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# THE BROAD SWEEP OF AESTHETIC FUNCTIONALITY: A THREAT TO TRADEMARK PROTECTION OF AESTHETIC PRODUCT FEATURES

## INTRODUCTION

The aesthetic appeal of a product has become increasingly important to its marketing potential<sup>1</sup> by aiding in the differentiation and identification of the product.<sup>2</sup> Consequently, obtaining trademark protection<sup>3</sup> for the aesthetic components of a product is quite benefi-

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1. See Spratling, *The Protectability of Package, Container, and Product Configurations* [Part I], 5 U.S.F.L. Rev. 451, 456, 462-63 (1971) [hereinafter cited as Spratling I].

2. See *id.* at 462-63.

3. Trademark protection in an identifying symbol may be acquired under federal or state law. At the federal level, the Lanham Act grants protection to marks registered on its Principal Register, Lanham Act, § 32, 15 U.S.C. § 1114 (1976), provided they have been adopted and used as an indication of source. *Id.* The Act also provides protection for unregistered common-law trademarks under its unfair competition section. Lanham Act, § 43(a), 15 U.S.C. § 1125(a) (1976); 1 J. Gilson, *Trademark Protection and Practice* § 7.02 [1], at 7-10 (1982); see *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 915 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981). At the state level, the common law of unfair competition and state trademark laws also may apply to prevent trademark infringement. *Id.* at 916; 1 J. Gilson, *supra*, § 1.04, at 1-38.3.

Trademark law is but a species of unfair competition law. *E.g.*, *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 915 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981); 1 J. McCarthy, *Trademarks and Unfair Competition* § 2:2, at 44 (1973). The early common law distinguished between "technical" trademarks, which were inherently distinctive identifying symbols protected under a body of law known as trademark infringement, and marks that were not inherently distinctive and protected only under unfair competition law upon a showing of secondary meaning. *Id.* § 4:3, at 98-100. Today, however, this distinction is considered insignificant. S. Rep. No. 1333, 79th Cong., 2d Sess. 3-4, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1275.

While the entire field of unfair competition law encompasses other unfair trade practices, such as trade dress simulation, 1 J. McCarthy, *supra*, § 1:5, at 14; see 1 J. Gilson, *supra*, § 7.02[2], at 7-19, a common-law action for unfair competition as to the confusingly similar use of an identifying symbol or mark is equivalent to an action for common-law trademark infringement. *Id.* § 1.04[1], at 1-40 n.10; see *Capewell Horse Nail Co. v. Mooney*, 172 F. 826, 827 (2d Cir. 1909); 1 J. McCarthy, *supra*, § 2:3, at 46; *id.* § 4:4, at 104. Such common-law actions typically involve marks adopted and used as indicia of origin that are not registered under the Lanham Act. See *Damn I'm Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 1360 (S.D.N.Y. 1981). When a mark has been registered under the Act, the cause of action is one for trademark infringement. Lanham Act, § 32, 15 U.S.C. § 1114 (1976). In a typical suit, however, a plaintiff may assert different counts based on the Lanham Act, common-law trademark infringement and unfair competition. See *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 654 (W.D. Wash. 1982).

cial for a manufacturer. In recent years, certain courts have denied exclusive trademark rights<sup>4</sup> in aesthetic features<sup>5</sup> because they have deemed those features functional.<sup>6</sup>

The doctrine of functionality provides that "functional" product features<sup>7</sup> not otherwise protected by a utility patent<sup>8</sup> are in the public domain and may be freely copied<sup>9</sup> despite the existence of a secondary

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4. The primary focus of this Note is the doctrine of functionality as it relates to trademark protection. For an extensive discussion of the functionality doctrine with respect to the law of unfair competition, see *Unfair Competition and the Doctrine of Functionality*, 64 Colum. L. Rev. 544 (1964)[hereinafter cited as *Doctrine of Functionality*].

5. For purposes of this Note, aesthetic features include: color, see *Ventura Travelware, Inc. v. Baltimore Luggage Co.*, 66 Misc. 2d 646, 647, 322 N.Y.S.2d 93, 96 (Sup. Ct. 1971) (striped color pattern on luggage), *aff'd*, 38 A.D.2d 794, 328 N.Y.S.2d 811 (1972), overall shape, see *In re Mogen David Wine Corp.*, 328 F.2d 925, 926-27 (C.C.P.A. 1964) (overall configuration of a wine decanter), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967), the shape of a component part, see *Famolare, Inc. v. Melville Corp.*, 472 F. Supp. 738, 740 (D. Hawaii 1979) (design of soles of shoes), *aff'd mem.*, 652 F.2d 62 (9th Cir. 1981), or an imprinted design pattern. See *Pagliero v. Wallace China Co.*, 198 F.2d 339, 340 (9th Cir. 1952) (floral pattern imprinted on china). Aesthetic features constitute a subcategory of product features. For an enumeration of types of product features, see *infra* note 7.

6. *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 920 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981); *Bliss v. Gotham Indus.*, 316 F.2d 848, 855 (9th Cir. 1963); *Damn I'm Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 1362-63 (S.D.N.Y. 1981); *Famolare, Inc. v. Melville Corp.*, 472 F. Supp. 738, 744 (D. Hawaii 1979), *aff'd mem.*, 652 F.2d 62 (9th Cir. 1981); *PPS, Inc. v. Jewelry Sales Representatives, Inc.*, 392 F. Supp. 375, 384 (S.D.N.Y. 1975); *Ventura Travelware, Inc. v. Baltimore Luggage Co.*, 66 Misc. 2d 646, 650-51, 322 N.Y.S.2d 93, 100 (Sup. Ct. 1971), *aff'd*, 38 A.D.2d 794, 328 N.Y.S.2d 811 (1972).

7. For purposes of this Note, product features analyzed under the doctrine of functionality include a design pattern inscribed or imprinted on the product, see *Pagliero v. Wallace China Co.*, 198 F.2d 339, 340, 343 (9th Cir. 1952), the product's overall shape, see *In re Deister Concentrator Co.*, 289 F.2d 496, 498 (C.C.P.A. 1961), and the shape of parts of the product. See *Alan Wood Steel Co. v. Watson*, 150 F. Supp. 861, 862 (D.D.C. 1957). For purposes of this Note, the features of a product's container are treated as "product features." See *Champion Spark Plug Co. v. A.R. Mosler & Co.*, 233 F. 112, 115 (S.D.N.Y. 1916) ("Nor does it matter . . . whether the feature lies in the case or container or in the very thing itself."); *Duo-Tint Bulb & Battery Co. v. Moline Supply Co.*, 46 Ill. App. 3d 145, 153, 360 N.E.2d 798, 804 (1977) ("[T]he doctrine of functionality applies equally to the package as to its contents.").

8. The only exclusive rights afforded to functional product features are those that may exist under the utility patent laws. 1 J. Gilson, *supra* note 3, § 2.13, at 2-101; 1 J. McCarthy, *supra* note 3, § 7:26, at 195; see *Best Lock Corp. v. Schlage Lock Co.*, 413 F.2d 1195, 1199 (C.C.P.A. 1969). A utility patent is a grant of "the right to exclude others from making, using or selling" a novel and non-obvious useful invention, 35 U.S.C. §§ 101, 102, 103 (1976), for a seventeen year period. 35 U.S.C. § 154 (1976).

9. *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 824 (3d Cir. 1981); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1336-37 (C.C.P.A. 1982); *In re Deister Concentrator Co.*, 289 F.2d 496, 504 (C.C.P.A. 1961); *Duo-Tint Bulb & Battery Co.*

meaning,<sup>10</sup> which is a consumer recognition of the feature as an indication of the product's source.<sup>11</sup> The basis of the doctrine is the strong public policy of promoting free competition;<sup>12</sup> courts have given great deference to the notion that no one should be awarded exclusive rights in useful product features.<sup>13</sup>

A feature is deemed functional if it is primarily dictated by utilitarian considerations; that is, it provides a significant contribution to the use or efficiency of a product.<sup>14</sup> Although this standard has been applied consistently to mechanical elements of a product's construction,<sup>15</sup> functionality analyses, in the past, did not address aesthetic product features.<sup>16</sup> A growing number of courts, however, have recently analyzed aesthetic features under a broad functionality stan-

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v. Moline Supply Co., 46 Ill. App. 3d 145, 151, 360 N.E.2d 798, 802-03 (1977); Spratling I, *supra* note 1, at 480-82.

10. *Famolare, Inc. v. Melville Corp.*, 472 F. Supp. 738, 744-45 (D. Hawaii 1979), *aff'd mem.*, 652 F.2d 62 (9th Cir. 1981); *Schwinn Bicycle Co. v. Murray Ohio Mfg. Co.*, 339 F. Supp. 973, 980 (M.D. Tenn. 1971), *aff'd per curiam*, 470 F.2d 975 (6th Cir. 1972); Spratling I, *supra* note 1, at 481.

11. Secondary meaning has been defined as "a mental recognition in buyers' and potential buyers' minds that products connected with the symbol or device emanate from or are associated with the same source." *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 658 (W.D. Wash. 1982).

12. *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 824, 827 (3d Cir. 1981); *Schwinn Bicycle Co. v. Murray Ohio Mfg. Co.*, 339 F. Supp. 973, 980 (M.D. Tenn. 1971), *aff'd per curiam*, 470 F.2d 975 (6th Cir. 1972); *Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 694-95 (S.D.N.Y. 1963); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1336-37, 1340 (C.C.P.A. 1982); *Doctrine of Functionality, supra* note 4, at 552, 560.

13. *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 824 (3d Cir. 1981); *Schwinn Bicycle Co. v. Murray Ohio Mfg. Co.*, 339 F. Supp. 973, 980 (M.D. Tenn. 1971), *aff'd per curiam*, 470 F.2d 975 (6th Cir. 1972); *In re Deister Concentrator Co.*, 289 F.2d 496, 504-05 (C.C.P.A. 1961); *cf. Duo-Tint Bulb & Battery Co. v. Moline Supply Co.*, 46 Ill. App. 3d 145, 151, 360 N.E.2d 798, 803 (1977) (the doctrine of functionality precludes exclusive unfair competition protection).

14. *E.g., In re Deister Concentrator Co.*, 289 F.2d 496, 500, 504 (C.C.P.A. 1961); *In re Ovation Instruments, Inc.*, 201 U.S.P.Q. (BNA) 116, 122-23 (Trademark Trial & App. Bd. 1978).

15. *Marvel Co. v. Pearl*, 133 F. 160, 161-62 (2d Cir. 1904) (the bulb shape of a syringe); *Schwinn Bicycle Co. v. Murray Ohio Mfg. Co.*, 339 F. Supp. 973, 980, 982 (M.D. Tenn. 1971) (the knurled markings on the inner facing of a bicycle rim), *aff'd per curiam*, 470 F.2d 975 (6th Cir. 1972); *Luminous Unit Co. v. R. Williamson & Co.*, 241 F. 265, 269 (N.D. Ill.) (the canopy and bowl configurations of a light fixture), *aff'd*, 245 F. 988 (1917), *cert. denied*, 253 U.S. 486 (1919); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1341-42 (C.C.P.A. 1982) (the design of a spray top and overall configuration of a plastic spray bottle); *see, e.g., In re Honeywell, Inc.*, 532 F.2d 180, 182-83 (C.C.P.A. 1976) (the round configuration of a thermostat cover); *In re Hollaender Mfg. Co.*, 511 F.2d 1186, 1189 (C.C.P.A. 1975) (the design of a cast aluminum fitting for joining tubing).

16. *Doctrine of Functionality, supra* note 4, at 553; Note, *Developments in the Law—Competitive Torts*, 77 Harv. L. Rev. 888, 919 (1964) [hereinafter cited as *Competitive Torts*]; *see Spratling I, supra* note 1, at 480 n.180.

dard,<sup>17</sup> readily holding aesthetic features functional if they are important ingredients in the commercial success of a product.<sup>18</sup>

This Note describes the development of this broad aesthetic functionality standard and argues against its future application. In denying trademark protection to aesthetic features on the basis of mere consumer appeal, courts fail to recognize that businessmen in today's mass marketing economy must select aesthetically pleasing product features to encourage consumer demand for their products.<sup>19</sup> The creation of this demand is a recognized trademark function<sup>20</sup> and therefore should not provide the basis for precluding trademark protection.

Furthermore, the granting of trademark protection to features that are merely aesthetically pleasing does not adversely affect free competition.<sup>21</sup> In fact, the adoption of this broad aesthetic functionality standard may have a numbing effect on the imagination involved in the creation of aesthetically pleasing product features.<sup>22</sup> This Note argues that aesthetic product features should be deemed functional only upon a showing that the feature substantially contributes to the use, efficiency or economy of the product.<sup>23</sup>

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17. Note, *The Problem of Functional Features: Trade Dress Infringement Under Section 43(a) of the Lanham Act*, 82 Colum. L. Rev. 77, 94-95 (1982) [hereinafter cited as *Trade Dress Infringement*]; *Doctrine of Functionality*, *supra* note 4, at 561-62, 564; *Competitive Torts*, *supra* note 16, at 919-20; *see, e.g.*, *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 917 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981); *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 662-63 (W.D. Wash. 1982); *Damn I'm Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 1360 (S.D.N.Y. 1981); *Famolare, Inc. v. Melville Corp.*, 472 F. Supp. 738, 743-44 (D. Hawaii 1979), *aff'd mem.*, 652 F.2d 62 (9th Cir. 1981).

18. *E.g.*, *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 917 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981); *Damn I'm Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 1360 (S.D.N.Y. 1981); *Famolare, Inc. v. Melville Corp.*, 472 F. Supp. 738, 743 (D. Hawaii 1979), *aff'd mem.*, 652 F.2d 62 (9th Cir. 1981); *see National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 662 (W.D. Wash. 1982).

19. *See Spratling I*, *supra* note 1, at 460-63.

20. *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942); *Restatement of Torts* § 715 comment b (1938); *see Spratling I*, *supra* note 1, 455-56, 462-63.

21. *See In re Penthouse Int'l Ltd.*, 565 F.2d 679, 682 (C.C.P.A. 1977); *In re Mogen David Wine Corp.*, 328 F.2d 925, 933 (C.C.P.A. 1964) (Rich, J., concurring), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967).

22. *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 825 (3d Cir. 1981); *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 663 (W.D. Wash. 1982).

23. *See Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 825 (3d Cir. 1981).

## I. THE DEVELOPMENT OF THE DOCTRINE OF FUNCTIONALITY

A. *Historical Background*

The doctrine of functionality developed as a result of a judicial desire to limit the protection afforded product features under the law of unfair competition.<sup>24</sup> At early common law, product features were not recognized as "technical" trademarks—those inherently distinctive marks deemed worthy of protection immediately upon adoption and use as an indication of a product's source.<sup>25</sup> These features, regardless of their arbitrary nature, were afforded legal protection from imitation only under the common law of unfair competition, which required a showing of secondary meaning in the features.<sup>26</sup>

The granting of such protection to product features was recognized as having a potentially greater anti-competitive effect than the granting of similar protection to such other identifying symbols as words or pictures affixed to labels.<sup>27</sup> An injunction against the imitation of a word affixed to a label, for example, was thought not to deprive an infringing competitor of anything of substantial value because the word could be changed easily to avoid confusion.<sup>28</sup> When protection is accorded a feature that is an integral component of a product, such as shape or an element of mechanical construction, however, the recipient of that protection acquires the right to exclude others from utilizing that feature and thus from producing a similar product.<sup>29</sup> Conse-

24. *Doctrine of Functionality*, *supra* note 4, at 551-52. Although at early common law, only word trademarks, labels and packages were protected under unfair competition law, *id.* at 546-49, by the early 1900's courts began to protect product configurations under unfair competition law as well. *Rushmore v. Manhattan Screw & Stamping Works*, 163 F. 939, 942 (2d Cir. 1908); *Yale & Towne Mfg. Co. v. Alder*, 154 F. 37, 38 (2d Cir. 1907); *Enterprise Mfg. Co. v. Landers, Fray & Clark*, 124 F. 923, 927-28 (C.C.D. Conn. 1903), *aff'd*, 131 F. 240 (2d Cir. 1904).

25. *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1336 (C.C.P.A. 1982); *Spratling I*, *supra* note 1, at 484; *see Doctrine of Functionality*, *supra* note 4, at 549-52.

26. *Doctrine of Functionality*, *supra* note 4, at 549-52. The reasons given for refusal of trademark protection included the fear that eventually all possible designs of a particular article would be granted exclusively to various trademark owners, thus impeding the entrance of competitors into the market for the goods. *See In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1336 (C.C.P.A. 1982); *Spratling I*, *supra* note 1, at 484.

27. *Doctrine of Functionality*, *supra* note 4, at 552 & n.50 (discussing *Shredded Wheat Co. v. Humphrey Cornell Co.*, 250 F. 960, 963-64 (2d Cir. 1918); *Flagg Mfg. Co. v. Holway*, 178 Mass. 83, 91, 59 N.E. 667, 667 (1901)).

28. *See Shredded Wheat Co. v. Humphrey Cornell Co.*, 250 F. 960, 963 (2d Cir. 1918).

29. *Doctrine of Functionality*, *supra* note 4, at 552 n.50 ("[T]he courts were not to tread upon the substantial right of the defendant to make and sell the same kind of goods as did the plaintiff.").

quently, protection of this kind was thought to inhibit the manufacture and marketing of goods<sup>30</sup> in an economic system that emphasizes vigorous competition.<sup>31</sup>

Thus, the doctrine of functionality was devised to preclude what were considered potentially perpetual monopolies in product features that were essential to the use or efficiency of a product.<sup>32</sup> Such "functional" features are legitimate subjects of free competition and should be accessible for all to imitate<sup>33</sup> even though they may have acquired secondary meaning.<sup>34</sup>

The policy concern of encouraging free competition in useful product features was incorporated into the law of trademarks,<sup>35</sup> once it was recognized that product features were capable<sup>36</sup> of trademark protection<sup>37</sup> if they either were inherently distinctive or had acquired

30. *Id.* Although the doctrine of functionality seems to have evolved as a response to protection of product configurations, the policy concerns of the doctrine apply equally to protection of container configurations. The acquisition of exclusive rights in either type of configuration may cause a decrease in competition. See Spratling I, *supra* note 1, at 457-58.

31. *Eastern Wine Corp. v. Winslow-Warren Ltd.*, 137 F.2d 955, 958 (2d Cir.), *cert. denied*, 320 U.S. 758 (1943); Spratling I, *supra* note 1, at 464.

32. *Daniel v. Electric Hose & Rubber Co.*, 231 F. 827, 833-34 (3d Cir. 1916); *Pope Automatic Merchandising Co. v. McCrum-Howell Co.*, 191 F. 979, 981 (7th Cir. 1911), *cert. denied*, 223 U.S. 730 (1912); *Marvel Co. v. Pearl*, 133 F. 160, 161-62 (2d Cir. 1904); see *Rushmore v. Saxon*, 158 F. 499, 507 (C.C.S.D.N.Y. 1908), *modified per curiam*, 170 F. 1021 (2d Cir. 1909).

33. *Marvel Co. v. Pearl*, 133 F. 160, 161-62 (2d Cir. 1904); *Luminous Unit Co. v. R. Williamson & Co.*, 241 F. 265, 269 (N.D. Ill.), *aff'd per curiam*, 245 F. 988 (7th Cir. 1917), *cert. denied*, 253 U.S. 486 (1919); *Doctrine of Functionality*, *supra* note 4, at 551-52.

34. *E.g.*, *In re Deister Concentrator Co.*, 289 F.2d 496, 504 (C.C.P.A. 1961); 1 J. McCarthy, *supra* note 3, § 7:26, at 195-96; Spratling I, *supra* note 1, at 481 & n.183.

35. Spratling I, *supra* note 1, at 494; see, *e.g.*, *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 824 (3d Cir. 1981); *Schwinn Bicycle Co. v. Murray Ohio Mfg. Co.*, 339 F. Supp. 973, 980 (M.D. Tenn. 1971), *aff'd per curiam*, 470 F.2d 975 (6th Cir. 1972); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1336-37 (C.C.P.A. 1982); *In re Deister Concentrator Co.*, 289 F.2d 496, 505 (C.C.P.A. 1961).

36. *Alan Wood Steel Co. v. Watson*, 150 F. Supp. 861, 863 (D.D.C. 1957); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1336 (C.C.P.A. 1982); *In re Minnesota Mining and Mfg. Co.*, 335 F.2d 836, 837 (C.C.P.A. 1964); *In re Mogen David Wine Corp.*, 328 F.2d 925, 932 (C.C.P.A. 1964), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967); *Ex Parte Haig & Haig Ltd.*, 118 U.S.P.Q. (BNA) 229, 230-31 (Comm'r Pat. 1958); see Dannay, *The Sears-Compco Doctrine Today: Trademarks and Unfair Competition*, 67 Trademark Rep. 132, 144 (1977); Spratling I, *supra* note 1, at 467-68, 493.

37. Under section 45 of the Lanham Act, 15 U.S.C. § 1127 (1976), a trademark is defined as "any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others." The statutory definition is essentially the same as that utilized by the common law. *McLean v. Fleming*, 96 U.S. 245, 254

secondary meaning.<sup>38</sup> Thus, as with unfair competition law, courts invoked the functionality doctrine to preclude the acquisition of exclusive trademark rights in those product features that were deemed functional.<sup>39</sup> They concluded that exclusive trademark rights in such "functional" features should not be awarded to one person even though the public has come to recognize the feature as an indication of

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(1877); see 1 J. McCarthy, *supra* note 3, § 3:1, at 85; Spratling, *The Protectability of Package, Container, and Product Configurations* [Part II], 6 U.S.F.L. Rev. 172, 184 (1971) [hereinafter cited as Spratling II]. Although product features are not listed in the statutory definition of a trademark, they have been held capable of trademark protection. *In re Kotzin*, 276 F.2d 411, 414-15 (C.C.P.A. 1960); *In re International Playtex Corp.*, 153 U.S.P.Q. (BNA) 377, 378 (Trademark Trial & App. Bd. 1967); see, e.g., *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1336 (C.C.P.A. 1982) (the configuration of a plastic spray bottle for liquid household cleaner); *In re Minnesota Mining & Mfg. Co.*, 335 F.2d 836, 838 (C.C.P.A. 1964) (the configuration of a chemical solid); *In re Superba Cravats, Inc.*, 145 U.S.P.Q. (BNA) 354, 355 (Trademark Trial & App. Bd. 1965) (the black and white color pattern of a hook-on-band for neckties). The ease with which trademark rights are acquired depends upon the nature of the mark in question. Inherently distinctive marks, such as fanciful and arbitrary marks, are afforded legal protection immediately upon adoption and use of the mark to identify goods. 1 J. McCarthy, *supra* note 3, § 16:2, at 569; see, e.g., *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 700 (2d Cir. 1961); *George Washington Mint, Inc. v. Washington Mint Inc.*, 349 F. Supp. 255, 263 (S.D.N.Y. 1972). For a comprehensive discussion of fanciful and arbitrary marks, see 1 J. McCarthy, *supra* note 3, §§ 11:2-:4. If, however, a mark is merely descriptive of a purpose, use, size or characteristic of a product, trademark rights will be acquired only upon a showing of secondary meaning. E.g., *Safeway Stores, Inc. v. Safeway Properties, Inc.*, 307 F.2d 495, 498-99 (2d Cir. 1962); *Charcoal Steak House, Inc. v. Staley*, 263 N.C. 199, 201-02, 139 S.E.2d 185, 187-88 (1964); 1 J. McCarthy, *supra* note 3, § 11:5, at 352-53. Trademark protection affords the owner an exclusive right to prevent others from using the mark in any way that might create a likelihood of public confusion as to the true source of the product. E.g., *McLean v. Fleming*, 96 U.S. 245, 251 (1877); *Safeway Stores, Inc. v. Safeway Properties, Inc.*, 307 F.2d 495, 499 (2d Cir. 1962); *Standard Brands, Inc. v. Smidler*, 151 F.2d 34, 36-37 (2d Cir. 1945); *Lanham Act*, § 32(1), 15 U.S.C. § 1114(1)(1976); 2 J. McCarthy, *supra* note 3, § 23:1, at 34-35. Such protection continues until the mark no longer serves its trademark purpose of identification, either through non-use with intent to abandon the mark, 1 J. McCarthy, *supra* note 3, §§ 17:3, :6, or whenever the mark is so widely associated with the particular product that it becomes the generic name of the product. 1 J. Gilson, *supra* note 3, § 3.06, at 3-101 to 3-102.

38. *Oxford Pendaflex Corp. v. Rolodex Corp.*, 204 U.S.P.Q. (BNA) 249, 255, 256 (Trademark Trial & App. Bd. 1979); 1 J. McCarthy, *supra* note 3, § 7:31, at 212-13; Spratling I, *supra* note 1, at 493-94.

39. *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1336 (C.C.P.A. 1982); 1 J. McCarthy, *supra* note 3, § 7:26, at 194; Spratling I, *supra* note 1, at 494; see, e.g., *Schwinn Bicycle Co. v. Murray Ohio Mfg. Co.*, 339 F. Supp. 973, 980-81 (M.D. Tenn. 1971) (the knurled markings on bicycle rims were held functional and precluded from trademark protection), *aff'd per curiam*, 470 F.2d 975 (6th Cir. 1972); *In re Deister Concentrator Co.*, 289 F.2d 496, 505-06 (C.C.P.A. 1961) (the shape of an ore concentrating and coal cleaning table was held functional and precluded from trademark protection).



source.<sup>40</sup> Similarly, the importance of free competition with respect to useful features prevails in the two other areas of intellectual property law,<sup>41</sup> patents<sup>42</sup> and copyrights.<sup>43</sup>

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40. *Schwinn Bicycle Co. v. Murray Ohio Mfg. Co.*, 339 F. Supp. 973, 980 (M.D. Tenn. 1971), *aff'd per curiam*, 470 F.2d 975 (6th Cir. 1972); *In re Deister Concentrator Co.*, 289 F.2d 496, 502-03 (C.C.P.A. 1961); *Spratling I*, *supra* note 1, at 498-500; *see Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 827 (3d Cir. 1981); 1 J. McCarthy, *supra* note 3, § 7:26, at 195-96. Two commentators have suggested that a functional product feature cannot be inherently distinctive because all similar products are likely to possess the useful feature and therefore, the feature will not appear in any way distinctive. 1 J. McCarthy, *supra* note 3, § 7:26, at 195; *Spratling I*, *supra* note 1, at 494-95. This argument does not appear persuasive. For example, in *In re Deister Concentrator Co.*, 289 F.2d 496 (C.C.P.A. 1961), a distinctive rhomboidal shape of an ore concentrating table was found to be functional. *Id.* at 498-500.

41. 1 J. Gilson, *supra* note 3, § 2.13, at 2-101 (noting that all three legal areas of intellectual property share the basic policy of the functionality doctrine: that the public interest in free competition prohibits the protectability of functional or utilitarian product features).

42. Patent law provides protection for two types of inventions: 1) functional or useful inventions, 1 J. McCarthy, *supra* note 3, § 6:3, at 127 (construing 35 U.S.C. § 101 (1976)); and 2) non-functional ornamental design inventions relating to articles of manufacture. 1 J. McCarthy, *supra* note 3, § 7:30, at 208 (construing 35 U.S.C. § 171 (1976)). In order to obtain either type of patent, the claimed invention must be novel and non-obvious. 35 U.S.C. §§ 102-103 (1976); *see Duo-Tint Bulb & Battery Co. v. Moline Supply Co.*, 46 Ill. App. 3d 145, 151, 360 N.E.2d 798, 803 (1977). Useful inventions are granted protection for seventeen years, 35 U.S.C. § 154 (Supp. IV 1980), whereas design patents are awarded for the elective terms of three and one half, seven or 14 years. 35 U.S.C. § 173 (1976). The basic policy objective underlying the patent grant is to encourage technological and industrial advances by assuring the creator an exclusive right to his invention. 1 J. McCarthy, *supra* note 3, § 6:1, at 124; *Spratling I*, *supra* note 1, at 485. Thus, the acquisition of a patent entitles its owner to exclude all others from making, using or selling his creation (even if another should by his own efforts discover the same invention at a later time). 35 U.S.C. § 271(a) (1976).

43. Copyright law protects the expressions of ideas fixed in tangible form. 17 U.S.C. § 102 (Supp. I 1977). It is only the expression of a particular idea or concept that is afforded legal protection—the idea itself is dedicated to the public domain. *Mazer v. Stein*, 347 U.S. 201, 217 (1954). All that is required is that the expression, such as a book, drawing or sculpture, be an original creation of the author. *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102 (2d Cir. 1951); *Doran v. Sunset House Distrib. Corp.*, 197 F. Supp. 940, 944 (S.D. Cal. 1961), *aff'd*, 304 F.2d 251 (9th Cir. 1962); *see Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1014 (5th Cir.), *cert. denied*, 423 U.S. 868 (1975). The term of copyright protection for works created on or after January 1, 1978 consists of the life of the author and fifty years after the author's death. 17 U.S.C. § 302(a) (Supp. I 1977). The policy objective in affording this protection is to encourage artistic and intellectual creativity. *Goldstein v. California*, 412 U.S. 546, 555 (1973); *Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1014 (5th Cir.), *cert. denied*, 423 U.S. 868 (1975). Unlike patent law, copyright protection does not entitle the owner to prevent others from using the copyrighted work. 1 M. Nimmer, *Nimmer on Copyright* § 2.18[A], at 2-195 (2d ed.

### B. Temporary Patent Protection for Utilitarian Product Features

The only exclusive rights allowed in useful product features are those limited rights available under the utility patent laws.<sup>44</sup> The temporary nature of utility patent protection is designed to grant only those rights under the patent laws that are necessary to encourage technological and industrial advances by assuring inventors some protection for their creative endeavors.<sup>45</sup> Consequently, courts have held consistently that a product feature qualifying as primarily functional and thus protected by a utility patent is ineligible for trademark protection;<sup>46</sup> utility patent and trademark protection for product features are mutually exclusive.<sup>47</sup> By contrast, because a product feature that qualifies for a design patent must be *non-functional* and ornamental, design patent and trademark protection are not mutually exclusive; dual protection in this instance does not violate the public policy of free competition in functional product features.<sup>48</sup>

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1982). It merely prohibits the unauthorized reproduction or copying of the work. *Goldstein v. California*, 412 U.S. 546, 555 (1973); see 17 U.S.C. § 106 (1976).

44. 1 J. Gilson, *supra* note 3, § 2.13, at 2-101; 1 J. McCarthy, *supra* note 3, § 7:26, at 195; see *Best Lock Corp. v. Schlage Lock Co.*, 413 F.2d 1195, 1199 (C.C.P.A. 1969).

45. See *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1215 (8th Cir.), *cert. denied*, 429 U.S. 861 (1976); 1 J. McCarthy, *supra* note 3, § 6:1, at 124; *Spratling I*, *supra* note 1, at 485.

46. *In re Honeywell, Inc.*, 497 F.2d 1344, 1347-48 (C.C.P.A.), *cert. denied*, 419 U.S. 1080 (1974); *In re Shenango Ceramics, Inc.*, 362 F.2d 287, 292 (C.C.P.A. 1966); 1 J. McCarthy, *supra* note 3, § 7:29, at 207; see *Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U.S. 249, 256 (1945); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 119-20 (1938). Typically, the question of dual protection arises in the context of one who attempts to acquire a trademark for a feature that is already the subject of a patent, see *In re Mogen David Wine Corp.*, 328 F.2d 925 (C.C.P.A. 1964), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967), or a feature for which patent protection has expired. See *In re Honeywell, Inc.*, 497 F.2d 1344 (C.C.P.A.), *cert. denied*, 419 U.S. 1080 (1974).

47. 1 J. McCarthy, *supra* note 3, § 7:29, at 207; see *In re Honeywell, Inc.*, 497 F.2d 1344, 1348 (C.C.P.A.), *cert. denied*, 419 U.S. 1080 (1974).

48. *In re Honeywell, Inc.*, 497 F.2d 1344, 1348 (C.C.P.A.), *cert. denied*, 419 U.S. 1080 (1974); *In re Mogen David Wine Corp.*, 328 F.2d 925, 928-30 (C.C.P.A. 1964), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967). In *In re Mogen David Wine Corp.*, 328 F.2d 925 (C.C.P.A. 1964), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967), the Court of Customs and Patent Appeals held that the existence of design patent protection did not preclude trademark protection for a wine bottle shape. *Id.* at 928-30. The lower court had denied registration, contending that the granting of trademark protection in the shape would extend the patent monopoly beyond the 17 year period of patent protection. The Court of Customs and Patent Appeals, in holding the lower court in error for denying registration, stressed the distinct concepts and purposes underlying the patent and trademark laws and found no valid reason why the two protections could not subsist at the same time in the same configuration. *Id.* More recently, in *In re Honeywell, Inc.*, 497 F.2d 1344 (C.C.P.A.), *cert. denied*, 419 U.S. 1080 (1974), the Court of Customs and Patent Appeals, again emphasizing the distinction between

### C. *Limitations on the Copyrightability of Utilitarian Expressions*

The importance placed on the free accessibility of useful product features in trademark and patent law has a counterpart in copyright law: the doctrine enunciated in *Baker v. Selden*.<sup>49</sup> The doctrine provides that if the use of an idea embodied in a copyrighted expression requires the reproduction of the expression itself, such reproduction does not constitute an infringement.<sup>50</sup> Thus, in *Baker* the Court held that the use of blank accounting forms, which represented a new bookkeeping system, did not constitute an infringement because reproduction of those forms was necessary to the use of the system.<sup>51</sup> Furthermore, the doctrine has been applied to permit the construction of a building from another's copyrighted architectural plans.<sup>52</sup> The policy rationale for this doctrine parallels the rationale underlying the doctrine of functionality. Expressions that are necessary to the use of ideas, methods or systems should not be monopolized under the copyright laws; they should be freely accessible for all to use.<sup>53</sup>

### D. *Potential Conflicts Between Trademark Protection and Design Patent Protection for Product Designs*

It has been argued that trademark protection should not be accorded product features for which protection under the design patent or copyright laws has expired or been denied.<sup>54</sup> Because patent and

the bases of patent and trademark law, held that the lower court had erred in refusing trademark registration for a thermostat cover configuration because it previously had been protected under a design patent. *Id.* at 1347-49.

49. 101 U.S. 99 (1879).

50. *Id.* at 102-04; 1 M. Nimmer, *supra* note 43, § 2.18[B], at 2-199. *See generally id.* § 2.18[A]-[D].

51. 101 U.S. at 102-04 (1879).

52. *DeSilva Constr. Corp. v. Herral*, 213 F. Supp. 184, 195-96 (M.D. Fla. 1962); *see Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971)(the doctrine applied to allow the copying of a jewelry pin in the shape of a bee); *Muller v. Triborough Bridge Auth.*, 43 F. Supp. 298, 300 (S.D.N.Y. 1942)(the doctrine applied to allow copying of a traffic system embodied in a drawing illustrating a novel approach to unsnarling traffic congestion). Other courts have interpreted *Baker* to hold that if only limited ways exist in which to express an idea, those expressions are not capable of copyright protection. *E.g.*, *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675 (1st Cir. 1967)(doctrine applied to reject the copyrightability of contest instructions); *Decorative Aides Corp. v. Staple Sewing Aides Corp.*, 497 F. Supp. 154 (S.D.N.Y. 1980)(doctrine applied to reject the copyrightability of instruction sheet for hanging drapery), *aff'd*, Nos. 80-7658, 80-7668 (2d Cir. March 9, 1981).

53. 101 U.S. at 102-04. As is the case with utilitarian product features, the right to copy useful works will be restricted only under the patent laws. *Id.* at 103.

54. *Scott Paper Co. v. Marcalus Co.*, 326 U.S. 249, 256 (1945); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 117-20 (1938); 1 J. McCarthy, *supra* note 3, § 7:33, at 217-18, 219-20; *Dannay*, *supra* note 36, at 137; *Derenberg*, *Symposium—*

copyright protection originate from the Constitution, which requires that those protections be limited in duration,<sup>55</sup> the granting of potentially indefinite trademark rights,<sup>56</sup> which originate at common law,<sup>57</sup> would extend the rights in a design for which protection has expired beyond the constitutionally prescribed period.<sup>58</sup> Furthermore, in the *Sears-Compco* decisions,<sup>59</sup> the Supreme Court held that an unpatent-

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*Product Simulation: A Right or a Wrong?*, 64 Colum. L. Rev. 1192, 1201-02 (1964); Spratling II, *supra* note 37, at 182-83, 185-88; see *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237-38 (1964); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230-31 (1964).

55. 1 J. McCarthy, *supra* note 3, § 6:1, at 122; see U.S. Const. art. I, § 8, cl. 8 ("[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries").

56. *In re Mogen David Wine Corp.*, 372 F.2d 539, 543 (C.C.P.A. 1967) (Smith, J., concurring). See *supra* note 36.

57. *Chadwick v. Covell*, 151 Mass. 190, 193, 23 N.E. 1068, 1069 (1890); McClure, *Trademarks and Unfair Competition: A Critical History of Legal Thought*, 69 Trademark Rep. 305, 314-16 (1979); Pattishall, *Two Hundred Years of American Trademark Law*, 68 Trademark Rep. 121, 123-28 (1978); see Spratling I, *supra* note 1, at 467.

58. *Derenberg*, *supra* note 54, at 1201; see *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230-31 (1964); 1 J. McCarthy, *supra* note 3, § 7:24, at 190; Spratling II, *supra* note 37, at 178.

59. *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964). The Court held that the federal patent and copyright laws preempted state common-law protection for product features. *Compco*, 376 U.S. at 237-38; *Sears*, 376 U.S. at 230-32; see 1 J. Gilson, *supra* note 3, § 2.13, at 2-100; 1 J. McCarthy, *supra* note 3, § 7:24, at 190-92; *Dannay*, *supra* note 36, at 135-37; Spratling II, *supra* note 37, at 178. Accordingly, in both *Sears* and *Compco*, the Court refused to enjoin the copying by competitors of certain lamp features ineligible for design patent protection despite evidence of secondary meaning and consumer confusion as to the source of the lamp. *Compco*, 376 U.S. at 238; *Sears*, 376 U.S. at 232-33. Initially, these decisions were interpreted as eradicating all state unfair competition and trademark protection for product features. 1 J. McCarthy, *supra* note 3, § 7:25, at 192-93; *Dannay*, *supra* note 36, at 137. Furthermore, those who argued that Lanham Act registration only extends to trademarks that qualify for protection under state common law suggested that the *Sears-Compco* decisions precluded federal trademark registration of product features as well. 1 J. McCarthy, *supra* note 3, § 7:33, at 217-18; Spratling II, *supra* note 37, at 182-83; see *Dannay*, *supra* note 36, at 137. Recent decisions, however, have refused to interpret the two cases so broadly. *Le Sportsac, Inc. v. Dockside Research, Inc.* 478 F. Supp. 602, 606 (S.D.N.Y. 1979); Spratling II, *supra* note 37, at 192-94; see *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204 (2d Cir. 1979); *Ives Labs., Inc. v. Darby Drug Co.*, 601 F.2d 631, 639-41 (2d Cir. 1979), *remand opinion rev'd on other grounds*, 638 F.2d 538 (2d Cir. 1981), *rev'd on other grounds sub nom.* *Inwood Labs., Inc. v. Ives Labs., Inc.*, 102 S. Ct. 2182 (1982); *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1214, 1215 n.6 (8th Cir.), *cert. denied*, 429 U.S. 861 (1976); *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 663 (W.D. Wash. 1982). The notion that the *Sears-Compco* doctrine bars federal trademark protection for product

able or uncopyrightable product design is in the public domain, and thus state law may not prevent its imitation by others.<sup>60</sup> Under the *Sears-Compco* philosophy, therefore, protection should not be afforded to product features that do not reach a level of invention sufficient to qualify for design patent protection.<sup>61</sup> The theory underlying the arguments against granting trademark protection both to designs for which patent or copyright protection has expired, as well as to unpatentable or uncopyrightable designs, is that upon the expiration or denial of patent or copyright protection, product designs must be irretrievably returned to or left in the public domain.<sup>62</sup>

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features has been rejected. *Rolls-Royce Motors Ltd. v. A & A Fiberglass, Inc.*, 428 F. Supp. 689, 692-93 (N.D. Ga. 1976); *In re Mogen David Wine Corp.*, 372 F.2d 539, 542-45 (C.C.P.A. 1967)(Smith, J., concurring); *Electric Storage Battery Co. v. Mine Safety Appliances Co.*, 143 U.S.P.Q. (BNA) 163, 166-67 (Trademark Trial & App. Bd. 1964); see *Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1013-14 (5th Cir.), cert. denied, 423 U.S. 868 (1975); Dannay, *supra* note 36, at 144-45; *Spratling II*, *supra* note 37, at 201. Language in the *Compco* case that "if the design is not entitled to a design patent or other federal statutory protection, then it can be copied at will," 376 U.S. at 238 (emphasis added), has been interpreted as allowing trademark protection for product configurations registered under the federal Lanham Act. 3 R. Callmann, *The Law of Unfair Competition, Trademarks and Monopolies* § 77.4(e)(5), at 411-12 (3d ed. 1969)[hereinafter cited as R. Callmann I]; Dannay, *supra* note 36, at 144-45; *Spratling II*, *supra* note 37, at 192-93. Similarly, the unfair competition section of the Lanham Act has been invoked to provide protection for unregistered trademarks as well as other state unfair competition claims involving product features. *Ives Labs., Inc. v. Darby Drug Co.*, 601 F.2d 631, 642 (2d Cir. 1979), remand opinion rev'd on other grounds, 638 F.2d 538 (2d Cir. 1981), rev'd on other grounds sub nom. *Inwood Labs., Inc. v. Ives Labs., Inc.*, 102 S. Ct. 2182 (1982); *Le Sportsac, Inc. v. Dockside Research, Inc.*, 478 F. Supp. 602, 606 (S.D.N.Y. 1979); 1 J. Gilson, *supra* note 3, § 2.13, at 2-100; Dannay, *supra* note 36, at 144. Some courts have explicitly rejected the suggestion that the *Sears-Compco* doctrine preempts state common-law trademark protection. See *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1214-1215 & n.6 (8th Cir.), cert. denied, 429 U.S. 861 (1976). In actuality then, the *Sears-Compco* doctrine only preempts state common-law unfair competition and trademark protection that is equivalent to a patent or copyright. *Ives Labs., Inc. v. Darby Drug Co.*, 601 F.2d 631, 642 (2d Cir. 1979), remand opinion rev'd on other grounds, 638 F.2d 538 (2d Cir. 1981), rev'd on other grounds sub nom. *Inwood Labs., Inc. v. Ives Labs., Inc.*, 102 S. Ct. 2182 (1982); Dannay, *supra* note 36, at 142-43.

60. *Compco*, 376 U.S. at 237-38; *Sears*, 376 U.S. at 230-32; see *Ives Labs., Inc. v. Darby Drug Co.*, 601 F.2d 631, 642 (2d Cir. 1979), remand opinion rev'd on other grounds, 638 F.2d 538 (2d Cir. 1981), rev'd on other grounds sub nom. *Inwood Labs., Inc. v. Ives Labs., Inc.*, 102 S. Ct. 2182 (1982); P. Rosenberg, *Patent Law Fundamentals* § 4.05, at 4-28.13 to 4-29 (rev. 2d ed. 1982); *Spratling II*, *supra* note 37, at 178-79.

61. 1 J. McCarthy, *supra* note 3, § 7:24, at 190-92; *Spratling II*, *supra* note 37, at 178; see *Compco*, 376 U.S. at 237-38; *Sears*, 376 U.S. at 230-32.

62. *Compco*, 376 U.S. at 237-38; *Sears*, 376 U.S. at 231-32; 1 J. McCarthy, *supra* note 3, § 7:24, at 190; *Spratling II*, *supra* note 37, at 185-88; *Spratling I*, *supra* note 1, at 514 n.399.

Courts and commentators have rejected these arguments on various grounds.<sup>63</sup> The Court of Customs and Patent Appeals has rejected the claim that granting trademark protection to a product feature for which design patent protection has expired would extend the patent monopoly.<sup>64</sup> The court in *In re Mogen David Wine Corp.*,<sup>65</sup> noted that the underlying purpose and nature of the rights afforded under the patent laws are separate and distinct from those protected under trademark law:

[T]rademark rights . . . which happen to continue beyond the expiration of a design patent, do not "extend" the patent monopoly. They exist independently of it, under different law and for different reasons. The termination of either has no legal effect on the continuance of the other. When the patent monopoly ends, it ends. The trademark rights do not extend it.<sup>66</sup>

The purpose of encouraging invention of ornamental designs under the federal design patent laws<sup>67</sup> is fulfilled by the granting of a patent.<sup>68</sup> Upon expiration of the patent right in a product feature that is non-functional and serves primarily as a means to distinguish the goods of the trademark owner from those of others, a new and separate interest arises—preventing public confusion as to the source of goods.<sup>69</sup> Thus, the granting of trademark protection to unpatentable

63. See *Rolls-Royce Motors, Ltd. v. A & A Fiberglass, Inc.*, 428 F. Supp. 689, 692 (N.D. Ga. 1976); *In re Honeywell, Inc.*, 497 F.2d 1344, 1347-49 (C.C.P.A.), cert. denied, 419 U.S. 1080 (1974); *In re Mogen David Wine Corp.*, 372 F.2d 539, 542 (C.C.P.A. 1967) (Smith, J., concurring); *In re Mogen David Wine Corp.*, 328 F.2d 925, 927-30 (C.C.P.A. 1964), aff'd, 372 F.2d 539 (C.C.P.A. 1967); *Electric Storage Battery Co. v. Mine Safety Co.*, 143 U.S.P.Q. (BNA) 163, 166-67 (Trademark Trial & App. Bd. 1964); 3 R. Callmann I, *supra* note 59, § 77.4(e)(5), at 411-12; *Dannay*, *supra* note 36, at 144-45; *Spratling II*, *supra* note 37, at 192-94; *Spratling I*, *supra* note 1, at 514 & n.399.

64. *In re Mogen David Wine Corp.*, 328 F.2d 925, 928-30 (C.C.P.A. 1964) (existing design patent for wine decanter shape), aff'd, 372 F.2d 539 (C.C.P.A. 1967); see *In re Honeywell, Inc.*, 497 F.2d 1344, 1347-48 (C.C.P.A.) (expired design patent for thermostat cover design), cert. denied, 419 U.S. 1080 (1974).

65. 328 F.2d 925, 929-30 (C.C.P.A. 1964), aff'd, 372 F.2d 539 (C.C.P.A. 1967).

66. *Id.* at 930; *accord Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1215 (8th Cir.), cert. denied, 429 U.S. 861 (1976); *In re Penthouse Int'l Ltd.*, 565 F.2d 679, 683 n.3 (C.C.P.A. 1977); *In re Honeywell, Inc.*, 497 F.2d 1344, 1348 (C.C.P.A.), cert. denied, 419 U.S. 1080 (1974); *In re Deister Concentrator Co.*, 289 F.2d 496, 501 & n.3 (C.C.P.A. 1961).

67. *In re Honeywell, Inc.*, 497 F.2d 1344, 1348 (C.C.P.A.), cert. denied, 419 U.S. 1080 (1974); 1 J. McCarthy, *supra* note 3, § 6:1, at 124; *Spratling I*, *supra* note 1, at 485.

68. *In re Mogen David Wine Corp.*, 372 F.2d 539, 543 (C.C.P.A. 1967) (Smith, J., concurring); see *Spratling I*, *supra* note 1, at 514 n.399.

69. *In re Honeywell, Inc.*, 497 F.2d 1344, 1348 (C.C.P.A.), cert. denied, 419 U.S. 1080 (1974); *In re Mogen David Wine Corp.*, 372 F.2d 539, 545 (C.C.P.A. 1967) (Smith, J., concurring).

features or features for which design patent protection has expired should not be considered an additional reward to the originator. In fact, the Court of Customs and Patent Appeals has held that the public interest in being protected from confusion overrides "any alleged extension of design patent rights."<sup>70</sup>

Furthermore, the notion that the expiration or denial of design patent protection must irretrievably place product designs in the public domain and thus preclude trademark protection has been rejected.<sup>71</sup> Some courts and commentators have contended that patent law does not grant an unrestricted right to copy those features that it returns to or leaves in the public domain.<sup>72</sup> Rather, the patent laws merely restrict for a limited time the inherent right of the public to copy product features;<sup>73</sup> they do not, upon expiration, create an affirmative right to copy.<sup>74</sup> Moreover, it has been suggested that the public domain concept is merely a legal construct determined only after consideration of various legal rights afforded product features, including trademark protection.<sup>75</sup> Thus, features denied design patent protection, or for which design patent protection has expired, may be afforded trademark protection provided the requirements for such protection are met.<sup>76</sup>

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70. *In re Honeywell, Inc.*, 497 F.2d 1344, 1348 (C.C.P.A.), *cert. denied*, 419 U.S. 1080 (1974).

71. 1 J. McCarthy, *supra* note 3, § 7:33, at 220; Spratling II, *supra* note 37, at 188-89; *see* *Gibbons v. Ogden*, 22 U.S. 1, 22-23, 9 Wheat. 1, 50-51 (1824); *Mine Safety Appliances Co. v. Electric Storage Battery Co.*, 405 F.2d 901, 902 n.2 (C.C.P.A. 1969); *In re Deister Concentrator Co.*, 289 F.2d 496, 501 n.3 (C.C.P.A. 1961).

72. *Gibbons v. Ogden*, 22 U.S. 1, 22-23, 9 Wheat. 1, 50-51 (1824); *In re Mogen David Wine Corp.*, 328 F.2d 925, 930 (C.C.P.A. 1964), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967); *In re Deister Concentrator Co.*, 289 F.2d 496, 501 n.3 (C.C.P.A. 1961); 1 J. McCarthy, *supra* note 3, § 7:33, at 220; Spratling II, *supra* note 37, at 188-89.

73. *Mine Safety Appliances Co. v. Electric Storage Battery Co.*, 405 F.2d 901, 902 n.2 (C.C.P.A. 1969); *In re Mogen David Wine Corp.*, 328 F.2d 925, 930 (C.C.P.A. 1964), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967); *In re Deister Concentrator Co.*, 289 F.2d 496, 501 n.3 (C.C.P.A. 1961); Spratling II, *supra* note 37, at 188, 190 n.485.

74. Spratling II, *supra* note 37, at 188 (footnote omitted).

75. *Mine Safety Appliances Co. v. Electric Storage Battery Co.*, 405 F.2d 901, 902 n.2 (C.C.P.A. 1969).

76. *See In re Honeywell, Inc.*, 497 F.2d 1344, 1347-49 (C.C.P.A.), *cert. denied*, 419 U.S. 1080 (1974); *In re Mogen David Wine Corp.*, 328 F.2d 925, 928-30 (C.C.P.A. 1964), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967); *Rolls-Royce Motors Ltd. v. A & A Fiberglass, Inc.*, 428 F. Supp. 689, 692-94 (N.D. Ga. 1976). Similarly, designs for which copyright protection has expired have been afforded trademark protection. *Frederick Warne & Co. v. Book Sales Inc.*, 481 F. Supp. 1191, 1196-97 (S.D.N.Y. 1979) (character illustrations in children's books for which copyright protection expired were afforded trademark protection because the characters identified the creator of the storybooks).

Although the functionality doctrine recognizes the need to preclude protection for useful product features that may have been protected under a utility patent for a limited period,<sup>77</sup> the basis for precluding protection is the concern that useful product features should be freely accessible and not that an inherent conflict between the utility patent and trademark laws exists.<sup>78</sup> The functionality doctrine more discriminately assigns to the public domain that which is most appropriate—useful product features that are important enough to competition to require their accessibility for public use.<sup>79</sup>

### E. The Utilitarian Standard

The earliest standard of functionality has been described as a strictly utilitarian approach.<sup>80</sup> Only those features absolutely necessary to a product's use were considered functional.<sup>81</sup> In addition, the only features deemed functional were elements of the mechanical construction of a product,<sup>82</sup> such as the longitudinal corrugations of a rubber hose,<sup>83</sup> the mouth-piece and rotary fan of a vacuum cleaner,<sup>84</sup> and the canopy shade of a light fixture.<sup>85</sup> Thus, most early decisions

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77. *In re Honeywell, Inc.* 497 F.2d 1344, 1347-48 (C.C.P.A.), *cert. denied*, 419 U.S. 1080 (1974); *see* *Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U.S. 249, 256 (1945); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 117-20 (1938).

78. *In re Honeywell, Inc.*, 497 F.2d 1344, 1347-48 (C.C.P.A.) ("When federal trademark rights have been sought for functional subject matter disclosed in a utility patent . . . the acquisition of such rights will not be allowed in view of the 'overriding public policy of preventing their monopolization, of preserving the public right to copy.'"), *cert. denied*, 419 U.S. 1080 (1974); *accord* *Best Lock Corp. v. Schlage Lock Co.*, 413 F.2d 1195, 1199 (C.C.P.A. 1969). *But see* *Sylvania Elec. Prods. v. Dura Elec. Lamp Co.*, 247 F.2d 730, 733 n.2 (3d Cir. 1957); 1 J. McCarthy, *supra* note 3, § 7:26, at 194-95; *cf.* *Duo-Tint Bulb & Battery Co. v. Moline Supply Co.*, 46 Ill. App. 3d 145, 151, 360 N.E.2d 798, 803 (1977) (conflict between patent and unfair competition law).

79. *In re Honeywell, Inc.*, 497 F.2d 1344, 1348 (C.C.P.A.), *cert. denied*, 419 U.S. 1080 (1974); *see, e.g.*, *Marvel Co. v. Pearl*, 133 F. 160, 161-62 (2d Cir. 1904); *In re Deister Concentrator Co.*, 289 F.2d 496, 504-05 (C.C.P.A. 1961).

80. *Doctrine of Functionality*, *supra* note 4, at 552-53; *see* *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 824 (3d Cir. 1981); *Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 691 (S.D.N.Y. 1963).

81. *Marvel Co. v. Pearl*, 133 F. 160, 161 (2d Cir. 1904); *Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 691 (S.D.N.Y. 1963); *Luminous Unit Co. v. R. Williamson & Co.*, 241 F. 265, 269 (N.D. Ill.), *aff'd per curiam*, 245 F. 988 (7th Cir. 1917), *cert. denied*, 253 U.S. 486 (1920); *Doctrine of Functionality*, *supra* note 4, at 552-53, 558-59; *Competitive Torts*, *supra* note 16, at 919.

82. *Doctrine of Functionality*, *supra* note 4, at 553; *Competitive Torts*, *supra* note 16, at 919.

83. *See* *Daniel v. Electric Hose & Rubber Co.*, 231 F. 827 (3d Cir. 1916).

84. *Pope Automatic Merchandising Co. v. McCrum-Howell Co.*, 191 F. 979 (7th Cir. 1911), *cert. denied*, 223 U.S. 730 (1912).

85. *Luminous Unit Co. v. R. Williamson & Co.*, 241 F. 265 (N.D. Ill.), *aff'd per curiam*, 245 F. 988 (7th Cir. 1917), *cert. denied*, 253 U.S. 486 (1920).



found product designs or configurations functional if the features were of a mechanical or technical nature essential for: 1) the successful practical use of the product;<sup>86</sup> 2) the efficiency of the product;<sup>87</sup> 3) the structural construction of the product;<sup>88</sup> or 4) the most economical manufacture of the product.<sup>89</sup> Most courts did not analyze aesthetic product features when determining functionality.<sup>90</sup> Aesthetic features were probably not considered essential to the use or efficiency of a product.<sup>91</sup> One court, however, expressly distinguished "between imitating the functional and mechanical construction essential to the proper operation or making of the device and imitating the general form and appearance or ornamentation essential to commercial success from the standpoint of taste and attractiveness."<sup>92</sup>

After the publication of the First Restatement of Torts in 1938,<sup>93</sup> a broader standard of functionality was adopted by courts, supplanting the strictly utilitarian approach to non-aesthetic product features.<sup>94</sup> Although essential utilitarian features were still deemed functional, the Restatement approach did not limit a finding of functionality to essential features alone.<sup>95</sup> According to section 742 of the Restatement:

86. *Marvel Co. v. Pearl*, 133 F. 160, 161 (2d Cir. 1904); *Luminous Unit Co. v. R. Williamson & Co.*, 241 F. 265, 269 (N.D. Ill.), *aff'd per curiam*, 245 F. 988 (7th Cir. 1917), *cert. denied*, 253 U.S. 486 (1920); *Doctrine of Functionality*, *supra* note 4, at 552.

87. *Marvel Co. v. Pearl*, 133 F. 160, 161 (2d Cir. 1904); *Luminous Unit Co. v. R. Williamson & Co.*, 241 F. 265, 269 (N.D. Ill.), *aff'd per curiam*, 245 F. 988 (7th Cir. 1917), *cert. denied*, 253 U.S. 486 (1920); *Doctrine of Functionality*, *supra* note 4, at 552.

88. *Daniel v. Electric Hose & Rubber Co.*, 231 F. 827, 833-34 (3d Cir. 1916); *see Keystone Type Foundry v. Portland Publishing Co.*, 180 F. 301, 303 (C.C.D. Me. 1910), *aff'd*, 186 F. 690 (1st Cir. 1911); *Doctrine of Functionality*, *supra* note 4, at 553 & n.56.

89. *Pope Automatic Merchandising Co. v. McCrum-Howell Co.*, 191 F. 979, 981 (7th Cir. 1911), *cert. denied*, 223 U.S. 730 (1912); *Diamond Expansion Bolt Co. v. United States Expansion Bolt Co.*, 177 A.D. 554, 563, 164 N.Y.S. 433, 439 (1917); *Doctrine of Functionality*, *supra* note 4, at 554.

90. *Doctrine of Functionality*, *supra* note 4, at 553; *Competitive Torts*, *supra* note 16, at 919; *see Luminous Unit Co. v. R. Williamson & Co.*, 241 F. 265, 269 (N.D. Ill.) (the "unique and attractive style" of a light fixture bowl was considered an indicia of origin; its functionality was not analyzed), *aff'd per curiam*, 245 F. 988 (7th Cir. 1917), *cert. denied*, 253 U.S. 486 (1920).

91. *See Rushmore v. Saxon*, 158 F. 499, 507 (C.C.S.D.N.Y. 1908), *modified per curiam on other grounds*, 170 F. 1021 (2d Cir. 1909).

92. *Id.*

93. Restatement of Torts § 742 (1938).

94. *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 824-25 (3d Cir. 1981); *Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 692 (S.D.N.Y. 1963); *Doctrine of Functionality*, *supra* note 4, at 558-60; *see In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340 (C.C.P.A. 1982). Today, the strictly utilitarian approach is a minority view. *See Doctrine of Functionality*, *supra* note 4, at 562-63.

95. *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 824-25 (3d Cir. 1981).

"A feature of goods is functional . . . if it *affects* their purpose, action or performance, or the facility or economy of processing, handling or using them; it is non-functional if it does not have any of such effects."<sup>96</sup> Comment a to section 742 states that a feature may be functional if it contributes to the efficiency or economy of manufacture or to the utility, durability or effectiveness with which goods serve their function.<sup>97</sup> Thus, this approach still may be described as utilitarian, but it does not require a product feature to be essential in order to be functional. A feature is functional if it merely contributes to or affects a utilitarian or useful purpose of the goods.<sup>98</sup>

Today, although most courts cite the Restatement approach,<sup>99</sup> they require that a feature be "primarily and essentially dictated by functional or utilitarian considerations" in order to be deemed functional.<sup>100</sup> Under this requirement the feature's mere possession of a

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96. Restatement of Torts § 742 (1938) (emphasis added). This section was omitted from the Restatement (Second) of Torts because the developing fields of unfair competition and trade regulation had become less reliant on tort law. *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 824 n.2 (3d Cir. 1981) (citing 4 Restatement (Second) of Torts 1-2 (1979) (Introductory Note)).

97. Restatement of Torts § 742 comment a (1938).

98. *Doctrine of Functionality*, *supra* note 4, at 558.

99. *E.g.*, *Schwinn Bicycle Co. v. Murray Ohio Mfg. Co.*, 339 F. Supp. 973, 981 (M.D. Tenn. 1971), *aff'd per curiam*, 470 F.2d 975 (6th Cir. 1972); *Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 695 (S.D.N.Y. 1963); *In re Deister Concentrator Co.*, 289 F.2d 496, 500 (C.C.P.A. 1961); *Moore Business Forms, Inc. v. National Computer Sys., Inc.*, 211 U.S.P.Q. (BNA) 909, 915 (Trademark Trial & App. Bd. 1981); *Duo-Tint Bulb & Battery Co. v. Moline Supply Co.*, 46 Ill. App. 3d 145, 152, 360 N.E.2d 798, 803 (1977). Under the Restatement approach, a greater number of features will be found functional than under the strictly utilitarian approach, and consequently, a greater number of product features will be freely imitated. *Doctrine of Functionality*, *supra* note 4, at 560.

100. This requirement was originally enunciated in *In re Deister Concentrator Co.*, 289 F.2d 496, 504 (C.C.P.A. 1961). In that case, the rhomboidal configuration of an ore concentrating and coal cleaning table was considered in essence utilitarian and incapable of trademark protection. *Id.* at 506. Subsequent cases have followed this standard of functionality. *See, e.g.*, *In re Hollaender Mfg. Co.*, 511 F.2d 1186, 1187-89 (C.C.P.A. 1975); *In re Ovation Instruments, Inc.*, 201 U.S.P.Q. (BNA) 116, 122-23 (Trademark Trial & App. Bd. 1978). Recently, however, the Court of Customs and Patent Appeals has updated its definition of functionality. A functionality determination requires an analysis of utility based upon design superiority and should emphasize the importance of the design to free competition. *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340 (C.C.P.A. 1982). For a configuration to be utilitarian according to this view, it must be superior in function or economy of manufacture. *Id.* at 1339. Furthermore, once such superiority is demonstrated, no showing that the feature is essentially functional is required. *See id.* at 1343 n.4. The court rejected the Restatement of Torts § 742 definition of functionality, noting that a finding of functionality upon mere contribution to utility or durability was too broad. *Id.* at 1340. The court suggested several factors to consider in determining the superior utility of a product feature: 1) the existence of an expired utility patent disclosing any utilitarian advantages of a configuration or any advertising by the

useful function is not sufficient to preclude protection.<sup>101</sup> Those factors considered by courts as weighing in favor of functionality include the difficulty with which alternative designs may be substituted for the feature,<sup>102</sup> and whether the feature is a significant component of the product that contributes to the product's use.<sup>103</sup> In addition, an overriding factor considered by a majority of courts is whether granting protection would have a potentially adverse effect on free competition.<sup>104</sup> Consequently, this emphasis on free competition allows the courts greater latitude in determining the functionality of features in particular factual situations.<sup>105</sup>

## II. THE DEVELOPMENT OF AESTHETIC FUNCTIONALITY

In the past, aesthetics may not have been as important an ingredient of products as it is today.<sup>106</sup> Before the advent of mass marketing, consumers bought goods in local shops, in which the choice of products was limited.<sup>107</sup> By contrast, today's consumer may be required to choose from among many functionally equivalent products placed side by side on the shelves of a large supermarket.<sup>108</sup> Thus, the appearance of a product or container can be important to the differentiation and identification of goods.<sup>109</sup>

-manufacturer stressing the utility of the configuration; 2) the availability of alternative configurations; and 3) the economy of manufacture of a particular design. *Id.* at 1340-41. The court, in applying this standard, found the configuration of a plastic spray container non-functional in that it was not a functionally or economically superior design. Allowing protection would not hinder competition in that numerous other designs were available to perform the same purpose. *Id.* at 1342.

101. *E.g.*, *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 825-26 (3d Cir. 1981); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204 (2d Cir. 1979); *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1218 (8th Cir.), *cert. denied*, 429 U.S. 861 (1976); *In re Deister Concentrator Co.*, 289 F.2d 496, 502 (C.C.P.A. 1961).

102. *See Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 827 (3d Cir. 1981); *In re World's Finest Chocolate, Inc.*, 474 F.2d 1012, 1014 (C.C.P.A. 1973).

103. *See In re Ovation Instruments, Inc.*, 201 U.S.P.Q. (BNA) 116, 122 (Trademark Trial & App. Bd. 1978).

104. *E.g.*, *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 827 (3d Cir. 1981); *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1218 (8th Cir.), *cert. denied*, 429 U.S. 861 (1976); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1339-40 (C.C.P.A. 1982).

105. *See In re Mogen David Wine Corp.*, 328 F.2d 925, 933 (C.C.P.A. 1964) (Rich, J., concurring), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967); *Doctrine of Functionality*, *supra* note 4, at 560.

106. *See Galbally, Unfair Trade in the Simulation of Rival Goods—The Test of Commercial Necessity*, 3 Vill. L. Rev. 333, 333 (1958).

107. *See Schechter, The Rational Basis of Trademark Protection*, 40 Harv. L. Rev. 813, 818 n.21 (1927) (quoting 1 H.G. Wells, *The World of William Clissold* 237-38 (1926)).

108. *See Spratling I*, *supra* note 1, at 460.

109. *See generally id.* at 456-58, 460-63.

Trademark protection has been accorded to aesthetic product features to the extent that the decorative or ornamental feature's primary purpose is to identify and distinguish goods from others.<sup>110</sup> For example, trademark protection has been granted to an ornamental candy bar wrapper,<sup>111</sup> a decorative striped pattern on athletic shoes,<sup>112</sup> and an attractive key design for jewelry.<sup>113</sup>

In the early 1900's, under the strictly utilitarian standard applied by the majority of courts, aesthetic features were not considered essential to the use or efficacy of the products they adorned and thus were not considered under the doctrine of functionality.<sup>114</sup> In addition, one court implicitly rejected the functionality of aesthetic features.<sup>115</sup> Nevertheless, two courts applied a functionality analysis to aesthetic product features.<sup>116</sup> The approach utilized, however, was significantly dissimilar to that applied to non-aesthetic features.<sup>117</sup> This new standard provided that an aesthetic feature may be freely copied if the design or configuration is desired by the public for its pleasing appearance.<sup>118</sup> Thus, the shape of a musical instrument was allowed to be imitated on the ground that the instrument was designed in part because of the public's desire for instruments in that form.<sup>119</sup> Similarly, one court stated in dictum that a design is functional if buyers choose an article partially because of its design.<sup>120</sup>

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110. 1 J. McCarthy, *supra* note 3, § 7:6, at 162.

111. *In re World's Finest Chocolate, Inc.*, 474 F.2d 1012 (C.C.P.A. 1973).

112. *In re Dassler*, 134 U.S.P.Q. (BNA) 265 (Trademark Trial & App. Bd. 1962).

113. *In re Penthouse Int'l Ltd.*, 565 F.2d 679 (C.C.P.A. 1977).

114. *See Doctrine of Functionality, supra* note 4, at 553; *Competitive Torts, supra* note 16, at 919. *See supra* notes 90-92 and accompanying text.

115. *Rushmore v. Saxon*, 158 F. 499, 507 (C.C.S.D.N.Y. 1908), *modified on other grounds per curiam*, 170 F. 1021 (2d Cir. 1909).

116. *Champion Spark Plug Co. v. A.R. Mosler & Co.*, 233 F. 112, 116 (S.D.N.Y. 1916); *Flagg Mfg. Co. v. Holway*, 178 Mass. 83, 91, 59 N.E. 667, 667 (1901); *see Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 693-94 (S.D.N.Y. 1963); *Doctrine of Functionality, supra* note 4, at 553; *Competitive Torts, supra* note 16, at 919.

117. *See Trade Dress Infringement, supra* note 17, at 94; *Doctrine of Functionality, supra* note 4, at 561-62; *Competitive Torts, supra* note 16, at 919-20.

118. *Champion Spark Plug Co. v. A.R. Mosler & Co.*, 233 F. 112, 116 (S.D.N.Y. 1916); *Flagg Mfg. Co. v. Holway*, 178 Mass. 83, 91, 59 N.E. 667, 667 (1901).

119. *Flagg Mfg. Co. v. Holway*, 178 Mass. 83, 91, 59 N.E. 667, 667 (1901). The court, however, required the defendant to clearly mark his products as his own to prevent consumer confusion as to the manufacturer of the instrument. *Id.*, 59 N.E. at 667.

120. *Champion Spark Plug Co. v. A.R. Mosler & Co.*, 233 F. 112, 116 (S.D.N.Y. 1916). The plaintiff sued the defendant for unfair competition for copying the design of plaintiff's spark plugs. The court's holding concerned the mechanical aspects of the plug. *Id.* For further discussion of this case and its view of aesthetic functionality, *see Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 693-94 (S.D.N.Y. 1963).

The modern aesthetic functionality standard was formulated in the 1940's and 1950's, perhaps due to certain courts' reliance on a reference to aesthetic features in comment a of section 742 of the Restatement of Torts,<sup>121</sup> which provides that aesthetic features are functional if they contribute to the aesthetic value of products that are purchased primarily for that value.<sup>122</sup> The United States Courts of Appeals for the Eighth and Ninth Circuits enunciated a broad approach in determining aesthetic functionality, holding that an aesthetic feature is functional if it "is an important ingredient in the commercial success of the product."<sup>123</sup> Aesthetic functionality, under their view, is based solely on the consumer appeal of the aesthetic design without any consideration of the utilitarian value of the feature.<sup>124</sup>

In the 1941 case of *J.C. Penney Co. v. H.D. Mercantile Co.*,<sup>125</sup> the Eighth Circuit held that the distinctive rounded-corner, bib-pocket design on overalls, which prevented the accumulation of dirt, was functional and could be imitated.<sup>126</sup> The court stated that a design may be functional if it contributes materially to the salability or commercial success of the product.<sup>127</sup> Similarly, in *Pagliero v. Wallace China Co.*,<sup>128</sup> the Ninth Circuit refused to enjoin the defendant from copying the floral patterns on the plaintiff's hotel china.<sup>129</sup> In finding the design functional,<sup>130</sup> the court emphasized: "[O]ne of the essential selling features of hotel china, if, indeed, not the primary, is the design. The attractiveness and eye-appeal of the design sells the china."<sup>131</sup> Consequently, the floral designs were important to the

121. Restatement of Torts § 742 comment a (1938); see *Pagliero v. Wallace China Co.*, 198 F.2d 339, 343 & n.7 (9th Cir. 1952) (citing the Restatement of Torts § 742 comment a (1938) as support for its holding); *J.C. Penney Co. v. H.D. Lee Mercantile Co.*, 120 F.2d 949, 954 (8th Cir. 1941) (same); *Trade Dress Infringement*, *supra* note 17, at 94 n.134; *Doctrine of Functionality*, *supra* note 4, at 561; *Competitive Torts*, *supra* note 16, at 919-20. The more recent case of *Famolare, Inc. v. Melville Corp.*, 472 F. Supp. 738, 744 (D. Hawaii 1979), *aff'd mem.*, 652 F.2d 62 (9th Cir. 1981), also invoked this comment as supporting its aesthetic functionality standard.

122. Restatement of Torts § 742 comment a (1938). The comment states: "When goods are bought largely for their aesthetic value, their features may be functional [in that they] aid the performance of an object for which the goods are intended." *Id.*

123. *Pagliero v. Wallace China Co.*, 198 F.2d 339, 343 (9th Cir. 1952); *accord J.C. Penney Co. v. H.D. Lee Mercantile Co.*, 120 F.2d 949, 954 (8th Cir. 1941); *Trade Dress Infringement*, *supra* note 17, at 94.

124. *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 825 (3d Cir. 1981).

125. 120 F.2d 949 (8th Cir. 1941).

126. *Id.* at 954.

127. *Id.*

128. 198 F.2d 339 (9th Cir. 1952).

129. *Id.* at 343-44.

130. *Id.* at 343.

131. *Id.* at 343-44.

commercial success of the china and could be freely copied by competitors.<sup>132</sup> The court enunciated a broad definition of functionality:

“Functional” in this sense might be said to connote other than a trade-mark purpose. If the particular feature is an important ingredient in the commercial success of the product, the interest in free competition permits its imitation in the absence of a patent or copyright. On the other hand, where the feature or, more aptly, design, is a mere arbitrary embellishment, a form of dress for the goods primarily adopted for purposes of identification and individuality and, hence, unrelated to basic consumer demands in connection with the product, imitation may be forbidden . . . . Under such circumstances, since effective competition may be undertaken without imitation, the law grants protection.<sup>133</sup>

The court's distinction between features that are important ingredients in the commercial success of products and those that are arbitrary embellishments which merely identify goods fails to acknowledge two important factors: 1) An arbitrary and identifying embellishment may materially contribute to a product's success;<sup>134</sup> and 2) a trademark in itself materially contributes to a product's commercial success,<sup>135</sup> and thus “a trademark may always be construed as having a quasi-functional aspect.”<sup>136</sup> Conceivably, the factual context of the case may have influenced the court's broad holding. The unfair competition claim for the protection of the floral design was coupled with a trademark infringement claim for the plaintiff's trademarked words, which described the flowers in the design.<sup>137</sup> Having preliminarily enjoined the defendant's use of the trademarked words,<sup>138</sup> the court may have concluded that the plaintiff was provided with sufficient protection.<sup>139</sup> Although it appears that the court addressed the issue of

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132. *Id.*

133. *Id.* at 343 (footnotes omitted).

134. *See Warner Bros. v. Gay Toys, Inc.*, 658 F.2d 76, 78 (2d Cir. 1981) (distinctive symbols used in the manufacture of a toy car had “tremendous sales potential”); *Vuitton Et Fils S.A. v. J. Young Enters.*, 644 F.2d 769, 774, 776-77 (9th Cir. 1981) (distinctive pattern “demonstrated in the marketplace a certain consumer appeal”); *Famolare, Inc. v. Melville Corp.*, 472 F. Supp. 738, 744 (D. Hawaii 1979) (the “distinctive appearance of . . . wavy-bottom soles” substantially contributed to the commercial success of the shoes), *aff'd mem.*, 652 F.2d 62 (9th Cir. 1981).

135. *See Vuitton Et Fils S.A. v. J. Young Enters.*, 644 F.2d 769, 774, 776-77 (9th Cir. 1981).

136. Hefter, *Trademark Law Unsettled on Design Functionality*, *Legal Times of Washington*, Sept. 28, 1981, at 26, col. 4.

137. 198 F.2d at 341.

138. *Id.* at 344.

139. The plaintiff also could have obtained copyright protection for the floral designs to the extent that they were original expressions fixed in a tangible form. *See supra* note 43.

functionality in the context of an unfair competition claim,<sup>140</sup> recent decisions have adopted this approach with respect to trademark infringement claims as well.<sup>141</sup>

Despite the enunciation of a broad aesthetic functionality standard in the 1940's and early 1950's, few courts dealt with the issue during the late 1950's and the 1960's.<sup>142</sup> Since the early 1970's, however, the aesthetic functionality standard adopted in *Pagliero* has been embraced by numerous courts which have found aesthetic product features functional and have thus precluded trademark protection for those features.<sup>143</sup>

In *Ventura Travelware, Inc. v. Baltimore Luggage Co.*,<sup>144</sup> the federally registered design trademark of a raised plastic band on luggage consisting of five symmetrical stripes, alternating in color, was held functional because its attractiveness substantially contributed to the luggage's salability.<sup>145</sup> In *Famolare, Inc. v. Melville*

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140. 198 F.2d at 343.

141. *E.g.*, *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 917 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981); *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 662 (W.D. Wash. 1982). See *infra* notes 143-74 and accompanying text.

142. Two courts that did address the issue were *Bliss v. Gotham Indus.*, 316 F.2d 848 (9th Cir. 1963) and *Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670 (S.D.N.Y. 1963). In *Bliss* a claim for unfair competition was denied because the court held that a kitchen pitcher design was functional based on *Pagliero's* standard. 316 F.2d at 855. The court's analysis was conclusory and it is of interest to note that earlier in the decision, in holding invalid the plaintiff's design patent for the configuration, the court remarked that the pitcher had no particular aesthetic appeal. *Id.* at 850. In *Zippo*, the Southern District of New York, noting the broad scope of *Pagliero's* aesthetic functionality standard, 216 F. Supp. at 693, appeared reluctant to adopt that standard completely. It held that "a feature of goods is functional at least if it affects their purpose, action, or performance, or the facility or economy of processing, handling, or using them, and possibly also if it affects the buyer's choice because of its pleasing appearance." *Id.* at 695 (emphasis added). Nevertheless, certain aspects of the design of a cigarette lighter were found functional based solely on utilitarian grounds. *Id.* at 696-97. The court did not reach the issue of aesthetic functionality, although it indicated that had the standard been applied, it would have required a finding of functionality in certain design features that would not have been found functional under the narrower utilitarian standard. *Id.* at 698-99.

143. See *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 917-18 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981); *Damn I'm Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 1360 (S.D.N.Y. 1981); *Famolare, Inc. v. Melville Corp.*, 472 F. Supp. 738, 744 (D. Hawaii 1979), *aff'd mem.*, 652 F.2d 62 (9th Cir. 1981); *PPS, Inc. v. Jewelry Sales Representatives, Inc.*, 392 F. Supp. 375, 384 (S.D.N.Y. 1975); *Ventura Travelware, Inc. v. Baltimore Luggage Co.*, 66 Misc.2d 646, 650-51, 322 N.Y.S.2d 93, 100 (Sup. Ct. 1971), *aff'd*, 38 A.D.2d 794, 328 N.Y.S.2d 811 (1972).

144. 66 Misc.2d 646, 322 N.Y.S.2d 93 (Sup. Ct. 1971), *aff'd*, 38 A.D.2d 794, 328 N.Y.S.2d 811 (1972).

145. *Id.* at 649-50, 322 N.Y.S.2d at 98-99. A color per se is not capable of trademark protection. 1 J. McCarthy, *supra* note 3, § 7:16, at 178-79. The reason given for this principle is that only a limited number of colors exist, and thus the

*Corp.*,<sup>146</sup> the unique, wavy-bottom sole design of shoes was held functional because the design substantially contributed to the commercial success of the shoes.<sup>147</sup> Had the court applied the utilitarian standard, it would have been compelled to find the design non-functional and capable of trademark protection because it was clear that the "design was dictated by stylistic not anatomical considerations."<sup>148</sup> The District Court for the Southern District of New York, in *Damn I'm Good Inc. v. Sakowitz, Inc.*,<sup>149</sup> similarly found an aesthetic feature functional based on *Pagliari's* aesthetic functionality standard.<sup>150</sup> For five years, the plaintiff had manufactured bracelets inscribed with the words "Damn I'm Good," and had recently attached tags bearing the phrase to its jewelry.<sup>151</sup> The court concluded that the inscription was functional because its appeal as an "ego booster" was a crucial ingredient in the success of the product.<sup>152</sup>

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granting of trademark protection would result in the eventual monopolization of all colors. *Id.* at 179. A color or combination of colors may be protected, however, if used in connection with some arbitrary design that indicates the source of goods. *Artus Corp. v. Nordic Co.*, 512 F. Supp. 1184, 1188 (W.D. Pa. 1981); *Ventura Travelware, Inc. v. Baltimore Luggage Co.*, 66 Misc. 2d 646, 649, 322 N.Y.S.2d 93, 98-99 (Sup. Ct. 1971), *aff'd*, 38 A.D.2d 794, 328 N.Y.S.2d 811 (1972). In *Ventura*, the colored stripe design, aside from being found functional, was held to be neither distinctive nor arbitrary, and was therefore incapable of trademark protection. *Id.* at 650, 322 N.Y.S.2d at 99.

146. 472 F. Supp. 738 (D. Hawaii 1979), *aff'd mem.*, 652 F.2d 62 (9th Cir. 1981).

147. *Id.* at 744.

148. *Id.* at 742 n.2.

149. 514 F. Supp. 1357 (S.D.N.Y. 1981).

150. *Id.* at 1360, 1362.

151. *Id.* at 1358-59. Defendants produced similar bracelets bearing the same inscription. *Id.*

152. *Id.* at 1362. This holding seems to stress a consumer demand for the product for reasons other than pure aesthetics. The aesthetics of a jewelry design, however, was the determining factor in the case of *PPS, Inc. v. Jewelry Sales Representatives, Inc.*, 392 F. Supp. 375 (S.D.N.Y. 1975), which involved similar facts. Plaintiff claimed a common-law trademark in the phrase "I Like You" inscribed on jewelry. *Id.* at 378. The court refused to grant a preliminary injunction against imitation of the phrase on the jewelry products of others because the design might be a functional element directly contributing to the general sale of the product. "A potential buyer . . . may be more motivated by the item's design and aesthetic features than by its source." *Id.* at 384. In *Damn I'm Good Inc.*, the court also relied on evidence suggesting that consumers did not associate the bracelets with *Damn I'm Good Inc.* specifically, but rather with a division of the company or its designer, and thus the mark did not serve as an identifying symbol. 514 F. Supp. at 1362. It is well established, however, that secondary meaning requires public association of a mark with a single, though anonymous, source: "This *does not* mean that the buyer knows the identity of that 'single source' in the sense that he knows the corporate name of the producer or seller. In fact, few buyers know, or care about, the corporate identity of the seller of a trademarked product." 1 J. McCarthy, *supra* note 3, § 15:2, at 520 (emphasis in original). The issue of secondary meaning is considered indepen-



This trend was taken a step further by the Ninth Circuit in *International Order of Job's Daughters v. Lindeburg & Co.*,<sup>153</sup> in which the collective mark<sup>154</sup> of a women's fraternal organization was held to be aesthetically functional when used as a design on jewelry.<sup>155</sup> Thus, even though the organizational emblem had been used by the organization on its own jewelry as an indication of source,<sup>156</sup> the defendant was allowed to produce jewelry bearing the identical emblem<sup>157</sup> because the emblem had been "merchandised on the basis of [its] intrinsic value, not as a designation of origin or sponsorship."<sup>158</sup> The court noted that this intrinsic value was represented in the phenomenon that consumers "commonly identify [themselves] by displaying emblems expressing allegiances"<sup>159</sup> to organizations, schools and sports teams.<sup>160</sup> The court thus held the emblem functional with respect to its use as a design on jewelry because it had commercial appeal as a mode of expressing allegiance;<sup>161</sup> the feature "constitute[d] the actual benefit that the consumer wishe[d] to purchase."<sup>162</sup>

The practical difficulties of a strict application of *Pagliero's* consumer appeal standard are reflected in certain courts' adoption of new

dently of functionality, *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 827 (3d Cir. 1981), and when a feature is found functional, trademark protection is precluded, despite evidence of secondary meaning. *Famolare, Inc. v. Melville Corp.*, 472 F. Supp. 738, 744-45 (D. Hawaii 1979), *aff'd mem.*, 652 F.2d 62 (9th Cir. 1981); *In re Deister Concentrator Co.*, 289 F.2d 496, 502 (C.C.P.A. 1961). Thus, even if *Damn I'm Good Inc.* had shown secondary meaning in the inscription, the finding of aesthetic functionality would have required the same result.

153. 633 F.2d 912 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981).

154. A collective mark is a "trademark or service mark used by the members of a cooperative, an association or other collective group or organization and includes marks used to indicate membership in a union, an association or other organization." Lanham Act, § 45, 15 U.S.C. § 1127 (1976). In *International Order*, the terms "collective mark" and "trademark" were used interchangeably. 633 F.2d at 914 n.2.

155. 633 F.2d at 918.

156. *Id.* at 914. The evidence indicated that since 1921, the organization had licensed at least one jeweler to manufacture jewelry bearing the emblem, and the organization itself sold some of the jewelry directly to its members. *Id.*

157. *See id.* at 920.

158. *Id.* at 918.

159. *Id.*

160. *Id.*

161. *Id.* The court further stated: "It would be naive to conclude that the . . . emblem is desired because consumers believe that the product somehow originated with or was sponsored by the organization." *Id. Contra Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004 (5th Cir.) (granting injunctive relief for the copying of a federally registered hockey team emblem trademark used in the design of jerseys), *cert. denied*, 423 U.S. 868 (1975). In *Boston Hockey*, the court noted that "the embroidered symbols [were] sold not because of any . . . aesthetic characteristic but because they are the trademarks of the hockey teams." *Id.* at 1013. *Boston Hockey* implies that consumer demand based on a desire to express allegiance is part of the trademark value of the mark.

162. 633 F.2d at 917.

factors as weighing against what otherwise would be a finding of functionality under the broad aesthetic functionality standard. Thus, in *Vuitton Et Fils S.A. v. J. Young Enterprises*,<sup>163</sup> the Ninth Circuit intimated that application of *Pagliero's* standard alone may not support a finding of functionality in cases involving well known, federally registered aesthetic trademarks.<sup>164</sup> The aesthetic feature in question—the letters “LV” surrounded by floral symbols—covered the entire surface of the plaintiff’s handbags and other related products.<sup>165</sup> The defendant produced a line of similar merchandise using almost the identical design but changed the “LV” to “LY.”<sup>166</sup> In reversing the district court’s granting of summary judgment for the defendant,<sup>167</sup> the Ninth Circuit suggested an additional factor that may weigh against a finding of functionality. The court noted that if the aesthetic feature increases the product’s consumer appeal because of consumers’ association of the feature with the quality of the goods or prestige of owning the product, then the design is serving the legitimate trademark function of identification and should be accorded protection.<sup>168</sup> The recent case of *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*<sup>169</sup> involved the copying by competitors of replicas of National Football League jerseys bearing team names, city and regional designations, and names of team players.<sup>170</sup> Despite the factual similarity to *International Order*, which held an organizational emblem functional,<sup>171</sup> the court seemed to find the descriptive terms on the jerseys non-functional because they were not “that aspect of [the] product which satisfies [the] consumers’ tastes for beauty.”<sup>172</sup> Furthermore, the court departed from the traditional functionality

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163. 644 F.2d 769 (9th Cir. 1981).

164. *Id.* at 773-74.

165. *Id.* at 772.

166. *Id.*

167. *Id.* at 771. The court reversed a lower court finding of aesthetic functionality, disagreeing that “any feature of a product which contributes to the consumer appeal and saleability of the product is, as a matter of law, a functional element of that product. Neither *Pagliero* nor the cases since decided . . . impel such a conclusion.” *Id.* at 773. *Pagliero* was distinguished as not involving a federally registered trademark. *Id.* Furthermore, the aesthetic appeal of the design was not sufficiently important to the success of the product to support a finding of functionality, despite the court’s acknowledgment that aesthetics is a factor in the consumer appeal of handbags and “Vuitton has without doubt succeeded in appealing to consumers with its products.” *Id.* at 774.

168. *Id.* at 776.

169. 532 F. Supp. 651 (W.D. Wash. 1982).

170. *Id.* at 655-56.

171. *International Order of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981). See *supra* notes 153-62 and accompanying text.

172. 532 F. Supp. at 663 (quoting *Vuitton Et Fils S.A. v. J. Young Enters.*, 644 F.2d 769, 774 (9th Cir. 1981)).

doctrine, holding that even though a feature is functional, it may be afforded protection under trademark law if it has acquired secondary meaning and, therefore, serves a trademark purpose.<sup>173</sup> Since the plaintiffs had shown such a trademark significance, copying of the features was enjoined.<sup>174</sup>

Further confusion regarding the functionality of aesthetic features is reflected in those cases addressing unfair competition claims that have cited *Pagliari*'s standard, yet determined the functionality of aesthetic features based upon a separate analysis of the operational utility or efficiency provided by the feature.<sup>175</sup> In *Artus Corp. v. Nordic Co.*,<sup>176</sup> the colors signifying the varying thicknesses of shims separating milling machinery parts were held non-functional.<sup>177</sup> Although the court cited *Pagliari*'s aesthetic functionality standard, it found that the colors did not relate to the shims' leveling ability as to machinery parts and, therefore, were entitled to protection provided that they had acquired secondary meaning.<sup>178</sup> Similarly, in *Le Sportsac, Inc. v. Dockside Research, Inc.*,<sup>179</sup> the various features of travel bags, such as the straps and zippers, were held merely decorative and thus non-functional.<sup>180</sup> The court cited *Pagliari*'s standard,<sup>181</sup> yet based its functionality determination on evidence that the bags served their function of carrying articles irrespective of the width of the straps or the hollowness of the zippers.<sup>182</sup> Finally, in *Ives Laboratories, Inc. v. Darby Drug Co.*,<sup>183</sup> the Second Circuit cited *Pagliari*'s

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173. *Id.* at 663. The court cited dictum in *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 919 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981), for this proposition. However, a well-established principle of the functionality doctrine states that if a feature is functional, it is incapable of trademark protection even if the feature has acquired secondary meaning. *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 827 (3d Cir. 1981); *Famolare, Inc. v. Melville Corp.*, 472 F. Supp. 738, 744-45 (D. Hawaii 1979), *aff'd mem.*, 652 F.2d 62 (9th Cir. 1981); *In re Deister Concentrator Co.*, 289 F.2d 496, 502 (C.C.P.A. 1961).

174. 532 F. Supp. at 663-64.

175. *See, e.g.*, *Ives Labs., Inc. v. Darby Drug Co.*, 601 F.2d 631, 642-43 (2d Cir. 1979), *remand opinion rev'd on other grounds*, 638 F.2d 538 (2d Cir. 1981), *rev'd on other grounds sub nom.* *Inwood Labs., Inc. v. Ives Labs., Inc.*, 102 S. Ct. 2182 (1982); *Artus Corp. v. Nordic Co.*, 512 F. Supp. 1184, 1189 (W.D. Pa. 1981); *Le Sportsac, Inc. v. Dockside Research, Inc.*, 478 F. Supp. 602, 607-08 (S.D.N.Y. 1979).

176. 512 F. Supp. 1184 (W.D. Pa. 1981).

177. *Id.* at 1189.

178. *Id.*

179. 478 F. Supp. 602 (S.D.N.Y. 1979).

180. *Id.* at 608.

181. *Id.* at 606-07.

182. *Id.* at 608.

183. 601 F.2d 631 (2d Cir. 1979), *remand opinion rev'd on other grounds*, 638 F.2d 538 (2d Cir. 1981), *rev'd on other grounds sub nom.* *Inwood Labs., Inc. v. Ives Labs., Inc.*, 102 S. Ct. 2182 (1982).

standard yet affirmed<sup>184</sup> the lower court's holding that the pale blue and blue-and-red color coatings of certain drug capsules were functional on the basis of their psychological and identification utility.<sup>185</sup> The evidence indicated that the colors reduce patients' anxiety and confusion as to which drug they are ingesting and assist physicians in identifying the drug in instances of overdose.<sup>186</sup> On certiorari,<sup>187</sup> the Supreme Court did not reach the issue of functionality,<sup>188</sup> although it did enunciate a functionality standard based upon whether the product feature was either "essential to the use or purpose of the article or . . . affect[ed] the cost or quality of the article."<sup>189</sup>

Finally, two courts have added to the uncertainty in this area by purporting to apply the broad aesthetic functionality standard to *non-aesthetic* product features.<sup>190</sup> In determining the functionality of the shapes of a one-piece compact telephone<sup>191</sup> and a trailer truck,<sup>192</sup> these courts have cited *Pagliari*'s standard,<sup>193</sup> and yet have analyzed these

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184. *Id.* at 643-44. The court affirmed the lower court's denial of plaintiff's motion for a preliminary injunction against imitation of the colors. *Id.* On remand, the district court found the colors functional and allowed their imitation. *Ives Labs., Inc. v. Darby Drug Co.*, 488 F. Supp. 394, 398, 401 (E.D.N.Y. 1980), *remand opinion rev'd on other grounds*, 638 F.2d 538 (2d Cir. 1981), *rev'd on other grounds sub nom.* *Inwood Labs., Inc. v. Ives Labs., Inc.*, 102 S. Ct. 2182 (1982). On appeal, the Second Circuit disregarded the lower court's finding of functionality and enjoined imitation. 638 F.2d 538, 545 n.1 (2d Cir. 1981) (Mulligan, J., dissenting), *rev'd on other grounds sub nom.* *Inwood Labs., Inc. v. Ives Labs., Inc.*, 102 S. Ct. 2182 (1982).

185. *Ives Labs., Inc. v. Darby Drug Co.*, 455 F. Supp. 939, 949-50 (E.D.N.Y. 1978), *aff'd*, 601 F.2d 631 (2d Cir. 1979), *remand opinion rev'd on other grounds*, 638 F.2d 538 (2d Cir. 1981), *rev'd on other grounds sub nom.* *Inwood Labs., Inc. v. Ives Labs., Inc.*, 102 S. Ct. 2182 (1982).

186. *Id.*; see *Inwood Labs., Inc. v. Ives Labs., Inc.*, 102 S. Ct. 2182, 2192 (1982) (White, J., concurring).

187. *Inwood Labs., Inc. v. Ives Labs., Inc.*, 102 S. Ct. 2182 (1982).

188. *Id.* at 2190. The Court held that the Second Circuit had erred in setting aside the district court's finding that defendants' had infringed plaintiff's trademark under § 32 of the Lanham Act, 15 U.S.C. § 1114 (1976), and remanded the case. As to the unfair competition claims that were not addressed by the Second Circuit, the Supreme Court remanded these claims for further proceedings. 102 S. Ct. at 2190.

189. *Id.* at 2186 n.10.

190. *Leisurecraft Prods., Ltd. v. International Dictating Equip., Inc.*, 210 U.S.P.Q. (BNA) 193 (D.C. Cir. 1981); *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210 (8th Cir.), *cert. denied*, 429 U.S. 861 (1976).

191. *Leisurecraft Prods., Ltd. v. International Dictating Equip., Inc.*, 210 U.S.P.Q. (BNA) 193, 194 (D.C. Cir. 1981).

192. *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1218 (8th Cir.), *cert. denied*, 429 U.S. 861 (1976).

193. *Leisurecraft Prods., Ltd. v. International Dictating Equip., Inc.*, 210 U.S.P.Q. (BNA) 193, 194 (D.C. Cir. 1981); *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1217-18 (8th Cir.), *cert. denied*, 429 U.S. 861 (1976).

non-aesthetic features under the traditional utilitarian approach.<sup>194</sup> The indiscriminate adoption of the aesthetic functionality approach with respect to engineering or mechanical product features would represent an unwarranted extension of the broad aesthetic functionality standard beyond its initially intended scope.<sup>195</sup>

### III. CRITICISM OF THE BROAD AESTHETIC FUNCTIONALITY STANDARD

#### A. *Rejection of the Standard*

The adoption of a broad aesthetic functionality standard in recent years has caused uncertainty in the area of product and container configuration trademarks<sup>196</sup> and has been criticized by several sources.<sup>197</sup> The Court of Customs and Patent Appeals has rejected a functionality standard based on ornamentation<sup>198</sup> alone.<sup>199</sup> In *In re*

194. The court in *Leisurecraft Prods., Ltd. v. International Dictating Equip., Inc.*, 210 U.S.P.Q. (BNA) 193 (D.C. Cir. 1981), held that the form of a telephone was functional because "[t]he shape [was] essential to its function as a one-piece compact telephone." *Id.* at 194. Similarly, the court in *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210 (8th Cir.), *cert. denied*, 429 U.S. 861 (1976), held the exterior design of a truck non-functional based on an engineer's report as to the construction and use of the design: "The entire side skin of the rear of the trailer . . . is useless. The way it is set up its only function will be to gather road dirt and mud." *Id.* at 1218.

195. This development can be traced, perhaps, to the fact that *Pagliero's* broad definition of functionality does not specifically mention aesthetics or confine its scope to aesthetic features: Rather, any feature of importance to the consumer appeal of the product would seem to fit *Pagliero's* test of functionality. See *Pagliero v. Wallace China Co.*, 198 F.2d 339, 343 (9th Cir. 1952). However, the historical development of the functionality doctrine, see *Trade Dress Infringement*, *supra* note 17, at 94, as well as the factual context of *Pagliero*—the case involved the functionality of a floral design on hotel china, clearly an aesthetic design—indicate that this broad standard was not intended to replace the classical utilitarian approach to functionality. *Trade Dress Infringement*, *supra* note 17, at 94-95; *Doctrine of Functionality*, *supra* note 4, at 564.

196. Hefter, *supra* note 136, at 26, col. 1. See *supra* pt. II.

197. E.g., *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 825 (3d Cir. 1981); *Haeger Potteries, Inc. v. Gilner Potteries*, 123 F. Supp. 261, 271 (S.D. Cal. 1954); 3 R. Callmann I, *supra* note 59, § 77.4 (e)(1), at 386 n.98; *Trade Dress Infringement*, *supra* note 17, at 88 & n.85.

198. In rejecting this standard, the court has consistently used the phrase "ornamentation function" of product features. It appears that "ornamentation function" is synonymous with aesthetic functionality. See *Trade Dress Infringement*, *supra* note 17, at 88 n.85.

199. *In re Penthouse Int'l Ltd.*, 565 F.2d 679, 682 (C.C.P.A. 1977); *In re Mogen David Wine Corp.*, 328 F.2d 925, 932-33 (C.C.P.A. 1964) (Rich, J., concurring), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967); *Trade Dress Infringement*, *supra* note 17, at 88 n.85. Only months after *Mogen David* was decided, however, Judge Rich, writing for the C.C.P.A. in *In re Minnesota Mining & Mfg. Co.*, 335 F.2d 836 (C.C.P.A. 1964), seemed to leave the door open for some type of aesthetic functionality. In granting trademark protection for a configuration of a chemical solid, he noted that

*Mogen David Wine Corp.*,<sup>200</sup> the court rejected the claim that a wine decanter shape was functional because of its pleasing appearance.<sup>201</sup> Judge Rich, in his frequently cited concurring opinion, noted: "[There is] an essential distinction between engineering function and ornamentation function . . . . [E]ven if we assume some value behind the specific design in an aesthetic sense, it is not in the least essential to use it in order to have a fully functioning bottle or an attractive bottle . . . ." <sup>202</sup> Rich's rejection of a broad aesthetic functionality standard was reinforced recently by the Court of Customs and Patent Appeals in *In re Penthouse International Ltd.*<sup>203</sup> In affording trademark protection for a stylized key design on jewelry, the court noted that a design "may have the function of attracting purchasers, but the shape of . . . jewelry . . . is arbitrary and nonessential to a functioning piece of jewelry."<sup>204</sup>

Several federal courts have rejected either implicitly or explicitly the application of a broad aesthetic functionality standard.<sup>205</sup> Certain courts implicitly reject the application of the aesthetic functionality standard by applying the traditional utilitarian standard to aesthetic features.<sup>206</sup> For example, one district court held that an attractive grill and a hood ornamentation of an automobile were non-functional in that they were not primarily utilitarian.<sup>207</sup>

In an early case,<sup>208</sup> a California federal district court explicitly rejected the functionality of an attractive ashtray design, stating that

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there had been no "indication that [the triangular configuration] was adopted primarily to be ornamental, or to make the goods easier to pack or to use or to make, or even more saleable. We deem it to be entirely arbitrary until the contrary be shown." *Id.* at 840. Although the court more recently has expressly acknowledged the bifurcated approach to mechanical and aesthetic product features adopted by certain courts, see *In re Morton-Norwich Prods., Inc.* 671 F.2d 1332, 1338 n.1 (C.C.P.A. 1982), it has yet to refute its established utilitarian approach to aesthetic product features.

200. 328 F.2d 925 (C.C.P.A. 1964), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967).

201. *Id.* at 931. The case was remanded for a determination of the existence of secondary meaning in the mark. *Id.* at 932.

202. *Id.* at 933 (Rich, J., concurring).

203. 565 F.2d 679 (C.C.P.A. 1977).

204. *Id.* at 682.

205. See *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 825 (3d Cir. 1981); *Rolls-Royce Motors Ltd. v. A & A Fiberglass, Inc.*, 428 F. Supp. 689, 692 (N.D. Ga. 1976); *Schwinn Bicycle Co. v. Murray Ohio Mfg. Co.*, 339 F. Supp. 973, 981 (M.D. Tenn. 1971), *aff'd per curiam*, 470 F.2d 975 (6th Cir. 1972); *Haeger Potteries, Inc. v. Gilner Potteries*, 123 F. Supp. 261, 271 (S.D. Cal. 1954); Note, *The Public Interest and the Right to Copy Nonfunctional Product Features*, 19 Wm. & Mary L. Rev. 317, 322 & n.32 (1977).

206. See *Rolls-Royce Motors Ltd. v. A & A Fiberglass, Inc.*, 428 F. Supp. 689, 692 (N.D. Ga. 1976); *Schwinn Bicycle Co. v. Murray Ohio Mfg. Co.*, 339 F. Supp. 973, 980-81 (M.D. Tenn. 1971), *aff'd per curiam*, 470 F.2d 975 (6th Cir. 1972).

207. *Rolls-Royce Motors Ltd. v. A & A Fiberglass, Inc.*, 428 F. Supp. 689, 692 (N.D. Ga. 1976).

208. *Haeger Potteries, Inc. v. Gilner Potteries*, 123 F. Supp. 261 (S.D. Cal. 1954).

"[i]f the aesthetic quality of the form were held to be functional, then every feature of a product, even the ornamental and nonutilitarian, would be functional."<sup>209</sup> The Court of Appeals for the Third Circuit in *Keene Corp. v. Paraflex Industries*<sup>210</sup> has clearly rejected the broad aesthetic functionality standard, noting that it discourages the production of new aesthetic product features.<sup>211</sup> In *Keene*, the design of an outdoor wall-mounted luminaire was held functional based upon a utilitarian approach to aesthetic features.<sup>212</sup> The court noted:

[T]he inquiry should focus on the extent to which the design feature is related to the utilitarian function of the product or feature. When the design itself is not significantly related to the utilitarian function of the product, but is merely arbitrary, then it is entitled to protection as a . . . trademark.<sup>213</sup>

The court considered the luminaire design intrinsically related to the luminaire's function in that part of a luminaire's utility lies in its "architectural compatibility" with the structure on which it is mounted.<sup>214</sup> Thus, the luminaire design was found functional because it significantly contributed to the actual use of the product.

Various commentators have noted the extremely broad scope of the aesthetic functionality standard,<sup>215</sup> and two have expressly questioned its application.<sup>216</sup> They have criticized the arbitrary, ambiguous<sup>217</sup> and impracticable<sup>218</sup> nature of this standard.

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209. *Id.* at 271. The claim in this case was for unfair competition in the imitation of plaintiff's pottery ashtray design. The court, defining "functional" as relating to the "natural, proper or characteristic" action of the article in question, held the design non-functional and enjoined its imitation: "The 'natural, proper or characteristic' action of an ashtray is to hold ashes. Its shape or form, so long as not substantially affecting utility for holding ashes, is clearly not functional." *Id.*

210. 653 F.2d 822 (3d Cir. 1981).

211. *Id.* at 825.

212. *Id.* at 826.

213. *Id.* at 825.

214. *Id.* at 826.

215. *Trade Dress Infringement*, *supra* note 17, at 88; *Doctrine of Functionality*, *supra* note 4, at 562; see 1 J. McCarthy, *supra* note 3, § 7:26, at 198; 3 R. Callmann I, *supra* note 59, § 77.4(e)(1), at 386 n.98.

216. 3 R. Callmann I, *supra* note 59, § 77.4(e)(1), at 386 n.98; *Trade Dress Infringement*, *supra* note 17, at 88.

217. See 3 R. Callmann I, *supra* note 59, § 77.4(e)(1), at 386 n.98 ("Unless the concept of functionality is limited to those features which clearly affect the process of manufacture or the mechanics of use, there is a danger of losing all distinction between functional and nonfunctional features. The distinction becomes especially meaningless when we label as functional any feature that contributes to consumer appeal . . .").

218. See *Trade Dress Infringement*, *supra* note 17, at 88-89.

### B. *Inherent Flaws of the Broad Aesthetic Functionality Standard*

Under the developing broad aesthetic functionality standard, courts have been finding aesthetic product features functional too readily.<sup>219</sup> An "aesthetic" product feature is presumed to contribute materially to the salability of a product,<sup>220</sup> necessitating a finding of functionality and thereby permitting the imitation of product features.<sup>221</sup> Furthermore, this conclusory approach fails to recognize that, in certain instances, the granting of trademark protection to aesthetic product features does not have an adverse effect on competition.<sup>222</sup>

Indeed, under this approach, an attractive design adopted and used to distinguish one's goods and thus serving as a valid trademark may be in danger of losing its legal protection whenever it becomes an important ingredient in the commercial success of a product.<sup>223</sup> Courts fail to recognize that product and container designs are often chosen by manufacturers as trademarks specifically for their aesthetic appeal<sup>224</sup> because trademarks, in addition to identifying and distinguish-

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219. See *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981); *Bliss v. Gotham Indus.*, 316 F.2d 848, 855 (9th Cir. 1963); *Damn I'm Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 1362-63 (S.D.N.Y. 1981); *Famolare, Inc. v. Melville Corp.*, 472 F. Supp. 738, 743-44 (D. Hawaii 1979), *aff'd mem.*, 652 F.2d 62 (9th Cir. 1981); *PPS, Inc. v. Jewelry Sales Representatives, Inc.*, 392 F. Supp. 375, 384 (S.D.N.Y. 1975); *Ventura Travelware, Inc. v. Baltimore Luggage Co.*, 66 Misc. 2d 646, 650-51, 322 N.Y.S.2d 93, 100 (Sup. Ct. 1971), *aff'd*, 38 A.D.2d 794, 328 N.Y.S.2d 811 (1972).

220. See, e.g., *Bliss v. Gotham Indus.*, 316 F.2d 848, 855 (9th Cir. 1963); *Damn I'm Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 1362 (S.D.N.Y. 1981); *PPS, Inc. v. Jewelry Sales Representatives, Inc.*, 392 F. Supp. 375, 384 (S.D.N.Y. 1975); *Ventura Travelware, Inc. v. Baltimore Luggage Co.*, 66 Misc. 2d 646, 650-51, 322 N.Y.S.2d 93, 99-100 (Sup. Ct. 1971), *aff'd*, 38 A.D.2d 794, 328 N.Y.S.2d 811 (1972).

221. See, e.g., *Bliss v. Gotham Indus.*, 316 F.2d 848, 855 (9th Cir. 1963); *Damn I'm Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 1362 (S.D.N.Y. 1981); *PPS, Inc. v. Jewelry Sales Representatives, Inc.*, 392 F. Supp. 375, 384 (S.D.N.Y. 1975); *Ventura Travelware, Inc. v. Baltimore Luggage Co.*, 66 Misc. 2d 646, 650-51, 322 N.Y.S.2d 93, 99-100 (Sup. Ct. 1971), *aff'd*, 38 A.D.2d 794, 328 N.Y.S.2d 811 (1972).

222. *In re Penthouse Int'l Ltd.*, 565 F.2d 679, 682 (C.C.P.A. 1977); *In re Mogen David Wine Corp.*, 328 F.2d 925, 933 (C.C.P.A. 1964) (Rich, J., concurring), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967). Indeed, many courts do not attempt any careful analysis of the possible competitive effect that would result from according protection. See, e.g., *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981); *Bliss v. Gotham Indus.*, 316 F.2d 848 (9th Cir. 1963); *PPS, Inc. v. Jewelry Sales Representatives, Inc.*, 392 F. Supp. 375 (S.D.N.Y. 1975).

223. See, e.g., *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981); *Damn I'm Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357 (S.D.N.Y. 1981); *Famolare, Inc. v. Melville Corp.*, 472 F. Supp. 738 (D. Hawaii 1979), *aff'd mem.*, 652 F.2d 62 (9th Cir. 1981).

224. *In re Ovation Instruments, Inc.*, 201 U.S.P.Q. (BNA) 116, 121 (Trademark Trial & App. Bd. 1978) (rounded bowl shape of a guitar chosen for its selling and identification potential); *Spratling I*, *supra* note 1, at 462-63.



ing a particular product, also serve an advertising function by materially contributing to the sale of the product.<sup>225</sup>

The advertising function of trademarks has taken on added importance with the advent of large, impersonal marketing centers.<sup>226</sup> Today, a consumer is likely to be confronted in a large self-service supermarket with a great number of similarly functioning items.<sup>227</sup> To compete effectively, a manufacturer will often devote a vast amount of time, money and effort to develop a product or container design that will differentiate his product from other similar products and encourage purchasers to choose his particular brand.<sup>228</sup> An aesthetically pleasing product or container design is, therefore, an important element in today's competitive economy<sup>229</sup> because it performs both of these functions.<sup>230</sup> Consequently, a manufacturer chooses a particular aesthetic design specifically to create consumer demand for his product, yet ironically, if his feature achieves success in creating that demand, he will be denied the exclusive right to his mark under the broad aesthetic functionality standard. Perhaps recognizing this catch-22, courts recently have been reluctant to find valid, federally registered, aesthetically pleasing trademarks functional, although a strict application of the broad aesthetic functionality standard would have demanded such a finding.<sup>231</sup>

The utility that the doctrine of functionality seeks to protect is the operational utility of a product feature:<sup>232</sup> If a design is important in the actual use or efficiency of a product, the public interest demands

225. *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205, 208 (1942); *Philadelphia Storage Battery Co. v. Mindlin*, 163 Misc. 52, 54, 296 N.Y.S. 176, 179 (Sup. Ct. 1937); Restatement of Torts § 715 comment b (1938); 1 J. McCarthy, *supra* note 3, § 3:5, at 95-96; P. Rosenberg, *supra* note 60, § 4.01, at 4-3; Lunsford, *Consumers and Trademarks: The Function of Trademarks in the Market Place* [Part 1], 64 Trademark Rep. 75, 78-79 (1974).

226. See Spratling I, *supra* note 1, at 461-62.

227. See *id.* at 460.

228. See *id.* at 461-63.

229. See *id.* at 462.

230. See *id.* at 459 n.29, 462-63.

231. See *Vuitton Et Fils S.A. v. J. Young Enters.*, 644 F.2d 769, 774 (9th Cir. 1981) (decorative floral design was found not aesthetically functional because it did not contribute significantly enough to the success of the handbags and related products despite the court's acknowledgment of the importance of aesthetics to the commercial appeal of handbags and the established appeal of Vuitton handbags); *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 662-63 (W.D. Wash. 1982) (finding the descriptive terms on football jerseys non-functional as not satisfying the consumers' tastes for beauty despite a finding of functionality on similar facts in *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981)). See *supra* notes 163-74 and accompanying text.

232. 1 [1981-1982] Trademark Law Handbook § 3.01[1], at 22.

free competition in that feature.<sup>233</sup> The inherent flaw in a consumer appeal standard that finds sales utility of a product feature dispositive<sup>234</sup> is that, by definition, a finding of this kind of utility ipso facto precludes a valid trademark function. Today, the creation of consumer demand for a product should be perceived as a significant trademark function.<sup>235</sup> In fact, evidence of the commercial success of a product has been considered by some courts to be a factor weighing in favor of granting trademark and patent rights.<sup>236</sup>

Furthermore, the underlying policy concern of the functionality doctrine with respect to mechanical features is with promoting free competition as to features relating to the practical, operational use of a product.<sup>237</sup> The granting of exclusive rights in a merely desirable

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233. See, e.g., *Marvel Co. v. Pearl*, 133 F. 160, 161 (2d Cir. 1904); *In re Penthouse Int'l Ltd.*, 565 F.2d 679, 682 (C.C.P.A. 1977); *In re Mogen David Wine Corp.*, 328 F.2d 925, 933 (C.C.P.A. 1964) (Rich, J., concurring), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967); *In re Deister Concentrator Co.*, 289 F.2d 496, 500 (C.C.P.A. 1961). See *supra* notes 32-33 and accompanying text.

234. 1 [1981-1982] *Trademark Law Handbook* § 3.01[1], at 22 (salability is not functionality).

235. *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205, 208 (1942); *Philadelphia Storage Battery Co. v. Mindlin*, 163 Misc. 52, 54-55, 296 N.Y.S. 176, 179 (1937); *Restatement of Torts* § 715 comment b (1938). As suggested by one commentator, the "creation and retention of consumer demand is a significant function of trademarks in today's billion dollar advertising market." 1 J. McCarthy, *supra* note 3, § 3:5, at 96.

236. Evidence of the large sales volume of a product may be used as a factor in establishing the existence of secondary meaning in a trademark. *Car-Freshner Corp. v. Auto Aid Mfg. Corp.*, 201 U.S.P.Q. (BNA) 233, 238 n.10 (N.D.N.Y. 1979); *North Carolina Dairy Found. v. Foremost-McKesson*, 92 Cal. App. 3d 98, 109-10, 154 Cal. Rptr. 794, 801 (Ct. App. 1979). *But see* 1 J. McCarthy, *supra* note 3, §§ 15:15-16, at 546-49 (evidence of the large sales volume of a product is only relevant, circumstantial evidence from which secondary meaning may be inferred; commercial success may result from other factors that have no effect of creating an association between the public and a specific producer). In addition, some courts have considered the commercial success of a patented article as a factor in establishing the non-obviousness and thus, the validity of utility and design patents. 1 D. Chisum, *Patents* § 1.04 [2], at 1-135 to 1-136 (1981); 2 D. Chisum, *supra*, § 5.05[2], at 5-246 to 5-247; see, e.g., *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *L.E. Sauer Mach. Co. v. Corrugated Finishing Prods., Inc.*, 642 F.2d 203, 206-07 (7th Cir. 1981); *Eutectic Corp. v. Metco, Inc.*, 579 F.2d 1, 4 & n.6 (2d Cir.), *cert. denied*, 439 U.S. 867 (1978); *Illinois Tool Works, Inc. v. Sweetheart Plastics, Inc.*, 436 F.2d 1180, 1187 (7th Cir.), *cert. denied*, 403 U.S. 942 (1971). One commentator, however, has noted that the commercial success of a patented product may not be particularly probative in determining the non-obviousness of a patent. 2 D. Chisum, *supra*, § 5.05 [2], at 5-247. For a comprehensive discussion of commercial success as a factor in determining the non-obviousness of a patent, see Boyer, *Commercial Success as Evidence of Patentability*, 37 *Fordham L. Rev.* 573 (1969); Note, *Subtests of "Non-obviousness": A Nontechnical Approach to Patent Validity*, 112 *U. Pa. L. Rev.* 1169, 1175-77 (1964).

237. *Daniel v. Electric Hose & Rubber Co.*, 231 F. 827, 833-34 (3d Cir. 1916); *Pope Automatic Merchandising Co. v. McCrum-Howell Co.*, 191 F. 979, 981 (7th

aesthetic design, however, does not adversely affect free competition.<sup>238</sup> Competition may, in fact, be promoted by granting such rights because manufacturers may be stimulated to develop even more aesthetically pleasing designs.<sup>239</sup>

Moreover, a standard that conclusively relies on a determination as to whether a product feature is an important ingredient in the commercial success of a product is inherently impracticable. A functionality analysis under this approach requires an examination as to what motivates consumers to buy a particular product, and thus involves rather difficult determinations regarding consumers' taste and personal preference.<sup>240</sup> Consequently, a court may be required to make subjective judgments as to artistic merit, taste and aesthetic appeal.<sup>241</sup>

Finally, the broad aesthetic functionality standard has been criticized generally as having a potentially numbing effect on the creativity and imagination involved in the development of aesthetic product features.<sup>242</sup> Unfortunately, a manufacturer may be deterred from creating an aesthetically appealing product feature for fear that once it materially contributes to his product's salability, he will be denied protection for that feature.<sup>243</sup>

#### IV. PROPOSAL: APPLICATION OF THE TRADITIONAL UTILITARIAN STANDARD TO AESTHETIC PRODUCT FEATURES

The aesthetic functionality standard adopted by a growing number of courts is overbroad.<sup>244</sup> A proper balance of the competing policy

Cir. 1911), *cert. denied*, 223 U.S. 730 (1912); *Marvel Co. v. Pearl*, 133 F. 160, 161 (2d Cir. 1904); *Rushmore v. Saxon*, 158 F. 499, 507 (C.C.S.D.N.Y. 1908), *modified on other grounds per curiam*, 170 F. 1021 (2d Cir. 1909); *Luminous Unit Co. v. R. Williamson & Co.*, 241 F. 265, 269 (N.D. Ill.), *aff'd per curiam*, 245 F. 988 (1917), *cert. denied*, 253 U.S. 486 (1919).

238. *In re Penthouse Int'l Ltd.*, 565 F.2d 679, 682 (C.C.P.A. 1977); *In re Mogen David Wine Corp.*, 328 F.2d 925, 933 (C.C.P.A. 1964) (Rich, J., concurring), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967); *see Vuitton Et Fils S.A. v. J. Young Enters.*, 644 F.2d 769, 777 (9th Cir. 1981).

239. *In re Mogen David Wine Corp.*, 328 F.2d 925, 933 (C.C.P.A. 1964) (Rich, J., concurring), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967).

240. *Competitive Torts*, *supra* note 16, at 920; *see* 3 R. Callmann I, *supra* note 59, § 77.4(e)(1), at 386 n.98; *Trade Dress Infringement*, *supra* note 17, at 95. In addition, recognition of the impracticability of this standard would also halt the recent application of the consumer appeal test to non-aesthetic mechanical product features. *See supra* notes 190-95 and accompanying text.

241. *See Competitive Torts*, *supra* note 16, at 920.

242. *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 825 (3d Cir. 1981); *see National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 662-63 (W.D. Wash. 1982).

243. *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 825 (3d Cir. 1981); *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 662-63 (W.D. Wash. 1982).

244. *See Trade Dress Infringement*, *supra* note 17, at 88; *Doctrine of Functionality*, *supra* note 4, at 562.

concerns underlying any functionality analysis dictates the application of a narrower and more practicable approach.

### A. Policy Concerns Dictate a Narrower Approach

A functionality inquiry, with respect to the preclusion of trademark protection,<sup>245</sup> should balance three basic policies:<sup>246</sup> 1) the public's interest in free competition;<sup>247</sup> 2) consumer protection in preventing confusion and deception as to the source of a product;<sup>248</sup> and 3) the property rights of the trademark owner in his identifying mark.<sup>249</sup> The importance of the goal of free competition is rooted in the belief that imitation stimulates competition, thereby promoting economic pro-

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245. The functionality doctrine may also preclude other, more general unfair competition protection such as trade-dress protection and protection against the palming off of one's goods as those of another. *See, e.g., Ives Labs., Inc. v. Darby Drug Co.*, 601 F.2d 631, 643-44 (2d Cir. 1979) (trade dress claim), *remand opinion rev'd on other grounds*, 638 F.2d 538 (2d Cir. 1981), *rev'd on other grounds sub nom. Inwood Labs., Inc. v. Ives Labs., Inc.*, 102 S. Ct. 2182 (1982); *Bliss v. Gotham Indus.*, 316 F.2d 848, 855-56 (9th Cir. 1963) (palming-off claim). Since trademark law is but a part of unfair competition law, the same basic policy considerations apply to both types of claims. Thus, whether a finding of functionality precludes trademark or trade-dress protection, the basic policies of consumer protection and protection of the businessman from the appropriation of his goodwill should be weighed. *See Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 694-95 (S.D.N.Y. 1963); 1 J. McCarthy, *supra* note 3, § 2:1, at 43-44.

246. In determining the breadth of a functionality standard that will preclude trademark protection, the trademark policies of consumer and trademark owner protection, S. Rep. No. 1333, 79th Cong., 2d Sess. 3-4, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1274-75, must be weighed against the policy of free competition, which underlies the functionality doctrine. *See supra* notes 38-40 and accompanying text.

247. *E.g., Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 827 (3d Cir. 1981); *Famolare, Inc. v. Melville Corp.*, 472 F. Supp. 738, 743 (D. Hawaii 1979), *aff'd mem.*, 652 F.2d 62 (9th Cir. 1981); *Schwinn Bicycle Co. v. Murray Ohio Mfg. Co.*, 339 F. Supp. 973, 980 (M.D. Tenn. 1971), *aff'd per curiam*, 470 F.2d 975 (6th Cir. 1972); *In re Deister Concentrator Co.*, 289 F.2d 496, 504 (C.C.P.A. 1961).

248. *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 919 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981); *Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 694 (S.D.N.Y. 1963); S. Rep. No. 1333, 79th Cong., 2d Sess. 3-4, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1274-75.

249. *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 919 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981); S. Rep. No. 1333, 79th Cong., 2d Sess. 3-4, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1274-75; *Restatement of Torts*, Introductory Note to ch. 35, at 536-40 (1938); 1 J. McCarthy, *supra* note 3, § 2:1, at 43-44; *see Pattishall, supra* note 57, at 121. Similarly, under unfair competition law, one policy consideration is the right of a businessman to secure the fruits of his labor from misappropriation by competitors. *Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 694 (S.D.N.Y. 1963); 1 J. McCarthy, *supra* note 3, § 2:1, at 43-44; *McClure, supra* note 57, at 305. Thus, even in cases of unfair competition claims this second policy concern should be considered. *See Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 694-95 (S.D.N.Y. 1963).

gress.<sup>250</sup> The functionality standards applied to both aesthetic and non-aesthetic product features recognize the importance of the principle of free competition.<sup>251</sup> The functionality standard applied to aesthetic features is broader, and thus precludes protection more readily than the standard applied to mechanical features.<sup>252</sup> And yet, the threat to free competition with respect to aesthetic features is less than it is with respect to mechanical features.<sup>253</sup> Because the range of possible aesthetic designs and configurations is as infinite as are the tastes that desire them,<sup>254</sup> according trademark protection to aesthetic features would not greatly hinder competition.<sup>255</sup>

In addition, the granting of trademark protection to an aesthetic feature allows the owner only a limited right;<sup>256</sup> he can prevent only

250. *American Safety Table Co. v. Schreiber*, 269 F.2d 255, 272 (2d Cir.), cert. denied, 361 U.S. 915 (1959); *In re Deister Concentrator Co.*, 289 F.2d 496, 501 (C.C.P.A. 1961); 1 J. McCarthy, *supra* note 3, § 1:15, at 33-35; Spratling I, *supra* note 1, at 464; *Doctrine of Functionality*, *supra* note 4, at 566 n.158; see *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 824 (3d Cir. 1981).

251. *Vuitton Et Fils S.A. v. J. Young Enters.*, 644 F.2d 769, 774 (9th Cir. 1981) (aesthetic feature); *Marvel Co. v. Pearl*, 133 F. 160, 161-62 (2d Cir. 1904) (mechanical feature); *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 662 (W.D. Wash. 1982) (aesthetic feature); *Damn I'm Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 1360 (S.D.N.Y. 1981) (same); *Famolare, Inc. v. Melville Corp.*, 472 F. Supp. 738, 743-44 (D. Hawaii 1979) (same), *aff'd mem.*, 652 F.2d 62 (9th Cir. 1981); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1339-42 (C.C.P.A. 1982) (mechanical feature); *In re Deister Concentrator Co.*, 289 F.2d 496, 504 (C.C.P.A. 1961) (same).

252. See 1 J. McCarthy, *supra* note 3, § 7:26, at 198; *Doctrine of Functionality*, *supra* note 4, at 562.

253. See *In re Penthouse Int'l Ltd.*, 565 F.2d 679, 682 (C.C.P.A. 1977); *In re Mogen David Wine Corp.*, 328 F.2d 925, 933 (C.C.P.A. 1964) (Rich, J., concurring), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967).

254. See *In re Mogen David Wine Corp.*, 328 F.2d 925, 933 (C.C.P.A. 1964) (Rich, J., concurring), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967).

255. *In re Penthouse Int'l Ltd.*, 565 F.2d 679, 682 (C.C.P.A. 1977); *In re Mogen David Wine Corp.*, 328 F.2d 925, 933 (C.C.P.A. 1964) (Rich, J., concurring), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967).

256. There has been a tendency to perceive exclusive trademark rights as evil, anti-competitive monopolies, similar to those guarded against by the antitrust laws. See 1 J. McCarthy, *supra* note 3, § 2:5, at 50; Brown, *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 Yale L.J. 1165, 1206 (1948); McClure, *supra* note 57, at 308. Under such a view, a broad functionality doctrine that precludes such monopolies would be favored. See *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 824 (3d Cir. 1981). A persuasive argument has been made, however, that trademarks are not competitively destructive "monopolies" as the term is commonly understood. *Artype, Inc. v. Zappulla*, 228 F.2d 695, 696-97 (2d Cir. 1956); *Philadelphia Storage Battery Co. v. Mindlin*, 163 Misc. 52, 56-57, 296 N.Y.S. 176, 181-82 (1937); 1 J. Gilson, *supra* note 3, § 1.03 [5], at 1-29; see *Levi Strauss & Co. v. Blue Bell, Inc.*, 632 F.2d 817, 821 n.5 (9th Cir. 1980); McClure, *supra* note 57, at 307-08; Pattishall, *supra* note 57, at 138, 142-43. Indeed, the legislative history of the Lanham Act indicates that the drafters perceived trademark protection as dis-

confusingly similar use of his mark by others.<sup>257</sup> Furthermore, the inability to imitate aesthetic features may, in fact, stimulate competitors to produce a more attractive feature.<sup>258</sup>

To the extent that courts too readily find aesthetic product features functional, the danger of consumer confusion as to the true source of products increases.<sup>259</sup> When an aesthetic feature is accorded trademark protection, the public is provided with "a device of identification which it did not have before."<sup>260</sup> If aesthetic features are consistently denied trademark protection, all competitors will be able to utilize the identical aesthetic feature in their products,<sup>261</sup> and purchasers will not be able to make knowledgeable choices among various competing products.<sup>262</sup> In addition, the manufacturer's right to be protected from such confusion in trade<sup>263</sup> should outweigh the possible harm resulting from depriving competitors of the right to imitate an arbitrary feature that does not contribute significantly to the product's use.<sup>264</sup> Moreover, unless limited exclusive rights are accorded

couraging monopolies by stimulating competition rather than creating monopoly situations. S. Rep. No. 1333, 79th Cong., 2d Sess. 3-4, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1274-75. Justice Holmes is cited for the proposition that trademark protection does not involve the creation of a monopoly but rather it only provides its owner with the right to prevent confusingly similar use of his mark. *Id.* at 3, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1275.

257. See S. Rep. No. 1333, 79th Cong., 2d Sess. 3-4, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1274-75; 1 J. Gilson, *supra* note 3, § 1.03 [5], at 1-29 to 1-30. See *supra* note 36.

258. *In re Mogen David Wine Corp.*, 328 F.2d 925, 933 (C.C.P.A. 1964) (Rich, J., concurring), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967); see *Vuitton Et Fils S.A. v. J. Young Enters.*, 644 F.2d 769, 777 (9th Cir. 1981).

259. See, e.g., *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 919 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981); *In re Deister Concentrator Co.*, 289 F.2d 496, 504 (C.C.P.A. 1961). The drafters of the Lanham Act acknowledged this factor in stating that a major purpose of the Trademark Act was "to protect the public so it may be confident that, in purchasing a product bearing a . . . trade-mark . . . it will get the product which it asks for and wants to get." S. Rep. No. 1333, 79th Cong., 2d Sess. 3-4, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1274; see *Yunker v. Nationwide Mut. Ins. Co.*, 137 U.S.P.Q. (BNA) 901, 904 (Ohio 1963).

260. 1 J. McCarthy, *supra* note 3, § 1:16, at 37.

261. 1 J. McCarthy, *supra* note 3, § 7:26, at 195-96; Spratling I, *supra* note 1, at 481.

262. S. Rep. No. 1333, 79th Cong., 2d Sess. 4, *reprinted in* 1946 U.S. Code Cong. Serv. 1274, 1275; see *Levi Strauss & Co. v. Blue Bell, Inc.*, 632 F.2d 817, 821 n.5 (9th Cir. 1980).

263. A manufacturer's right is often substantial because his mark may acquire significant financial value. See *United Drug Co. v. Parodney*, 24 F.2d 577, 579 (E.D.N.Y. 1928) ("Theoretically and perhaps practically as well this hard-earned right is as important as money in the bank. It should not be taken, or even nibbled away, by another . . ."); 1 J. McCarthy, *supra* note 3, § 2:9, at 65-66 (in the valuation of a business, the goodwill represented by a trademark is considered).

264. *In re Mogen David Wine Corp.*, 328 F.2d 925, 933 (C.C.P.A. 1964) (Rich, J., concurring), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967).

these features, money may not be spent on creating aesthetic features because there will not be "an adequate return on investment in creative business activities if everyone is free to copy the results when made public."<sup>265</sup>

Given the public interest in the prevention of consumer confusion, the trademark owner's valid property interest in his identifying mark, and the possible pro-competitive effects of according trademark rights, a narrow functionality standard should be applied to preclude trademark protection only if an adverse effect on the competitive process would result.<sup>266</sup> Only when an aesthetic feature is of substantial value in the use or efficiency of a product does society have a definite interest in preserving the freedom to utilize that feature.<sup>267</sup>

### B. *Clothing Designs*

The proposed narrow standard would not apply, however, to clothing designs.<sup>268</sup> Clothing designs consistently have been excluded from any practical protection.<sup>269</sup> Although copyright protection for fabric designs printed on clothing has been allowed,<sup>270</sup> copyright protection traditionally has been denied for dress design.<sup>271</sup> Courts similarly have refused unfair competition protection to designers from the concededly unjust appropriation of their designs.<sup>272</sup> Finally, although design

265. 1 J. McCarthy, *supra* note 3, § 1:16, at 37 (discussing protection for trademarks in general).

266. See *In re Mogen David Wine Corp.*, 328 F.2d 925, 933 (C.C.P.A. 1964) (Rich, J., concurring) ("Whether competition would in fact be hindered is really the crux of the matter."), *aff'd*, 372 F.2d 539 (C.C.P.A. 1967).

267. See *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 825 (3d Cir. 1981); *Marvel Co. v. Pearl*, 133 F. 160, 161 (2d Cir. 1904).

268. "Clothing design" or "dress design" as used in this Note refers to the overall shape, cut or style of an article of clothing as distinguished from fabric design, which refers to the design imprinted on the fabric. See 1 M. Nimmer, *supra* note 43, § 2.08[H][1], at 2-124.

269. *Millinery Creators' Guild v. Federal Trade Comm'n*, 109 F.2d 175, 177 (2d Cir. 1940), *aff'd*, 312 U.S. 469 (1941); *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279, 279, 281 (2d Cir. 1929), *cert. denied*, 281 U.S. 728 (1930); see *American Safety Table Co. v. Schreiber*, 269 F.2d 255, 271-72 (2d Cir.), *cert. denied*, 361 U.S. 915 (1959); *Famolare, Inc. v. Edison Bros. Stores*, 202 U.S.P.Q. (BNA) 373, 384 (N.D. Ill. 1979), *aff'd*, No. 79-1451 (7th Cir. Jan. 30, 1980), *cert. denied*, 446 U.S. 984 (1980).

270. *Irving J. Dorfman Co. v. Borlan Indus.*, 309 F. Supp. 21, 23 (S.D.N.Y. 1969); *Peter Pan Fabrics, Inc. v. Brenda Fabrics, Inc.*, 169 F. Supp. 142, 143 (S.D.N.Y. 1959).

271. *Millinery Creators' Guild v. Federal Trade Comm'n*, 109 F.2d 175, 177 (2d Cir. 1940), *aff'd*, 312 U.S. 469 (1941); *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279, 279 (2d Cir. 1929), *cert. denied*, 281 U.S. 728 (1930); *Verney Corp. v. Rose Fabric Converters Corp.*, 87 F. Supp. 802, 803 (S.D.N.Y. 1949).

272. *American Safety Table Co. v. Schreiber*, 269 F.2d 255, 271-72 (2d Cir.), *cert. denied*, 361 U.S. 915 (1959); see *Millinery Creators' Guild v. Federal Trade Comm'n*, 109 F.2d 175, 177 (2d Cir. 1940), *aff'd*, 312 U.S. 469 (1941); *Cheney Bros.*

patent protection is technically available for such designs, the short-lived, seasonal nature of most clothing designs makes the acquisition of a patent either impracticable or meaningless.<sup>273</sup> In addition, often the originality involved in the production of a new dress design does not reach the level of novelty and non-obviousness required for patent protection.<sup>274</sup> Thus, original clothing designs may be copied freely by competitors, leaving their creators without recourse.<sup>275</sup> The policy consideration for denial of protection for fashion designs stems from the judicial concern that designer styles be available to the less affluent purchaser through inexpensive copies.<sup>276</sup>

v. Doris Silk Corp., 35 F.2d 279, 279, 281 (2d Cir. 1929), *cert. denied*, 281 U.S. 728 (1930); Verney Corp. v. Rose Fabric Converters Corp., 87 F. Supp. 802, 804 (S.D.N.Y. 1949); 1 R. Callmann, *The Law of Unfair Competition and Trade-marks* § 16.3, at 253-58 (2d ed. 1950 & Supp. 1965) [hereinafter cited as R. Callmann II].

273. Cheney Bros. v. Doris Silk Corp., 35 F.2d 279, 279 (2d Cir. 1929), *cert. denied*, 281 U.S. 728 (1930); Jack Adelman, Inc. v. Sonners & Gordon, Inc., 112 F. Supp. 187, 190 (S.D.N.Y. 1934).

274. Millinery Creators' Guild v. Federal Trade Comm'n, 109 F.2d 175, 177 (2d Cir. 1940), *aff'd*, 312 U.S. 469 (1941); Cheney Bros. v. Doris Silk Corp., 35 F.2d 279, 279 (2d Cir. 1929), *cert. denied*, 281 U.S. 728 (1930); Famolare, Inc. v. Edison Bros. Stores, 202 U.S.P.Q. (BNA) 373, 384 (N.D. Ill. 1979), *aff'd*, No. 79-1451 (7th Cir. Jan. 30, 1980), *cert. denied*, 446 U.S. 984 (1980).

275. Millinery Creators' Guild v. Federal Trade Comm'n, 109 F.2d 175, 177 (2d Cir. 1940), *aff'd*, 312 U.S. 469 (1941); see 1 R. Callmann II, *supra* note 272, § 16.3, at 253.

276. Kieselstein-Cord v. Accessories By Pearl, Inc., 632 F.2d 989, 999 (2d Cir. 1980) (Weinstein, J., dissenting). Similarly, this judicial concern for the accessibility of inexpensive copies of clothing designs may be shared by Congress. Congress has considered providing a new form of copyright protection for ornamental designs of useful articles in what would have been Title II of the Copyright Act of 1976. H.R. Rep. No. 1476, 94th Cong., 2d Sess. 49-50, *reprinted in* 1976 U.S. Code Cong. & Ad. News 5659, 5662-63. Noting the lack of appropriate protection for these designs under the patent and copyright laws, the Senate has repeatedly passed legislation providing for five year protection for ornamental designs of useful articles. H.R. Rep. No. 1476, 94th Cong., 2d Sess. 49-50, *reprinted in* 1976 U.S. Code Cong. & Ad. News 5659, 5662-63; e.g., S. Rep. No. 473, tit. II, 94th Cong., 1st Sess. 161 (1975). To date, however, the proposed legislation has not been adopted by the full Congress because several issues require further examination: the designation of the protection as copyright protection; the procedural machinery required by the legislation; and whether the benefits of creating such protection would outweigh "the disadvantage of removing such designs from free public use." H.R. Rep. No. 1476, 94th Cong., 2d Sess. 50, *reprinted in* 1976 U.S. Code Cong. & Ad. News 5659, 5663. The proposed legislation was aimed at circumventing the Supreme Court decision in *Mazer v. Stein*, 347 U.S. 201 (1954), which held that only designs capable of standing as works of art separate from the useful articles in which they are incorporated are copyrightable. In addition, the legislation would provide protection for designs not reaching the level of invention required for a design patent. H.R. Rep. No. 1476, 94th Cong., 2d Sess. 50, *reprinted in* 1976 U.S. Code Cong. & Ad. News 5659, 5663. Even under this proposed legislation, however, protection for "three-dimensional features of . . . apparel" has been expressly excluded. S. Rep. No. 473, tit. II, 94th Cong., 1st Sess. 39 (1975).



C. *Practical Application of a Utilitarian Standard to Aesthetic Product Features*

A functionality standard with respect to aesthetic product features should allow protection for those aesthetic features that are merely pleasing to the eye, while permitting the imitation of those aesthetic features that contribute substantially to the usefulness of a product. Aesthetic product features must be analyzed as to their purpose and effect. If the feature is merely pleasing in appearance, and identifies the source of the goods, the interests of both the public and the trademark owner will be served by affording trademark protection to these arbitrary and merely ornamental features.<sup>277</sup> By contrast, if the feature is not just pleasing to the eye, but also contributes substantially to the practical operation or efficiency of the product, *either by means of a specific aesthetic effect*<sup>278</sup> or *apart from its aesthetics*,<sup>279</sup> then a finding of functionality is warranted. In this instance, the granting of exclusive rights in such an operationally utilitarian feature would give the owner of those rights an unfair advantage over his competitors.<sup>280</sup>

Application of this proposed standard requires a determination as to whether the aesthetic product feature is merely pleasing to the eye and thus non-functional. These purely decorative and ornamental features might include an abstract color pattern on clothing or the tear drop shape of jewelry. If the symbol or design's principal purpose is the identification of goods, it should be afforded trademark protection.<sup>281</sup>

By contrast, an aesthetic feature should be found functional if it contributes significantly to the utility of a product due to a particular aesthetic effect it provides.<sup>282</sup> For example, a heart shaped necklace should be found functional because the aesthetic effect resulting from

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277. See *supra* pt. IV(A).

278. See *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 826 (3d Cir. 1981).

279. See *J.C. Penney Co. v. H.D. Lee Mercantile Co.*, 120 F.2d 949, 954 (8th Cir. 1941); *cf. Ives Labs., Inc. v. Darby Drug Co.*, 601 F.2d 631, 643 (2d Cir. 1979) (involving unfair competition claim), *remand opinion rev'd on other grounds*, 638 F.2d 538 (2d Cir. 1981), *rev'd on other grounds sub nom. Inwood Labs., Inc. v. Ives Labs., Inc.*, 102 S. Ct. 2182 (1982).

280. See *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 827 (3d Cir. 1981); *J.C. Penney Co. v. H.D. Lee Mercantile Co.*, 120 F.2d 949, 954 (8th Cir. 1941).

281. 1 J. McCarthy, *supra* note 3, § 7:6, at 62. Aesthetic product features may also be protected under the law of unfair competition either at common law, *cf. International News Serv. v. Associated Press*, 248 U.S. 215 (1918) (misappropriation doctrine), or under § 43(a) of the federal Lanham Act. 15 U.S.C. § 1125(a) (1976). Section 43(a) provides a cause of action for the false designation of the origin of goods and has been held applicable to a wide variety of unfair competition claims. 1 J. Gilson, *supra* note 3, § 7.02, at 7-7, 7-19. A comprehensive discussion of these potential areas of protection is beyond the scope of this Note.

282. See *Keene Corp. v. Paraflex Indus.*, 653 F.2d 822, 825-26 (3d Cir. 1981).

the heart shape directly relates to its use as a gift for a loved one.<sup>283</sup> Similarly, a Christmas tree design on holiday china should be found functional because the aesthetic effect resulting from the depiction directly relates to the product's seasonal use. Clearly, these features should be accessible for all to incorporate into their products.

Accordingly, in *Keene Corp. v. Paraflex Industries*,<sup>284</sup> in which the shape of an outdoor wall-mounted luminaire was held functional,<sup>285</sup> the court should have initially analyzed the configuration to determine whether it was merely aesthetically pleasing or whether it provided a particular aesthetic effect significantly related to the use of the product. Since the configuration was not merely pleasing to the eye, but its particular aesthetic effect was its unique compatibility with architecture, its effect directly contributed to the luminaire's use as an outdoor lighting fixture on buildings<sup>286</sup> and a finding of functionality was warranted.

Aesthetic features may also be found functional if, apart from and in addition to their aesthetic appeal, they contribute significantly to the use, efficiency or economy of a product.<sup>287</sup> For example, the seemingly decorative shape of a chair may be functional because its structural design contributes substantially to its comfort. Similarly, an aesthetically pleasing shoe design may be functional because it increases the shoe's arch support. In fact, *J.C. Penney Co. v. H.D. Lee Mercantile Co.*,<sup>288</sup> a decision integral to the formation of the modern aesthetic functionality standard,<sup>289</sup> involved this type of aesthetic feature: a 4-in-1 overall pocket design with rounded corners. Although the court correctly held the design functional,<sup>290</sup> its finding should have been based upon the following analysis. Because the rounded pocket corners were not merely pleasing to the eye, but also decreased the accumulation of dirt in the pockets more effectively than traditional square pockets,<sup>291</sup> the design provided a sufficient utilitarian value to the overalls to support a finding of functionality.<sup>292</sup>

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283. See Restatement of Torts § 742 comment a (1938).

284. 653 F.2d 822 (3d Cir. 1981). See *supra* notes 210-14 and accompanying text.

285. 653 F.2d at 826.

286. See *id.*

287. See *J.C. Penney Co. v. H.D. Lee Mercantile Co.*, 120 F.2d 949, 954 (8th Cir. 1941). Certain courts have, in fact, utilized this approach in holding certain aesthetic features non-functional and thus capable of protection under unfair competition law. See *Artus Corp. v. Nordic Co.*, 512 F. Supp. 1184, 1189 (W.D. Pa. 1981); *Le Sportsac, Inc. v. Dockside Research, Inc.*, 478 F. Supp. 602, 607-08 (S.D.N.Y. 1979).

288. 120 F.2d 949 (8th Cir. 1941). See *supra* notes 125-27 and accompanying text.

289. *Doctrine of Functionality*, *supra* note 4, at 561-62; see *Competitive Torts*, *supra* note 16, at 919-20.

290. 120 F.2d at 954.

291. *Id.*

292. See *id.*

## CONCLUSION

A broad aesthetic functionality standard based solely on consumer appeal has evolved as a divergent branch of the well-established, utilitarian-oriented functionality doctrine. This broad approach, however, disregards the very heart of the traditional functionality doctrine—that only product features that contribute substantially to the practical operational use of the product should be freely accessible to the public. A more reasoned approach recognizes that an aesthetic feature is functional if it provides a significant contribution to the practical use of a product. Only in these instances does the granting of protection pose a threat to free competition.

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