

Trademark Law

Prof. Madison

Today: Acquired distinctiveness

Key concepts from Class 5:

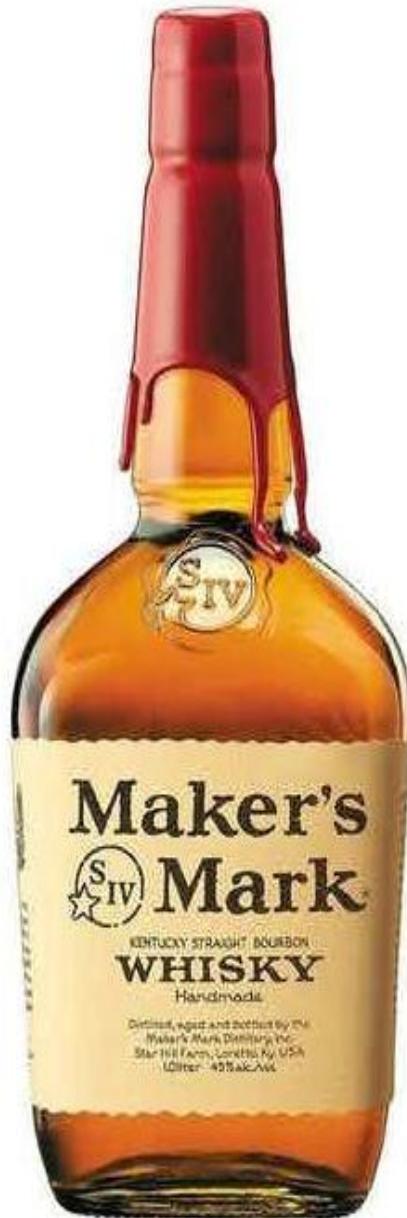
Legal rules and concepts as tools for problem solving.

Mark X for Product (Service) Y.

Trade dress: distinctiveness v. “mere ornamentation.”

Product packaging and product configuration.

The *Abercrombie* spectrum and the *Seabrook* factors.



Maker's Mark Distillery, Inc. v.
Diageo North America, Inc.
(W.D. Ky. 2010; aff'd 6th Cir. 2012)



Distinctiveness analysis (eligibility for TM protection) and **functionality** analysis (bar to TM protection) as two versions of the same policy questions:

1. Protect new competitors (*right to copy* reasoning)
2. Channel innovation into the right IP category (patent, trademark, copyright have their distinct policy balances)
3. Protect consumer interests in accurate search
4. Protect producer investments in goodwill

Then why do lawyers, judges, or the Trademark Office use one or the other?

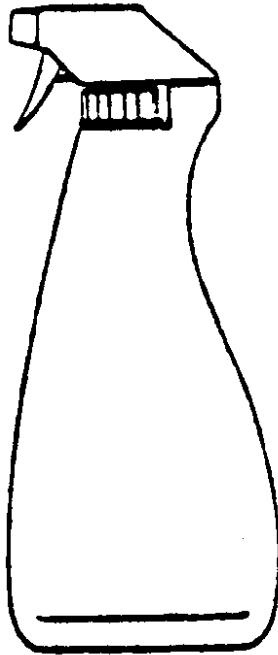
Lanham Act § 2 (15 U.S.C. § 1052):

No trademark by which the goods of the applicant may be **distinguished** from the goods of others shall be refused registration on the principal register **unless** it -- **(e)** Consists of a mark which, ...

(5) comprises any matter that, as a whole, is **functional**

Lanham Act § 43(c)(3) (15 U.S.C. § 1025):

In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not **functional**.



Is the shape of the spray top “functional” or is it (potentially) distinctive?

Court asks: Is the fundamental right to compete impaired? “Exhaustion of available designs” as a concern.

1/ Focus on utility of the claimed mark: does the mark [design] have **de facto utility** (is the design useful as a thing)?

a/ If no, then evaluate for distinctiveness.

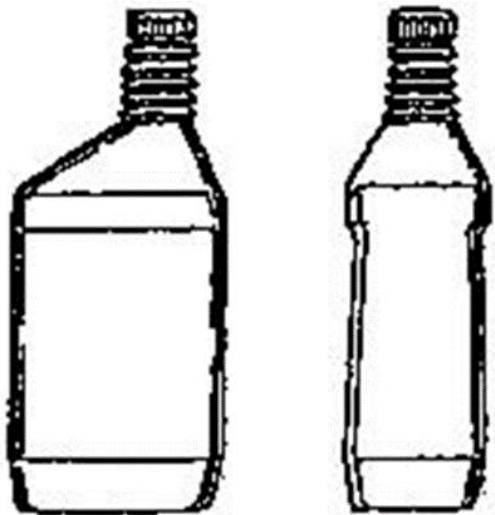
b/ If yes, then evaluate competitive need: Is the mark **de jure** functional, so that it cannot be protected as a mark? Do competitors need to have access to this design feature in order to exercise their rights under copyright and patent effectively?

2/ If the design is not “functional,” then ask: Is it distinctive?

(Registrable)

**In re Morton-
Norwich
Products, Inc.
(CCPA 1982)**

Is this design registrable?



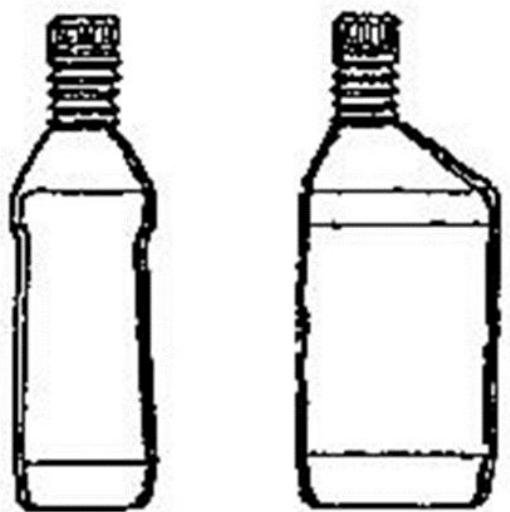
Apply the *M-N* factors.

- Existence of expired utility patent
- Utilitarian advantages touted in advertising
- Availability of alternative designs
- Manufacturing advantages

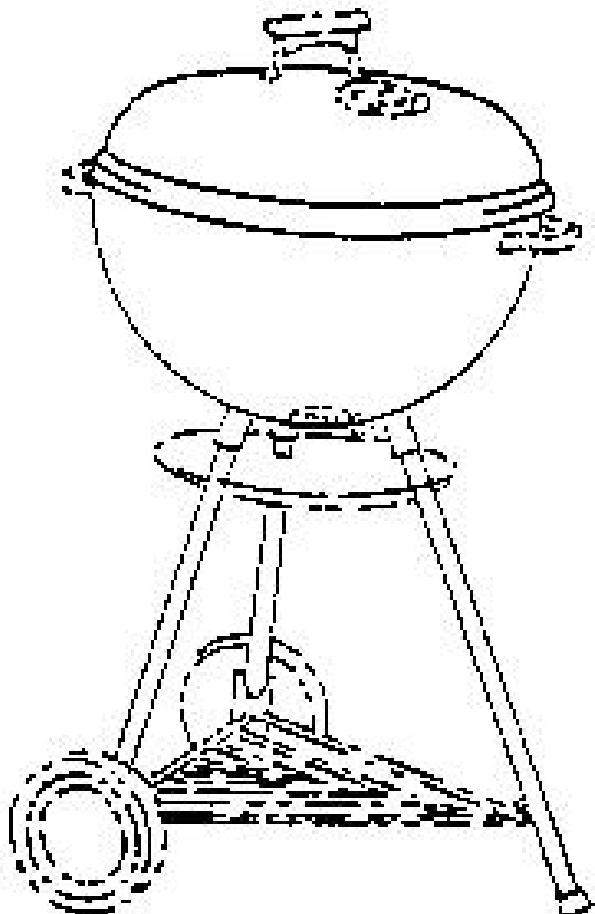
Company advertising said:

“Extensive research has shown that consumers prefer the Kendall ridged neck bottle because it helps prevent spillage while pouring.

Fun-L-Fil is a great consumer package that is easy to open, easy to pour with a special ribbed neck.”



Is this design registrable?



Apply the *M-N* factors.

- Existence of expired utility patent
- Utilitarian advantages touted in advertising
- Availability of alternative designs
- Manufacturing advantages

Company advertising said:

“It's round for a reason!

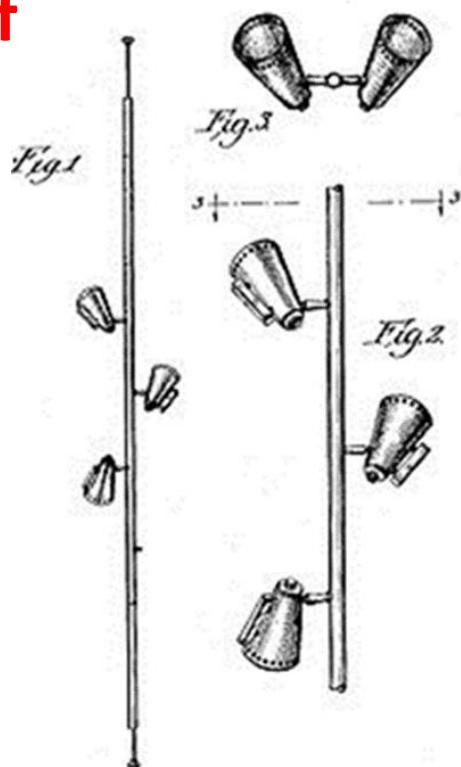
Forget the rotisserie and electric cord that ordinary grills need! *Round* means rotate the heat, not the meat.

Cook faster, more evenly, and save energy.”

**A “functional”
feature = “Essential
to the use or
purpose of the
article or if it affects
the cost or quality of
the article.”**

*Qualitex,
borrowing from
Inwood
Laboratories, Inc.
v. Ives
Laboratories, Inc.
(U.S. 1982)*

10. In general terms, 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. See *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 232, 84 S.Ct. 784, 789, 11 L.Ed.2d 661 (1964); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 122, 59 S.Ct. 109, 115, 83 L.Ed. 73 (1938).





Qualitex Co.
Jacobson
Products Co.,
Inc.
(U.S. 1995)

[T]his Court consequently has explained that, "[i]n general terms, a product feature is functional," and cannot serve as a trademark, **"if it is essential to the use or purpose of the article or if it affects the cost or quality of the article," that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.** Inwood Laboratories, Inc., *supra*, 456 U.S., at 850, n. 10

Summing up: two definitions of functionality:

One -- the “traditional” definition of functionality: “a product feature is functional, and cannot serve as a trademark, ‘if it is essential to the use or purpose of the article or if it affects the cost or quality of an article.’” [*Inwood/Qualitex/Traffix*] If a product feature is “the reason the device works,” then the feature is functional. The availability of alternative designs is irrelevant.

Utilitarian test – for useful things.

Two -- “a functional feature is one the ‘exclusive use of which would put competitors at a significant non-reputation-related disadvantage.’”

Competitive necessity test – for aesthetic attributes of things.

**Traffix Devices, Inc. v. Marketing Displays, Inc.
(U.S. 2001)**

[54] POSTER DISPLAY DEVICE

[72] Inventor: Robert Sarkisian, 8644 Woodside Park Drive, Oak Park, Mich. 48237

[22] Filed: July 30, 1970

[21] Appl. No.: 19.213

Related U.S. Application Data

[63] Continuation-in-part of Ser. No. 670,511, Sept. 11, 1967.

[52] U.S. Cl. 40/125 H, 40/145 A
[51] Int. Cl. G09f 7/22
[58] Field of Search 40/125 H, 145 A

[56] References Cited

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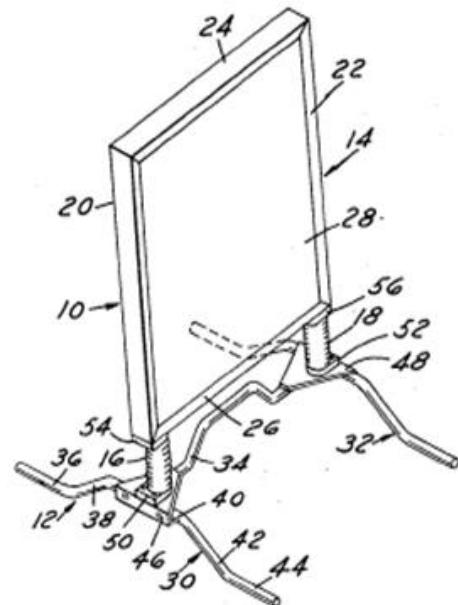
FOREIGN PATENTS OR APPLICATIONS

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ABSTRACT

The poster display device includes a base upon which is mounted a poster frame for receiving posters and like advertising media. The means for mounting the poster frame onto the base comprise a spring structure interconnecting the lower portion of the poster frame to the base at at least two points. The poster frame normally extends vertically upwardly from the base. The surface area of the frame is relatively large. The spring structure upon which the frame is mounted permits the frame to deflect downwardly upon the application of a force thereto, as for example, the wind when the structure is located out-of-doors. The frame may deflect in either direction without danger of tipping the base. The stronger the applied force, the more the frame will deflect downwardly thus reducing the component of any force tending to topple the display device. Further, the frame size, center of gravity and base size are so dimensioned as to prevent tipping as a result of gravity leverage after the frame has been deflected by the wind.

3 Claims, 9 Drawing Figures



TrafFix: “A **utility patent** is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection.”

[Nb. the burden of proof on functionality]

Marketing Displays, Inc.

Work-site signage catalog



- WINDMASTER®/SYSTEM 3®
- STEELMASTER®
- DURALATCH®

 **MDI**
Traffic Control Products

1-800-521-6776

Traffic Fix Devices, Inc.

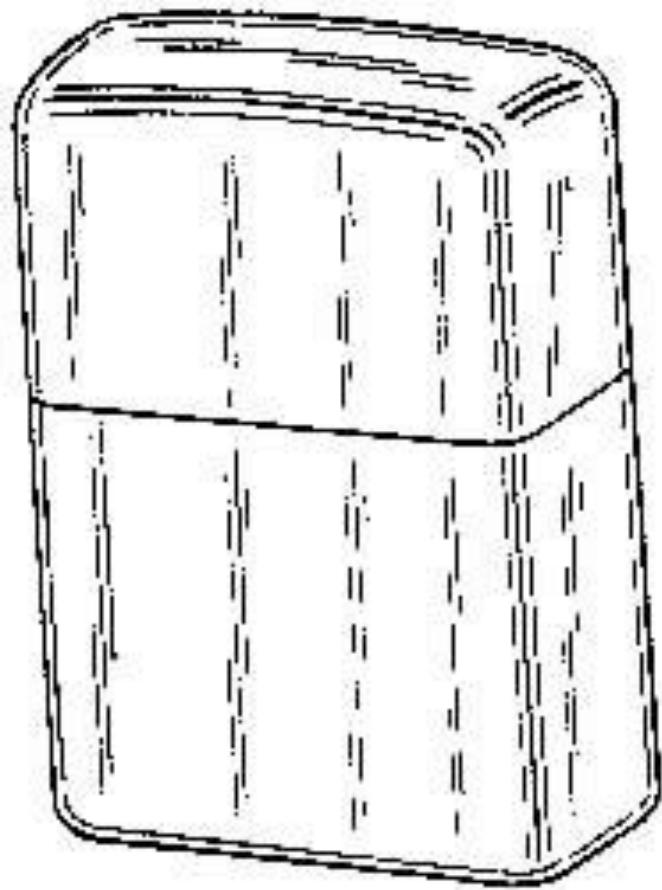
WindBuster™



WindBuster features a dual spring mounted base for added stability during high winds and new Step-n-Drop legs enable you to set-up in seconds without having to bend over or stoop down.

Traffic Fix
Devices Inc.





Can Zippo register the design of its lighter as a mark?



Zippo's utility patent on this design has expired.



Gibson “Les Paul”

vs

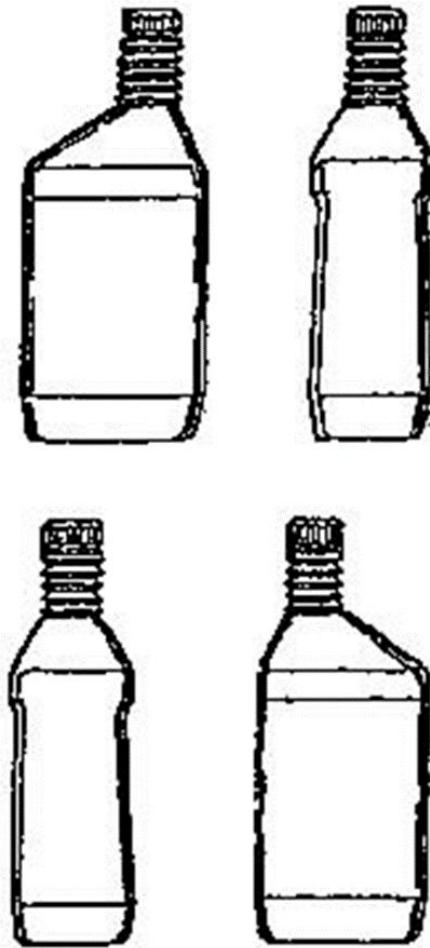
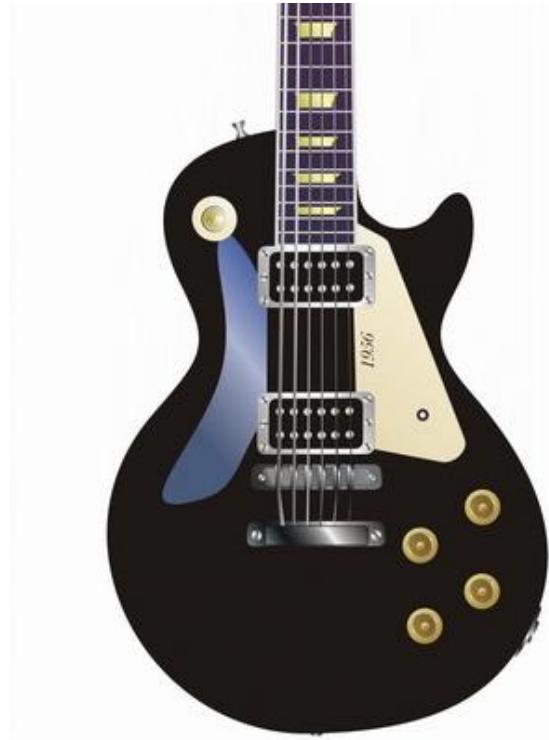
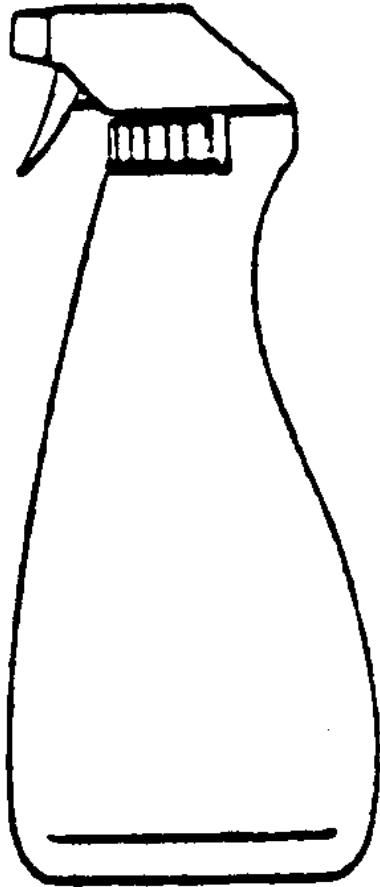


Paul Reed Smith (PRS) “Singlecut”

Is the Les Paul guitar body design protectable as a mark?

Is the body shape functional? Ask questions!

“Functionality” questions: (i) how does the shape affect how the guitar is used; (ii) how does the shape affect the market for guitars



Utility: analyze the case by comparing it to things we have answers about. Spray bottle configuration is registrable. Motor oil bottle is not registrable. Guitar body shape is ...?



Pictured: MH-C-LB

Alternatives and competitive need: Analyze the case by looking at the state of the market for (guitars) (electric guitars). Guitars come in lots of shapes and styles, incl. dreadnoughts (far left); Fender Stratocaster (middle); special designs (right and far right).



Is the number “3” functional in the context of motor sports? That is: Can the number “3” be registered as a mark?

THE END



FIRST NATIONAL
PICTURES INC.