

23-1150

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

**BRIEF OF *AMICUS CURIAE* INTERNATIONAL
TRADEMARK ASSOCIATION (INTA)
IN SUPPORT OF APPELLANT**

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CERTIFICATE OF INTEREST

Counsel for *Amicus Curiae* the International Trademark Association (“INTA”) certifies the following:

1. The full name of the party represented by counsel:

The International Trademark Association

2. The name of the real parties in interest represented by counsel:

Not applicable.

3. All parent corporations and publicly held companies that own 10 percent or more of the stock of the party represented by counsel:

None.

4. The names of all law firms, partners, and associates that have not entered an appearance in the appeal, and (A) appeared for the entities in the lower tribunal, or (B) are expected to appear for the entities in this Court:

None.

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this Court’s decision in the pending appeal:

None.

6. Information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees):

Not applicable.

DATED: April 5, 2023

By: /s/ Jonathan E. Moskin
Jonathan E. Moskin

CERTIFICATION PURSUANT TO FED. R. APP. P. 29

Pursuant to Federal Rule of Appellate Procedure 29(a)(2), *amicus curiae* certifies that Appellant has consented to the filing of this brief. Appellee has stated that it takes no position as to the filing of this brief. Accordingly, submitted herewith is a motion for leave to file this brief. Additionally, in accordance with Federal Rule of Appellate Procedure 29(a)(4)(E), *amicus curiae* states that only the International Trademark Association and its counsel authored this brief, and no part of this brief was authored by counsel to a party. No party or counsel for a party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than *amicus curiae* and its counsel made such a monetary contribution to its preparation or submission.

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The International Trademark Association (“INTA”) respectfully submits this brief in support of neither party.

INTEREST OF *AMICUS CURIAE*

Founded in 1878 as the United States Trademark Association, INTA is a not-for-profit organization dedicated to the advancement of trademarks and related intellectual property principles as essential elements of trade and commerce. With more than 6,500 member organizations from 185 countries, and representing tens of thousands of trademark owners, professionals, and members of the academic community, INTA’s members share the goals of fostering fair competition and informed decisions by consumers.

For decades, INTA has provided recommendations and assistance to legislators in connection with almost all major federal trademark and related legislation. In addition, INTA’s members frequently are plaintiffs, defendants, and advisors in legal actions under the Lanham Act, including actions involving trade dress under of the Lanham Act.

INTA is interested in the development of clear, consistent, and equitable principles of trademark and trade dress law. Accordingly, INTA has participated

as *amicus curiae* in numerous cases on significant Lanham Act issues, including trade dress issues.¹

At its core, the Lanham Act is about protecting consumers. Trademark protections for product designs enable consumers to identify the source of such products and thus protect consumers from being misled. INTA seeks to safeguard the interests of brand owners and consumers alike. As applied to this case, INTA's

¹ Cases in which INTA has filed amicus briefs since 2000 include: *Jack Daniel's Props., Inc. v. VIP Prods., LLC*, No. 22-148 (S. Ct. pending); *Abitron Austria GmbH et. al. v. Hetronic Int'l, Inc.*, No. 21-1043 (S. Ct. pending); *U.S. Patent & Trademark Office v. Booking.com B.V.*, 140 S. Ct. 2298 (2020); *Romag Fasteners, Inc. v. Fossil, Inc.*, 140 S. Ct. 1492 (2020); *Peter v. NantKwest, Inc.*, 140 S. Ct. 365 (2019); *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019); *Mission Prod. Holdings, Inc. v. Tempnology, LLC*, 139 S. Ct. 1652 (2019); *Matal v. Tam*, 137 S. Ct. 1744 (2017); *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138 (2015); *Hana Fin., Inc. v. Hana Bank*, 574 U.S. 418 (2015); *Pom Wonderful LLC v. Coca-Cola Co.*, 573 U.S. 102 (2014); *Herb Reed Enters., LLC v. Fla. Entm't Mgmt., Inc.*, 574 U.S. 815 (2014); *Already, LLC v. Nike, Inc.*, 568 U.S. 85 (2013); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003); *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000); *Crocs, Inc. v. Effervescent, Inc.*, Case No. 2022-2160 (Fed. Cir. pending); *Vans, Inc., et al. v. MSCHF Product Studio, Inc.*, Case No. 22-1006-cv (2d Cir. pending); *LTTB LLC v. Redbubble, Inc.*, 840 Fed. Appx. 148 (9th Cir. 2021); *Ohio State Univ. v. Redbubble, Inc.*, 989 F.3d 435 (6th Cir. 2021); *Ferring Pharms., Inc. v. Watson Pharms., Inc.*, 765 F.3d 205 (3d Cir. 2014); *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012); *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144 (4th Cir. 2012); *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958 (9th Cir. 2011) (on rehearing); *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2009); and *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007).

principal interest is in ensuring that the courts consistently apply the statutory rights provided by Congress to protect product designs.

In that regard, the full scope and nature of the District Court’s reasoning in foreclosing protection for the Timberland’s Icon Boot design is inconsistent with the statutory mandate as well as decisions of this and other courts that designs be assessed “as a whole.” Instead, the District Court here dissected the subject design into constituent elements, each of which it determined was functional, without analyzing whether the design as a whole creates an appearance warranting protection under the Lanham Act.

Moreover, the analysis of discrete elements exceeded the guidance of the Supreme Court in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001), that only subject matter actually claimed in a utility patent is “strong evidence” of functionality. Conversely, subject matter merely disclosed in the specification of a patent is not presumptively functional. The practical consequence of ruling Timberland’s design functional is that competitors might henceforth be permitted to make exact copies of the design, thus potentially misleading consumers.

INTA takes no position on the ultimate merits whether Timberland’s design is not legally protectable – either because it fails to meet the requirements that Timberland prove the design as a whole is non-functional or that Timberland prove

the design has acquired distinctiveness. Rather, INTA respectfully offers this submission solely to address the proper standard of functionality under the Lanham Act.

I. SUMMARY OF ARGUMENT

The decision of the District Court below, which concluded that the Timberland’s “Icon Boot” design was unprotectable under the Lanham Act, begins with the correct premise that the Lanham Act precludes protection where the claimed mark “comprises any matter that, as a whole, is functional.” Lanham Act, § 2(e)(5), 15 U.S.C. § 1052(e)(5). *TBL Licensing, LLC v. Vidal*, Case No. 21-681, 2022 WL 17573906 at *5 (E.D. Va. Dec. 8, 2022). This is consistent with Fourth Circuit precedent, *CTB, Inc. v. Hog Slat, Inc.*, 954 F.3d 647, 656-7 (4th Cir. 2020), as well as precedents from other circuits. However, rather than analyzing whether the boot design “as a whole” is functional, the District Court incorrectly dissected the overall appearance of the Icon Boot design into constituent elements, without addressing whether the combination of elements (even if individually functional) formed a whole that was more than just the sum of its parts.

The recent decision, *Blumenthal Distrib., Inc. v. Herman Miller, Inc.*, 963 F.3d 859 (9th Cir. 2020), is instructive. That case concerned the designs of certain chairs, and the Ninth Circuit, in finding the designs non-functional, explained that, “as a matter of law, a product’s ‘overall appearance’ is functional, and thus

unprotectable, where the whole product is ‘nothing other than the assemblage of functional parts,’ and ‘even the arrangement and combination’ of those parts is designed to make the product more functional.” *Id.* at 866 [Citations omitted]. The court likewise held that “a product’s overall appearance is necessarily functional if everything about it is functional, not merely if anything about it is functional.” *Id.* at 867. Hence, the Ninth Circuit recognized that “to examine a product ‘as a whole’ is to examine 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.” *Id.* at 866.

Here, the District Court considered each design element of the Icon Boot only individually. It also exceeded the guidance of the Supreme Court in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001), as to the relevance of utility patents disclosing design features. *TrafFix* is one of three key Supreme Court cases establishing the basic test for determining whether a product design is functional (the other two being *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850 n.10 (1982), and *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)). Adhering to the test previously enunciated in *Inwood* and *Qualitex*, *TrafFix* reaffirmed that “a product feature is functional, if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.”

532 U.S. at 24. In *TrafFix*, the product feature claimed as a trademark (a simple dual-spring design for a road sign) was expressly *claimed* in a prior patent, and the patent claims directly read on the claimed trademark design. The Supreme Court there said only that material *claimed* in a patent (not merely disclosed in a patent) was “strong evidence” (not conclusive evidence) of functionality. *Id.* at 29.

Similarly confining the relevance of prior utility patents, this Court has explained that for *TrafFix* to apply, the claimed trade dress must reflect the “central advance” of a utility patent, not merely an incidental feature. *McAirlaids, Inc. v. Kimberly-Clark Corp.*, 756 F.3d 307, 312 (4th Cir. 2014).

Although the facts in *TrafFix* made it unnecessary to consider other factors (such as the existence or not of alternative designs), this Court and others continue to endorse consideration of such factors where appropriate. *CTB*, 954 F.3d at 657-58; *McAirlaids, Inc.*, 756 F.3d at 312. Here, the District Court provided no such analysis, but merely concluded that because each individual element of the design had been disclosed (not claimed) in a patent, the overall Icon Boot design was legally functional.

INTA here expresses no opinion on the ultimate factual question whether the Icon Boot is functional. Nor does it express any opinion as to the scope of protection for a product design such as the Icon Boot that incorporates some functional elements. Likewise, INTA does not address whether the Icon Boot

design has acquired distinctiveness, which also is an essential prerequisite to determining whether a product design can be protected as a trademark. However, INTA does believe that prior precedents of this and other courts require a deeper analysis whether the combination—even of features serving functional ends—can create a protectable whole; *i.e.*, whether the design as a whole is “essential to the use or purpose of the article or if it affects the cost or quality of the article.”

TrafFix, supra.

II. BACKGROUND

Timberland has sold its Icon Boot for approximately fifty years. The boot appears as follows:



On May 19, 2015, Timberland filed U.S. Trademark Application No. 86/634,819 to register the overall design. The application described the product design as 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 five additional individual features. Timberland described these additional individual features as follows:

- (a) the external appearance of a tube-shaped ankle collar on the outside surface of the product running from one eyelet panel to the other eyelet panel around the sides and rear of the boot and protruding over the upper side and rear panels of the boot (material on the inside of the ankle collar not being claimed);
- (b) outsoles having two color tones divided horizontally and extending around the circumference of the boot, and visibly showing inverted tooth shaped cuts on each side of the heel of the outsole and around the sides and front of the forward portion of the outsole;
- (c) an hourglass-shaped rear heel panel, defined by four vertical stitching lines from the top of the outsole to the rear collar;
- (d) quad-stitching forming an inverted “U” shape around the vamp line in front of the boot at the bottom of the tongue and curving around to the left and right sides and ending at the cinched portion of the hourglass stitching of the rear heel panel; and
- (e) eyelets shaped hexagonally on the exterior-facing outside surface.

Case 1:21-cv-00681-CMH-IDD ECF Document No. 50 at 13.

The Examining Attorney refused registration on two principal grounds:

- (1) the proposed mark was a product configuration comprising non-distinctive features for which the evidence of acquired distinctiveness was insufficient;² and
- (2) the trade dress was functional. Case 1:21-cv-00681-CMH-IDD ECF Document No. 50 at 13. The Trademark Trial and Appeal Board (“TTAB”) affirmed the acquired distinctiveness refusal under Lanham Act §§ 1, 2, and 45, and did not

² As noted above, INTA expresses no views whether the design has acquired distinctiveness or whether the District Court properly applied the test of acquired distinctiveness.

reach the functionality refusal under Section 2(e)(5) of the Lanham Act or the amended drawing and description requirements. *Id.*

On June 4, 2021, Timberland commenced an action under Lanham Act § 21(b), 15 U.S.C. § 1071(b) in the Eastern District of Virginia seeking *de novo* review. In the district court, the parties filed cross motions for summary judgment, but agreed that the court could decide any disputed issues of fact, so the case was, in effect, tried on a stipulated record. On December 8, 2022, the District Court granted the USPTO's motion, denied Timberland's, and dismissed the appeal. In its decision, on the issue of functionality, the District Court principally relied on one prior Fourth Circuit decision, *CTB, supra*, as well as *TrafFix, supra*.

In the District Court, Timberland identified eight features composing the trade dress of the Icon Boot: soft collar, two-tone sole, lug soles, hourglass heel counter, quad stitching, shape of the vamp stitching, hexagonal eyelets, and bulbous toe box.

In purportedly addressing these trade dress features as a whole, the District Court relied principally on at least eleven prior utility patents (and referenced several others): (i) Timberland's U.S. Patent No. 7,730,640, issued in 2010, which (in the court's words) "depicts" the same collar as in the claimed trade dress; (ii) U.S. Patent No. 3,545,107, issued in 1970, which "discloses" a cushioned upper back portion; (iii) U.S. Patent No. 3,803,731, issued in 1974, which

“discloses” a shoe with a collar constructed of a cushioning element; (iv) U.S. Patent No. 1,559,532, issued in 1925, which “discloses” a resilient sole for boots and shoes and “teaches a light weight, cushioned and less expensive method of producing a sole;” (v) U.S. Patent No. 3,793,750, issued in 1974, which “discloses” an athletic shoe that 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; (vi) Swiss Patent No. 214,887 (the “Vibram” boot), issued in 1941, which “discloses” a boot with a rubber sole that has rubber bosses, or lugs, on the outside; (vii) U.S. Patent No. 1,620,712, issued in 1927, which “discloses” an inner and outer back stay for leather-top rubbers; (viii) U.S. Patent No. 1,360,177, issued in 1920, which “discloses” a boot stitched with the same configuration as the Timberland boot design and “describes” the u-shaped end of the vamp stitching on the boot; (ix) U.S. Patent No. 1,725,749, issued in 1929, which “describes *and claims*” a waterproof seam for a boot; (x) U.S. Patent Application Publication No. 021/0145124, which “teaches” a boot with one or more rows of stitches that run continuously; (xi) U.S. Patent No. 138,221, which “discloses” crimping the sides of an eyelet to create a hexagonal shape is not a new technique, and (xii) U.S. Patent No. 8,359,772, issued in 2013, which “discloses” construction boots, and “explains” that a toe cap

protects the toes against the impact from objects falling against the footwear. *TBL Licensing*, 2022 WL 17573906 at * 1-4.

The District Court decision notes only in respect of one of the eleven cited patents that it actually *claimed* the subject matter in issue, No. 1,725,749, otherwise noting only more broadly that each patent disclosed relevant subject matter.

For its part, Timberland attempted in its brief in the District Court to address why the cited patents did not require a finding of functionality of the individual elements. Case 1:21-cv-00681-CMH-IDD ECF Document No. 50 at 41-42. However, without addressing these specific distinctions, 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. Said the court: “TBL has failed to carry its burden to prove that these eight features are nonfunctional and that consumers recognize these eight features as a unique indicator of the source of the boots. For the foregoing reasons, Defendant’s Motion for Summary Judgment should be granted and Plaintiff’s motion denied.” *TBL Licensing*, 2022 WL 17573906 at *9.

III. ARGUMENT

The test for functionality set forth by the Supreme Court is that “a product’s feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Inwood Labs., Inc.*, 456 U.S. at 850-51 n. 10 (1982). The Court reaffirmed this test in *Qualitex Co.*, 514 U.S. at 165, and, with some modifications specific to cases in which product features have been the subject of expired utility patents, in *TrafFix* 532 U.S., at 33.³

TrafFix concerned claimed trade dress rights in a road sign mounted on a dual-spring assembly (which provided reinforced wind resistance), where the asserted design benefits were actually claimed in an expired utility patent, not simply stated somewhere in the specification. In the later language of this Court in *McAirlaids*, they were its “central advance.” The Supreme Court in *TrafFix* did not hold that subject matter found in a patent specification was entitled to any special deference nor did it hold that even subject matter claimed in a utility patent

³ Every circuit court that has addressed the issue follows the *Inwood Labs* test, including this Circuit. See, *CTB, Inc. v. Hog Slat, Inc.*, 954 F.3d 647, 657 (4th Cir. 2020); *Blumenthal Distrib., Inc. v. Herman Miller, Inc.*, 963 F.3d 859, 865 (9th Cir. 2020); *Groeneveld Transp. Efficiency, Inc. v. Lubecore Int’l, Inc.*, 730 F.3d 494, 503-04 (6th Cir. 2013); *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 219 (2d Cir. 2012); *Dippin’ Dots, Inc. v. Frosty Bites Distrib., LLC*, 369 F.3d 1197, 1200 (11th Cir. 2004); *Shire U.S., Inc. v. Barr Labs, Inc.*, 329 F.3d 348, 353-54 (3d Cir. 2003); *Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH*, 289 F.3d 351, 355-56 (5th Cir. 2002); *Valu Eng’g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1274-76 (Fed. Cir. 2002); *Publ’ns Int’l, Ltd. v. Landoll, Inc.*, 164 F.3d 337, 342 (7th Cir. 1998); *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 37 (1st Cir. 1998).

was determinative of possible trademark rights. What *TrafFix* actually said was only that “[a] utility patent is strong evidence that the features *therein claimed* are functional.” 532 U.S. 23, 29 (emphasis added). Further confirming that even subject matter literally claimed in a utility patent is strong but not conclusive evidence, *TrafFix*, in its final passages, also specifically rejected the notion (urged by various *amici*) that the law always prohibits the holder of an expired utility patent from claiming trade dress protection:

TrafFix and some of its amici argue that the Patent Clause of the Constitution, Art. I, § 8, cl. 8, of its own force, prohibits the holder of an expired utility patent from claiming trade dress protection. [Citations omitted.] We need not resolve this question. If, despite the rule that functional features may not be the subject of trade dress protection, a case arises in which trade dress becomes the practical equivalent of an expired utility patent, that will be time enough to consider the matter.

Id. at 23-24.

Most importantly, *TrafFix* did not hold that the existence of a utility patent for one or more individual features of claimed product trade dress relieves a court of the duty to consider other relevant evidence regarding the distinctiveness of the claimed trade dress as a whole. As shown below, the patent claim concerning the dual-spring design there in issue resolved the legal question whether the overall design was functional without the need to consider other evidence, but this Court and other courts routinely require consideration of other evidence, including alternative designs. Indeed, this Court expressly noted in *McAirlaids* that “*TrafFix*

did not alter our precedents that look to the availability of alternative designs when considering, as an initial matter, whether a design affects product quality or is merely ornamental.” 756 F.3d at 312. [Citations omitted.]

A. The District Court Did Not Properly Consider the Design as a Whole.

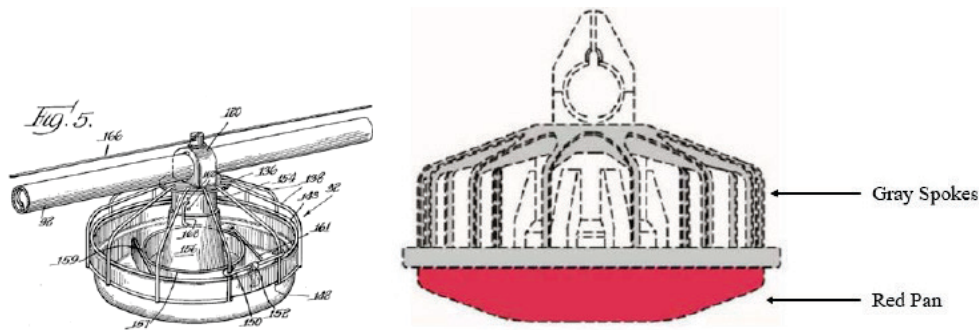
The District Court here correctly notes that the Lanham Act precludes protection where the claimed mark “comprises any matter that, as a whole, is functional.” 15 U.S.C. § 1052(e)(5). 2022 WL 17573906 at *5. This is consistent with prior decisions of this Court, *Tools USA & Equip. Co. v. Champ Frame Straightening Equip. Inc.*, 87 F.3d 654, 658 (4th Cir. 1996) (“the critical functionality inquiry is not whether each individual component of the trade dress is functional, but rather whether the trade dress as a whole is functional”)⁴, as well as the nearly universal decisions of other courts. *See, e.g., Fuddruckers, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837, 842 (9th Cir. 1987) (“We examine trade dress as a whole to determine its functionality; functional elements that are separately unprotectable can be protected together as part of a trade dress”); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1538 (11th Cir. 1986) (“That individual elements of packaging are functional does not, however, render the package as a whole

⁴ *Tools USA* concerned the trade dress of a “Tools USA and Equipment” catalog, not a product design. The court there noted that “[t]he trade dress of the Tools USA catalog consists of a number of elements, combined in a particular fashion,” 87 F.3d at 658, some of which (such as a stars and stripes logo) were more purely ornamental.

unprotectable”), *cert. denied*, 481 U.S. 1041, 107 S. Ct. 1983, 95 L. Ed. 2d 822 (1987); *LeSportsac, Inc. v. Kmart Corp.*, 754 F.2d 71, 76 (2d Cir. 1985) (“by breaking [plaintiff’s] trade dress into its individual elements and then attacking certain of those elements as functional, [defendant] misconceives the scope of the appropriate inquiry”); *Miche Bag, LLC v. Marshall Grp.*, 818 F. Supp. 2d 1098, 1104 (N.D. Ind. 2010) (finding trade dress valid and nonfunctional where “[t]he way in which even functional parts are assembled may be protected as trade dress.”).

Prior decisions of this Court, including *Tools USA, supra*; *CTB, supra*; and *McAirlaids, Inc., supra*, set forth the proper test for assessing functionality, which the District Court here did not follow.

In addition to citing *TrafFix*, the District Court here primarily relied on *CTB, supra*, in enunciating the standards for addressing functionality. 2022 WL 17573906 at *5. *CTB* concerned a commercial chicken feeder that had been subject to a utility patent that (as noted by that court) “claimed a novel structure for the spokes and pan that improved upon several issues observed with prior art pan feeders.” The figure below shows this feeder (on the left). The plaintiff there also obtained a trademark registration on the Supplemental Register solely for the colors of its feeders (after the USPTO repeatedly rejected its claims for the design configuration).



In *CTB*, this Court cited *TrafFix* and explained that:

[A] product feature is functional “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *TrafFix*, 532 U.S. at 32 (quoting *Qualitex*, 514 U.S. at 165 (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850, n.10, 102 S. Ct. 2182, 72 L. Ed. 2d 606 (1982))). Put simply, a feature is functional if “it is the reason the device works.” *Id.* at 34.

CTB, 954 F.3d at 657. *CTB* also cited the four *Morton-Norwich* factors⁵ as part of its functionality inquiry, namely:

(1) the existence of utility patents disclosing the utilitarian advantages of a design; (2) advertising focusing on the utilitarian advantages of a design; (3) the availability of functionally equivalent alternative designs which competitors may use; and (4) facts indicating that a design results in a comparatively simple or cheap method of manufacturing the product.

Id. at 657-8.

Significantly, although *CTB* relied almost exclusively on the plaintiff’s utility patent (without giving particular weight to alternative designs) the court carefully distinguished the prior Fourth Circuit decision in *McAirlaids, Inc.*, where the trade dress was *not* the central feature of any utility patent, such that the

⁵ *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41 (C.C.P.A. 1982))

associated patents did not constitute the type of “strong evidence” that decided the functionality issue in *TrafFix*. Moreover, the court expressly acknowledged that merely finding the elements of the chicken feeder functional was only step one: “Our inquiry does not end there. As Plaintiff notes, ‘the critical functionality inquiry is not whether each individual component of the trade dress is functional, but rather whether the trade dress *as a whole* is functional.’” *CTB, Inc.*, 954 F.3d at 665 [citation omitted].

The court in *CTB* proceeded to analyze the overall configuration and concluded that plaintiff failed to offer any reason why the combination of two wholly-functional components—the pan and the spoke assembly—added some non-functional synergy or other characteristic beyond the bare functionality of the constituent elements that would qualify the entire feeder as being non-functional for purposes of assessing trade dress protection. *Id.* at 665, citing *Leatherman Tool Grp., Inc., v. Cooper Indus., Inc.*, 199 F.3d 1009, 1013 (9th Cir. 1999) (“[W]here 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 nonfunctional.”)⁶

⁶ While not all courts expressly embrace the distinction between de facto and de jure functionality, most honor the distinction in practice, and in *Leatherman*, the court first determined that each element of the multi-tool at issue was de jure

Applying the same reasoning, the Ninth Circuit in *Blumenthal Distributing, supra*, recently rejected a similar proposed reductionist test in upholding trade dress protection for Herman Miller’s Eames Aluminum Group and Aeron chair designs: “As we have long held, a product’s overall appearance is necessarily functional if everything about it is functional, not merely if anything about it is functional. [Citations omitted.]” *Blumenthal Distributing*, 963 F.3d at 867 (emphasis added). The Third Circuit similarly recognized in *American Greetings Corp. v. Dan-Dee Imports, Inc.*, that “virtually every product is a combination of functional and non-functional features and a rule denying protection to any combination of features including a functional one would emasculate the law of trade dress infringement.” 807 F.2d 1136, 1143 (3d Cir. 1986) (emphasis added). *See also Sunbeam Prods. v. W. Bend Co.*, 123 F.3d 246, 56 (5th Cir. 1997) (“the fact that the American Classic Mixmaster® incorporates functional features named in utility patents does not compel the conclusion that the product configuration is legally functional. Insofar as the trade dress of a product entails its ‘total image’ and ‘overall appearance,’ [citation omitted], an arbitrary combination of functional

functional before finding that the whole was nothing more than the sum of its parts. *Textron, Inc. v U.S. Int’l Trade Comm’n*, 753 F.2d 1019, 1024-25 (Fed. Cir. 1985), explained that: “[O]nly de jure functional designs, as contrasted with de facto functional designs, can be exempted from trademark protection. ‘In essence, de facto functional means that the design of a product has a function, i.e., that a bottle of any design holds fluids. De jure functionality, on the other hand, means that the product is in its particular shape because it works better in this shape.’”

features may nevertheless be non-functional for purposes of trade dress protection”); *Cybergun, S.A. v. JAG Precision*, 2012 U.S. Dist. LEXIS 147113, *11-16 (D. Nev. Oct. 11, 2012) (“although various features of a product may not be protected as trade dress because these features are functional, a combination of visual elements taken together may create a distinctive visual impression and thus entitles an owner to trade dress protection. One does not focus on the individual components but on the integration of those components into a single product.”)

Contrary to *Tools USA* and *CTB*, the District Court barely addressed the appearance of the whole design of the Icon Boot. The District Court did note, without analysis, that “[t]he features of the applied-for boot design as a whole do what these features are supposed to do in any good boot . . .” 2022 WL 17573906 at *5. However, the District Court then simply concluded, after separately reviewing the eleven or more cited utility patents and the eight features identified by Timberland, with the summary conclusion that: “TBL has failed to carry its burden to prove that these eight features are nonfunctional and that consumers recognize these eight features as a unique indicator of the source of the boots. For the foregoing reasons, Defendant’s Motion for Summary Judgment should be granted and Plaintiff’s motion denied.” 2022 WL 17573906 at *9. Contrary to *CTB*, the District Court thus omitted the “critical functionality inquiry” of

explaining why the trade dress as a whole is functional, even if Timberland were to concede that each element serves some function.

B. The District Court Did Not Consider Other Available Evidence Relevant to the Multi-factor Test of Functionality

Not only was the District Court's analysis of the design as a whole wanting, but also the District Court did not follow *TrafFix* as to the relevance of prior utility patents and did not attempt to consider possible alternative designs or the relative costs of manufacturing.

Repeatedly, the district court stated that several cited patents "disclosed" something functional, but only said of one cited utility patent (No. 138,221) that it disclosed *and claimed* the relevant subject matter. As noted, what *TrafFix* actually held was only that features actually claimed in a utility patent are "strong evidence" (not conclusive evidence) that "the features *therein claimed* are functional." 532 U.S. at 29 (emphasis added). Nor did the district court address the conclusion in *McAirlaids* that the design element must be the "central advance" of the patent for *TrafFix* to apply. Although other courts have broadened their analyses of utility patents to include materials merely disclosed in a patent specification, often they have done so (as in *CTB*) in more detail to show why the particular disclosure was deemed so vital to functionality.

Although not every case presents the straightforward factual and legal basis to find functionality as in *TrafFix*, where it was not necessary to consider

alternative designs or relative costs of manufacturing, virtually every Circuit acknowledges the importance of considering such factors in assessing whether a design is legally functional (as distinct from simply having a function). Indeed, although in *TrafFix* the central advance of the expired utility patent was the dual-spring design at issue, the District Court here did not explain its reasoning for not considering alternative designs or relative costs of manufacturing, and did not address the guidance of *McAirlaids*, quoted above, preserving prior precedents emphasizing the importance of such evidence. 756 F.3d at 312. In the language of *CTB*, it found only that each individual component of the trade dress was functional, but omitted the “critical functionality inquiry” of explaining why the trade dress as a whole is functional.

This Court’s precedent (cited by the District Court) expressly relies on the *Morton-Norwich* factors. *CTB*, 954 F.3d at 657-58. The Ninth Circuit, in *Blumenthal Distributing*, 963 F.3d at 865, similarly reaffirmed its *Disc Golf* factors: (1) whether the design yields a utilitarian advantage; (2) whether alternative designs are available; (3) whether advertising touts the utilitarian advantages of the design; and (4) whether the particular design results from a comparatively simple or inexpensive method of manufacture. *Disc Golf Ass’n v.*

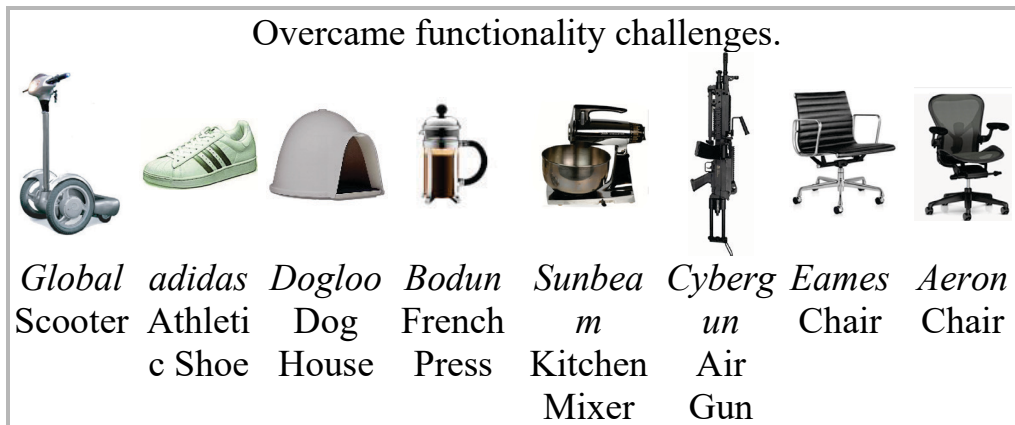
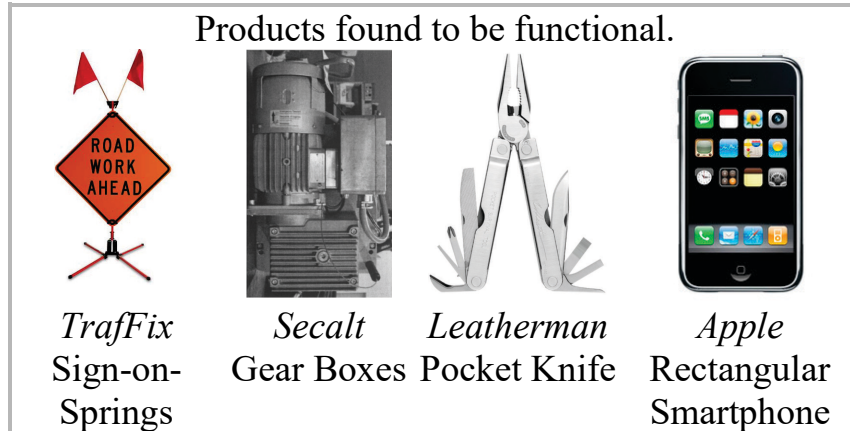
Champion Discs, Inc., 158 F.3d 1002, 1006 (9th Cir. 1998).⁷ See also *Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 429 (5th Cir. 1984) (a design is not functional “unless the design is only one of a limited number of equally efficient options and free competition would be unduly hindered by according that design trademark protection.”)

Although Timberland argued that innumerable boots use completely different elements and composite designs, and although it presented evidence that its design choices did not result in a less expensive product, the District Court did not address or weigh such evidence.

Sufficient understanding of how any given product is made may sometimes be so apparent as to require no elaboration or explication. This was true in *TrafFix*, where the dual-spring design was the heart of what the patent claimed and taught. But other more complex designs generally cannot be understood in isolation. If one had only ever examined one boot, one chair or one car, each of which is designed to serve functional ends, the design decisions or engineering choices involved in making that product would not be apparent, such that it would be impossible to know how essential was the design or how it affected cost or quality. Nor could one assess the relative costs of manufacturing.

⁷ *Moldex-Metric, Inc. v. McKeon Prods.*, 891 F.3d 878, 883-84 (9th Cir. 2018), specifically rejected the suggestion that *TrafFix* held that looking at competitive designs was not necessary.

The following chart summarizes how the opportunity to make design choices in complex versus simplistic designs is essential to the assessment of functionality.



Found Functional: *TrafFix.*, 532 U.S. at 23 (sign-on-springs); *Secalt S.A. v Wuxi Shenxi Constr. Mach. Co.*, 668 F.3d 677 (9th Cir 2012) (gear boxes); *Leatherman Tool Group, Inc. v. Cooper Indus., Inc.*, 199 F.3d 1009, 1011 n.3 (9th Cir. 1999) (pocket knife); *Apple, Inc. v. Samsung Elecs. Co.*, 786 F.3d 983 (Fed. Cir. 2015), *rev'd in part on other grounds*, 137 S. Ct. 429 (2016) (rectangular smartphone).

Found Non-Functional: *Blumenthal Distrib., Inc.*, 963 F.3d 859 (Eames Aluminum Group and Aeron chairs); *Glob. Mfr. Grp., LLC v. Gadget Universe.com*, 417 F. Supp. 2d 1161, 1163 (S.D. Cal. 2006) (electric scooter); *adidas Am., Inc. v. Payless Shoesource, Inc.*, 546 F. Supp. 2d 1029, 1084-1085 (D. Or. 2008) (sneaker); *Dogloo, Inc. v. Doskocil Mfg. Co.*, 893 F. Supp. 911, 918-19 (C.D. Cal. 1995) (doghouse); *Bodum USA, Inc. v. A Top New Casting, Inc.*, 927 F.3d 486, 495 (7th Cir. 2019), *cert. denied*, 140 S. Ct. 675 (2019) (french press); *Sunbeam Prods. v. W. Bend Co.*, *supra* (kitchen mixer); *Cybergun, S.A.*, 2012 U.S. Dist. LEXIS 147113 at *11-16 (air gun).

The Supreme Court’s holding in *TrafFix* made clear that to be functional, the claimed trade dress rights must be “essential” to the use or purpose, or must put competitors at a “significant . . . disadvantage.” *TrafFix*, 532 U.S. at 32. As in *TrafFix*, where the design was self-evidently functional and there was no need to review alternative designs, it may be tempting to generalize from a simple product, such as the chicken feeders in *CTB*, to a broader universe of more complex designs where the analysis of functionality is likewise more complex. Indeed, without educating oneself on alternative designs, it is impossible to know what design or cost considerations might motivate a designer or engineer to pick one design over another.

It might be that Timberland designed its Icon Boot without considering alternatives, but most products permit or require design choices. One cannot assess if a design was “essential” to the use or purpose or affected cost or quality without considering whether the designer had other options. Even if every individual element of the Icon Boot is functional in and of itself, the whole of the design entails an additional level of design choices that might not be apparent viewing the product in isolation. The District Court here included no such analysis in its decision. Because the result of finding a product design functional is to preclude protection of the design and hence permit competitors to make exact copies, caution is appropriate before casting any given design into the public domain.

IV. CONCLUSION

For the foregoing reasons, INTA respectfully submits that the Court should clarify the proper the test for determining functionality and correct any error of the District Court in dissecting the claimed trade dress into component elements without addressing whether the design as a whole is functional.

Respectfully submitted,

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Dated: May 5, 2023

/s/ Jonathan E. Moskin
Counsel for Amicus Curiae
International Trademark Association

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I hereby certify that on this 5th day of May, 2023, I caused this Brief of *Amicus Curiae* International Trademark Association to be filed electronically with the Clerk of the Court using the CM/ECF System, which will send notice of such filing to all counsel of record as registered CM/ECF users.

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