

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

REPLY BRIEF OF APPELLANT

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I. The USPTO’s attempts to prop up the district court’s analysis are insufficient.

A. The district court failed to engage in the critical inquiry of whether the trade dress, as a whole, is functional.

The USPTO argues the Icon Boot Design should be barred registration because the district court cited “overwhelming evidence” that the design, as a whole, is functional. Resp. Br. at 29 (Dkt. 32). But beyond the hyperbole, there’s nothing in the record that touches on “the critical functionality inquiry” of “whether the *trade dress as a whole is functional.*” *CTB, Inc. v. Hog Slat, Inc.*, 954 F.3d 647, 665 (4th Cir. 2020) (emphasis added). Not a single patent covers the whole Icon Boot Design. [JA90-91]; Opening Br. at 34-36 (Dkt. 21); *see also* Br. of *Amicus Curiae* the International Trademark Association (“INTA Br.”) at 5, 11, 14-15 (Dkt. 22). And not one ad touts any functional advantages of the *entire* design. This glaring evidentiary void warrants reversal and remand.

With no evidence pertinent to the whole Icon Boot Design, the court turned its focus from the forest to the trees, analyzing the boot’s eight “features” and, one by one, looking at patents and advertisements purportedly showing that each *individual* feature acts as *that* feature is “supposed to.” [JA91.] To get there, the court had to contort and misconstrue the features. All the while, it failed to address (and in some instances even acknowledge) the potent contrary evidence presented by TBL. *See* INTA Br. at 11 (INTA noting in its amicus brief that “without

addressing these specific distinctions [over the patents], and without expressly considering the design as a whole, the District Court decision simply concluded without detailed analysis that the design is functional because each of these elements is functional.”) (Dkt. 22).

Even disregarding the court’s myopic and legally erroneous focus on parts versus whole, its findings still do not establish functionality.

B. The district court should have evaluated all four *Morton-Norwich* factors.

To assess functionality, the Fourth Circuit applies the four *Morton-Norwich* factors. *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41 (CCPA 1982); *McAirlaids, Inc. v. Kimberly-Clark Corp.*, 756 F.3d 307, 313 (4th Cir. 2014). The USPTO argues that if the first two factors constitute “strong evidence” of functionality, this compels a finding of functionality without considering the remaining two. Resp. Br. at 29.

Applying less than all four *Morton-Norwich* factors is the exception to the rule—only applicable when the “strong evidence” threshold is met for the first two factors. In *CTB*, because the court was presented with “substantial and uncontroverted evidence” of functionality based on the first two factors, it did not consider the last two. *CTB*, 954 F.3d at 659, 662-64; *see also TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001) (finding a “strong evidentiary

inference of functionality” based on plaintiff’s expired patents that claimed the entire asserted trade dress).

In *CTB*, the plaintiff owned a *single* utility patent that depicted *both* halves of the bird-feeder design at issue, disclosed functional benefits of *both* halves, and—critically—explained how the *two parts should be interlocked* to function properly. 954 F.3d at 660, 664-65. The asserted trade dress was thus the “central advance” of a “prior patent” that the court found to be of “vital significance” and “strong evidence” of functionality. *Id.* at 660.

This case is different. Here, the court cobbled together disclosures from a dozen patents and one application—all but two owned by third parties and none disclosing any functional benefit of the whole Icon Boot Design. [JA80-89.] Further, the record in *CTB* showed advertising “focusing on the utilitarian advantage” of the *entire* product design. 954 F.3d at 660. Not so here. The ads cited by the USPTO, and relied on by the court, do not extoll the virtues of the *entire* Icon Boot Design, let alone its individual features with any specificity.

With no patents claiming the Icon Boot Design *as a whole*, this case is much more like *McAirlaids* than *CTB*. In *McAirlaids*, patents covered a process and a material, while the trade dress covered a pattern resulting from the patented process. 756 F.3d at 312. The court looked to whether the “feature in question is shown as a useful part of the invention” and, finding that not to be so, held that

McAirlaid's trade dress was not the "central advance" of any patent. 756 F.3d at 312 (quoting *TrafFix*, 532 U.S. at 30). It then proceeded to consider the other *Morton-Norwich* factors. *McAirlaids*, 756 F.3d at 312-14. The same analysis should follow here.

Consideration of the entire Icon Boot Design under all four *Morton-Norwich* factors would have dictated a different result. The evidence shows that the entire Icon Boot Design is not "essential to the use or purpose" of boots (demonstrated at least by myriad alternative boot designs). *Id.* at 310 (citations omitted). The design is also more expensive, complex, and time consuming to manufacture. Opening Br. at 45-46. Accordingly, nothing would be taken from the public in finding the Icon Boot Design protectable. *Id.* at 39-46, 68-70.

C. The USPTO's functionality analysis of the eight features is legally irrelevant and factually inaccurate.

1. To be relevant, the functional advantage of the applied-for trade dress must be the "central advance" of the cited patents.

The USPTO oversimplifies the law and misstates TBL's arguments. TBL does not argue that the applied-for trade dress on whole must be claimed in a patent (although no such patent exists here, unlike in *TrafFix* or *CTB*). Opening Br. at 39-40.

Rather, TBL accurately argues that trade dress must be the "central advance" of a patent. *Id.* at 39-40. While the "central advance" may be the subject of a

patent's claims, it need not be. A patent can disclose that other designs have utilitarian advantages, even without explicitly claiming the material. But merely mentioning a design in a patent without attributing a functional benefit to it is insufficient. *See McAirlaids*, 756 F.3d at 312.

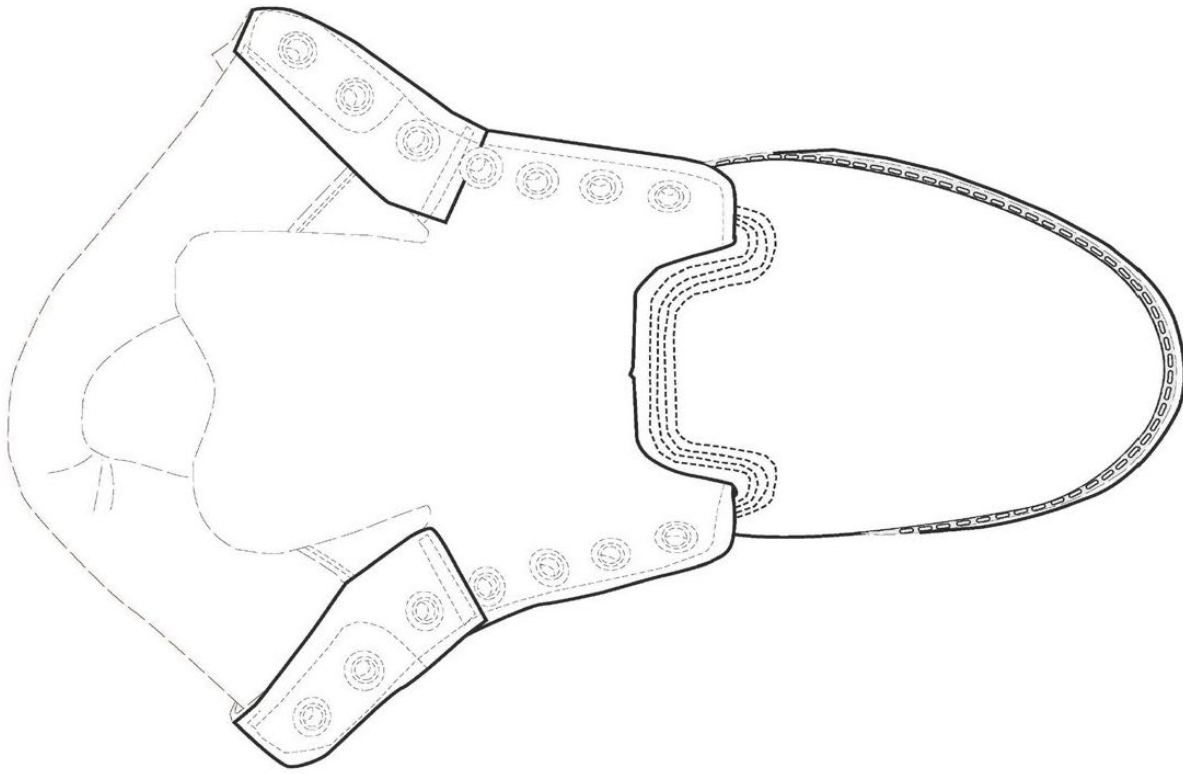
The USPTO's reliance on *In re Becton, Dickinson & Co.* is also misplaced. There, the specification of Becton's patent taught "functional benefits of two important features of [its] *proposed* mark." 675 F.3d 1368, 1375 (Fed. Cir. 2012) (emphasis added). Here, however, the patents relied on by the district court do not *describe* any functional advantage of the Icon Boot Design *as a whole*, let alone its parts, rendering those patents irrelevant to the first *Morton-Norwich* factor.

2. The district court clearly erred in specific factual findings under *Morton-Norwich* factor no. 1.

In concluding the Icon Boot Design's individual elements are disclosed in the cited patents, the court (at the USPTO's urging) misunderstood and misconstrued the elements, effectively analyzing the *wrong* features—ones *not* part of the Icon Boot Design. Along the way, the court did not substantively address (or even acknowledge) most of TBL's arguments, evidence, and/or expert testimony showing and explaining how and why the cited patents do not functionally describe each individual feature. These fundamental errors leave "a definite and firm conviction that a mistake has been made." *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1526 (4th Cir. 1984).

a. The district court clearly erred in finding the Icon Boot Design has an interior ankle collar.

In analyzing the Icon Boot Design’s ankle collar, the court assumed this element includes an *interior* collar—one that faces towards the wearer’s leg, describing its function as providing a “comfortable fit around the ankle [that] helps keep out debris.” [JA80.] Not so. The collar element comprises just the “*external* appearance of a tube-shaped ankle collar on the *outside* surface of the product” with the notable *express* exception of “material on the *inside* of the ankle collar not being claimed[.]” [JA250 (emphasis added).] The applied-for ankle collar thus extends “*away* from the wearer’s leg” never coming in contact with the leg. [JA411-419.] This is also shown in the application’s drawing, which claims *nothing* inside the boot:

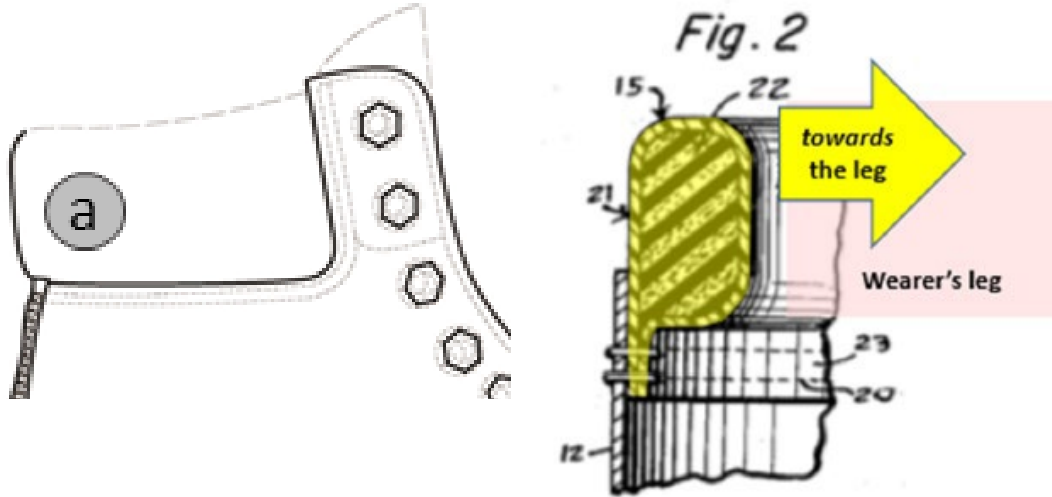


[JA246].

Moreover, the court relies on a dissection of the exemplar boot¹ [JA80-81] and concludes that the *unclaimed* elements function similarly to three patents. But none of those patents attribute the stated functions to an “ankle collar on the *outside* surface of the product.” [JA411-413.] U.S. Patent No. 3,803,731 [JA5090-5092] requires a collar with a “closed generally P-shaped [padding] element”

¹ For multiple elements, the district court was misled by the USPTO expert’s dissection of the exemplar boot, which contains elements not claimed in the Icon Boot Design (and that are thus irrelevant), like the “interior collar.”

facing “*inwardly* towards the wearer’s leg” as shown below (in yellow) [JA5092 (2:9-40, 47-48)], not found in the Icon Boot Design. [JA411-413.]



(a) applied-for ankle collar on the boot exterior '731 patent, Figure 2, annotated

Similarly, it was error to rely on U.S. Patent No. 7,730,640’s [JA5023-5050] stated benefit of its collar providing “comfort,” for example, “around the ankle region of the wearer” [JA80-81] because the Icon Boot Design’s collar *extends away from* the wearer’s ankle. [JA411-413.] And that collar is not the central advance of the ’640 patent, which is directed to an improved interchangeable cartridge system to adjust the interior volume of a shoe and a magnetized toe tool. [JA5050 (citing to ’640 patent, at 19:1-20:51)]. U.S. Patent No. 3,545,107 is likewise irrelevant because it touts the functional benefit of an *interior* collar designed to “conform” to the wearer’s leg. [JA248 (2:6-21).]

b. It was clear error to find the “two color tone” outsole functional.

The USPTO initially deemed the two-color outsole “nonfunctional” [JA251.] This makes sense. The two-color outsole was a deliberate aesthetic choice by TBL, created by using specific dye colors, not dictated by materials or function. [JA431, JA439-444, JA4877.]

The court’s analysis was off-base because neither U.S. Patent No. 1,559,532 [JA5071-5073] nor U.S. Patent No. 3,793,750 [JA5074-5079] relates to the creation or appearance of a two-tone colored sole.² [JA431, JA435-438.] The court appears to have been misdirected by the USPTO’s expert, Mr. Whatley. He assumed that color difference arose from having two layers of the same material of different hardnesses. [JA431.] But TBL presented incontrovertible evidence that both layers can be produced in a variety of colors—including the *same* color—and that TBL specifies the exact color variation to create the two-tone effect. [JA440-441 (company documents specifying Pantone Brown Sugar 17-1134 TPX for the outsole layer and Pantone Dachshund 18-1033 TPG for the midsole layer).]³ The

² To the extent the court credited Whatley’s dissection of the exemplar boot, that was inappropriate because the court needed to consider only the colors on the *exterior* of the outsole, which is evident from the drawings in TBL’s application.

³ TBL also presented evidence that the soles of the exemplar boot are made from different materials. [JA439-441.]

court did not address this discrepancy, simply adopting the USPTO’s incorrect position wholesale.

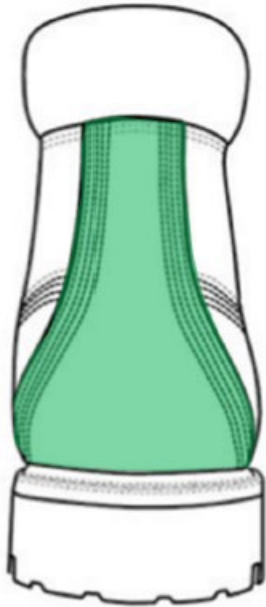
c. The court’s findings on the “lug sole” were based on the underside tread, which is not part of the Icon Boot Design.

The USPTO defends the court’s conclusion that the “lug soles” of the applied-for trade dress “improves traction.” Resp. Br. at 9-10. But the Icon Boot Design is not directed to the “lug soles” but to the “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.” [JA250 (emphasis added).] Accordingly, the court’s reliance on Swiss Patent 214,887 [JA5080-5085] was erroneous because it discloses the functional advantage of additional traction from the lug sole on the *underside* of a boot, which is not part of the applied-for design. [JA445-446.]

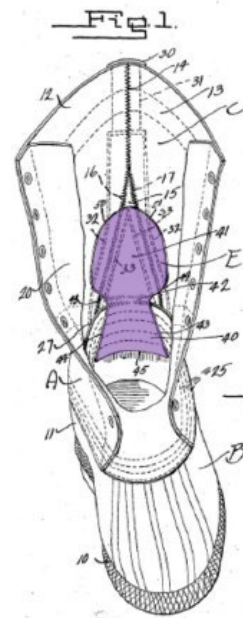
d. The patent relied on by the court does not disclose the hourglass-shaped rear heel panel of the Icon Boot Design.

The applied-for trade dress includes “an hourglass-shaped *rear* heel panel, defined by four vertical stitching lines from the top of the *outsole* to the rear collar.” [JA250 (emphasis added).] The USPTO also conceded that this element is nonfunctional before the TTAB. [JA251.] The sole patent the USPTO now relies on, U.S. Patent No. 1,620,712, titled “Inside Protecting Stay for Leather Top Rubbers” [JA5094-5100] is directed to an “improved” *inner* backstay (shown in

purple). [JA5098 (2:26-28).] While the '712 patent extolls many functional virtues of a backstay (also known as a heel panel) generally, the patent *does not disclose* an hourglass-shaped heel panel (shown in green). [JA451-453.]



Icon Boot Design's hourglass-shaped rear heel panel



Inner backstay of '712 Patent

It was clear error for the court to attribute the functional advantage described in the '712 patent to a *different shape*, namely the hourglass-shaped rear heel panel of the applied-for trade dress.⁴

Moreover, the existence of alternative backstay shapes that, according to the '712 patent, perform the function of “stitch[ing] together the two edges of the upper or vamp along the rear” [JA84], shows that the shape of the rear heel panel is

⁴ While it depicts an outer backstay (“K”) as having a shape that is closer to the applied-for design (but still not an hourglass), the '712 patent sets forth no functional benefits of this particular shape. [JA453-454.]

not functional. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 775 (1992) (“[A] design is legally functional . . . if it is one of a limited number of equally efficient options available to competitors[.]”).

e. The court cites no patent covering the Icon Boot Design’s quad-stitching “forming an inverted ‘U’ shape around the vamp line.”

Citing several patents, the court found “quad-stitching” functional because “additional rows of stitching improve durability,” “security,” limited “movement of the seam,” and “resist[ing] the effects of rot, mildew, and stress” [JA85-87]. The USPTO repeats these arguments. Resp. Br. at 12-14.

This is all clearly erroneous because “quad-stitching” is not a standalone element of the Icon Boot Design. The design claims only a *specific configuration* of “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.” [JA250.] The court failed to appreciate this in finding quad-stitching, generally, and not as claimed in the Icon Boot Design, was functional. [JA85-87.]

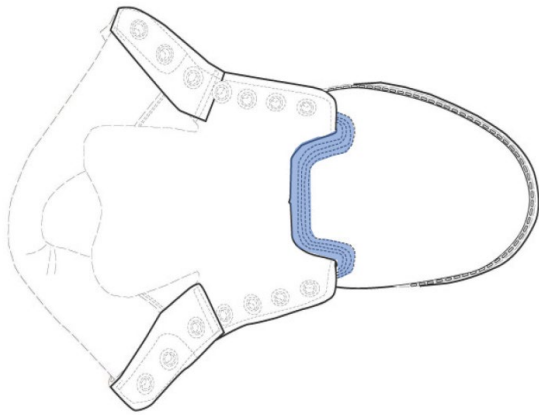
Importantly, none of the cited patents sets forth functional advantages to using quad-stitching to form “an inverted ‘U’ shape around the vamp line.”⁵ That is likely why the PTO previously conceded this as another nonfunctional element below. [JA251.] It was clearly erroneous for the court to find that *any* of those patents support a finding that quad-stitching forming “an inverted ‘U’ shape around the vamp line,” as described in the Icon Boot Design, was functional when not a single patent actually discussed this configuration, let alone as its central advance.

f. The court clearly erred by adopting the USPTO’s inaccurate description of the vamp-line element.

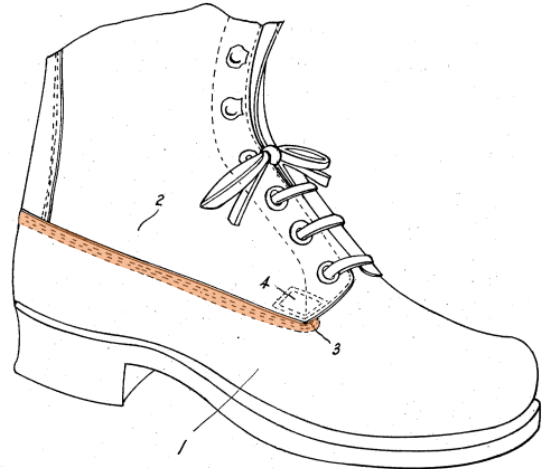
Even though the Icon Boot Design’s vamp line is “an inverted ‘U’ shape” that extends “in front of the boot at the bottom of the tongue and curving around to the left and right sides and ending at the cinched portion of the hourglass stitching of the rear heel panel” [JA250], the USPTO misconstrues it simply as “a feature for joining the upper and vamp with a notch and a stitch line that curls under the

⁵ U.S. Patent No. 1,360,177 [JA5101-5102] and U.S. Patent Application No. 2021/0145124 [JA4974-4980] do *not* show quad-stitching, much less stitching forming an inverted “U” shape configuration described in the Icon Boot Design. [JA399-410. And U.S. Patent No. 1,725,749 [JA5020-5022] depicts quad-stitching in a *different* configuration (not an “inverted ‘U’ shape). [JA386-387.] Finally, U.S. Patent No. 799,685 [JA4981-4984] depicts four rows of stitching, but again not in the “inverted ‘U’ shape,” and does not claim any unique functional benefit to four rows of stitching. [JA4983 (ll. 97-104).]

upper” (Resp. Br. at 14). In agreeing with the USPTO, the court effectively altered the element to make it fit within the functional description of the “vamp line” in U.S. Patent No. 1,360,177 [JA5101-5102]. But, as shown below, the two designs are quite different:



[JA399-402].

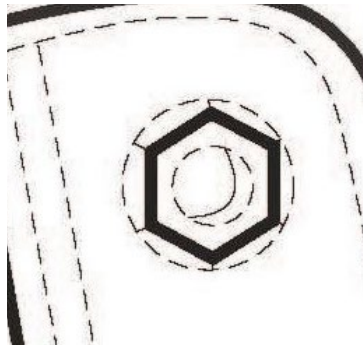


“Vamp line” disclosed by the ’177 patent [JA5154] (highlighted in orange)

The ’177 patent is missing *any* depiction (or discussion) of the “‘U’ shape around the vamp line in *front* of the boot at the bottom of the tongue” as shown in blue above. [JA250 (emphasis added).] Relying on the ’177 patent was thus clear error.

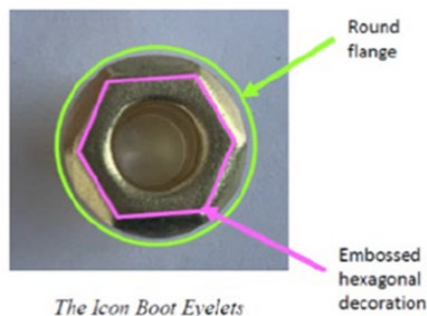
g. The district court misunderstood the basic shape of the Icon Boot Design’s eyelets.

The court also misconstrued the Icon Boot Design’s eyelets. The applied-for trade dress shows and describes “eyelets shaped hexagonally on the exterior-facing outside surface” [JA250]:



*Eyelet Shown in Drawing
for Icon Boot Design
Application*

Consistent with this drawing, in the exemplar boot, the embossed hexagonal design decoratively sits *atop* the round eyelet (formed from a round blank), although the round flange of the eyelet is not part of the Icon Boot Design [JA424-429]:



*Eyelet Used in
Exemplar Icon Boot*

Yet the court repeatedly described the eyelets as “hexagonal,” not appreciating that shape is simply a decorative feature that sits *atop* the eyelet, whose exterior shape is not part of the Icon Boot Design. [JA87-88.] Thus, the court found U.S. Patent No. 138,221 [JA5103-5105] relevant because it discloses “hexagonal eyelets . . . [that] can be stamped with less wasted metal *than round eyelets.*” [JA88.] Not so for the Icon Boot Design, which does not include the exterior shape of the eyelet.

Moreover, the claimed appearance of the eyelet’s embossed hexagonal decoration does not make the boot more durable, easier to use, or efficient to produce. [JA429-430, JA4840-4843.] To the contrary, the decoration is more expensive and time consuming to make. [JA429-430, JA4840-4843.]

h. The district court clearly erred by mischaracterizing the toe-box element of the Icon Boot Design.

While the USPTO argues the bulbous toe box is functional because the exemplar boot is worn in a “work environment,” it simultaneously acknowledges the boot does not meet OSHA requirements for a safety boot. (Resp. Br. at 16-17.) Indeed, the bulbous toe design is not “require[d]” for safety toe inserts (somehow adding “incremental safety” like a crumple zone of a car) nor is it “healthy because the toes can move inside the boot, thereby increasing circulation to the foot.” [JA88-89.] The evidence shows otherwise. Both science and common-sense dictate that it is the material—not the specific bulbous shape—of a boot that provides

durability, demonstrated by the variety of different non-bulbous toe boxes used across actual safety footwear:



*Ariat 10" Groundbreaker Wide Square
Toe Steel Toe Boots [JA483]*



*Reebok Pitch Line Composite Toe SD
Boots [JA484]*



*Justin Original Work Boots Cappie ST,
[JA485]*

[JA482-487.] TBL proved this through standard industry compression and impact-resistance testing showing that several Timberland PRO® safety boots, built with steel toe caps, are much stronger than the Icon Boot, which is made with a thin plastic liner. [JA469-490, JA4875-4876, JA4879-4833.] The court's automotive

crumple zone analogy is thus incomplete and imperfect. Like a boot, 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 non-functional. So too with a boot, like the Icon Boot.

Regarding “foot health” benefits, the USPTO’s expert conceded the design’s toe shape does not prevent bunions. [JA5126-5127.] Other features, unrelated to the toe-box shape and not part of the Icon Boot Design, such as material used and softness of the sole, are what’s important to prevent bunions. [JA461-469.]

Finally, the court’s reliance on U.S. Patent No. 8,359,772 [JA5051-5060] was clear error. [JA88-89.] It discloses a “toe cap,” but fails to describe a specific shape—much less one that tracks the Icon Boot Design’s toe box. [JA5059 (4:18-21; 4:35-36).] Indeed, there are multiple alternative toe-box designs that provide the same (and often better) function of “protect[ing] the toes against the impact from objects falling” [JA5058 (1:20-24)], demonstrating nonfunctionality under the third *Morton-Norwich* factor. The court’s finding otherwise was clear error.

3. The district court erred in applying *Morton-Norwich* factor no. 2 because none of TBL’s advertising touts any utilitarian function of the Icon Boot Design or its elements.

The court relied on generalized TBL advertisements touting certain benefits, but none involving the Icon Boot Design or its elements in particular. [JA393-396, JA417-418, JA464.] For example, the court relied on advertising about the extra

comfort of padded leather collars [JA80], but this statement pertains to the *inner* collar (Resp. Br. at 6)—not the decorative *exterior* collar claimed in the Icon Boot Design—which never touches the wearer’s ankle.

Likewise, the court credits advertisements that soles made of two materials have antifatigue and waterproof advantages and are replaceable. [JA81-83.] While this might be so, the Icon Boot Design does not claim a two-component sole, but rather a sole with *two-color tones*, which have no bearing on these advertised benefits.

Regarding TBL ads mentioning strong stitching, the benefits of quad stitching is referenced *in conjunction with other technology* not part of the Icon Boot Design, including “seam-sealed construction.” [JA4904.] One ad even specifically explained that quad stitching was a non-utilitarian design choice—“four rows of stitching when three would be plenty.” [JA4905.]

As for ads touting waterproofing, TBL’s expert explained it is the specific *combination* of seam-sealed construction, waterproof leather, and injection molding that makes the Icon Boot waterproof. [JA386-396.] Moreover, no ads specifically attribute waterproofing to the Icon Boot Design’s quad-stitching “forming an inverted ‘U’ shape around the vamp line.” And ads touting the benefit of additional traction for hiking afforded by lug soles touch on a feature not claimed in the Icon Boot Design, its underside.

Further, it is irrelevant that the Icon Boot has been called a “work boot” in the past because, by today’s standards, it is not appropriate 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. [JA491-492]; *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 trade dress as performance basketball shoes, it had no bearing on whether the trade dress was functional by today’s standards). On this point, the court was stuck in time when it characterized the Icon Boot Design’s origin as a work boot, failing to acknowledge or understand that’s far from the case today.

D. The USPTO’s “assemblage of the parts” theory does not save the district court’s faulty analysis.

Hoping to fill the evidentiary void created by the court’s failure to analyze the Icon Boot Design *as a whole*, the USPTO argues that the court considered the “amalgamation” of the eight elements and found that functional. (Resp. Br. at 34.) The USPTO posits the eight elements, when arranged into the Icon Boot Design, are “nothing other than the assemblage of functional parts,” analogizing to *CTB*, 954 F.3d at 665, and *Leatherman Tool Grp., Inc. v. Cooper Indus., Inc.*, 199 F.3d 1009, 1013 (9th Cir. 1999). (Resp. Br. at 34.) This argument fails for several reasons.

First, the court plainly analyzed the functionality of each element in isolation, at most making a passing reference to the Icon Boot Design as a whole, but certainly not analyzing the design as an “amalgamation.”

Second, this ignores the law, which recognizes that the arbitrary combination of functional features may form a nonfunctional whole. *Tools USA & Equip. Co. v. Champ Frame Straightening Equip. Inc.*, 87 F.3d 654, 658 (4th Cir. 1996) (“That individual elements of packaging are functional does not, however, render the package as a whole unprotect[a]ble.” (quoting *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1538 (11th Cir. 1986))); *Blumenthal Distrib., Inc. v. Herman Miller, Inc.*, 963 F.3d 859, 867 (9th Cir. 2020) (“[A] product’s overall appearance is necessarily functional if *everything* about it is functional, not merely if *anything* about it is functional.”) (emphasis in original); *Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, 644 (6th Cir. 2002) (finding an arrangement of functional elements “can constitute more than the sum of its non-protectable parts”); *Sunbeam Prods., Inc. v. West Bend Co.*, 123 F.3d 246, 256 (5th Cir. 1997) (“[A] particular arbitrary combination of functional features, the combination of which is not itself functional, properly enjoys protection.” (citation omitted), *abrogated on other grounds by Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225 (5th Cir. 2010)).

This is especially so for complex designs, like the Icon Boot Design. [JA384.] Indeed, the record reflects the existence of “thousands—if not tens of thousands—of [other] boot” designs illustrating that there are many ways to arrange the common elements of a boot to arrive at a different overall design. [JA496-498, JA506-792, JA798, JA2438-2454, JA4802-4815, JA4817-4850, JA4854-4869.] The existence of these alternative designs shows that others compete successfully in the boot market without adopting the Icon Boot Design, so protection of the Icon Boot Design “would not impinge upon the rights of others to compete effectively . . . the litmus test of functionality.” *Sunbeam*, 123 F.3d at 257. And this principle is not limited to boots. Indeed, in its amicus brief, INTA showed multiple designs where individual elements all serve a utilitarian purpose but were found nonfunctional as a whole, including a kitchen mixer, an athletic shoe, and a scooter, amongst others. INTA Br. at 22-23. If the Icon Boot Design is deemed functional, then these iconic product designs must be too.

This case is also not like *CTB* (where the patent disclosed functional benefits of interlocking the two halves of a bird feeder, as explained above) or *Leatherman*. In *Leatherman*, there was no evidence that any feature of the multi-function pocket tool (other than its name) was ornamental. *Leatherman*, 199 F.3d at 1013. Indeed, *Leatherman* touted the superiority of the tool’s overall design and the tool’s designer agreed. *Id.* Based on this evidence, the court held it would be “semantic

trickery to say that there is still some sort of separate ‘overall appearance’ which is non-functional.” *Id.* Not so here. As TBL’s expert explained, the Icon Boot Design’s eight elements are “aesthetic, diverse, and located in different areas of the shoe,” necessarily precluding “any suggestion that one or more of them combine mechanically to create a functional advantage.” [JA384.]

This case is more like *Blumenthal Distributing*, where the Ninth Circuit found a chair design nonfunctional, noting that examining the trade dress as a whole means “examin[ing] all of its features, including the ways in which its various parts are combined or arranged, and to recognize that nonfunctional combinations or arrangements of functional parts can create an overall appearance that should be deemed nonfunctional.” 963 F.3d at 866. Further, in *Blumenthal Distributing*, the Ninth Circuit distinguished Leatherman’s “pocket-knife-like tool,” and other “thoroughly utilitarian” products from Herman Miller’s Eames chairs. *Id.* at 867 (distinguishing the chairs from the tool for cutting a seatbelt in *Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 786 (9th Cir. 2002), and the traction hoist in *Secalt S.A. v. Wuxi Shenxi Const. Machinery Co.*, 668 F.3d 677, 687 (9th Cir. 2012)). The court found that in *Leatherman*, there was no evidence of any non-utilitarian design choices; however, in *Blumenthal*, Herman Miller introduced evidence that the Eames chairs’ overall appearances derive from non-

utilitarian design choices. *Blumenthal Distributing*, 963 F.3d at 867. That is certainly so with the Icon Boot Design.

Because the court clearly erred in failing to apply all four *Morton-Norwich* factors and did not explain why the Icon Boot Design as a whole (or as an assemblage of elements) is functional, the decision should be reversed and remanded.

II. The USPTO raises no persuasive arguments on secondary meaning.

A. The USPTO did not carry its burden of showing the marketplace impact of third-party boots.

Beyond parroting the court’s finding that the market was purportedly “saturated” with look-alike boots, the USPTO points to no evidence showing that third-party boots had a sufficient market presence to impact the strength of the Icon Boot Design. As the party seeking to rely on evidence of third-party boot designs to challenge TBL’s potent evidence of marketplace strength, the USPTO had the burden to show that those designs were commercially meaningful. *See Combe Inc. v. Dr. August Wolff GmbH & Co. KG Arzneimittel*, 382 F. Supp. 3d 429, 452-453 (E.D. Va. 2019) (finding defendant’s evidence of 66 similar third-party marks “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 sold or promoted in the United States,” and (2) several

marks “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), *aff’d*, 851 F. App’x 357 (4th Cir. 2021).

Tellingly, the USPTO does not even put forward a specific number of third-party boots on which it is relying. Considering the many thousands of boots in the U.S. marketplace, the handful of third-party designs in the record can hardly be considered market “saturation.” *See AmBrit*, 812 F.2d at 1537 (“Isolated or piecemeal third party uses of various elements of the Klondike trade dress do not detract from the distinctiveness of the overall impression conveyed by the combination of those elements on the Klondike wrapper.”). Significantly, the USPTO cannot (and does not) dispute that there was absolutely *no* evidence in the record regarding when any of the third-party boots were first offered for sale, how long any of them may have been offered for sale, whether any of the boots were actually sold, and whether any sales made a sizable marketplace impact. Without that evidence, the court’s finding regarding market “saturation” lacks any factual basis and is erroneous.

B. TBL’s enforcement against third-party lookalikes is entitled to weight.

While the USPTO recognizes that “efforts to plagiarize the mark” can show that a design has acquired distinctiveness,⁶ it argues the third parties imitating the Icon Boot Design cannot support a finding of secondary meaning because TBL did not produce any *documents* showing that TBL took action against those parties. The absence of documents is irrelevant because TBL introduced un rebutted employee testimony regarding two separate instances where TBL stopped third parties (including giant Levi Strauss) from selling boots that blatantly copied the Icon Boot Design. [JA5484; SA1-2.] Because both matters were resolved via telephone, there were no written communications to produce. The USPTO neither takes issue with this testimony nor points to anything in the record challenging or undermining its credibility, and it was clear error for the court to disregard it. *See Vans, Inc. v. Walmart, Inc.*, No. 21-cv-01876, 2022 WL 1601530, at *6 (C.D. Cal. Mar. 31, 2022) (finding support for secondary meaning from two successful enforcement examples); *Venetian Casino Resort, LLC v. Venetiangold.Com*, 380 F. Supp. 2d 737, 743 (E.D. Va. 2005) (finding support for secondary meaning from two successful enforcement examples).

⁶ 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.”) (citations omitted).

C. While TBL's survey is not necessary for a finding of secondary meaning, it supports that the Icon Boot Design has acquired distinctiveness.

The USPTO discusses TBL's secondary meaning survey at length, even though TBL indicated in its opening brief that it was electing not to challenge the court's findings regarding the weight to be given the survey results for secondary meaning. Opening Br. at 65 n.19. TBL elected not to challenge those factual findings because the survey results are ultimately not necessary for the Court to find clear error with respect to secondary meaning, considering the other compelling evidence of direct consumer association in the record.

Nonetheless, even were the Court to consider the survey as the USPTO urges, and even accepting the alleged flaws as described by the USPTO (which TBL disputes), the difference between the parties' views on the level of secondary meaning shown by the survey results was marginal. While TBL believes the survey established 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 *also* specifically named Timberland) (Opening Br. at 65 n.19), the USPTO puts that number at 28.2% (Resp. Br. at 22, 25. Even assuming the USPTO's calculations are correct, courts have concluded that such percentages weigh in favor of a finding of secondary meaning. *See Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 795 (5th Cir. 1983) (affirming that 28%

association with Zatarain's by name, coupled with circumstantial evidence of advertising and usage, established secondary meaning), *abrogated on other grounds by KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Centaur Commc'ns, Ltd. v. A/S/M Commc'ns, Inc.*, 652 F. Supp. 1105, 1111 (S.D.N.Y. 1987) (finding 22% of recognition "actually tends to support, not negate, plaintiff's claim of secondary meaning"), *aff'd* 830 F.2d 1217 (2d Cir. 1987).

The verbatim company name mentions provided by respondents in the survey are yet another data point weighing in favor of secondary meaning. Of the test group respondents who indicated they associate the Icon Boot Design with one company, a whopping 86% (83 out of 97) identified that company as Timberland. [JA338-339.] In contrast, the second-most referenced companies received only 2% of all company mentions.⁷ [JA338-339.]

Examining the survey results in their totality and even accepting the USPTO's arguments regarding the survey's alleged flaws, overall, the survey results support a finding of secondary meaning.

⁷ While it was not TBL's burden to show that the third-party designs introduced by the USPTO *lacked* any commercial impact, the stark disparity between the number of respondents mentioning Timberland and any third-party company forcefully proves this point.

D. TBL’s prior statements do not detract from the extensive unsolicited media evidence showing secondary meaning.

The USPTO attempts to downplay the tens of thousands of pages of evidence showing that consumers recognize the Icon Boot in a wide array of colorways and patterns⁸ by pointing to statements made by TBL’s former officers nine years ago during prosecution of an unrelated application for the color yellow. [Resp. Br. at 42.] As that application did not seek protection for the Icon Boot Design, the statements made there should be weighed accordingly. In any event, “it is well settled that any such statements [to the USPTO during prosecution] do not give rise to estoppel in subsequent proceedings.” *Institutional Wholesalers, Inc. v. Saxons Sandwich Shoppes, Inc.*, 170 USPQ 107, 1971 WL 16746, at *2 (TTAB Mar. 29, 1971); *see also Le-Vel Brands, LLC v. DMS Nat. Health, LLC*, Civil No. 20-CV-398, 2021 WL 3048445, at *4 (E.D. Tex. July 20, 2021) (“The Court agrees with the weight of authority that prosecution-history estoppel does not apply in trademark cases.”); *Polo Fashions, Inc. v. Extra Special Prods., Inc.*, 451 F. Supp. 555, 561 (S.D.N.Y. 1978) (finding trademark owners are not bound by statements made to the USPTO in *ex parte* trademark prosecutions).

⁸ The USPTO’s singular focus on yellow boots misrepresents the record evidence showing that boots bearing the Icon Boot Design are not limited to any specific color. [JA496-498, JA798, JA506-792, JA2438-2454, JA4802-4815, JA4817-4850, JA4854-4867, JA4868-4869.]

Significantly, neither the district court nor the USPTO challenges let alone addresses TBL’s evidence that well *over 1,000 people*—just by viewing the Icon Boot Design, without any prompting or logos present, and whether or not the boots were yellow—were able to identify the boots as “Timberlands” (or the like).

[JA799-1989.]

E. Both the USPTO and district court fail to address the case law holding that house logos or other branding do not undermine secondary meaning.

TBL pointed to substantial case law in its opening brief (including two Federal Circuit cases) holding that the presence of house marks or other branding in ads does not undermine an ad’s effectiveness in building rights and secondary meaning. (Opening Br. at 57.) Significantly, one of the Federal Circuit cases reversed the Trademark Trial and Appeal Board on this precise issue, holding that the TTAB erred as a matter of law in finding that the presence of the BRIDGESTONE house mark in ads diminished the strength of the asserted POTENZA and TURANZA marks. *See Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 1336-37 (Fed. Cir. 2012). The USPTO neither distinguishes these cases nor cites any contrary authorities, saying only that the court “appropriately found” that the presence of other marks weighs against

acquired distinctiveness of the boot design.⁹ Resp. Br. at 42. Given how common it is in today’s market for trade dress to contain house marks or other branding, the Court should adopt the reasoning of the cases cited by TBL and hold that the presence of house marks or other branding does *not* undermine secondary meaning. *See, e.g., Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1374-75 (Fed. Cir. 2002). To find otherwise would not only go against the prevailing case law, but from a practical standpoint, make it virtually impossible for product designs to ever acquire distinctiveness when the designs also contain house marks or other branding. *See 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.”).

F. Effectively requiring look-for advertising sets the bar too high for brand owners to establish secondary meaning, and is not supported by the law.

The USPTO concedes that TBL’s sales of the Icon Boot Design have been “impressive” but argues the court correctly disregarded this evidence on the ground there was no “look-for” advertising tying the sales success specifically to

⁹ The USPTO also does not challenge or even address the scores of advertising and promotional examples that feature the Icon Boot Design without any conspicuous logo on the boot or other branding prominently visible. (Opening Br. at 50-53.)

the Icon Boot Design. Whether the court gave “heavy weight” to the absence of look-for advertising or effectively required it, affirming the district court’s holding in this regard would make it virtually impossible for owners of even the most commercially successful product designs to prove secondary meaning unless they engage in a highly specific (and uncommon) form of advertising. Tellingly, the USPTO does not distinguish any of the numerous cases cited by TBL (including cases from the Fourth Circuit, Third Circuit, Federal Circuit and TTAB) squarely holding that look-for advertising is *not* required to establish secondary meaning. (Opening Br. at 46-50.)

III. Conclusion.

TBL respectfully requests this Court reverse the district court’s decision and remand it with directions to enter judgment in TBL’s favor.

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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 reply brief contains 6,497 words.

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