Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH

289 F.3d 351 (5th Cir. 2002)

{Plaintiff Eppendorf–Netheler–Hinz GMBH ("Eppendorf") manufactured disposable pipette tips and dispenser syringes to which the pipette tips can be attached for use in laboratories. Defendant Ritter GMBH ("Ritter") began to manufacture pipette tips that were interchangeable with and priced lower than Eppendorf's tips. Eppendorf brought suit against Ritter for, among other things, trade dress infringement. In June of 2000, ten months before the Supreme Court handed down *TrafFix*, Eppendorf's claims were tried before a jury, which returned a verdict in favor of Eppendorf. The district court denied Ritter's motion for judgment as a matter of law. Ritter appealed.}

EDITH H. JONES, Circuit Judge

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Eppendorf contends that Ritter infringed upon eight elements of the Combitips's trade dress: (1) the flange on top of the tip; (2) the fins connecting the

flange to the body of the tip; (3) the plunger head; (4) the plunger; (5) the length of the tips; (6) the eight sizes of the tips; (7) the coloring scheme on the tips; and (8) the angle of the stump on the tips.

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The crucial issue presented by this appeal is whether the eight design elements of the Eppendorf Combitips are functional as a matter of law. This case was tried in June of 2000, almost ten months before the Supreme Court decided *TrafFix*. The district court, correctly applying this circuit's utilitarian test of functionality, instructed the jury as follows:

> A design or characteristic is nonfunctional if there are reasonably effective and efficient alternatives possible. Hence, a product's trade dress is functional only, one, if competitors need to incorporate it in order to compete effectively because it is essential to the product's use, or, two, if it significantly affects the cost or quality of the article. A design is functional and thus unprotectable if it is one of a limited number of equally efficient options available to competitors and free competition would be significantly disadvantaged by according the design trademark protection.

Relying on this instruction, the jury determined that the Combitips were non-functional. Ritter and RK Manufacturing moved for judgment as a matter of law on the issue of functionality, and the district court denied the motion.

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Eppendorf contends that the evidence supports the jury's finding of non-functionality because "[t]he evidence clearly established that there were alternative designs to each of the eight non-functional features." *Appellee's Brief* at 20. Indeed, there is extensive testimony in the record regarding available alternative designs for each of the eight elements. For example, Eppendorf's expert testified that the number of fins under the flange "could be increased or decreased or their appearance could be changed." *Appellee's Brief* at 5. Thus, Eppendorf argues that the fins are non-functional because alternative designs are available to competitors in the marketplace.

Eppendorf's argument, while consistent with this circuit's utilitarian definition of functionality, is unpersuasive in light of the Court's discussion of functionality in *TrafFix*. As explained above, the primary test for functionality is whether the product feature is essential to the use or purpose of the product or if it affects the cost or quality of the product. In *TrafFix,* the Court determined that the dual-spring design on a wind-resistant road sign was functional because the dual-spring design "provides a unique and useful mechanism to resist the force of the wind." 532 U.S. at 33, 121 S.Ct. at 1262. The Court rejected the argument that

the springs were non-functional because a competitor could use three or four springs which would serve the same purpose. *Id.* The Court explained,

> There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose . . . . The dual-spring design is not an arbitrary flourish in the configuration of [the road sign]; it is the reason the device works. Other designs need not be attempted.

Id. at 33–34, 121 S.Ct. at 1261. Accordingly, the design features for which Eppendorf seeks trade dress rights are functional if they are essential to the use or purpose of the Combitips or affect the cost or quality of the Combitips. The availability of alternative designs is irrelevant.

In this case it is undisputed that the Combitips's fins provide necessary support for the flange. Without the fins, the flange is subject to deformation. The only testimony offered by Eppendorf to prove non-functionality of the fins related to the existence of alternative design possibilities. Eppendorf's functionality expert testified that the appearance and number of fins could be changed without affecting the function of the fins. Eppendorf did not prove, however, that the fins are an arbitrary flourish which serve no purpose in the Combitips. Rather, Eppendorf's experts concede that fins of some shape, size or number are necessary to provide support for the flange and to prevent deformation of the product. Thus, the fins are design elements necessary to the operation of the product.[5] Because the fins are essential to the operation of the Combitips, they are functional as a matter of law, and it is unnecessary to consider design alternatives available in the marketplace. *TrafFix,* 532 U.S. at 33–34.

Likewise, a careful review of the record demonstrates that Eppendorf failed to prove that the remaining Combitip design elements are unnecessary, non-essential design elements. It is undisputed that: (1) The flange is necessary to connect the Combitip to the dispenser syringe; (2) The rings on the plunger head are necessary to lock the plunger into a cylinder in the dispenser syringe; (3) The plunger is necessary to push liquids out of the tip, and the ribs on the plunger stabilize its action; (4) The tips at the lower end of the Combitips are designed to easily fit into test tubes and other receptacles; (5) The size of the Combitip determines the dispensed volume, and size is essential to accurate and efficient dispensing; (6) The color scheme used on the Combitip—clear plastic with black lettering—enables the user easily to see and measure the amount of liquid in the Combitip, and black is standard in the medical industry; and (7) The stumps of the larger Combitips

[5] Additionally, Eppendorf's experts concede that some of the suggested alternative designs would slightly increase the cost of the product. This provides further support for the conclusion that the fins are functional under the traditional definition of functionality.

must be angled to separate air bubbles from the liquid and ensure that the full volume of liquid is dispensed. Thus, all eight design elements identified by Eppendorf are essential to the operation of the Combitips.

Eppendorf's theory of non-functionality focused on the existence of alternative designs. Eppendorf's design expert summarized Eppendorf's approach to functionality: "My conclusion was that to achieve the same functional purpose, [the design elements identified by Eppendorf] can be changed significantly, considerably without affecting the overall intended purpose." Although alternative designs are relevant to the utilitarian test of functionality, alternative designs are not germane to the traditional test for functionality. Each of the eight design elements identified by Eppendorf is essential to the use or purpose of the Combitips, and is not arbitrary or ornamental features. Therefore, no reasonable juror could conclude that Eppendorf carried its burden of proving non-functionality.

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Accordingly, we REVERSE the judgment of the district court and RENDER judgment for Ritter and RK Manufacturing. We likewise VACATE the injunction entered by the district court . . . .