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## Can an Inventor Continue Protecting an Expired Patented Product via Trade Dress Protection

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# CAN AN INVENTOR CONTINUE PROTECTING AN EXPIRED PATENTED PRODUCT VIA TRADE DRESS PROTECTION?

## I. INTRODUCTION

Imagine investing a large amount of time and money into thinking about, creating, and patenting your own product. For twenty years, no one has infringed on your innovative product due to the patent you obtained.<sup>1</sup> However, your patent has now expired and your competitors may legally strip your idea from you.<sup>2</sup> Should there be other means to protect your ideas from competitors?<sup>3</sup> There are other alternatives, but they are not easily attainable.<sup>4</sup> Thus, when applying for a patent based on aesthetic features and determining which patent should be filed to gain other forms of protection, such as trade dress protection, an inventor should consider several questions after the patent expires.<sup>5</sup>

First, with respect to an expired patent under a trade dress protection claim, is the functionality doctrine established in *Traffix Devices, Inc. v. Marketing Displays, Inc.*<sup>6</sup> a uniform standard that can be used when evaluating the meaning behind “essential to the use or purpose” of a product?<sup>7</sup>

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1. See 35 U.S.C. §154(a)(2) (2000) (stating that a patent lasts for twenty years from the filing date of the patent application); *but see id.* §173 (stating that a design patent lasts for fourteen years from the date the patent is granted).

2. See *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 35 (2001) (concluding that Traffix Devices, Inc. was able to keep their reverse-engineered sign on the market because it did not infringe on the expired patent of MDI’s similar sign).

3. See *Dippin’ Dots, Inc. v. Frosty Bites Distribution*, 369 F.3d 1197, 1202 (11th Cir. 2004) (quoting *Ambrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1535 (11th Cir. 1986), which stated that trade dress protects the “total image of a product and may include features such as size, shape, color, . . . texture graphics, or even particular sales techniques”).

4. See *Shire U.S., Inc. v. Barr Labs., Inc.*, 329 F.3d 348, 353 (3d Cir. 2003) (citing *Eppendorf-Netheler-Hinz GmbH v. Ritter GmbH*, 289 F.3d 351, 355 (5th Cir. 2002)) (“[T]rade dress protection, unlike patent law . . . does not foster innovation by preventing reverse engineering or copying of innovative product design features.”).

5. See generally Nancy Sya, Comment, *Presumed Functional Until Rebutted: The Increased Difficulty of Obtaining Trade Dress Protection with an Expired Utility Patent*, 43 SANTA CLARA L. REV. 971, 994-95 (2003) (explaining that an inventor may file for a design and a utility patent concurrently in pursuit of protecting the product from current competitors and later having the opportunity to seek trade dress protection in the future).

6. 532 U.S. 23, 30-32 (2001).

7. See *Valu Eng’g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1274 (Fed. Cir. 2002) (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41 (CCPA 1982)) (applying the Morton-Norwich factors):

Secondly, should courts consider other design alternatives?<sup>8</sup> Finally, is the functionality standard necessary when a non-functional standard exists?<sup>9</sup>

In *Traffix*, the United States Supreme Court set the functionality standard in determining whether a particular feature of a product is functional to the overall product, and settled a circuit split.<sup>10</sup> However, since *Traffix* in 2001, circuit courts and district courts have applied different interpretations of the *Traffix* decision.<sup>11</sup> This note explains how the functionality doctrine is overly vague and how it has created more inconsistencies in determining whether a product should be afforded trade dress protection. However, before presenting the applications and implications of the *Traffix* decision, an explanation of trade dress and patent protection requirements are addressed to underscore the importance behind the functionality doctrine.

Part II provides a background to trade dress protection that includes a brief elemental analysis and reasons for seeking such protection. Part III continues with the background of patent law. Part IV of this note discusses the rule, facts, holding, and reasoning of the *Traffix* decision. Part V focuses on the aftermath of *Traffix* and provides a possible explanation of why the functionality doctrine is too vague. Part VI examines a pre-existing element to the functionality doctrine that considers other design alternatives used by the Federal Circuit and district courts. Part VII provides reasoning on why the United States Supreme Court rejected consideration of other design alternatives in determining functionality. Part VIII then discusses the non-functionality test established in *Traffix*, which

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- (1) the existence of a utility patent disclosing the [functional] advantages of the design,
  - (2) advertising materials in which the [design's originator publicizes] the design's [functional] advantages, (3) the availability to competitors of functionally equivalent designs, and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product).

*But see* Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co., 292 F. Supp. 2d 535, 548 (S.D.N.Y. 2003) (applying the Second Circuit's functionality standard that a design feature is essential only if the feature is dictated by the functions to be performed). *See generally* Tracy McCormick, Note, *Will Traffix "Fix" the Splintered Functionality Doctrine?: Traffix Devices, Inc. v. Marketing Displays, Inc.*, 40 HOUS. L. REV. 541, 542 (2003) (stating that the *Traffix* decision has left unanswered questions to the functionality doctrine).

8. *See* New Colt Holding Corp. v. RJG Holdings of Fla., Inc., 312 F. Supp. 2d 195, 214 (D. Conn. 2004) (finding that the existence of design alternatives is helpful when determining whether a particular design is truly necessary to the way a product works).

9. *See Traffix*, 532 U.S. at 30 (finding that a particular feature was considered non-functional when the feature is ornamental, arbitrary, or incidental to the overall product).

10. *Id.* at 32 (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995), quoting *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 850 n. 10 (1982)).

11. *See Valu Eng'g, Inc.*, 278 F.3d at 1276 (applying the Morton-Norwich factors that considers other design alternatives to determine functionality); *see also* *Maharishi Hardy Blechman Ltd.*, 292 F. Supp. 2d at 548 (applying the Second Circuit's functionality standard that a design feature is essential only if the feature is dictated by the functions to be performed).

created more confusion for the lower courts and a higher burden for an individual or company seeking trade dress protection. Finally, Part IX presents several different proposals: to use the Second Circuit's functionality test, to have Congress harmonize the Patent and Lanham Act and adopt a uniform standard, or to adopt the Federal Circuit's interpretation of *TrafFix*. Ultimately, the Federal Circuit's interpretation should be adopted because the Federal Circuit interpretation is consistent with prior cases and it exclusively handles patent prosecution issues on appeal.<sup>12</sup>

## II. TRADE DRESS BACKGROUND

### A. WHAT DOES IT MEAN TO HAVE "TRADE DRESS" PROTECTION?

The term "trade dress" identifies a producer or a product's source based on the appearance of a product.<sup>13</sup> Initially, trade dress protected exclusive rights over packaging, labeling, or display of a product.<sup>14</sup> However, trade dress currently protects the "total image of a product and may include features such as size, shape, color, . . . texture, graphics, or even particular sales techniques."<sup>15</sup> To receive trade dress protection, the product design features must be (1) confusingly similar to another product, (2) primarily non-functional, and (3) inherently distinctive or have acquired a secondary meaning.<sup>16</sup> This three-step process may be difficult because this test presents a subjective analysis.

The first step overlaps with the purpose of trademark law.<sup>17</sup> However, trademark claims arise when competitors use the mark of another in pursuit of confusing the consumer of the original source and gaining a market

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12. See 35 U.S.C. §141 (2000) (stating that a dissatisfied applicant may appeal a Board of Patent Appeals' decision to the Federal Circuit Court of Appeals); see also DONALD S. CHISUM, CHISUM ON PATENTS G1-5 (2004) (stating that the Federal Circuit Court of Appeals handles most cases on appeal involving patent issues, including (1) Board of Patent Appeals' decisions; (2) district courts' patent infringement suits; (3) United States Claims Court's decisions; and (4) United States Trade Commission's determinations).

13. *Dippin' Dots*, 369 F.3d at 1202 (quoting *Publ'n Int'l, Ltd. v. Landoll, Inc.*, 164 F.3d 337, 338 (7th Cir. 1998)).

14. *Sya*, *supra* note 5, at 977.

15. *Dippin' Dots*, 369 F.3d at 1202 (quoting *Ambrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1535 (11th Cir. 1986)).

16. See *id.* (stating how to prevail on a trade dress infringement claim) (citing *Epic Metals Corp. v. Souliere*, 99 F.3d 1034, 1038 (11th Cir. 1996)); see also 15 U.S.C. § 1125(a) (2000) (stating that "any person" who misleads a consumer by "any word, term, name, symbol, or device, or any combination thereof . . . shall be liable in a civil action").

17. See generally *Sya*, *supra* note 5, at 977 (stating that a trademark is used for distinguishing goods or services to prevent confusingly similar products from appearing in the market).

advantage.<sup>18</sup> For instance, the University of North Dakota's (UND) trademark logo is the face of a "Fighting Sioux Indian."<sup>19</sup> If another university or company used this mark on products unaffiliated with UND, consumers could be confused as to the mark's source because UND did not appear on or appear to endorse the product that replicated the Fighting Sioux Indian face.

Trade dress is a subset of trademark law that protects the aesthetic features or overall image of the product.<sup>20</sup> Therefore, trade dress for the "Fighting Sioux Indian" face includes the artistic design that involves the use of color, size, shape, and texture graphics of the face and background.<sup>21</sup> If another company or university ostensibly used UND's logo including the specific features intimately associated with the logo, the company's product could be confusingly similar to consumers as to the product's original source.<sup>22</sup>

The second element to trade dress protection requires the product's design features to be primarily non-functional.<sup>23</sup> Most courts have a difficult time determining whether the features of a product are non-functional.<sup>24</sup> The United States Supreme Court found that a feature is non-functional when the feature is "ornamental", "arbitrary", or "incidental" to the overall device.<sup>25</sup> This non-functional in trade dress test created a problem for expired utility patents because the Supreme Court also found that a utility patent displays strong evidence of functional features.<sup>26</sup>

Third, if a product is found to contain non-functional features, the product still needs to have acquired secondary meaning before it can be protected by trade dress.<sup>27</sup> To acquire secondary meaning, consumers must

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18. *Id.*

19. See <http://www.fightingsioux.com/> (last visited Jan. 24, 2005) (displaying the "Fighting Sioux Indian" trademark logo).

20. *Sya*, *supra* note 5, at 977-78.

21. See *c.f.*, *Dippin' Dots*, 369 F.3d at 1202 (providing examples of certain features that trade dress protects on products).

22. *Contra id.* at 1208 (concluding that although six out of seven factors showed how two design logos could be confusingly similar, no reasonable jury could find the two logos are confusingly similar based on a lack of visual similarity).

23. *Id.* at 1202.

24. See *id.* (finding that the design of colored ice cream is functional); see also *New Colt Holding Corp. v. RJG Holdings of Fla., Inc.*, 312 F. Supp. 2d 195, 219 (D. Conn. 2004) (finding functional elements of every aspect of a revolver, but also finding numerous factual disputes with respect to each individual element making a summary judgment on functionality inappropriate).

25. *TrafficFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 30 (2001).

26. *Id.* at 29.

27. See *New Colt Holding*, 312 F. Supp. 2d at 203 (stating that one of the elements to assert a trade dress claim is to show how a design is "distinctive as to the source of the good" such as acquiring secondary meaning); but see *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767

be able to identify the source of a product based on the product's features instead of the product itself.<sup>28</sup> Even though there are three steps to attain trade dress protection, the Supreme Court has also considered the overall experience that a product or service may present to a customer instead of viewing the visual impression of the product.<sup>29</sup>

## B. WHY SHOULD AN INVENTOR OR COMPANY SEEK TRADE DRESS PROTECTION?

Trade dress protection secures the goodwill of a business and allows consumers to distinguish between an original and a duplicated product.<sup>30</sup> Companies can generate more sales and to avoid confusion on the part of consumers, by having a trade dress protected product.<sup>31</sup> For example, in North Dakota, a consumer may purchase a similar-looking Columbia Titanium jacket, but this jacket may not be as insulated as the original.<sup>32</sup> The consumer will be uncomfortable during the winter months because the original Columbia Titanium jacket could not obtain trade dress protection.

Even though the Columbia jackets are expensive, an imitated product that is ostensible to the Columbia Titanium jacket's features or design should not be allowed in the market because the imitated product may confuse the consumer.<sup>33</sup> This is only a hypothetical, but once a patented product expires, trade dress protection for the overall product is difficult to attain.<sup>34</sup> However, trade dress protection should still interest businesses because this protection creates an incentive to produce competitive and

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(1992) (finding that an inherently distinctive trade dress can be afforded protection without acquiring secondary meaning).

28. *Two Pesos*, 505 U.S. at 766 (quoting *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 851 (1982)).

29. *Id.* at 765, 776 (Scalia, J., concurring) (recognizing that a Mexican restaurant's festive atmosphere can be afforded trade dress protection); see generally Jason R. Berne, *Article: All Dressed Up and No Place to Go: The Need for Trade Dress Protection of Internet Sites*, 27 AIPLA Q. J. 265, 267-68 (1999) (explaining how trade dress protection may also apply via Internet websites).

30. *Shire U.S., Inc. v. Barr Labs., Inc.*, 329 F.3d 348, 353 (3d Cir. 2003) (quoting *Two Pesos, Inc.*, 505 U.S. at 774).

31. *Id.*

32. See [http://www.columbia.com/lines\\_int/tech\\_titanium\\_us.cfm](http://www.columbia.com/lines_int/tech_titanium_us.cfm) (last visited Jan. 27, 2005) (explaining the quality of a Columbia Titanium jacket).

33. *Cf.*, *Dippin' Dots, Inc. v. Frosty Bites Distribution*, 369 F.3d 1197, 1207 (11th Cir. 2004) (stating that the seven following factors need to be considered when determining whether something is confusingly similar: (1) trade dress strength, (2) design similarity, (3) product similarity, (4) retail outlets' and purchasers' similarity, (5) advertising media similarity, (6) defendant's intent, and (7) actual confusion) (quoting *Ambrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1538 (11th Cir. 1986)).

34. See *Shire U.S.*, 329 F.3d at 353 (citing *Eppendorf-Netheler-Hinz GmbH v. Ritter GmbH*, 289 F.3d 351, 355 (5th Cir. 2002)) ("[T]rade dress protection, unlike patent law. . . does not foster innovation by preventing reverse engineering or copying of innovative product design features.").

creative goods.<sup>35</sup> Thus, companies with trade dress protection can assert claims that companies using their product's features prevent them from further utilization of their own product.<sup>36</sup>

### III. PATENT LAW BACKGROUND

#### A. WHAT DOES IT MEAN TO HAVE PATENT PROTECTION?

A patent protects an idea for twenty years from the filing date of the patent application.<sup>37</sup> The ability to file falls under the subject matter of §101 of the Patent Act.<sup>38</sup> If an invention falls under one of the categories stated in §101 and meets the other patentability requirements under §§102, 103, and 112 of the Patent Act, then an invention may be patented.<sup>39</sup> Also, the expansive term “any” in §101 indicates that Congress intended to extend §101 to mean “anything under the sun that is made by man” may be considered patentable as long as the invention is novel, non-obvious, and useful.<sup>40</sup> To pass the novelty prong requirement, the idea must be new.<sup>41</sup> The non-obviousness prong requires that the idea to be more inventive than the idea of an expected ordinary person skilled in the art.<sup>42</sup> The useful prong is satisfied as long as the invention is operable and provides a tangible benefit.<sup>43</sup>

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35. *See generally, contra* Sya, *supra* note 5, at 993 (stating that the purpose of patent law was to give inventors an incentive when they disclosed their invention in order to allow other inventors to develop new technology from the disclosed information).

36. *See* E-Z Bowz, L.L.C. v. Prof'l Prod. Research Co., No. 00 CIV.8670, 2003 WL 22068573, at \*23-24 (S.D.N.Y. Sept. 5, 2003) (finding that a patented bow-making device with non-functional features may prevent other similar products to remain in the market).

37. 35 U.S.C. § 154(a)(2) (2000); *see generally* MARTIN J. ADELMAN ET AL., CASES AND MATERIALS ON PATENT LAW 8 (2d ed. 2003) (stating that a utility patent lasts for twenty years from the patent filing application date).

38. *See* 35 U.S.C. § 101 (2000) (defining patentable subject matter to include “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof”).

39. *See* State St. Bank & Trust Co. v. Signature Fin. Group, 149 F.3d 1368, 1372-76 (Fed. Cir. 1998) (finding that computer programs that implement business methods and business methods themselves were patentable under §§ 101, 102, 103, and 112 of the Patent Act). *See generally* 35 U.S.C. §§101-03, 112 (2000) (explaining patentable subject matter, novelty, non-obviousness, and specification, respectively).

40. *See* Diamond v. Diehr, 450 U.S. 175, 182 (1981) (finding that a process is patentable under § 101 of the Patent Act).

41. *See* 35 U.S.C. § 102 (2000) (stating that the invention must not be fully anticipated by a prior patent, publication, or other knowledge within the public domain).

42. *See* 35 U.S.C. § 103(a) (2000) (stating that the invention must not be readily available within the ordinary skills of a competent individual at the time the invention was made).

43. *Id.* § 101.

However, the three categories of subject matter that are not patentable are laws of nature, natural phenomena, and abstract ideas.<sup>44</sup> For example, mathematical equations by themselves are not patentable because they are abstract.<sup>45</sup> Nevertheless, the United States Supreme Court held that processes, which included mathematical equations, were patentable because the patentee did not invent the algorithm, but found a way to implement the algorithm within the process.<sup>46</sup> The Court explained that mathematical subject matter was considered an abstract idea until the idea was reduced to some type of practical application that produces a useful, concrete, and tangible result.<sup>47</sup>

#### B. WHY SHOULD AN INVENTOR APPLY FOR A PATENT?

The Patent and Trademark Office grants a twenty-year monopoly for utility patents in order “[t]o promote the [p]rogress of [s]cience and useful [a]rts.”<sup>48</sup> If an inventor does not apply for a patent, the inventor’s idea can be stripped away by a competitor.<sup>49</sup> A patent gives the inventor exclusive rights to exclude others from making, using, or selling the claimed invention.<sup>50</sup> The United States Constitution grants Congress power to encourage innovation via patents or copyrights in order to have technological growth and provide incentives to inventors to contribute to the “[p]rogress of [s]cience and useful [a]rts” in our society.<sup>51</sup>

#### C. WHAT IS THE DIFFERENCE BETWEEN A UTILITY PATENT AND A DESIGN PATENT?

Another kind of patent that an inventor may apply for is a design patent.<sup>52</sup> A design patent protects the ornamental features of a product, which must still be novel and non-obvious to be considered as patentable

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44. *Diamond*, 450 U.S. at 185.

45. *State St. Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368, 1373 (Fed. Cir. 1998) (citing *Diamond*, 450 U.S. at 175).

46. *Diamond*, 450 U.S. at 191-93.

47. *Id.* at 185.

48. See U.S. CONST. art. I, § 8, cl. 8 (encouraging innovation via patents and copyrights); see also 35 U.S.C. § 154(a)(2) (stating that a patent lasts for twenty years from the filing date of the patent application).

49. See 35 U.S.C. § 102 (stating that the invention must not be fully anticipated by a prior patent, publication, or other knowledge within the public domain).

50. 35 U.S.C. § 154(a)(1).

51. U.S. CONST. art. I, § 8, cl. 8; see generally *Sya*, *supra* note 5, at 993 (stating that the purpose of patent law was to give inventors an incentive when they disclosed their invention to allow other inventors to develop new technology from the disclosed information).

52. See 35 U.S.C. § 171 (2000) (stating that a design patent protects “ornamental design[s] for ‘an article of manufacture’”).



subject matter.<sup>53</sup> However, unlike a utility patent lasting twenty years,<sup>54</sup> a design patent only lasts fourteen years from the date the patent is granted.<sup>55</sup> Although a design patent does not last as long as a utility patent, a design patent has a greater chance to obtain trade dress protection after the design patent expires, as trade dress protection and design patents deal with non-functional features.<sup>56</sup>

Initially, an inventor should apply for a design patent instead of seeking trade dress protection because trade dress protection requires the product to be in the market before the protection applies.<sup>57</sup> This requirement creates a problem for the inventor because it allows other potential competitors to become familiar with the inventor's new product and legally replicate the product.<sup>58</sup> Thus, an inventor should seek a design patent and a utility patent concurrently, not only because design patents are limited, but also because of the increased opportunity to obtain trade dress protection after the design patent expires.<sup>59</sup> However, if the inventor only obtains a utility patent, some courts, as in *TrafFix*, have a difficult time determining whether trade dress protection applies to an expired utility patent that involves design features as in *TrafFix*.<sup>60</sup>

#### IV. THE *TRAFFIX* DECISION

In *TrafFix*, the United States Supreme Court found that a utility patent should display strong evidence of functional features.<sup>61</sup> The court explained that a feature is functional "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article."<sup>62</sup>

In *TrafFix*, an inventor named Robert Sarkisian obtained two utility patents for a dual-spring design mechanism to keep outdoor signs upright

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53. *Id.* § 171.

54. *Id.* §154(a)(2).

55. 35 U.S.C. §173 (2000).

56. *See TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001) (finding that a utility patent displays strong evidence of functional features within this kind of patent); *see also* *Dippin' Dots, Inc. v. Frosty Bites Distribution*, 369 F.3d 1197, 1202 (11th Cir. 2004) (explaining that a product's feature needs to be non-functional in order to obtain trade dress protection).

57. *Sya*, *supra* note 5, at 995.

58. *Id.*

59. *Id.*

60. *See* 532 U.S. at 32 (holding that an expired patented dual-spring mechanism at the base of a sign was not afforded trade dress protection because there was no proof that the sign's design features were non-functional).

61. *Id.* at 29.

62. *Id.* at 32 (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995), quoting *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 850 n. 10 (1982)).

and wind-resistant.<sup>63</sup> Marketing Displays, Inc. (MDI) became the owner of Sarkisian's patents and established a business using the design at the base of an outdoor sign, called the "Windmaster."<sup>64</sup> The "Windmaster" prevented the sign from being blown down by strong gusts of wind.<sup>65</sup> However, when MDI's patent expired, Traffix Devices, Inc. reverse-engineered the "Windmaster" sign and renamed it the "Windbuster."<sup>66</sup> MDI then sued Traffix for trademark infringement, trade dress infringement, and unfair competition.<sup>67</sup> However, the United States Supreme Court in the case focused only on the trade dress protection claim.<sup>68</sup>

The Court held that MDI was not afforded trade dress protection because MDI did not meet its burden in establishing how the dual-spring design was non-functional.<sup>69</sup> The court reasoned that the dual-spring design was not an arbitrary or ornamental aspect of MDI's product, but rather a mechanism that made the device work.<sup>70</sup> The Court stated that if MDI had asserted protection on the arbitrary curves in the legs or an ornamental design on the springs, the result would be different.<sup>71</sup> However, MDI was only seeking protection on the dual-spring, which was considered a functional aspect, not an ornamental feature of the product as was required under a trade dress protection claim.<sup>72</sup> Thus, the Court concluded that Traffix Devices, Inc. was able to keep their "Windbuster" sign on the market without infringing MDI's expired patent.<sup>73</sup>

## V. THE FUNCTIONALITY STANDARD AND MIXED INTERPRETATION

### A. THE AFTERMATH OF IMPLEMENTING OR NOT IMPLEMENTING THE FUNCTIONALITY DOCTRINE

The decision in *Traffix* resulted in a difficult functionality standard to apply because the decision was based on specific facts with respect to an

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63. *Id.* at 25.

64. *Id.* at 25-26.

65. *Id.*

66. *Traffix*, 532 U.S. at 26.

67. *Id.*

68. *Id.*

69. *Id.* at 32; *see also* *Dippin' Dots, Inc. v. Frosty Bites Distribution*, 369 F.3d 1197, 1202 (11th Cir. 2004) (explaining that a product's feature needs to be non-functional in order to obtain trade dress protection).

70. *Traffix*, 532 U.S. at 34.

71. *Id.*

72. *Id.*

73. *Id.* at 35.

expired utility patent.<sup>74</sup> Inventors may also seek trade dress protection on other patents.<sup>75</sup> For instance, in *Dippin' Dots, Inc. v. Frosty Bites Distribution*,<sup>76</sup> Dippin' Dots, Inc. (DDI), which marketed and sold a "brightly-colored flash-frozen" ice cream product called "Dippin' Dots," filed a trade dress infringement suit based on its product's design.<sup>77</sup> Unlike merely having a utility patent as in *TrafFix*, DDI had a patent for the method it used to make Dippin' Dots.<sup>78</sup> Though the Eleventh Circuit was not dealing with an expired utility patent, the court applied the functionality standard established in *TrafFix*<sup>79</sup> to determine whether Dippin' Dots' features were functional.<sup>80</sup> The court stated that "[t]he line between functionality and non-functionality is not . . . brightly drawn."<sup>81</sup> However, the court analyzed the color, size, and shape of Dippin' Dots to determine whether these features were functional.<sup>82</sup> The Eleventh Circuit Court of Appeals held that the design of colored ice cream was functional based on *TrafFix*'s functionality doctrine.<sup>83</sup>

However, *TrafFix*'s functionality doctrine created a higher burden for defendants to rebut the presumed functional aspects of a product.<sup>84</sup> The Eleventh Circuit determined that DDI's product design was functional because the colors of Dippin' Dots indicated flavor, the size contributed to the product's taste, and the shape of the ice cream beads conveyed consistency.<sup>85</sup> Thus, the court concluded that DDI's design as a whole was functional because any competitor in the flash-frozen ice cream business would essentially have the same features as Dippin' Dots.<sup>86</sup> Additionally, the court determined that Dippin' Dots' features were functional because

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74. See *Shire U.S., Inc. v. Barr Labs., Inc.*, 329 F.3d 348, 358 n. 22 (3d Cir. 2003) (stating that *TrafFix* did not consider a trade dress claim with respect to a process).

75. *Contra Dippin' Dots, Inc. v. Frosty Bites Distribution*, 369 F.3d 1197, 1206 (11th Cir. 2004) (denying trade dress protection on a method patent).

76. 369 F.3d 1197 (11th Cir. 2004).

77. *Dippin' Dots*, 369 F.3d at 1200-01.

78. *Id.* at 1200.

79. 532 U.S. at 32 (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995), quoting *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 851 n.10 (1982)) (finding that a feature is functional "if it is essential to the use or purpose of the article or [when] it affects the cost or quality of the article").

80. *Dippin' Dots*, 369 F.3d at 1202-03.

81. *Id.* at 1203 (quoting *Epic Metals Corp. v. Souliere*, 99 F.3d 1034, 1039 (11th Cir. 1996)).

82. *Id.*

83. *Id.* at 1209.

84. See 532 U.S. at 30 ("[O]ne who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.").

85. *Dippin' Dots*, 369 F.3d at 1205-06.

86. *Id.* at 1206.

the design as a whole was essential to its purpose and affected the quality of DDI's product.<sup>87</sup>

Although the Eleventh Circuit held that the design of colored ice cream was functional, DDI argued that its patented method of how to make Dippin' Dots did not specify color or size.<sup>88</sup> However, the court stated that the *Traffix* decision "did not . . . conclude the inverse."<sup>89</sup> In other words, the *Dippin' Dots* court reasoned that *Traffix* did not find that if there were no utility features in a patent, then those features would not be functional.<sup>90</sup> In addition, the *Dippin' Dots* court stated that even if *Traffix* concluded the inverse as the law, the result would be the same, because a product's features are considered functional until proven otherwise.<sup>91</sup> This created a problem because other courts began to consider other elements to determine functionality.<sup>92</sup>

In *Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co.*,<sup>93</sup> the court found that the *Traffix* decision was highly elusive when considering alternate designs to the question of functionality.<sup>94</sup> In addition, the court applied the Federal Circuit's interpretation of *Traffix* and found that military-style baggy pants with dragon embroidery known as "Snopants" did not have trade dress protection.<sup>95</sup> The court reasoned that this line of clothing did not have a consistent overall look.<sup>96</sup> In order to assert trade dress protection for an entire product line instead of a single product, the plaintiff must show the entire product line has a "consistent" overall look.<sup>97</sup> If there were no such requirement, the question of the product's

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87. *Id.* at 1206-07.

88. *See id.* at 1207 (quoting *Traffix*, 532 U.S. at 29) (stating that DDI made this argument because the United States Supreme Court found that a utility patent displayed strong evidence of functional features).

89. *Id.*

90. *Id.*

91. *Id.* at 1207 (quoting *Traffix*, 532 U.S. at 30); *see also* *Shire U.S., Inc. v. Barr Labs., Inc.*, 329 F.3d 348, 359 (3d Cir. 2003) (stating that the United States Supreme Court in *Traffix* only dealt with a utility patent and did not consider other patents, such as a process patent, seeking trade dress protection).

92. *See* *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276 (Fed. Cir. 2002) (applying the Morton-Norwich factors that considers other design alternatives to determine functionality); *see also* *Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co.*, 292 F. Supp. 2d 535, 548 (S.D.N.Y. 2003) (applying the Second Circuit's functionality standard that a design feature is essential only if the feature is dictated by the functions to be performed).

93. 292 F. Supp. 2d 535 (S.D.N.Y. 2003).

94. *Maharishi*, 292 F. Supp. 2d at 546.

95. *Id.* at 549-50.

96. *Id.*

97. *Id.* at 542 (citing *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 116 (2d Cir. 2001), quoting *Walt Disney Co. v. Goodtimes Home Video Corp.*, 830 F. Supp. 762, 766 (S.D.N.Y. 1993)).

design and configuration would easily turn into a question of quality, beauty, or cachet.<sup>98</sup> In addition to this burden, the plaintiff still has to prove that the product's design is non-functional.<sup>99</sup>

The court in *Maharishi* reached a decision by interpreting the functionality doctrine as one test.<sup>100</sup> However, the Third Circuit recognized that *TrafFix* set forth two tests for determining functionality.<sup>101</sup> In *Shire U.S., Inc. v. Barr Labs. Inc.*,<sup>102</sup> the Third Circuit stated that the first test, which is the traditional test, determines whether a feature is functional based on the feature's essential use or purpose to the overall product.<sup>103</sup> The second test stated that a feature is functional when it "put[s] competitors at a significant non-reputation-related disadvantage."<sup>104</sup>

In addition, the court in *Maharishi* applied the Second Circuit interpretation of the functionality doctrine, but added an explanation on how a product's feature is essential to the product's use or purpose.<sup>105</sup> The Second Circuit had held that "[a] design feature of a particular article is 'essential' only if the feature is dictated by the functions to be performed; a feature that merely accommodates a useful function is not enough."<sup>106</sup> However, the Second Circuit provided this explanation before *TrafFix* was decided.<sup>107</sup> Thus, the court in *Maharishi* illustrated the extent of the functionality doctrine's vagueness by adding a further explanation to the doctrine to determine whether a product's feature is functional.<sup>108</sup>

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98. *Id.*

99. *Id.*

100. *See id.* at 542 (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995), quoting *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 850 (1982), which stated that a product's feature is functional "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article," that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage").

101. *Shire U.S., Inc. v. Barr Labs., Inc.*, 329 F.3d 348, 353-54 (3d Cir. 2003).

102. 329 F.3d 348 (3d Cir. 2003).

103. *Shire U.S., Inc.*, 329 F.3d at 353-54.

104. *Id.* at 354 (quoting *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001), quoting *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 165 (1995)).

105. *Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co.*, 292 F. Supp. 2d 535, 548 (S.D.N.Y. 2003).

106. *Stormy Clime Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 975 (2d Cir. 1987).

107. *Id.* at 975-77 (interpreting the functionality doctrine in 1987); *see also TrafFix*, 532 U.S. 31-32 (interpreting the functionality doctrine in 2001).

108. *See Maharishi*, 292 F. Supp. 2d at 543 n. 4 (citing *Eppendorf-Netheler-Hinz GmbH v. Ritter GmbH*, 289 F.3d 351, 355 (5th Cir. 2002) ("[T]he definition of functionality is not as clear as the Supreme Court's statement might indicate.")).

## B. THE FUNCTIONALITY DOCTRINE IS TOO VAGUE

The functionality doctrine has created a broad range of interpretations inconsistent with the intent of the *Traffix* decision.<sup>109</sup> Some district and circuit courts have addressed the uncertainties of the *Traffix* decision, while other courts, such as *Maharishi*, have set their own functionality standard.<sup>110</sup> However, other courts, including the Federal Circuit, have added a prior existing element to determine functionality.<sup>111</sup>

The Federal Circuit, in *Valu Engineering, Inc v. Rexnord Corporation*,<sup>112</sup> used the factors set forth in *In re Morton-Norwich Products, Inc.*<sup>113</sup> to determine functionality.<sup>114</sup> The Morton-Norwich factors include:

- (1) the existence of a utility patent disclosing the [functional] advantages of the design, (2) advertising materials in which the [design's originator publicizes] the design's [functional] advantages, (3) the availability to competitors of functionally equivalent designs, and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product.<sup>115</sup>

The Federal Circuit applied the Morton-Norwich factors because the *Traffix* decision did not alter the *Morton-Norwich* analysis.<sup>116</sup> The *Traffix* decision did not exclude the consideration of alternative designs, but found no need to consider alternative designs when a product's feature is functional.<sup>117</sup> However, this “[did] not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine

109. See *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276 (Fed. Cir. 2002) (applying the Morton-Norwich factors that consider other design alternatives to determine functionality); see also *Maharishi*, 292 F. Supp. at 548 (applying the Second Circuit's functionality standard that a design feature is essential only if the feature is dictated by the functions to be performed); see generally McCormick, *supra* note 7, at 542 (stating that the *Traffix* decision has left unanswered questions to the functionality doctrine).

110. See *Maharishi*, 292 F. Supp. 2d at 542 (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995), quoting *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 850 (1982), which stated that a product's feature is functional “‘if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,’ that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage”).

111. See *Valu Eng'g*, 278 F.3d at 1276 (applying the Morton-Norwich factors that consider other design alternatives to determine functionality); see also *New Colt Holding Corp. v. RJG Holdings of Fla., Inc.*, 312 F. Supp. 2d 195, 214 (D. Conn. 2004) (finding that the existence of design alternatives is helpful when determining whether a particular design is truly necessary or functional in the way a product works).

112. 278 F.3d 1268 (Fed. Cir. 2002).

113. 671 F.2d 1332 (CCPA 1982).

114. *Valu Eng'g*, 278 F.3d at 1274.

115. *Id.* (citing *Morton-Norwich*, 671 F.2d at 1340-41).

116. *Id.* at 1276.

117. *Id.*

whether a feature is functional in the first place.”<sup>118</sup> Although the *Traffix* Court did not include the availability of alternative designs in determining functionality, the Federal Circuit stated that *Traffix* did not change the law of functionality.<sup>119</sup> Thus, the *Traffix* decision left a vague standard, and opened the door for other courts to consider alternative designs when analyzing this doctrine, as evidenced by the inconsistency of the courts in interpreting the functionality doctrine.<sup>120</sup>

## VI. CONSIDERING OTHER DESIGN ALTERNATIVES

### A. WHEN IS IT ESSENTIAL TO COMPARE OTHER DESIGNS?

The existence of design alternatives is helpful in determining whether a particular design is truly necessary in how a product works.<sup>121</sup> The trier of fact will be able to use other design alternatives as a reference point when determining functionality.<sup>122</sup> In *New Colt Holding Corp. v. RJG Holdings of Florida, Inc.*,<sup>123</sup> the district court faced a situation that considered other design alternatives.<sup>124</sup>

In *New Colt Holding*, the plaintiffs manufactured three generations of revolvers called the Peacemaker.<sup>125</sup> The plaintiffs argued that the overall appearance and trade dress remained the same in all three generations.<sup>126</sup> However, the defendant manufactured replica Peacemaker revolvers.<sup>127</sup> One of the defendant’s revolvers was an extremely accurate replica of the plaintiffs’ first generation Peacemaker model.<sup>128</sup>

The plaintiffs also manufactured a revolver called the Rampant Colt, with a logo of a horse rearing up with a spear between its forelegs and another in its mouth on the revolver’s handle.<sup>129</sup> The defendant also placed a horse logo on their revolver’s handle, but the defendant’s horse was

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118. *Id.*

119. *Id.*

120. *See New Colt Holding Corp. v. RJG Holdings of Florida, Inc.*, 312 F. Supp. 2d 195, 214 (D. Conn. 2004) (finding that the existence of design alternatives is helpful when analyzing the functionality doctrine).

121. *Id.*

122. *Sya, supra* note 5, at 990.

123. 312 F. Supp. 2d 195 (D. Conn. 2004).

124. *New Colt Holding*, 312 F. Supp. 2d at 214.

125. *Id.* at 201.

126. *Id.*

127. *Id.*

128. *Id.*

129. *Id.* at 201-02.

galloping instead of rearing up.<sup>130</sup> In addition, the defendant's logo did not contain spears, but rather had a horse inside an oval that appeared in a similar location as on the plaintiffs' revolvers.<sup>131</sup>

The plaintiffs in *New Colt Holding* alleged trade dress infringement on their Peacemaker revolver and infringement of their registered trademark on the Rampant Colt.<sup>132</sup> The defendant argued that the plaintiffs could not be afforded any protection, because the plaintiffs failed to adequately describe their claimed trade dress.<sup>133</sup> The plaintiffs described the unique features of their Peacemaker revolver and the appearance of the entire gun.<sup>134</sup> However, the defendant pointed to changes in the revolver's frame and the appearance of the entire gun.<sup>135</sup>

The court held that although there were functional elements to every aspect of the plaintiffs' revolver, there were also factual disputes as to whether the revolver's individual features were functional.<sup>136</sup> The court reasoned that if there were factual disputes with respect to the individual elements, then there would be a factual dispute whether the features as a whole were functional.<sup>137</sup> Thus, the court declined to grant summary judgment on behalf of the defendant on the question of functionality.<sup>138</sup>

The court in *New Colt Holding* explained that the fundamental question to ask when considering other design alternatives is whether other design arrangements do not impair the purpose or functional aspect of the product.<sup>139</sup> The plaintiffs in *New Colt Holding* argued that "the contours of the frame do or do not serve any specific purpose."<sup>140</sup> Instead, the grip frame was merely "a specific shape of a handle that is separable from the handle itself."<sup>141</sup> However, to determine whether the specific shape was in fact separable, there must be a study on whether other shapes exist that can be just as effective.<sup>142</sup> In other words, there must be evidence

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130. *New Colt Holding*, 312 F. Supp. 2d at 202.

131. *Id.*

132. *Id.* at 200.

133. *Id.* at 203.

134. *Id.* at 205.

135. *Id.*

136. *New Colt Holding*, 312 F. Supp. 2d at 219.

137. *Id.*

138. *Id.*

139. *Id.* at 215 (citing *Stormy Clime Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 977 (2d Cir. 1987)).

140. *Id.*

141. *Id.* at 214.

142. *New Colt Holding*, 312 F. Supp. 2d at 214.



demonstrating how other alternative designs would be as effective as a functional matter.<sup>143</sup>

The plaintiffs argued that the defendant did not use other possible designs when making replicas of their revolvers.<sup>144</sup> However, the defendant “argue[d] that the composition of the frame [and] steel work[ed] more effectively than other metals and that the [available] finishes . . . prevent oxidation.”<sup>145</sup> The defendant also noted other possible designs for the grip frame, but these designs failed to offer better functional advantages for a gun purchaser.<sup>146</sup> The court concluded that there was no reason why the defendant could not copy the plaintiffs’ features based on the functionality doctrine.<sup>147</sup> In addition, considering other design alternatives was not enough to show a certain functionality without establishing that other features, such as other finishes and metals for the revolvers, could work just as well.<sup>148</sup> Thus, the court held that the plaintiffs did not have sufficient evidence to show how the grip frame of their revolvers was non-functional.<sup>149</sup>

The *New Colt Holding* decision could affect gun collectors because although these collectors may have different brands to choose from, the defendant’s revolvers and the plaintiffs’ revolvers may appear identical.<sup>150</sup> This similarity may confuse the average gun purchaser in distinguishing both the original Peacemaker and the Colt Rampant from the defendant’s replicas.<sup>151</sup> If the *Traffix* decision provided a clear functionality doctrine, the *New Colt Holding* court may have reached a different conclusion.<sup>152</sup> However, courts such as *New Colt Holding* have turned to circuit courts for extra guidance in interpreting the functionality doctrine.<sup>153</sup> Thus, courts

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143. *Id.*

144. *Id.* at 215.

145. *Id.* at 214.

146. *Id.* at 214-15.

147. *Id.* at 215.

148. *New Colt Holding*, 312 F. Supp. 2d at 215.

149. *Id.*

150. *See id.* at 201-02 (describing the similarities between the plaintiffs’ and defendant’s revolvers).

151. *Id.*

152. *See Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co.*, 292 F. Supp. 2d 535, 543 (S.D.N.Y. 2003) (citing *Eppendorf-Netheler-Hinz GmbH v. Ritter GmbH*, 289 F.3d 351, 355 (5th Cir 2002) (“[T]he definition of functionality is not as clear as the Supreme Court’s statement might indicate.”)).

153. *See Valu Eng’g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276 (Fed. Cir. 2002) (applying the Morton-Norwich factors that consider other design alternatives to determine functionality); *see also New Colt Holding Corp. v. RJG Holdings of Fla., Inc.*, 312 F. Supp. 2d 195, 214 (D. Conn. 2004) (adopting the federal circuit’s interpretation of the functionality doctrine by considering design alternatives).

should consider design alternatives when analyzing the functionality doctrine because the existence of a design alternative was a pre-existing element that was essential in determining how a product works.<sup>154</sup>

#### B. WHY ARE COURTS ADDING A PRE-EXISTING ELEMENT IN DETERMINING FUNCTIONALITY?

The Federal Circuit recognized the need to consider design alternatives because this was a pre-existing element that did not change the law in functionality.<sup>155</sup> However, trade dress law should not create “back-door patents” for products that cannot meet the requirements of the Patent Act.<sup>156</sup> If trade dress was applied to any generic feature, copyright and patent restrictions would be undermined.<sup>157</sup> Consideration of other design alternatives merely follows a pre-existing element derived from *Morton-Norwich*, and does not undermine the principles of patent law.<sup>158</sup>

“Trade dress is not designed to protect [useful, novel, and non-obvious] ideas” that patents protect during a twenty-year monopoly.<sup>159</sup> Instead, trade dress protection avoids granting a manufacturer a complete monopoly over a certain product or idea.<sup>160</sup> However, the primary significance of having trade dress protection “is to identify the source of the product rather than the product itself.”<sup>161</sup> Thus, companies or inventors should still seek trade dress protection because the Federal Circuit and district courts have lightened the burden of proving non-functionality by considering design alternatives as an element to the functionality doctrine.<sup>162</sup>

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154. See *New Colt Holding*, 312 F. Supp. 2d at 214 (stating that design alternatives can be as effective as a functional matter).

155. See *Valu Eng’g*, 278 F.3d at 1276 (stating that *Traffix* did not alter the *Morton-Norwich* analysis and neither party argued that *Traffix* changed the law of functionality).

156. *Maharishi*, 292 F. Supp. 2d at 542; see generally 35 U.S.C. §§ 101-03, 112 (2000) (explaining that an invention can be patented when it is useful, novel, non-obvious, and meets the specification requirements, respectively).

157. *Maharishi*, 292 F. Supp. 2d at 542.

158. See *In re Morton-Norwich*, 671 F.2d 1332, 1340-41 (CCPA 1982) (finding that “the availability to competitors of functionally equivalent designs” is a factor to determine whether a design is a functional aspect to its product).

159. *New Colt Holding*, 312 F. Supp. 2d at 203; see generally 35 U.S.C. §§ 101-03, 112 (2000) (explaining that an invention can be patented when it is useful, novel, non-obvious, and meets the specification requirements, respectively); see also 35 U.S.C. § 154(a)(2) (stating that a patent lasts for twenty years from the filing date of the patent application).

160. *New Colt Holding*, 312 F. Supp. 2d at 203.

161. *Id.* at 206 (quoting *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 210-11 (2000)).

162. See *Valu Eng’g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276 (Fed. Cir. 2002) (applying the *Morton-Norwich* factors that consider other design alternatives to determine functionality); see also *New Colt Holding*, 312 F. Supp. 2d at 214 (adopting the federal circuit’s interpretation of the functionality doctrine by considering design alternatives because this consideration helps determine how a product’s feature works or functions).

## VII. REJECTING OTHER DESIGN ALTERNATIVES

## A. REASONING TO REJECT OTHER DESIGNS

Once a particular design is found to be functional, then the availability of alternative designs may be irrelevant.<sup>163</sup> A product cannot receive trade dress protection when the feature or product is functional.<sup>164</sup> In *TrafFix*, the Court found it unnecessary to explore other designs.<sup>165</sup> The dual-spring sign was not an ornamental aspect of the product but was the reason the device worked.<sup>166</sup>

In *Maharishi*, the district court stated that a “feature cannot be given trade dress protection merely because there are alternative designs available.”<sup>167</sup> Even though *Maharishi* agreed with the Federal Circuit’s interpretation of *TrafFix*, the district court stated that *TrafFix* dealt with an “easy case of functionality.”<sup>168</sup> The *Maharishi* court also explained that if the *TrafFix* court had provided a clear standard, then the *TrafFix* decision would have resulted in a significant change in trade dress law.<sup>169</sup> However, the defendant in *Maharishi* agreed with *TrafFix*, arguing that other design alternatives are irrelevant under the traditional test of functionality because other designs may serve as the same purpose of the expired patented product.<sup>170</sup>

In *Antioch Co. v. W. Trimming Corp.*,<sup>171</sup> the Sixth Circuit did not consider design alternatives.<sup>172</sup> The Sixth Circuit in *Antioch Co.* interpreted *TrafFix* to mean that a court is not required to review other designs when applying the traditional functionality test.<sup>173</sup> If a product’s feature is clearly functional, then a court need not consider the second test of functionality or alternative designs.<sup>174</sup>

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163. *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001).

164. *Id.*

165. *Id.* at 34.

166. *Id.*

167. *Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co.*, 292 F. Supp. 2d 535, 548 (S.D.N.Y. 2003) (quoting *Valu Eng’g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276 (Fed. Cir. 2002)).

168. *Id.*

169. *Id.* (citing *TrafFix*, 532 U.S. at 29).

170. *Id.* at 547.

171. 347 F.3d 150 (6th Cir. 2003).

172. *See Antioch*, 347 F.3d at 156, 159 (holding that when one functional feature is the reason a product works, then there is no trade dress protection because the entire product can be considered functional).

173. *Id.*

174. *Id.*

## B. CONSEQUENCES

If courts do not consider other design alternatives when determining what constitutes functionality, it would be inconsistent with the law of functionality as stated by the Federal Circuit.<sup>175</sup> A party seeking trade dress protection will have a difficult burden proving a product contains non-functional features without comparing other designs.<sup>176</sup> In *New Colt Holding*, the district court was not able to find factual disputes with respect to functionality of individual features without considering other design alternatives.<sup>177</sup> In addition, consumers may become confused between the original and an imitated product.<sup>178</sup> Thus, the Supreme Court will have to address another trade dress infringement claim with respect to patents in order to reset the functionality doctrine and create consistency among the lower courts' interpretation of *Traffix*.

## VIII. THE NON-FUNCTIONALITY STANDARD

### A. DEFINITION AND APPLICATION

A particular feature is considered non-functional when the feature is "ornamental," "arbitrary," or "incidental" to the overall product.<sup>179</sup> In *E-Z Bowz, L.L.C. v. Professional Product Research Company*,<sup>180</sup> the plaintiffs owned a utility and a design patent on a bow-making machine.<sup>181</sup> Six months after E-Z Bowz was formed, a distributor of E-Z Bowz wrote a letter to the plaintiffs enclosing an advertisement for another bow-making product.<sup>182</sup> "Th[is] [bow-making] device, called 'Create-A-Bow,' consisted of a stand and two upright members."<sup>183</sup> However, Create-A-Bow looked similar to the E-Z Bowz bow maker.<sup>184</sup> The plaintiff contacted the

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175. *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276 (Fed. Cir. 2002).

176. *See New Colt Holding Corp. v. RJG Holdings of Fla., Inc.*, 312 F. Supp. 2d 195, 214 (D. Conn. 2004) (finding that the existence of design alternatives is helpful when determining whether a particular design is truly necessary to the way a product works).

177. *Id.* at 218; *see also E-Z Bowz, L.L.C. v. Prof'l Prod. Research Co.*, No. 00 CIV.8670, 2003 WL 22068573, at \*23-24 (S.D.N.Y. Sept. 5, 2003) (finding that a bow-making device had non-functional features within a utility patent by comparing thirty-six other bow-making machines that used features differently).

178. *New Colt Holding*, 312 F. Supp. 2d at 201-02 (describing the similarities between the plaintiffs' and defendant's revolvers).

179. *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 30 (2001); *see also E-Z Bowz*, 2003 WL 22068573, at \*22 (adopting the non-functionality standard from *Traffix*).

180. No. 00 CIV. 8670, 2003 WL 22068573 (S.D.N.Y. Sept. 5, 2003).

181. *E-Z Bowz*, 2003 WL 22068573, at \*2.

182. *Id.*

183. *Id.*

184. *Id.*

defendant, Professional Product Research Company (PPR), and requested that they stop selling the Create-A-Bow device.<sup>185</sup> However, PPR refused, and E-Z Bowz filed suit claiming patent infringement, trade dress infringement, and common law unfair competition.<sup>186</sup> The district court denied PPR's motion for summary judgment on E-Z Bowz's trade dress claim because E-Z Bowz provided sufficient evidence that its trade dress carried a secondary meaning and its product's features were non-functional.<sup>187</sup>

*E-Z Bowz* interpreted the *TrafFix* decision and argued that its product's trade dress was arbitrary and ornamental as a whole.<sup>188</sup> The court examined E-Z Bowz's utility patent to determine whether any elements in the bow-making device were useful features.<sup>189</sup> The court found that the base and dowels of the device were clearly functional in the utility patent because these elements were described as functional within the patent.<sup>190</sup> However, the court found other portions of the base and dowels were ornamental, as they did not have an actual function or purpose in how the device operated.<sup>191</sup> These ornamental portions were the color, grain, and texture of the wood that were used in E-Z Bowz's product.<sup>192</sup>

The more difficult elements of E-Z Bowz's trade dress claim were the colors, graphics, and markings on the base of the bow maker because these elements were aesthetic and functional.<sup>193</sup> The court found that these features were afforded trade dress protection as a matter of law because the functional aspects did not outweigh the aesthetic features.<sup>194</sup> Further, the court found that the instructions on how to use the bow-making device were functional because the instructions enabled consumers to use the product.<sup>195</sup>

With E-Z Bowz's design patent, the court found that the features within this patent served as evidence of non-functionality.<sup>196</sup> "A design patent cannot be issued if the invention [was] functional."<sup>197</sup> Thus, even though some of the elements of E-Z Bowz's bow maker were functional, the court

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185. *Id.* at \*3.

186. *Id.*

187. *E-Z Bowz*, 2003 WL 22068573, at \*24.

188. *Id.* at \*22.

189. *Id.*

190. *Id.*

191. *Id.* at \*23.

192. *Id.*

193. *E-Z Bowz*, 2003 WL 22068573, at \*23.

194. *Id.*

195. *Id.*

196. *Id.* at \*24.

197. *E-Z Bowz*, 2003 WL 22068573, at \*24 n. 2 (citing *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1460 (Fed. Cir. 1997)).

was concerned about “the dress as a whole,” and found that E-Z Bowz provided enough evidence to sustain trade dress protection.<sup>198</sup>

Regardless of *E-Z Bowz*'s application of the non-functionality doctrine, in *ASICS Corp. v. Target Corp.*,<sup>199</sup> the court found that the non-functionality doctrine in *Traffix* was merely dictum.<sup>200</sup> The assertion made by the plaintiff in *ASICS* was untimely and incomplete.<sup>201</sup> The court stated that it would be inappropriate to allow *Traffix*'s dictum as a means to order an injunction.<sup>202</sup> Thus, the *Traffix* decision provided a vague standard because courts are not only interpreting the functionality doctrine differently, but there is also a question as to whether the non-functional test is the law or merely dictum.<sup>203</sup>

## B. FUNCTIONALITY V. NON-FUNCTIONALITY

Similarly, the United States Supreme Court has offered little guidance in how to apply the functionality doctrine and likewise has not been clear on whether the non-functionality test is dictum or an applicable legal standard.<sup>204</sup> The Court's lack of guidance creates a high burden for a party seeking trade dress protection because the claimant may have to pass two hurdles.<sup>205</sup> First, the claimant may need to prove that a particular feature is ornamental, arbitrary, or incidental to the overall product to show how the feature is non-functional, as in *E-Z Bowz*.<sup>206</sup> Second, the claimant may need to prove that a feature is not “essential to the use or purpose of the article” to further show non-functionality.<sup>207</sup>

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198. *Id.* at \*24.

199. CIV. No. 03-3486, 2003 WL 22005602 (D. Minn. Aug. 22, 2003).

200. *ASICS*, 2003 WL 22005602, at \*1.

201. *Id.*

202. *Id.*

203. *See id.* (indicating that the non-functional doctrine in *Traffix* is dictum); *but see* *Dippin' Dots, Inc. v. Frosty Bites Distribution*, 369 F.3d 1197, 1202-03 (11th Cir. 2004) (applying *Traffix*'s functionality and non-functionality doctrine to a method patent with respect to a trade dress claim).

204. *See ASICS*, 2003 WL 22005602, at \*1 (indicating that the non-functional doctrine in *Traffix* is dictum); *but see Dippin' Dots*, 369 F.3d at 1202-03 (applying *Traffix*'s functionality and non-functionality doctrine to a method patent with respect to a trade dress claim).

205. *See Shire U.S., Inc. v. Barr Labs., Inc.*, 329 F.3d 348, 353-54 (3d Cir. 2003) (stating that *Traffix* set two functionality tests).

206. *E-Z Bowz, L.L.C. v. Prof'l Prod. Research Co.*, No. 00 CIV. 8670, 2003 WL 22068573, at \*22 (S.D.N.Y. Sept. 5, 2003).

207. *See Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001) (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995), quoting *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 850 (1982) (finding that a feature is functional “if it is essential to the use or purpose of the article” or “[when] it affects the cost or quality of the article”).

However, the Supreme Court in *Traffix* found that the sign's feature was "essential to the use or purpose of the article" because the sign's dual-spring mechanism was not an ornamental feature, but rather the reason the sign worked.<sup>208</sup> In other words, the *Traffix* Court used the non-functionality test to conclude that MDI's sign was not afforded trade dress protection.<sup>209</sup> Nevertheless, some courts apply the non-functional test as the standard, while other courts may only use the functionality test with respect to a different kind of patent and not a utility patent.<sup>210</sup> Although the functionality test and the non-functional test seem to co-exist based on the tests themselves, the Supreme Court has not distinguished these two tests.<sup>211</sup> Thus, the mixed interpretation of the *Traffix* decision demonstrates that the Court will have to revisit a trade dress infringement claim with respect to patents to provide a clearer legal standard.

## IX. CONSIDERING DIFFERENT PROPOSALS

### A. ADOPTING THE SECOND CIRCUIT'S FUNCTIONALITY TEST

Some scholars suggest that the Second Circuit's functionality test would be a better approach than the *Traffix* standard.<sup>212</sup> The Second Circuit stated that a product's feature was considered "'essential' only if the feature is dictated by the functions to be performed; a feature that merely accommodates a useful function is not enough."<sup>213</sup> In other words, this test indicates that when the product cannot function or operate without a particular feature, the particular feature is a functional part to the product and the overall product cannot be afforded trade dress protection.<sup>214</sup> The Second Circuit's standard may provide a uniform functionality doctrine because it explains how a feature can be "essential to the use or purpose of

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208. *Id.* at 33.

209. *Id.*

210. *E-Z Bowz*, 2003 WL 22068573, at \*22. See also *Dippin' Dots, Inc. v. Frosty Bites Distribution*, 369 F.3d 1197, 1200-09 (11th Cir. 2004) (applying *Traffix*'s functionality doctrine to a method patent).

211. See *Dippin' Dots*, 369 F.3d at 1203 (quoting *Epic Metals Corp. v. Souliere*, 99 F.3d 1034, 1039 (11th Cir. 1996)) ("The line between functionality and non-functionality is not . . . brightly drawn.").

212. See generally *McCormick*, *supra* note 7, at 573-75 (arguing that the Second Circuit provided a well-reasoned attempt in interpreting the functionality doctrine at a time when there was a circuit split on this issue).

213. *Stormy Clime, Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 975 (2d Cir. 1987) (quoting *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1342 (CCPA 1982)).

214. *Id.*

the article,” which may avoid future circuit splits that *TrafFix* did not resolve.<sup>215</sup>

## B. HARMONIZING PATENT AND TRADEMARK LAW

Other scholars have suggested harmonizing patent and trademark law.<sup>216</sup> They argue that Congress should amend the Lanham Act and the Patent Act to provide a single definition of functionality.<sup>217</sup> However, any definition that Congress decides to enact should be equally applicable to trade dress and design patent protection.<sup>218</sup> Any difference that Congress finds should be harmonized in a way that each definition does not cancel the other out or create one definition more favorable than the other.<sup>219</sup> As technology continues to grow, the courts will be facing more trade dress infringement suits with respect to patents, which would be better resolved by Congress offering a uniform definition of functionality.<sup>220</sup> The courts and the United States Patent and Trademark Office would be able to apply the new definitions that Congress might enact to resolve complex cases dealing with the interrelationship between patents and trade dress protection.<sup>221</sup>

## C. ADOPTING THE FEDERAL CIRCUIT’S INTERPRETATION OF *TRAFFIX*

Another proposal is to adopt the Federal Circuit’s interpretation of *TrafFix*. The Federal Circuit is the only circuit exclusively handling patent prosecution issues and may have a better grasp of the interrelationship between patents and trade dress protection.<sup>222</sup> According to Professor Rochelle Cooper Dreyfuss, judges who do not understand a patent application for software or the Internet usually find the idea patentable.<sup>223</sup>

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215. See generally McCormick, *supra* note 7, at 542 (stating that the *TrafFix* decision has left unanswered questions to the functionality doctrine).

216. Sya, *supra* note 5, at 996-98.

217. *Id.* at 997.

218. *Id.* at 998.

219. *Id.*

220. *Id.*

221. *Id.*

222. See DONALD S. CHISUM, CHISUM ON PATENTS G1-5, (2004) (stating that the Federal Circuit Court of Appeals handles most cases on appeal involving patent issues, including (1) Board of Patent Appeals’ decisions; (2) district courts’ patent infringement suits; (3) United States Claims Court’s decisions; and (4) United States International Trade Commission’s determinations).

223. See generally Rochelle Cooper Dreyfuss, Essay, *Are Business Method Patents Bad for Business?* 16 SANTA CLARA COMPUTER & HIGH TECH. L.J. 263, 267-69 (2000) (explaining that when patents deal with technical issues, it creates a difficult understanding for judges reviewing the patents). Rochelle Cooper Dreyfuss is a Professor and Director at New York University



Other judges who do understand patent applications would find the idea obvious and unpatentable.<sup>224</sup>

When the Federal Circuit interpreted the *TrafFix* decision, it analyzed consideration of design alternatives in determining functionality because the *TrafFix* decision did not change the law of functionality.<sup>225</sup> The *TrafFix* decision attempted to resolve a circuit split prior to 2001, but appeared to be unsuccessful based on the mixed interpretation of this decision in subsequent lower court cases.<sup>226</sup> Therefore, courts such as *New Colt Holding* should follow the Federal Circuit's interpretation of the functionality doctrine, because the Federal Circuit's interpretation is consistent with functionality law, and the Federal Circuit is in a better position to resolve complex issues involving patents and trade dress based on the volume of patent cases heard before it.<sup>227</sup> In addition, inventors or companies will be encouraged to seek trade dress protection after their patent expires because other design alternatives would be an element that courts would consider in these complex cases.<sup>228</sup>

## X. CONCLUSION

Unfortunately, there is no uniform functionality doctrine.<sup>229</sup> The Supreme Court in *TrafFix* has only created more confusion and mixed interpretations in the lower courts.<sup>230</sup> The courts can either adopt the

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School of Law who delivered a speech about business method patents at Santa Clara University School of Law. *Id.* at 263.

224. *Id.* at 268.

225. See *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276 (Fed. Cir. 2002) (applying the Morton-Norwich factors that consider other design alternatives to determine functionality).

226. See generally McCormick, *supra* note 7, at 542 (stating that the *TrafFix* decision has left unanswered questions to the functionality doctrine).

227. See *e.g.*, 35 U.S.C. §141 (2000) (stating that a dissatisfied applicant may appeal a Board of Patent Appeals' decision to the Federal Circuit Court of Appeals).

228. See *New Colt Holding Corp. v. RJG Holdings of Fla., Inc.*, 312 F. Supp. 2d 195, 214 (D. Conn. 2004) (finding that the existence of design alternatives is helpful when determining whether a particular design is truly necessary to the way a product works).

229. See *Valu Eng'g.*, 278 F.3d at 1274-76 (applying the Morton-Norwich factors that consider other design alternatives to determine functionality); *but see* *Maharishi Hardy Blechman Ltd v. Abercrombie & Fitch Co.*, 292 F. Supp. 2d 535, 548 (S.D.N.Y. 2003) (applying the Second Circuit's functionality standard that a design feature is essential only if the feature is dictated by the functions to be performed). See generally McCormick, *supra* note 7, at 542 (stating that the *TrafFix* decision has left unanswered questions to the functionality doctrine).

230. See *ASICS Corp. v. Target Corp.*, No. Civ. 03-3486 RHK/AJB, 2003 WL 22005602, at \*1 (D. Minn. Aug. 22, 2003) (indicating that the non-functional doctrine in *TrafFix* is dictum); *but see* *Dippin' Dots, Inc. v. Frosty Bites Distribution*, 369 F.3d 1197, 1202-03 (11th Cir. 2004) (applying *TrafFix*'s functionality and non-functionality doctrine to a method patent with respect to a trade dress claim).

Second Circuit<sup>231</sup> or the Federal Circuit<sup>232</sup> interpretation of the functionality doctrine. If the Supreme Court does not adopt either one of these standards, then Congress should amend the Lanham Act and the Patent Act to provide a uniform definition of functionality.<sup>233</sup> However, the better solution is to adopt the Federal Circuit's interpretation of the *Traffix* decision because this interpretation is consistent with previous cases on the issue and serves the purpose of seeking trade dress protection without undermining the principles of patent law.<sup>234</sup>

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231. See *Stormy Clime Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 975 (2d Cir. 1987) (citations omitted) (stating that a product's feature was considered "'essential' only if the feature is dictated by the functions to be performed; a feature that merely accommodates a useful function is not enough").

232. See *Valu Eng'g*, 278 F.3d at 1274 (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41 (CCPA 1982)) (applying the Morton-Norwich factors:

- (1) the existence of a utility patent disclosing the [functional] advantages of the design,
- (2) advertising materials in which the [design's originator publicizes] the design's [functional] advantages, (3) the availability to competitors of functionally equivalent designs, and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product [to determine functionality]).

*Id.*

233. *Sya*, *supra* note 5, at 996-98.

234. See *Valu Eng'g*, 278 F.3d at 1276 (stating that *Traffix* did not alter the *Morton-Norwich* analysis and neither party argued that *Traffix* changed the law of functionality).

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