

UNITED STATES COURT OF APPEALS  
FOR THE FOURTH CIRCUIT

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**TBL Licensing, LLC,**  
Plaintiff–Appellant

v.

**Katherine K. Vidal**, Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office;  
**United States Patent and Trademark Office,**  
Defendants–Appellees

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On appeal from the United States District Court  
for the Eastern District of Virginia at Alexandria

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**Page-Proof Brief for the Defendants–Appellees**

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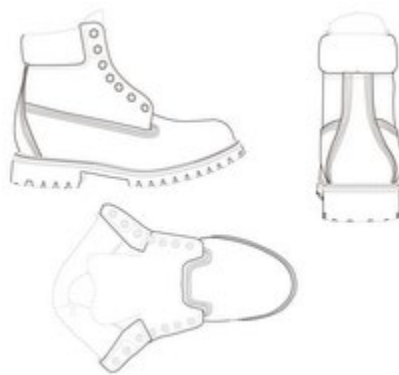
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## **STATEMENT OF THE ISSUES**



1. Trademark law prohibits the registration of functional product designs. Here, the district court found that the boot design shown above is functional, as a whole, after considering the features that make up the design—the toe box, the stitching, the sole, and other features addressed below—because the design makes the boot feel and perform better. The first issue is whether the district court’s finding of functionality is clearly erroneous.

2. A product design also cannot be registered if it has not acquired distinctiveness in the minds of consumers. Here, the district court found that TBL failed to prove that the boot design has acquired distinctiveness because, among other things, many similar boots have saturated the market and TBL’s advertising has touted the functional benefits of the boot. The second issue is whether the district court’s finding of no acquired distinctiveness is clearly erroneous.

Because each issue presents an independent ground for refusing registration, this Court may affirm the district court’s judgment if this Court fails to find clear error for either ground of refusal.

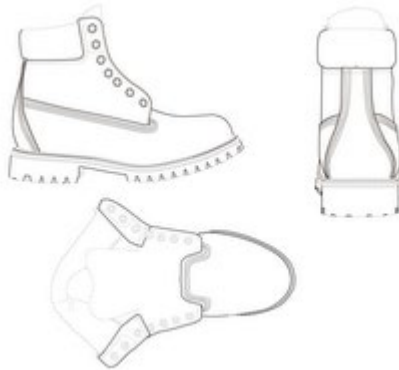


## STATEMENT OF THE CASE AND FACTS

### **I. TBL's application: trade-dress protection for a boot design**

An application to register a product design such as TBL's boot design must include a drawing of the mark defining the portions of the design claimed for protection and a written description. *See* Trademark Manual of Examining Procedure ("TMEP") §§ 1202.02(c), 1202.02(c)(ii).<sup>1</sup>

TBL's application provided the following drawing:



TBL's application provided the following written description:

The mark consists of a three-dimensional configuration of a lace-up boot having an overall shape and silhouette as depicted in the drawings, with **a visibly bulbous toe box** and the following individual features:

(1) 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);

(2) **outsoles having two color tones** divided horizontally

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<sup>1</sup> Available at <https://tmept.uspto.gov/RDMS/TMEP/current>.

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;

(3) **an hourglass-shaped rear heel panel**, defined by **four vertical stitching lines** from the top of the outsole to the rear collar;

(4) **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

(5) **eyelets shaped hexagonally** on the exterior-facing outside surface.

The double row stitching around the rear and side ankle collar, the single stitching around the upper two eyelets on each side, the single stitching along the upper perimeter of the shaft in front of the eyelets and the boot tongue, the appearance of the eyelets on the boot interior, the top of the ankle collar, the bottom, outer most surface of the outsole, and the uppermost surface of the outsole connecting to the boot around the perimeter, all of which are depicted in broken or dotted lines, are not being claimed ... and serve only to show the position or placement of the mark.

[JA1763–1764 (paragraph breaks and bolding added).]

This description reduces to a boot design comprising eight features: (1) the tube-shaped padded collar, (2) the two-tone sole, (3) the lug soles, (4) the hourglass heel panel, (5) quad stitching, (6) the U-shaped end of the vamp

stitching, (7) the hexagonal eyelets, and (8) the bulbous toe box. The application does not claim color as part of the product design. [*Id.*]

## **II. The USPTO's refusal to register: The boot design is functional and has failed to acquire distinctiveness.**

Examination of TBL's application began with a USPTO examining attorney, who refused registration because the boot design is functional and lacks acquired distinctiveness. TBL appealed to the USPTO's Trademark Trial and Appeal Board, which affirmed the examining attorney's refusal based on the lack of acquired distinctiveness; the Board did not reach the issue of functionality. [JA1762–1789.]

## **III. The evidence developed in the district court**

To challenge the Board's decision, TBL filed a civil action, providing the parties an opportunity to augment the agency record and for the district court to consider the case de novo. Lanham Act § 21(b), 15 U.S.C. § 1071(b).

The district court record contains the following evidence:

### **A. Functionality: eight features of the boot design that perform their traditional, intended purposes**

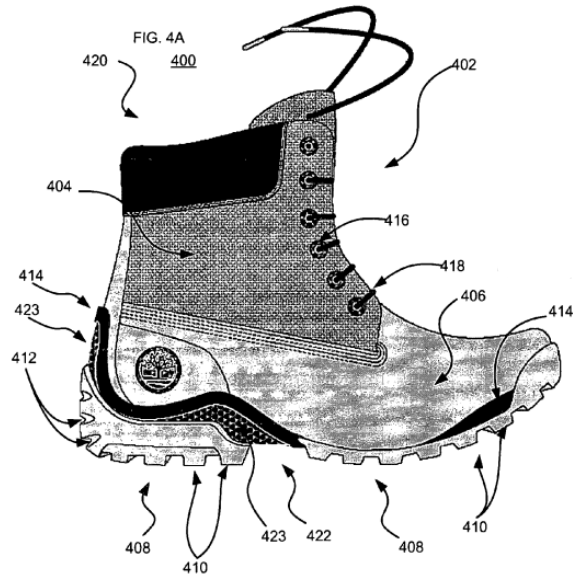
#### **1. Padded tube-shaped ankle collar**

Utility patents, including one of TBL's, disclose soft padded collars like that of the applied-for boot design for comfort and protection from outdoor elements.

U.S. Patent No. 7,730,640 (“TBL’s ’640 patent”), issued in 2010, depicts, as in the illustration to the right, a collar indistinguishable from the collar in TBL’s boot design.

It discloses a “high-performance boot” including an upper that “preferably ... comprises a collar **420** which provides

comfort, for example, around the ankle region of the wearer.” [JA21372–21399, 11:29–32 & Fig. 4A.]



U.S. Patent No. 3,545,107, issued in 1970, discloses a “cushioned upper back portion for reducing and substantially eliminating chafing and binding.” [JA1499–1501; JA1500 (abstract).] The upper back portion “provides a relatively soft, padded, yieldable member ....” [*Id.* (2:11–14).]

And U.S. Patent No. 3,803,731, issued in 1974, discloses a shoe with a collar constructed of a cushioning element and secured to the top edge of the upper opening, which is meant to provide comfortable, light, and firm support without scraping the wearer’s leg. [JA21841–21843].

Before the district court, the USPTO offered the expert testimony of Ian Whatley, a veteran shoe designer, to assess the functionality of the TBL boot design. [JA22055–22056.] Mr. Whatley dissected a Timberland boot, revealing a collar with a tube made of a soft natural or synthetic leather filled with a foam

material like that claimed in the '731 patent. [JA22123 ¶ 176.] Mr. Whatley observed that the exemplar collar acts as a gasket around a wearer's leg, excluding debris, snow, and water from the boot while containing warm air. [JA22126 ¶ 182.]

TBL's advertising and third-party media clips tout the functional benefits of the padded ankle collar. An advertisement features Timberland boots that have "the extra comforts of padded leather collars and glove leather linings." [JA8810.] An article from the men's fashion website Hypebeast also notes this benefit: "The padded collar for a comfortable fit around the ankle helps keep out debris from any circumstance." [JA10281.]

## **2. Two-tone sole**

The two-tone sole adopts a long-known configuration, a multi-hardness two-component sole.

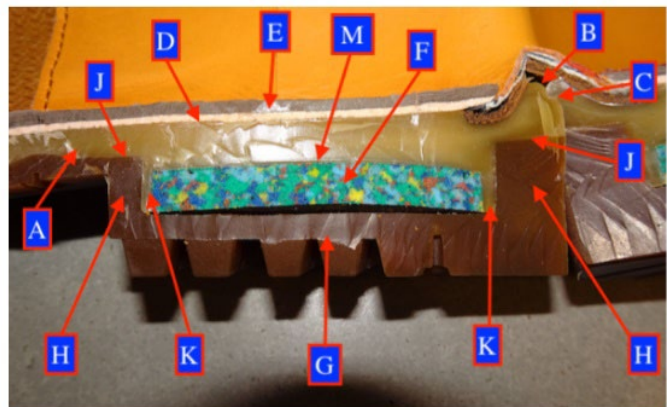
Utility patents disclose that more than one grade of hardness for sole construction improves comfort. U.S. Patent No. 1,559,532, issued in 1925, discloses a resilient sole for boots and shoes. [JA21771–21773.] In one version of the sole, the intermediate sole is preferably made of rubber, rubber fabric, or other suitable waterproof material. [JA21772 (2:74–105).] There is a recess in which material such as "sponge rubber or other soft springy material" can be inserted. [JA21773 (1:7–8).] According to Mr. Whatley, this patent describes "a light weight, cushioned and less expensive method of producing a sole ...." [JA22100 ¶ 112.]

U.S. Patent No. 3,793,750, issued in 1974, discloses an athletic shoe. [JA21792–21797.] The shoe includes an upper portion that is bonded to a two-component sole comprising an intermediate sole made of resilient material such as synthetic rubber whose lower surface is bonded to an outer sole layer made of a harder rubber or other synthetic material. [JA21795 (2:39–46)].

TBL and third parties have touted three functional advantages of this type of sole: It combats fatigue, it's easy to replace, and it's waterproof.

First, the sole combats fatigue because the sole is made of multiple components: a hard rubber outsole, a relatively softer rubber midsole, and, inside the heel, a section of spongy material. In its advertising, TBL has touted that its “exclusive anti-fatigue technology” is built into the midsole. [JA8863.] And TBL has advertised a “light-weight, dual-density sole” comprising a midsole bonded to a durable rubber outsole. [JA8826, JA8803, JA8453.]

Confirming what the advertising touts, Mr. Whatley cut the exemplar boot down the midline to dissect the sole. [JA22101–22102.] As shown in the photograph to the right, the outsole **G** and



midsole **A** are composed of rubber. [*Id.*] The recess in the heel is filled with a sponge rubber or other soft, springy material **F**. [*Id.*] Using an industry-standard instrument, Mr. Whatley found that the exemplar boot's outsole **G** is about 10-

15 degrees harder than the midsole A [JA22105 ¶ 125], just as TBL promotes. [JA8826, JA8803, JA8453.]

Mr. Whatley explained that, in the exemplar Timberland boot, “the midsole and outsole are structurally adapted for different functions. ... Since rubber of different hardness [may be] unmatched in tone or color, a differential or two-tone effect may arise incidentally when this functional construction is adopted.” [JA22105 ¶ 124, JA22106 ¶ 126, JA9055.]

Second, third parties have observed that the sole permits replacement of a worn outsole. The fashion website and store Allsole reports that, “As the upper and sole are two separate pieces, the sole is easily removed and replaced. While Timberland doesn’t currently offer this service, any good cobblers or shoe repair store should be able to replace your well-worn soles.” [JA19668.]

Third, the sole helps waterproof the boot because it is directly bonded to the rest of the boot without stitching. TBL’s ’640 patent teaches that “[t]he midsole ... may connect the upper ... with the outsole ... of the boot ... in a water-tight fashion in order to provide the wearer with protection from water, even when the wearer stands in a certain depth of water.” [JA21393 (7:25–28).] Timberland advertisements tout that the “lug outsoles ... are permanently bonded to the top of the boot to guarantee that feet will stay dry.” [JA250, JA381, JA374, JA369, JA899, JA8452, JA8863.]

### 3. Lug soles

Another feature of the boot design is the lug sole, which improves traction. Swiss Patent No. 214,887 (“Bramani”), issued in 1941, discloses a boot with a rubber sole that has rubber bosses, or lugs, on the outside. [JA21807–21809, JA21811–21813.] The named inventor, Vitale Bramani, is the namesake of the brand Vibram, which makes soles for many shoes on the market today, including Timberland boots.

In his patent, Mr. Bramani explained that the rubber bosses provide superior grip on all terrains, especially on rock, compared to that of prior soles, which were often outfitted with iron nails. [JA21811–21812.] Mr. Bramani also stated that the sole is glued to the boot to make it “perfectly waterproof.” [*Id.*]

As Mr. Whatley explains, the sole of the Bramani patent is the precursor of Vibram’s Carrarmato sole, Vibram’s leading sole on the market today. [JA22112–22113 ¶ 150–55.] Timberland’s classic yellow boot has Vibram Carrarmato soles, which Vibram touts, as in the image below, as having “maximum support and durability.” [JA22115.] Indeed, TBL’s ’640 patent depicts the very Vibram-style lug sole shown in the boot-design application, teaching that the lugs are useful “for traction.” [JA21377–21378, JA21395 (11:37–38, 12:37).] Timberland advertisements and promotional materials highlight the Carrarmato sole and not only characterize the boot as being suitable for hiking and similar outdoor uses, but they also frequently tout the traction afforded by the claimed lug soles [JA22115]:




Timberland Yellow Boot | Dress & Casual | Lifestyle | Partner Products | partners

Sign In and Enjoy Halloween Free Shipping.

SIGN IN | SIGN UP | STORE LOCATOR | SHOE REPAIR LOCATOR | B2B | EUROPE |

SHOP ▾ BRAND ▾ PARTNERS ▾ SUSTAINABILITY ▾

Home




## TIMBERLAND YELLOW BOOT

Timberland Yellow Boot, a true fashion icon and concentrate of technology, is now even more tenacious and high performing.

- GORE - TEX® PrimaLoft® insulation, able to retain heat even in extreme wet condition
- Vibram® Carrarmato outsole


### SOLE



**Carrarmato**

You can't mention Vibram without thinking of the legendary Carrarmato sole. A true international design icon, Carrarmato was created 70 years ago by Milanese mountaineer Vitale Bramani, founder of Vibram. Carrarmato was the first mountaineering sole made of vulcanized rubber. Today it is the only sole that has climbed all of the highest and most difficult peaks in the world. Today, Vibram Carrarmato is available in multiple versions (Vibram Roccia, Montagna, Himail, Saas Maor, Marmolada, Jankuat, Breithorn), each with its own specific properties. With star or spiral cleats, with round or square tips, Carrarmato is always at the top!

### TECHNOLOGY AND COMPOUND



**MONT**

- Tested on the world's highest peaks
- Maintains performance at extremely low temperatures
- Firmer compound for maximum support and durability

Other advertisements tout the same benefits, such as a “[r]ubber lug outsole for durability and maximum traction on any surface.” [JA927; *see also* JA21814–21815, JA21816–21817, JA1091, JA1326–1327, JA13173, JA8549, JA8669, JA10281.]

#### 4. Hourglass heel panel

Another feature of the boot design is a stitched heel panel with an outer boundary that looks like an hourglass. This feature is important to prevent the vamp (the lower part of the boot) and the upper from wearing and degrading from constantly pulling boots on and off, and to avoid having to stitch together the two edges of the upper or vamp along the rear, where it could uncomfortably crinkle and wear over time.

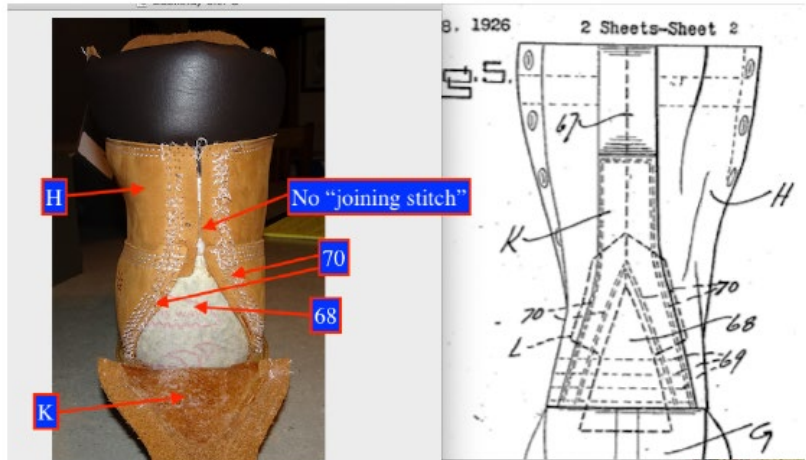
Also called a “backstay” and “heel guard,” this component “is a strip of leather that runs up the back of a shoe or boot,” and is “used for additional stability and sometimes to connect the two halves of the quarter.” [JA20607.] As one magazine put it, a “mark of a good boot is a backstay that runs all the way from the heel to the top of the back of the boot. Double or triple stitching is important here also.” [JA21191–21196, JA21022–21027.]

U.S. Patent No. 1,620,712 (“L.L. Bean”), issued in 1927, discloses an inner and outer backstay for leather-top rubbers. [JA21866–21872.] The inner stay is a “substantially triangular shaped rear insert.” [JA21872 (ll. 1–13.)] The backstay remedies a problem with seam bursting. [JA21870.] When a wearer pulls on the shoes over the heel, the wearer can catch the heel on the shoe, which can tear the stitching that holds the vamp and upper together. *Id.* L.L. Bean’s backstay remedies the problem by “extending across the edge ... at the joint between the vamp and upper ...” [*Id.*] The L.L. Bean patent also claims an “outer back stay” in a configuration that is narrow along the upper part of the back stay and wider as it approaches the heel portion; like the TBL

“hourglass,” the L.L. Bean backstay “effectively protects” the stitching where the two ends of the upper meet in the back of the shoe, or could also “cover the space between the edges of the upper.” [JA21869–21870 (l. 129–l. 19).]

On the exemplar boot, Mr. Whatley showed that, just as in the L.L. Bean patent, the two edges of leather panel **H** do not have an independent stitch

joining them. Instead, hourglass backstay **K** is stitched along the hourglass shape of the edges of the panel **70** to hold everything together. [JA22144.] Mr. Whatley



also pointed out that an hourglass-shaped stay can save money on materials: The upper leather can be smaller because the two ends don’t have to meet precisely at a back Achilles seam. [JA22145 ¶ 240.]

TBL, in effect, promotes this feature of its boot by advertising to customers that they should “be the one who never comes apart at the seams.” [JA8673.]

## 5. Quad stitching

Quad stitching is also part of the boot design, and it has long been known that additional rows of stitching improve durability.

U.S. Patent No. 1,360,177, issued in 1920, discloses a boot stitched with the same configuration as the TBL boot design, explaining that this method of stitching the vamp to the upper not only prevents the front part of the attachment point from “com[ing] into contact with obstacles during use, so that the corner stitching wears and rips,” but also “prevents leakage.” [JA21882–21883 ll. 11–14, ll. 24–31, ll. 41–42.] The patent drawing shows three rows of stitching, but another patent, U.S. Patent No. 799,685, issued in 1905, confirms that four rows are even better when it comes to boots: “There are preferably about four rows of stitches, all or all but one of which by preference pass through all the layers .... This affords great security and durability and effectually prevents leakage at the top of the foot portion.” [JA20882–20885 ll. 97–104.]

U.S. Patent No. 1,725,749, issued in 1929, describes and claims a waterproof seam for a boot. [JA21362–21364.] This patent depicts four rows of stitching to secure the vamp to the upper. It recommends using a sealant such as glue in the lap space between the leathers to reinforce the quad stitching. [JA21363 (2:87–88).]

Mr. Whatley’s photographs of the exemplar boot show that TBL also uses a rubber-type adhesive with four rows of stitching, combining the teachings of these two patents. [JA22130–22131.]

TBL’s U.S. Patent Application Publication No. 2021/0145124 teaches a boot with “[o]ne or more rows of stitches ... [that] run continuously ....” [JA20875–20881; JA20880 ¶ 19.] Although the exemplary boot in this

application has three rows of stitching, the application states that “embodiments may include more than or less than three rows of stitching. An advantage of a continuous stitching and multiple rows of stitching is that the movement of the seam during wear may be limited.” *Id.*

TBL’s advertisements tout not only the boot’s waterproof qualities but, in particular, that “4 ROWS OF STITCHING ... is used to resist rot, mildew, and stress.” [JA494.]

### 6. “U-shaped end” of the vamp stitching

U.S. Patent No. 1,360,177 also teaches that the U-shaped end of the vamp–upper stitching configuration in the applied-for design keeps the boot together over time when worn in outdoor settings, such as where the wearer is walking through brush that could fray and damage the seam attaching the upper to the vamp. [JA21882–21883.] The patent describes and claims this now-commonplace benefit, a feature for

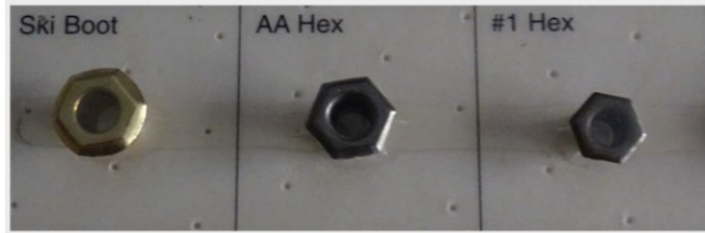


joining the upper and vamp with a notch and a stitch line that curls under the upper in what TBL calls a “U-shape.” Mr. Whatley depicted the patent and the exemplar boot side-by-side to show this. [JA22135.] For both boots, the upper and vamp interlock “so that they may be tightly clasped together.” [JA22135.]

## 7. Hexagonal eyelets

The hexagonal eyelet on TBL’s boot design is a common piece of hardware that can be found on many items of footwear.

Mr. Whatley provided a photo of three hexagonal eyelets that he obtained from



a supplier in the 1990s. The crimped circular flange for the ski boot, as in the photograph above, is essentially the same eyelet on the exemplar Timberland boot, in the photo below. [JA22148.]



Mr. Whatley explained that the hexagonal eyelets result from crimping the sides of the eyelets to securely affix them to the leather. [JA22146, JA22148–22149 ¶¶ 246, 252.] “[T]hese points formed by making the flange in the shape of a hexagon serve as braces, extending radially from all sides of the flange.” JA22148–22149 ¶ 252.

Crimping the sides of an eyelet to create a hexagonal shape is not a new technique. U.S. Patent No. 138,221, issued in 1873, discloses and claims precisely that eyelet. The functional benefits disclosed are that hexagonal eyelets stay secured to the shoe better and can be stamped with less wasted metal than round eyelets. [JA21890–21892, col. 2.] The patent explains that “[t]he

advantages accruing from the hexagonal-flanged eyelet will be appreciable more in connection with the shoe trade than elsewhere.” [*Id.*]

### **8. Bulbous toe box**

Finally, the TBL boot design includes a bulbous toe box, because boots worn in work environments, such as the TBL boot, need to have a safety toe built in to prevent feet from being crushed.

OSHA regulations require safety toes in many work environments. [*See* JA21747–21748.] Safety toes typically are built into the toe box. *See id.* Safety toe inserts require a bulbous toe construction. *See id.* And “rounded bulbous toes” also are “considered to be healthy because the toes can move inside the boot, thereby increasing circulation to the foot.” [*See id.*]

U.S. Patent No. 8,359,772, issued in 2013, which discloses construction boots, explains that a toe cap “protect[s] the toes against the impact from objects falling against the footwear.” [JA21400–21409; JA21407 (1:20–24).]

Although the exemplar Timberland boot does not meet OSHA requirements, Mr. Whatley demonstrated that the boot includes a hard-plastic toe reinforcing element within the bulbous toe box. [JA22091–22096 ¶¶ 89–101.] Mr. Whatley explained that the plastic reinforcing element provides structural and foot-health benefits because the shape is similar, if not identical to, that of boots with officially-approved safety toes. [JA22093–22094 ¶ 94.]

Moreover, Mr. Whatley explained, the shape of the bulbous toe box corresponds to the shape of both competitors’ and TBL’s own OSHA-compliant

safety-toe boots. [JA22093 ¶¶ 92–93.] And even without any plastic or steel insert, the additional room afforded by a bulbous toe box adds incremental safety just like a crumple zone adds safety to a car. [JA22095 ¶¶ 98–99.]

TBL has consistently stated that boots embodying its applied-for design are not only



suitable as a work boot but also that its boots were originally

designed for that purpose. *See id.* Indeed, as Mr. Whatley noted, a sufficiently roomy toe box, such as that provided by TBL’s design, helps prevent bunions, a functional benefit that TBL touted in one of its advertisements, at right.

[JA22088–22089 ¶¶ 81–82, JA21746.] TBL also has touted boots embodying the applied-for design as being suitable for some work projects, as in the photograph to the left. [See JA21759–21765.]





**B. Lack of acquired distinctiveness: one boot of many on the market**

The district court record contains the following evidence about acquired distinctiveness:

**1. A market saturated with look-alike boots**

The evidence before the district court showed that consumers can go to many shoe stores, brick-and-mortar and online, and easily find boots with



hexagonal eyelets, bulbous toe boxes, and the other features that make up TBL's applied-for boot design.

The USPTO offered images of look-alike boots, including the examples to the left (AdTec) and right (Magnum/Foreman). [Casagrande

Decl., JA19651, JA20280.]

Although Timberland boots have been on the market for almost 50 years, TBL never has demanded that competitors cease and desist from selling look-alike boots. [See Casagrande Decl. ¶¶ 5–6].






## 2. Absence of look-for advertising

In almost 50 years on the market, TBL also has failed to engage in any “look-for” advertising, advertising that instructs consumers to “look for” the claimed product design as the designation of source. TBL does not dispute that fact in its opening brief. Any advertising that mentions the boot’s design features touts their functionality, such as “4 ROWS OF STITCHING ... is used to resist rot, mildew, and stress,” and “[r]ubber lug outsole for durability and maximum traction on any surface.” [JA494, JA927.]

## 3. Advertising featuring other Timberland trademarks

Essentially all Timberland boots have a Timberland tree logo or the stylized lettering “Timberland” burned into the leather. [JA21212–21214.]

TBL owns registrations for these marks, including:

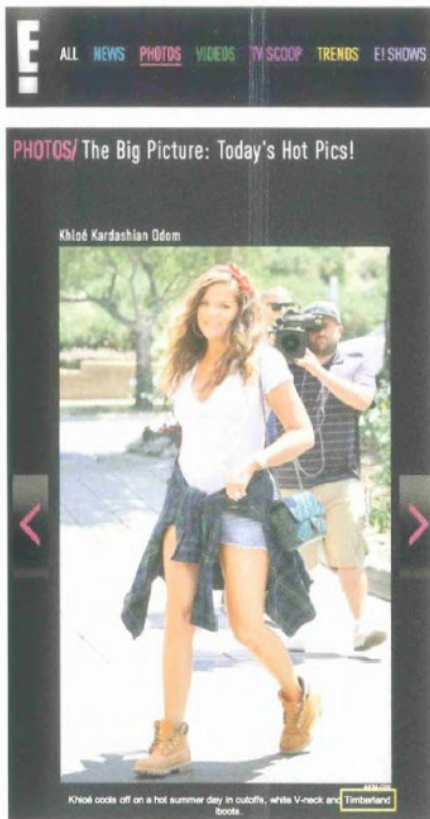
- The word mark TIMBERLAND (U.S. Reg. Nos. 1,300,704 and 2,932,268) [JA21200–21202, JA21206–21208];
- The tree logo  (U.S. Reg. No. 1,075,061) and  (U.S. Reg. No. 2,947,228) [JA21197–21199, JA21209–21211];
- A stylized version of the word mark plus the tree logo **Timberland**  (U.S. Reg. No. 1,355,531) [JA21203–21205]; and
- The word mark TIMBERLAND BOOT COMPANY [U.S. Reg. No. 3,687,531, JA21212–21214].

As one marketing guide explains to distributors, “The Timberland logo stands for quality, durability, and performance, and your customer knows it.” [JA8798.]

Timberland boots are also well-known for a wheat-yellow color scheme. Timberland advertising has long touted “the original yellow boot.” [JA310.]

#### 4. Unsolicited media coverage featuring the unclaimed classic yellow color scheme

As TBL pointed out in the district court, paparazzi have shot many photographs of celebrities wearing Timberland boots; however, most of the



photographs that TBL offered into evidence depicted celebrities wearing the Timberland classic yellow boot, as in the photograph to the left. [JA20434.]

Before it filed the application at issue in this appeal, TBL unsuccessfully applied to register its classic yellow color, rather than the boot design, for trade-dress protection.

[See JA20190–20196 at 20194 ¶ 24; JA20419–20454, JA20419 ¶ 3.] During examination of that application, senior TBL executives

submitted sworn declarations in which they

alleged that paparazzi photos under consideration there depicted the boots from a distance at which only the yellow color, and no other features, could be perceived. [*Id.*]

Despite that sworn testimony, TBL submitted the same paparazzi photos to the USPTO during examination of this application. This time, TBL alleged

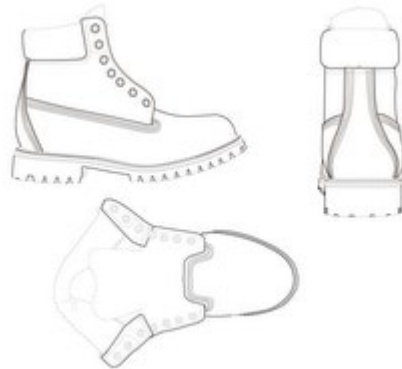
that those photos provided evidence of acquired distinctiveness not of the yellow color but of the eight design features claimed in this application. [*Compare* JA20226, JA20230, JA20232, JA20234, JA20240, JA20242, JA20244, JA20246, and JA20248 *with* JA267, JA391, JA682, JA269, JA393, JA684, JA397, JA688, JA276, JA400, JA691, JA282, JA406, JA697, JA285, JA409, JA700, JA289, JA413, JA704, JA296, JA420, JA711, JA299, JA423, and JA714.]

**5. A consumer survey that nudged respondents to guess Timberland as the answer**

Before the district court, TBL hired Dr. Michael Barone to conduct a survey purportedly designed to test whether consumers associate the applied-for product design primarily with

Timberland.

Dr. Barone had to present respondents with a stimulus, the technical name for an image of the thing being tested for



distinctiveness. While TBL applied to register its product design as defined by the drawing above, Dr. Barone did not use that drawing as the stimulus; rather, he presented respondents with the grayscale photograph to the left. [JA3062.] Dr. Barone asked respondents the following question: “Do you

associate this boot design with any company or companies?” [JA3060–3061.]

Then, Dr. Barone followed up with this question: “What company?” [*Id.*]

The USPTO’s survey expert, Dr. Bruce Isaacson, criticized Dr. Barone’s choice of stimulus and his wording of the questions. [JA22215–22216.]

As Dr. Isaacson explained, the grayscale photograph depicted light-colored boots, suggesting that the boots were of the Timberland classic yellow color.

[*Id.*] And Dr. Isaacson explained that Dr. Barone’s wording encouraged respondents to name Timberland by nudging them toward a single company with the follow-up question “What company?”—singular—even if respondents associated the photographed boot with more than one company. [JA22210–22213.]

Even with Dr. Barone’s skewed prompt, the survey found the percentage of people associating the photograph with Timberland still was only in the 30s. [JA22210–22213.]

#### **IV. The district court’s decision: The boot design is functional and has failed to acquire distinctiveness.**

On December 8, 2022, the district court issued its decision finding that TBL failed to carry its burden to prove that its boot design was nonfunctional and that it had acquired distinctiveness. [Mem. Op., ECF No. 74.]

##### **A. On functionality, the district court found that the boot design, as a whole, is functional.**

The district court first reviewed each of the features making up the claimed design: (1) the padded tube-shaped collar, (2) the two-tone sole, (3) the

lug soles, (4) the hourglass heel panel, (5) quad stitching, (6) the U-shaped end of the vamp stitching, (7) the hexagonal eyelets, and (8) the bulbous toe box.

[Mem. Op. pp. 3–12.] The district court found that each patent discussed above in this brief describes or claims the respective design feature. [*Id.*] The district court also found that advertising and media clips, and Mr. Whatley’s dissection of the exemplar boot supported the finding that each design element is functional. [*Id.*]

The district court then assessed the boot design, as a whole, considering whether the combination of the individually functional components resulted in a non-functional design. [Mem. Op. pp. 13–14, citing *CTB, Inc. v. Hog Slat, Inc.*, 954 F.3d 647, 658 (4th Cir. 2020); *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1372 (Fed. Cir. 2012).]

The district court found that the boot design, as a whole, is functional because it applies the constituent features to perform their ordinary functions, resulting in a boot that performs better because of the design. [*Id.*] As the district court observed,

[U]sage of the claimed features [is] for their precise intended functional purposes: 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. The features of the applied-for boot design as a whole do what these features are supposed to do in any good boot: they make it comfortable, they make it durable, they make it waterproof, and they make it suitable for its intended uses, including hiking through a variety of environments

and pursuing some work projects for which toe protection is needed.”

[*Id.*] And, the district court observed, Timberland’s own advertising touts the functional benefits of the boot design, as a whole. [*Id.*]

**B. On acquired distinctiveness, the district court found that the boot design is no different than the plethora of similar boots on the market.**

As the district court ruled, TBL bore the burden of proving that its boot design had acquired distinctiveness. [Mem. Op. p. 24.]

The district court found that the boot design has not enjoyed exclusive use because of “the saturation of the marketplace with look-alike boots using many of the same functional features,” which, the district court found, “is fatal to TBL’s claim that consumers look for these features to identify TBL’s boots and distinguish them from others.” [*Id.* at 19.]

On advertising expenditures, the district court found that, despite almost 50 years of advertising, TBL has not engaged in any look-for advertising inviting consumers to view the design feature(s) at issue as a source indicator. [*Id.* at 17, 21.]

The district court also found TBL’s evidence of unsolicited media coverage not probative because that evidence depicted the boots with other source identifiers, such as the Timberland word mark and the tree logo, and in Timberland’s classic yellow color scheme. [*See id.* at 17–19.]

The district court declined to give weight to TBL’s consumer survey due to the flaws with the stimulus photograph and the questions. [*Id.* at 24.]

The district court noted, in any event, that the percentage of people associating the photo with Timberland was in the 30s, “a marginal figure, at best.” [*Id.*]

Finally, the district court rejected TBL’s reliance on impressive advertising and sales data: “in assessing sales numbers in product design cases, the inference normally drawn from a product’s market success is that sales reflect the desirability of the product configuration rather than the source-designating capacity of its features.” [*Id.* at 20 (quoting *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431, 1453 (3d Cir. 1994)).]

The district court concluded, “TBL has failed to link-up its large sales and advertising with the one thing it needs to prove: that amidst a sea of similar-looking boots, consumers nevertheless can identify TBL’s product just by the eight specified product features irrespective of any other marks used on or with the product.” [Mem. Op. pp. 20–21.]

### **SUMMARY OF ARGUMENT**

The district court did not clearly err when it found that TBL’s boot design is unregistrable on two grounds: The design, as a whole, is functional; and the design has failed to acquire distinctiveness.



On functionality, the district court found that utility patents disclose, and some even claim, all features of the claimed boot design. The district court also found that TBL has touted the functional benefits of those features over decades of advertising. The district court, thus, had ample evidence on which to find that the boot design, as a whole, adds up to no more than the sum of its functional parts—a good boot, perhaps, but a functional boot, nevertheless.

On acquired distinctiveness, the district court weighed the factors set forth in this Court’s precedent and had ample evidence on which to find that the boot design has not attained source-identifying significance in the minds of consumers. Among other things, the district court found that the market is awash in look-alike boots, look-alike boots that TBL has failed to police for almost 50 years. The district court also found that TBL’s advertising practices and survey evidence did nothing to help TBL’s case.

Because copious evidence supports the district court’s findings, this Court should affirm the district court’s judgment. And, because functionality and acquired distinctiveness are independent grounds for refusing registration, this Court may affirm the district court’s judgment as long as it finds no clear error for at least one ground.

### **STANDARD OF REVIEW**

The parties agreed to submit this case to the district court on cross-motions for summary judgment and to authorize to district court to resolve any issues of

material fact. The district court, in substance, conducted a trial on a stipulated record. [Mem. Op. p. 2.]

Functionality is a question of fact. *CTB, Inc. v. Hog Slat, Inc.*, 954 F.3d 647, 658 (4th Cir. 2020). Acquired distinctiveness is also a question of fact. *U.S. Search, LLC v. U.S. Search.com Inc.*, 300 F.3d 517, 525 (4th Cir. 2002); *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1372–73 (Fed. Cir. 2012).

This Court reviews the district court’s factual findings for clear error and its legal determinations de novo. *Int’l Bancorp, LLC v. Société des Bains de Mer et du Cercle des Etrangers à Monaco*, 329 F.3d 359, 362–63 & n.4 (4th Cir. 2003); *Satellite Tel. & Assoc. Res., Inc. v. Cont’l Cablevision of Va., Inc.*, 714 F.2d 351, 354 (4th Cir. 1983).

Clear error is a deferential standard of review. *Walsh v. Vinoskey*, 19 F.4th 672, 677 (4th Cir. 2021) (cleaned up; citations omitted). A factual finding is not clearly erroneous unless “the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed.” *Id.*

The question is not whether this Court would reach a different result on a clean slate, but whether “the district court’s account of the evidence is plausible in light of the record viewed in its entirety. If so, we may not reverse the district court’s conclusion—even if we may have weighed the evidence differently.” *Id.* This is the case even when the district court’s findings do not rest on credibility determinations but are based instead on physical or documentary evidence or inferences from other facts. *Id.*

## ARGUMENT

### **I. The district court did not clearly err when it found that the boot design, as a whole, offers nothing more than the functional benefits of its constituent elements.**

#### **A. The law of functionality: Utility patents and advertising are supreme evidence.**

Product design such as TBL’s boot cannot receive trade-dress protection, and is barred from registration, if the design, as a whole, is functional.

Lanham Act § 2(e)(5), 15 U.S.C. § 1052(e)(5). A product feature or design is functional “when it is essential to the use or purpose of the device or when it affects the cost or quality of the device.” *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 33 (2001). Trade-dress protection may extend only to “ornamental, incidental, or arbitrary” product features that identify the source of the product. *CTB*, 954 F.3d at 658 (quoting *TrafFix*, 532 U.S. at 30).

That rule strikes a balance between trademark law and patent law:

The former protects reputation, potentially in perpetuity, because registered trademarks do not expire as long as they continue to designate source; the latter promotes innovation with a patent grant for a limited term of 20 years from the date of filing. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164–65 (1995). When a patent expires, the claimed invention enters the public domain, advancing innovation. *TrafFix*, 532 U.S. at 34–35. Thus, even if functional trade dress has acquired distinctiveness, the Lanham Act bars registration because the matter should be protected, if at all, by patent law rather than trademark law. *See id.*; Lanham Act § 2(f), 15 U.S.C. § 1052(f).

Courts apply four factors—with an important qualification—to assess whether a product design is functional: (1) the existence of utility patents disclosing the applied-for design, (2) advertisements and other promotional materials touting the functional benefit of the design, (3) the existence of alternative designs, and (4) any effect on the manufacturing or quality of the product. *CTB*, 954 F.3d at 657–58; *see also In re Morton–Norwich Prods., Inc.*, 671 F.2d 1332 (CCPA 1982).

The qualification: A showing on the first two factors, utility patents and advertisements, compels a finding of functionality, because “a prior patent ‘has vital significance . . .,’ constituting strong evidence that the features therein claimed are functional.” *CTB*, 954 F.3d at 660 (quoting *TrafFix*, 532 U.S. at 29). Indeed, for the third factor, alternative designs, the Supreme Court and this Court have made clear that when evidence under factors (1) and (2) shows that the design is functional, inquiry into whether alternatives are available to competitors is “foreclosed.” *Id.* at 659–60, 662 (citing *TrafFix*, 532 U.S. at 33–34); *see also Valu Eng’g v. REXNORD Corp.*, 278 F.3d 1268, 1276 (Fed. Cir. 2002) (explaining that there is “no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available.”).

Here, the district court cited overwhelming evidence to find that TBL’s boot design, as a whole, is functional. Utility patents disclose, and some claim,

the features of TBL’s design, and TBL’s own advertising touts the functional benefits the features.

**B. Utility patents and advertising leave no doubt that each of the eight design features is functional.**

Evidence relevant to the first two factors conclusively proves that this case does not involve any “ornamental, incidental, or arbitrary aspect[s]” of boots. *See TrafFix*, 532 U.S. at 30. Each of the claimed features is common in the industry and has been for decades.

**1. Utility patents**

If a utility patent discloses the benefits of the applied-for features, that disclosure is “strong evidence” of functionality, and the applicant bears the “heavy burden” of proving the features non-functional, “for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.” *TrafFix*, 532 U.S. at 29–30.

A two-sentence primer about utility patents is helpful to understand the evidentiary value of utility patents in a functionality analysis: A patent’s claims are the legal metes and bounds of what the inventor claims a right to protect, while a patent’s written description, or “disclosure,” is a narrative that explains how the invention works. *See generally* Manual of Patent Examining Procedure § 601(I).<sup>2</sup> Patents almost always disclose more in the written description than an

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<sup>2</sup> Available at <https://mpep.uspto.gov/RDMS/MPEP/current>.

inventor recites for patent protection in the claims, including explaining how the elements in the claims actually improve function. *See id.*

In addition to the claims, written description in a patent and an applicant's statements to the USPTO referring to utilitarian advantages of design features during examination of a patent application weigh in favor of functionality. *Id.*; accord *Valu Eng'g*, 278 F.3d at 1279. That is true regardless whether the features are claimed; the law "does not require that a patent claim the exact configuration for which trademark protection is sought in order to undermine an applicant's assertion that an applied-for mark is not de jure functional." *Becton, Dickinson*, 675 F.3d at 1375. Even a showing that patents discuss the benefit of two out of many features of a design is enough to constitute strong evidence of functionality. *See id.* at 1370, 1375.

As the full discussion in the statement of facts above shows, at least one utility patent discloses each feature of the TBL boot design, and some patents claim the features. [Mem. Op. pp. 3–12; *see also supra* pp. 4–17.] Many of the patents are expired, with some dating to the late 1800s and early 1900s. *See id.* As the district court observed, those facts present serious competition concerns, because "the disclosed features are in the public domain. To conclude that TBL can strip the public's right to copy and benefit from these features today would be antithetical to the pro-competitive objectives of both trademark and patent law." [Mem. Op. p. 14.]

## **2. Advertising**

Advertising extolling useful advantages of the design is also strong evidence of functionality. *CTB*, 954 F.3d at 660 (relying on plaintiff’s advertising touting the functionality of the design at issue); *see also Becton, Dickinson*, 675 F.3d at 1376.

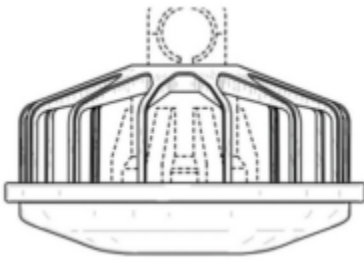
The record is replete with materials published by TBL and third parties such as the media extolling the functional benefits of each element of the boot design. While a complete accounting of those materials is provided above [*see supra* pp. 4–17], notable ones include a Timberland advertisement touting boots that “[c]an be found with the extra comforts of padded leather collars and glove leather linings,” and “antifatigue technology” with a “light-weight, dual-density sole.” [JA8810, JA8826, JA8803, JA8453.]

## **3. As a whole, the design offers nothing more than the functional benefits of the individual features.**

As the district court found, “[t]he features of the applied-for boot design, as a whole, do what these features are supposed to do in any good boot: they make it comfortable, they make it durable, they make it waterproof, and they make it suitable for its intended uses, including hiking through a variety of environments and pursuing some work projects for which toe protection is needed.” [Mem. Op. p. 14.] That finding clearly is correct.

This Court has addressed the distinction between a registrable product design, which amounts to more than the sum of its constituent parts, and an unregistrable product design, which does not. An example of an unregistrable

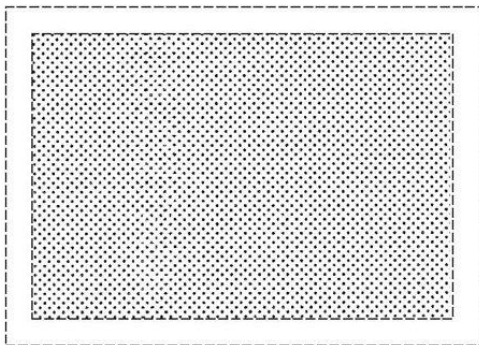
design is the chicken feeder at issue in *CTB*, reproduced here. 954 F.3d at 664.



There, this Court agreed with the district court’s findings that the upper, spoke portion and the bottom, pan portion of the feeder were individually functional. *Id.* at 659–65. This Court then

considered whether the entire design amounted to anything more than those two functional parts. *Id.* at 665. It did not: “[T]he pan must be positioned beneath the spoke assembly for the two to interlock and function as intended. . . . The overall feeder profile thus results from a simple and utility-driven amalgamation of its two functional halves.” *Id.*

In contrast, this Court found a genuine issue of material fact about whether an embossing pattern on an absorbent material, reproduced here, was non-functional. *McAirlaids, Inc. v. Kimberly–Clark Corp.*, 756 F.3d 307 (4th Cir.



2014). There, McAirlaids embossed holes on cellulose absorption sheets intended for medical and food uses. *Id.* at 314. McAirlaids had obtained patents on the sheet material and on a method for making the sheets with a high-pressure technique; however, McAirlaids had

not patented the pattern for embossing the holes. *Id.* Because the record contained conflicting evidence about whether the embossing pattern had a functional purpose, this Court held that a jury should decide whether the design,



as a whole, was functional rather than the district court on summary judgment: “[T]here remains a dispute of material fact as to whether a specific embossing pattern is ‘the reason the device works’ or ‘merely an ornamental, incidental, or arbitrary aspect of the device.’” *Id.* at 314 (quoting *TrafFix*, 532 U.S. at 34).

Here, TBL’s boot design is an amalgamation of eight features that make the boot function, just as the chicken feeder in *CTB* was an amalgamation of an interlocking spoke assembly and pan that made the feeder function. Although TBL contends that looking at the boot design, as a whole, “changes the result completely,” Opening Br. 36, this Court has rejected such an argument, observing that, “where the whole is nothing other than the assemblage of functional parts, and where even the arrangement and combination of the parts is designed to result in superior performance, it is semantic trickery to say that there is still some sort of separate ‘overall appearance’ which is non-functional.” *CTB*, 954 F.3d at 665 (quoting *Leatherman Tool Grp., Inc., v. Cooper Indus., Inc.*, 199 F.3d 1009, 1013 (9th Cir. 1999)).

In sum, the district court had ample evidence on which to find that the boot design, as a whole, is functional; thus, the district court correctly concluded that it was.

**C. TBL fails to demonstrate clear error in the district court’s functionality findings.**

**1. A court may examine the individual features of a product design before considering the design, as a whole.**

While TBL contends that the district court “dissected” the boot design, a court may properly consider the functionality of each component as the court determines whether the design, as a whole—the combination of the constituent features—is functional. *See* TBL Opening Br. 33–34.

That is the way this Court considered the functionality of the chicken feeder in *CTB*. First, it examined the “upper spoke section” of the feeder and determined that its components were functional. 954 F.3d at 659–64. Then, it examined the “bottom half” of the feeder, finding that each component of that element also was functional. *Id.* at 664–65. This Court then assessed “whether the trade dress as a whole” was functional. *Id.* at 665. It observed that “Plaintiff offer[ed] no reason why the combination of two wholly-functional components—the pan and the spoke assembly—gains some non-functional character that qualifies the entire feeder for trade dress protection.” *Id.* As a matter of law, “the total feeder profile [was] functional and ineligible for trade dress protection.” *Id.* That is precisely the analysis that the district court employed here.

**2. A design need not be the “central advance” of a utility patent for that patent to be evidence of functionality.**

TBL argues that the utility patents cited by the district court are not probative because the boot features in question are not a “central advance” of

the patents. TBL Opening Br. 36. The INTA amicus brief proposes the same rule, arguing that a cited patent must claim a product design. *See* INTA Br. 12. TBL and INTA are merely re-packaging the argument that the boot features do not infringe the cited patents, an argument that the courts have rejected.

“[R]eadability of patent claims on structure is not the test of functionality for trademark purposes.” *In re Bose Corp.*, 772 F.2d 866, 872 (Fed. Cir. 1985). Likewise, “[r]elevance does not require proof that a claim of the patent would ‘read on’ the claimed trade dress in the sense that the trade dress design would infringe under the law of patents.” 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (5th ed. 2022) § 7:89.30.

While TBL and INTA purport to glean the “central advance” or “patent claim” requirement from *TrafFix*, that decision contains no such requirement. *See* 532 U.S. at 30–32. There, the Supreme Court observed, as a factual matter, that the dual-spring feature of an outdoor sign was claimed in utility patents and was a “central advance” of that sign. *Id.* But the “central advance” was not the only aspect of the utility patents that the Court found probative. *Id.* The Court also found probative the patents’ written descriptions and representations that the patent owner made during prosecution of the patents. *Id.*

Indeed, “statements in a patent’s specification illuminating the purpose served by a design may constitute equally strong evidence of functionality.” *Becton, Dickinson*, 675 F.3d at 1375 (citations and internal quotations omitted).

As shown above, all the patents that the district court cited illuminate the purposes of the features disclosed. [*See supra* pp. 4–17.]

**3. The district court was entitled to give no weight to the availability of alternative designs and to the expense of the design features when the utility patents and advertising established functionality.**

TBL argues that its agglomeration of design features is not functional because there are equally functional alternatives for each that competitors can be forced to change to; TBL also contends that the design that it desires to monopolize is more expensive to produce than others. TBL Opening Br. 43–46. But the Supreme Court has held that when utility patents provide strong evidence of functionality, “[o]ther designs need not be attempted” by competitors, for to countenance otherwise would be anticompetitive. *TrafFix*, 523 U.S. at 33–34. For that reason, this Court has held that strong evidence of functionality in utility patents “precludes” the consideration of available alternative designs. *CTB*, 954 F.3d at 659–60, 662. The evidence on the first and second factors here is so strong that it decides the functionality question. The district court did not clearly err by deciding the case that way.

**II. The district court did not clearly err by finding that TBL’s boot design has failed to acquire distinctiveness.**

To be registrable, a proposed mark must “identify and distinguish [a producer’s] goods ... from those manufactured or sold by others and ... indicate the source of the goods....” *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 209 (2000). That ability to identify and distinguish a producer’s

goods from those of others is called “distinctiveness”; a proposed mark comprising product design always requires proof of acquired distinctiveness to be protected. [*See id.* at 212; TMEP § 1202.02(b)(i).]

Acquired distinctiveness, also known as secondary meaning, requires proof that, “in the minds of the public, the *primary* significance of a product feature or term is to identify the *source* of the product rather than *the product itself*.” *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982) (emphases added). This Court has made clear that “secondary meaning entails a rigorous evidentiary standard.” *George & Co. v. Imagination Entm’nt Ltd.*, 575 F.3d 383, 395 (4th Cir. 2009) (citation omitted); *U.S. Search*, 300 F.3d at 525. The “rigorous evidentiary requirements” of proving acquired distinctiveness are hard to meet in product-design cases because, normally, it is difficult to parse out how much of a product’s sales success is due to the inherent desirability of the product as opposed to whether consumers see the product’s design as a source identifier: “Consumers are aware of the reality that, almost invariably, even the most unusual of product designs—such as a cocktail shaker shaped like a penguin—is intended not to identify the source, but to render the product itself more useful or more appealing.” *Wal-Mart*, 529 U.S. at 213. So, “[i]n the context of product design marks, it is imperative that the evidence of acquired distinctiveness ‘relate to the promotion and recognition of the specific configuration embodied in the applied-for mark and not to the goods in general.’” *In re Jasmin Larian, LLC*, 2022 USPQ2d 290, at \*39 (TTAB 2022)

(quoting *In re Change Wind*, 123 USPQ2d 1453, 1467 (TTAB 2017) (further citations omitted)). “Secondary meaning cannot be proven by advertising that merely pictures the claimed trade dress and does nothing to emphasize it or call attention to it.” 1 *McCarthy* § 8:8.50.

Six factors are considered in assessing acquired distinctiveness:

(1) advertising expenditures; (2) consumer studies linking the mark to a source; (3) record of sales success; (4) unsolicited media coverage; (5) attempts to plagiarize the mark; and (6) the length and exclusivity of the plaintiff’s use of the mark. *George & Co.*, 575 F.3d at 395 (citing *Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 125 (4th Cir. 1990)).

The district court examined TBL’s proof against that legal backdrop. Although the district court acknowledged that TBL has spent a lot of money on advertising and that TBL has sold a lot of boots, the district court correctly found that the evidence overwhelmingly compelled a finding of no acquired distinctiveness. [Mem. Op. pp. 16–25.]

**A. The district court did not clearly err in weighing the six acquired-distinctiveness factors.**

**1. The design has not enjoyed exclusive use for any amount of time.**

As the district court found, “[t]he saturation of the market with look-alike boots using many of the same functional features is fatal to TBL’s claim that consumers look for these features to identify TBL’s boots and distinguish them from competing boots.” [Mem. Op. p. 19.] This state of affairs is at odds with

the principle of acquired distinctiveness, which requires that a mark or dress have “come through use to be *uniquely* associated with a specific source.” *Two Pesos, Inc. v. Taco Cabana Int’l, Inc.*, 505 U.S. 763, 766 n.4 (emphasis added; citation omitted); *George & Co.*, 575 F.3d at 394 (“a mental association in buyers’ minds between the alleged mark and a *single* source of the product”) (emphasis added; citation omitted).

Here, there is copious “evidence point[ing] strongly away from a finding of secondary meaning,” including “the existence of other similar [boot] designs which compete with the [TBL] design.” *Cicena Ltd. v. Columbia Telecommc ’ns Grp.*, 900 F.2d 1546, 1552 (Fed. Cir. 1990). At the threshold factor of exclusive use, TBL’s claim of acquired distinctiveness as a unique source indicator, which consumers could use to distinguish one source from another, fails.

**2. Even if others have copied the boot design, TBL has failed to enforce its rights for nearly 50 years.**

One of the factors potentially relevant to acquired distinctiveness is evidence of “efforts to plagiarize the mark.” *George & Co.*, 575 F.3d at 395. TBL argues that any similar boots on the market should be considered infringers. But, as the district court found, TBL has identified no court findings that anyone has been found to have copied these features in violation of the Lanham Act. [Mem. Op. p. 22.] TBL does aver that it successfully persuaded two of its many competitors to change their allegedly similar-looking boots; however, as the district court observed, in response to a USPTO document request for documentation of this alleged enforcement activity, TBL produced

no communications with either company. [Mem. Op. p. 22; *see also* Casagrande Decl. ¶¶ 5–6]; *see also* *Norfolk & W. Ry. Co. v. Transp. Commc'ns Int'l Union*, 17 F.3d 696, 702 (4th Cir. 1994) (“the drawing of an adverse inference against a party who fails to come forward with relevant evidence within its control is a reasonable and well-recognized evidentiary rule”) (citations omitted).

**3. TBL’s consumer survey was fatally flawed, a finding that TBL does not challenge on appeal.**

As explained above, TBL’s consumer survey was rife with irregularities. *See supra* pp. 21–22] The district court agreed, finding that “the report suffers from deficiencies that fail to prove secondary meaning.” [Mem. Op. p. 22.] TBL does not challenge the district court’s finding on appeal. TBL Opening Br. 65 n.19.

**4. The unsolicited media coverage, at best, is relevant to whether the unclaimed classic yellow color is distinctive, as TBL executives have asserted in sworn testimony.**

Unsolicited media coverage can be evidence of acquired distinctiveness, *see George & Co.*, 575 F.3d at 395, and TBL submitted many celebrity photos and social media posts. But TBL admitted that these photos do not demonstrate consumer recognition of the boot design applied for here because TBL executives swore otherwise under oath for prior trade-dress applications; thus, as the district court found, TBL’s prior testimony “undercuts the sworn statements and evidence TBL submits in this case.” [Mem. Op. p. 21.]



Specifically, two TBL officers swore that the only way that the paparazzi articles were able to identify the celebrities' boots in those photos as Timberland boots was by the yellow color, because nothing else identifying the boots as TBL's was discernable from the photos. [JA20194, JA20419–20454.] The district court was well within its right to assign no weight to TBL's contradictory statements in this case.

**5. TBL's advertising features other Timberland marks and the unclaimed classic yellow color.**

TBL identifies itself as the source of its boots through use of a comprehensive range of traditional word marks, stylized word marks, logos, and slogans that allow consumers to see that a boot is a TBL product before they get close enough to examine a pair of boots to tick off a checklist of eight specific product features. These include the tree logos and stylized TIMBERLAND marks discussed above. [See *supra* p. 19.] The district court appropriately found that the presence of the other marks weighs against acquired distinctiveness of the boot design. [Mem. Op. p. 18.]

**6. Impressive sales figures fail to carry the day in light of all the other evidence weighing against acquired distinctiveness.**

TBL argues that its sales and advertising of boots are so large that trademark rights must attach. TBL Opening Br. 62–63. Sales may be one thing, but trying to prove that consumers see a product design as a brand is a different matter. In particular, in assessing sales numbers in product design cases, the inference normally drawn from a product's market success is that the sales

reflect “the desirability of the product configuration rather than the source-designating capacity” of its features. *See Duraco Prods.*, 40 F.3d at 1453; *see also In re Bongrain Int’l (Am.) Corp.*, 894 F.2d 1316, 1318 (Fed. Cir. 1990) (“growth in sales” did not prove acquired distinctiveness where it might equally have “indicate[d] the popularity of the product itself”). This would especially seem to be the case where, as here, the product seller’s advertising, to the extent it mentions the features for which trade-dress protection is sought, highlights the functional benefits of the features. [See Mem. Op. p. 20.]

As the district court ultimately found, “TBL has failed to link-up, as an evidentiary matter, its large sales and advertising numbers with the one thing it needs to prove: that amidst a sea of similar-looking boots, consumers nevertheless can identify TBL’s product just by the eight specified product features irrespective of any other marks used on or with the product.” [*Id.*] The district court had ample evidence on which to make that finding.

**B. TBL fails to demonstrate clear error in the district court’s acquired-distinctiveness findings.**

**1. The district court did not clearly err by giving heavy weight to the absence of look-for advertising.**

“For advertising to serve as evidence to prove secondary meaning in a trade dress, the advertising must draw attention to the alleged trade dress.”

2 *McCarthy* § 15:52. “The use of ‘look for’ advertising of a nonverbal designation like a package design can be persuasive evidence that this design drew consumers’ attention so that they used it to identify the source of the

goods.” *Id.*; *see also* 1 *McCarthy* § 7:30 (“look for” advertising “draws the shopper’s attention to [the] particular feature” or features at issue”).

This type of evidence is especially important in product-design cases because “consumer predisposition to equate [product features] with the source does not exist.” *Wal-Mart*, 529 U.S. at 213; 1 *McCarthy* § 7:30 (“Since the burden is on the company that argues that a particular feature or designation is its exclusive trademark or trade dress property, it is incumbent on that company to prove that an otherwise unremarkable feature has achieved the status of a source indicator. ‘Look for’ advertising is the best way to accomplish this.”).

The district court found no evidence that TBL ever once, over decades of advertising, encouraged consumers to “look for” any of the claimed features as source indicators. [Mem. Op. p. 17.] TBL does not dispute that finding on appeal; rather, TBL argues that the district court placed too much weight on the lack of look-for advertising in the record. TBL Opening Br. 46–49.

But the district court did not hold as a matter of law that the complete lack of look-for advertising by itself doomed TBL’s acquired-distinctiveness claim. It also noted, for example, that what little evidence there was of advertising mentioning any of the claimed features highlighted the features’ functional benefits. [Mem. Op. p. 20.] And, of course, the district court considered the lack of look-for advertising in the context of all the other evidence in the record.

[*See id.*]

TBL tries to expand what counts as look-for advertising by saying its ads picturing the boot “call attention” to its “overall look” and arguing that the district court “disregarded” this. Br. 50–53. But there is no indication that the district court “disregarded” this evidence. Rather, the district court’s finding that TBL never once engaged in look-for advertising is consistent with the applicable legal principle. *See, e.g., Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 44 (1st Cir. 2001) (look-for advertising “specifically directs a consumer’s attention to a particular aspect of the product,” as opposed to “[m]erely featuring the relevant aspect of the product”) (cleaned up; citations omitted). The district court’s findings simply reflect that TBL never even tried to teach, let alone successfully taught, consumers to identify source by confirming the presence of the eight claimed design elements.

**2. The district court did not clearly err by giving heavy weight to the market saturation of look-alikes.**

TBL argues that the USPTO did not prove up the “sales and advertising expenditures” of these dozens of look-alike boots, relying primarily on *LD Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349 (Fed. Cir. 1999). TBL Opening Br. 53–57. But it was not the USPTO’s burden to do so, and TBL cites no decision of this Court imposing such a requirement. As the party seeking trade-dress protection, TBL was required to prove substantially exclusive use of the features as part of its proof of acquired distinctiveness. *Wal-Mart*, 529 U.S. at 212 (product “design, like color, is not inherently distinctive”). The evidence that the USPTO offered in district court revealed that the boot design has not

enjoyed substantially exclusive use. Further, in the “conceptually similar” context of assessing the strength of a mark, *see George & Co.*, 575 F.3d at 395, TBL’s argument has been rejected when there is evidence of “a fair number of third-party uses” of similar marks. *See, e.g., Juice Generation, Inc. v. GS Enters., LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015). Indeed, “extensive evidence of third-party use” is “powerful on its face, even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1373–74 (Fed. Cir. 2015). The district court permissibly found that TBL’s claim of secondary meaning was undermined by this “powerful” evidence of third-party use.

### **CONCLUSION**

Clear-error review requires this Court to consider whether “the district court’s account of the evidence is plausible in light of the record viewed in its entirety.” *Walsh*, 19 F.4th at 677. The evidence developed in the district court provides potent proof that TBL’s boot design is unregistrable.

The boot design is unregistrable as functional because it is merely an agglomeration of parts that make the boot feel and perform better. To award TBL a potentially perpetual trademark registration would withdraw from the public domain features that have been available to the public for decades, for more than a century in some cases.

The boot design also is unregistrable for lack of acquired distinctiveness, a finding that TBL bore the burden to disprove. Despite successful sales, TBL has failed to demonstrate that consumers view the boot design as a designation of Timberland as the source as opposed to the myriad look-alike boot producers.

This Court should affirm the district court's judgment.

Dated: June 13, 2023

Respectfully submitted,

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**CERTIFICATE OF COMPLIANCE**

I certify pursuant to Rule 23(f) of the Federal Rules of Appellate Procedure and the Local Rules of the Fourth Circuit, this brief contains 11,776 words.

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