noting that it is common in today’s market for product marks and famous house marks to appear together, such as “INTEL PENTIUM, FORD MUSTANG, APPLE MACINTOSH, [and] KELLOGG’S FRUIT LOOPS”); *YETI Coolers, LLC v. RTIC Coolers, LLC*, No. A-

15-CV-597, 2017 WL 429210, at *1 n.2 (W.D. Tex. Jan. 28, 2017) (noting “[c]ourts do not require that the trade dress be advertised without any other brand identifying information [T]his is to be expected.”). Far from undermining secondary meaning, the use of other branding in advertising can *reinforce* and *strengthen* a trade dress’ connection to its source. For example, in one case, a court noted that the use of a brand with a handbag trade dress served to “reinforce the connection consumers draw between the design features of the handbags and its source—Givenchy.” *Givenchy S.A.*, 2012 WL 3072327, at *5.¹⁴

There is good reason for these holdings; they recognize the practical realities of modern advertising, which routinely features house marks and logos on trade dress. If courts were to follow the district court’s reasoning, protection for all trade dress would essentially be doomed any time a trade dress also contained any

¹⁴ As explained by TBL’s marketing expert, “[t]he presentation of Timberland’s brand name, trade dress, and logo should prompt, and indeed has prompted, consumers to develop strong associations among these three elements, making each of them highly—and independently—memorable. . . . [S]eeing or thinking about one brand element is likely to prompt consumers to think about other, closely-related brand elements, and vice versa. As an example, when consumers think about a brand like McDonald’s, they are likely to retrieve from memory information they have stored pertaining to the brand, including its products (e.g., Big Macs) and related brand information (e.g., its Golden Arches logo and Ronald McDonald mascot).” [JA1833.]

“traditional trademarks” like house marks or logos. There is no support or viable reason for this harsh result.

5. The district court erred in finding no secondary meaning because it failed to consider the totality of the evidence.

When considering the totality of both the circumstantial and direct evidence, the court clearly erred in finding that the Icon Boot Design lacks secondary meaning. *Little Tavern Shops, Inc. v. Davis*, 116 F.2d 903, 906 (4th Cir. 1941) (reversing district court’s factual finding that plaintiff’s name had not acquired secondary meaning based on the totality of the evidence, including plaintiff’s use of the name for 12 years).

a. The record contains substantial circumstantial evidence of secondary meaning.

In addition to direct consumer evidence of secondary meaning (discussed below), the Fourth Circuit considers circumstantial evidence, such as the length and exclusivity of use, advertising expenditures, sales success, and unsolicited media coverage. *Perini*, 915 F.2d at 125. On each of these points, the record evidence significantly exceeds what this Court and others have found to be compelling evidence of secondary meaning—in both quantity and quality.

Regarding the length and exclusivity of use, Timberland has continuously used the Icon Boot Design for around four decades:



[JA7130, JA3258, JA5352-JA5372.] Over this time, the design's appearance has been consistent and the use substantially exclusive. This vastly exceeds time periods that have been considered sufficient to establish secondary meaning in the Fourth Circuit and elsewhere. *See e.g., Select Auto Imps.*, 195 F. Supp. 3d at 833 (finding secondary meaning from, *inter alia*, nearly three decades of exclusive use, irrespective of third-party uses of SELECT as marks and business names); *Teaching Co. P'ship v. Unapix Ent., Inc.*, 87 F. Supp. 2d 567, 580 (E.D. Va. 2000)

(finding secondary meaning because, among other things, plaintiff used the mark for eight consecutive years without interruption). *See also* 15 U.S.C. § 1052(f) (“[The PTO may accept as prima facie evidence that the mark has become distinctive . . . proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.”).

With respect to advertising, TBL has spent over \$81 million on Icon Boot ads, promotions, and marketing campaigns in the U.S. in the past *six* years alone. [JA5372-JA5373.] This has resulted in the Icon Boot Design being promoted across nearly every conceivable medium and method, including print ads in magazines and various other publications, mailings, brochures, sales banners, in-person store displays, television, the Internet (via Timberland’s own website, retailer websites, banner ads, and social media), public relations campaigns (e.g., *Equal Justice Initiative*, *City Year Youth Service Corps*, *Plant the Change*[™], *Drive. Recycle. Wear.*), promotional items, and collaborations with well-known designers, celebrities, and entities. [JA5372-JA5437, JA6442-JA6565, JA6568-JA7348, JA7350-JA7395, JA7398-JA7527.]

Again, the evidence on this point far surpasses the promotional activities and expenditures that have supported a finding of secondary meaning (or commercial strength/fame) in other cases. *See, e.g., Swatch, S.A. v. Beehive Wholesale, LLC*,

888 F. Supp. 2d 738, 748-49 (E.D. Va. 2012) (\$30M spent on newspaper, magazine, and billboard ads over ten years), *aff'd* 739 F.3d 150 (4th Cir. 2014); *Lumber Liquidators, Inc. v. Stone Mountain Carpet Mills, Inc.*, Civ. Action No. 8-cv-573, 2009 WL 2013599, at *11 (E.D. Va. July 10, 2009) (\$200M in ad expenditures over more than ten years); *Unapix*, 87 F. Supp. at 580, 580 n.6 (\$700,000 on print ads and \$11M on catalogues and mailings) (citing *George Basch Co., Inc. v. Blue Coral, Inc.*, 968 F.2d 1532, 1536 (2d Cir. 1992) (\$75,000 in advertising over four years)); *Walmart*, ECF No. 65 at 11 (finding “significant [advertising] expenditures,” i.e., “tens of millions of dollars advertising the shoes” over 45 years); *Bose*, 293 F.3d at 1373 (over \$60M in nine years); *Planters Nut & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916, 917-18 (CCPA 1962) (finding Planter’s MR. PEANUT design among the “best known . . . trade symbol[s]” in the U.S. based in part on ad expenditures of over \$10M over ten years).

The effectiveness of these various advertising campaigns and activities across multiple media is evident from the Icon Boot’s massive sales—over one billion dollars from 2013-2021 alone with well over \$100 million in sales during most years. [JA5428-JA5429.] Yet again, this evidence far surpasses sales figures that have supported a finding of secondary meaning (and in some cases the higher threshold of “fame”) in the Fourth Circuit.¹⁴ *See e.g., Combe*, 382 F. Supp. at 450 (noting Combe’s “sales figures alone [over \$1 billion in 28 years] exceed those that

courts have found to be indicative of fame”); *JFJ Toys, Inc. v. Sears Holdings Corp.*, 237 F. Supp. 3d 311, 335 (D. Md. 2017) (“Plaintiffs’ STOMP ROCKET has considerable commercial strength as demonstrated by its ‘substantial revenues’ [of] [over four million dollars of sales in 2013 alone.”); *Swatch*, 888 F. Supp. 2d at 749 (E.D. Va. 2012) (noting that \$275M in revenue over a nine year timespan from sales of more than 3.75 million SWATCH watches was commercially significant) (citing cases where much lower revenues satisfied *Perini* factor 2), *aff’d* 739 F.3d 150 (4th Cir. 2014); *Worsham Sprinkler Co. v. Wes Worsham Fire Protection, LLC*, 419 F. Supp. 861, 871-72 (finding annual revenues in excess of \$20M throughout the 1990s and \$18M per year in 2002, 2003, and 2004 sufficient to support a finding of secondary meaning); *Unapix*, 87 F. Supp. 2d at 580 (finding sales of over \$6M over eight years indicative of secondary meaning).¹⁵

While TBL’s advertising of the Icon Boot has been substantial (and is alone sufficient to prove secondary meaning), this product has literally promoted itself. It has garnered extensive unsolicited media coverage over the past several decades and continues to receive widespread attention from the press, celebrities, and in

¹⁵ See also *Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.*, 889 F.2d 1070, 1073 (Fed. Cir. 1989) (holding that NINA RICCI was a strong mark based on \$200M in sales over five years); *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 674 (Fed. Cir. 1984) (finding SPICE ISLANDS famous based on forty years of use, annual sales of \$25,000,000 for seasonings, and \$12,000,000 for teas).

popular culture—demonstrating the same, if not greater, level of unsolicited media attention that courts have recognized as evidence of secondary meaning. The Icon Boot has been the subject of repeated and diverse pop cultural sightings and references on hit television shows (e.g., *Seinfeld*, *Saturday Night Live*, *Keeping Up With The Kardashians*, *Grey’s Anatomy*, *The Carmichael Show*), movies (e.g., *Men in Black*, *The Shining*, *Scary Movie*), music videos (e.g., Nicki Minaj’s “Feeling Myself,” Ed Sheeran’s “Perfect,” Drake’s “Take Care,” and Rihanna’s “Goodnight Gotham”), and broadcast performances (e.g., Rihanna performing “Diamonds” on *Saturday Night Live*). [JA5446-JA5468, JA7634-JA7685.]

In *Walmart*, the court found that similar media appearances and cultural references—including evidence of Vans sneakers being featured in movies and music videos—“indicate the . . . iconic status” of Vans’ trade dresses “and thereby further support . . . secondary meaning.” *Walmart*, ECF No. 65 at 12. Further, like the Vans’ shoes in *Walmart*,¹⁶ the Stan Smith shoes in *Adidas*,¹⁷ and the SWATCH

¹⁶ *Id.* at 3-12 (citing several articles that have referenced the popularity of Vans’ sneakers among various athletes, musicians, artists, and celebrities).

¹⁷ *adidas*, 2017 WL 3319190, at *11-13 (finding “adidas has a very strong case that the Stan Smith Trade Dress has acquired distinctiveness through secondary meaning,” noting that “the Stan Smith [shoe] has been displayed by influential actors, musicians, and athletes . . . [and the shoe has received] industry praise in newspapers and magazines . . .”).

brand in *Swatch*,¹⁸ the Icon Boot has enjoyed enormous publicity from celebrities wearing the product in all colors, as regularly featured in major publications (*e.g.*, *The New York Times*, *The Boston Globe*, *Glamour*, *Vogue*, *Rolling Stone*, *TIME Magazine*, *Elle*, *Forbes*), shows, and websites. [JA5437-JA5442, JA7528-JA7627.]

b. The record contains significant direct consumer evidence of secondary meaning.

Not surprisingly, the above activities—including promotions that have called attention to the overall appearance of the Icon Boot Design as discussed above—have caused consumers to associate the design with one source: Timberland.¹⁹ Searches for the Icon Boot on social media revealed many hundreds of instances where well-known celebrities, athletes, and others posted photos of an Icon Boot—

¹⁸ *Swatch*, 888 F. Supp. at 749 (noting that unsolicited media coverage from celebrities wearing the product, and press from major publications such as the *New York Times* and *Los Angeles Times*, demonstrated commercial strength of the SWATCH brand under *Perini* factor 4).

¹⁹ TBL conducted a consumer survey establishing that 36% of respondents who were shown the Icon Boot without any logos or branding (net of the control) identified the boot as coming from only one company and specifically named Timberland—exceeding the levels found sufficient in other cases. TBL is not challenging the district court’s findings regarding the weight to be given the survey for secondary meaning given the other compelling record evidence of direct consumer association. However, even with its alleged flaws, the survey established that the Government’s alleged similar third-party boots have not had any significant marketplace impact. That’s because, contrasted against the many respondents who mentioned Timberland when shown the Icon Boot, only two other companies received 2% of mentions, with the remaining few receiving 1%. [JA3077-JA3078.]

often with the Timberland name or tree logo not visible. From viewing just the boots' design, well over 1,000 people spontaneously identified them as "Timberlands" (or synonymous names, like "Tims" or "Timbs") on their own without any prompting, posting comments like:

- "rihanna only person I know who can slay a pin stripe blazer with some timbs" [JA3681]
- "I feel like wearing my timbs now" [JA3722]
- "she looks so cool in those timberlands" [JA3725]
- "That's why I love J-lo, she wearing timberland's" [JA4453]
- "Jlo is still rockin Timbalands" [JA4470]
- "Love how you rock tims!" [JA4478]

The district court completely disregarded the 1,000+ consumer comments like these above showing that—day in and day out—people spontaneously name Timberland when they see the Icon Boot absent any logo or branding. [JA1834, JA1840-JA1843, JA1845, JA3077-JA3078, JA3083-JA3085, JA3670-JA4860.] That so many people are able to specifically name the source of the product without any logo or other branding (which is not required for secondary meaning) is powerful *direct evidence* of secondary meaning, providing "proof positive that consumers who see the [Icon Boot Design] in real life associate that boot design specifically with Timberland." [JA3084.] And these posts have certainly been seen,

as they were collectively “liked” by nearly 17 million people on Instagram.

[JA3084.]

In sum, when considering TBL’s (a) direct social-media evidence—demonstrating *directly* that consumers associate the Icon Boot Design with one source, and specifically Timberland; (b) extensive advertising and expenditures; (c) over \$1 billion in U.S. sales, \$100 million *annually* for almost a decade; (d) widespread unsolicited media coverage; and (e) continuous and substantially exclusive use for decades, the district court’s finding that the Icon Boot Design lacks secondary meaning is clearly erroneous.²⁰ Courts have found secondary meaning for footwear designs based on comparable evidence. *See e.g., Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 226 (2d Cir. 2012) (finding secondary meaning in Louboutin’s red-sole trade dress when used on shoes with a contrasting upper); *adidas-Am., Inc. v. Payless Shoesource, Inc.*, 546 F. Supp. 2d 1029, 1057 (D. Or. 2008) (determining that adidas’ Superstar Trade Dress had acquired secondary meaning).

²⁰ The district court relies on statements made by TBL’s former officers nine years ago during prosecution of a different application for the color yellow. [Op._24.] But that application did not seek protection for the Icon Boot Design and did not have the diversity and quantity of secondary-meaning evidence presented here. Indeed, TBL has offered tens of thousands of pages of evidence to show consumers recognize the Icon Boot in a wide array of colorways and patterns. [JA3262-JA3264, JA3668, JA3370-JA3656, JA5311-JA5327, JA7715-JA7728, JA7730-JA7763, JA7767-JA7780, JA7782-JA7783.]

E. The district court’s decision is contrary to public policy and undermines the purpose of trade dress protection.

Hoping to justify findings, the court postulated it “would be antithetical to the pro-competitive objectives of both trademark law and patent law” to strip the public’s right to copy and benefit from the Icon Boot Design’s features. [Op._14.] This fear is unfounded and is an unfortunate byproduct of the court’s misguided analysis of the design’s individual elements. Recognition of the Icon Boot Design *in its entirety* as protectable trade dress will not result in monopoly protection for any individual element competitors may wish to use. *See Fuddruckers, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837, 842 n.7 (9th Cir. 1987) (“Viewing the elements as a whole does not result in monopoly protection for necessary elements. If Fuddruckers were to get protection for its trade dress . . . it could not preclude other [competitors] from using those items.”); *Target*, 228 F. Supp. 2d at 1204 (rejecting Target’s argument that adidas’ trade dress hinders competition; “adidas may not prevent competitors from using strips, stripes, . . . bars, . . . heel patches, flat soles, or rubberized toes into their shoe designs. However, it can prevent competitors from using those elements in a way that, viewed as a whole, is likely to cause confusion.”). TBL does not seek to protect the individual elements. Rather, it seeks to protect very specific iterations of those elements, combined together to form a highly distinctive and recognizable boot design—and one whose

existence and success owes to its aesthetics, not its utility (which, candidly, is lacking).

Moreover, the record shows that there is no competitive need to use the Icon Boot Design. It exists in a sea of tens of thousands of available alternatives on the market and serves to separate TBL's boot from the pack. It does not practice the claims of any utility patent; improve the boot's durability, comfort, or waterproof capacities; or make the boot cheaper or simpler to produce (to the contrary).

Through a comprehensive array of potent, diverse, and reliable evidence, TBL also demonstrated that the Icon Boot Design has acquired secondary meaning. To hold otherwise (and deny registration to one of the most celebrated American fashion icons, when so many other footwear designs have been awarded registrations) would conflict with legal precedent, undermine trademark policy, and disserve the public interest. Indeed, allowing the PTO's refusal to stand will discourage attempts to register any footwear or apparel designs, as TBL's evidence goes far beyond that which has justified such designs over many years. And it will discourage investment in these important source-identifiers, which companies and the public rely on to distinguish products in the marketplace. Denying registration would also increase consumer search time and costs, the potential for consumer deception, and unjustly hinder brand owners' efforts to protect the fruits of their

labor—undercutting the very tenets of trademark law and policy.²¹ For almost 50 years, consumers have relied on the Icon Boot Design as a promise of consistent quality, and TBL has developed substantial goodwill from investing in what it has built into “one of the most recognizable shoes of all time.” Neither should be taken away. This Court has the power to correct a significant error, and doing so will promote fair competition, while benefiting trademark owners and the public.

VI. CONCLUSION

For all the foregoing reasons, TBL respectfully requests this Court to reverse the district court’s December 8, 2022 decision, and remand it with directions to enter judgment TBL’s favor.

²¹ Trademark law is designed to (1) protect the public so that “in purchasing a product bearing a particular trademark which it favorably knows, [the consumer] will get the product which it asks for and wants to get;” and (2) to protect trademarks as property, so that a trademark owner like TBL who spends “energy, time, and money” promoting a trademark “is protected in his investment from its misappropriation by pirates and cheats.” *Two Pesos*, 505 U.S. at 782, n.15 (Stevens, J., concurring); citation omitted). *See also* William M. Landes & Richard A. Posner, *THE ECONOMICS OF TRADEMARK LAW*, 78 *TRADEMARK REP.* 267, 277 (1988) (“[T]rademarks enable the consumer to economize on a real cost because he spends less time searching to get the quality he wants.”). The PTO’s refusal frustrates both objectives.

REQUEST FOR ORAL ARGUMENT

Pursuant to Local Rule 34(a), TBL respectfully requests that this Court hear oral argument in this appeal. Oral argument is appropriate here because it will assist in classifying the issues and promote the efficient use of judicial resources.

Dated: May 1, 2023

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

This brief complies with the type-volume limits because, excluding the parts of the brief exempted by Rule 23(f) of the Federal Rules of Appellate Procedure and the Local Rules of the Fourth Circuit, this brief contains 12,634 words.

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