

COGNITIVE AND AESTHETIC FUNCTIONALITY IN TRADEMARK LAW

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INTRODUCTION

Each field of intellectual property has rules that determine what is “in” and what is “out” of its boundaries. Some of these rules dictate what can *never* be protected (abstract ideas in patent law, the originality requirement in copyright law), some of these rules determine what can *no longer* be protected (expired patent claims), and some determine what can *not yet be* protected (a descriptive trade name that has not yet acquired secondary meaning). For trademark law, the functionality and genericity doctrines are perhaps the most important regulators of what is unprotected and, therefore, “out” of the realm of trademarks.

Trademark’s functionality doctrine forbids trademark protection of any aspect of a product that is essential to the use or purpose of the product or when that aspect affects the cost or quality of the product. For example, if “fins” along the thin walls of a plastic product add strength and provide stability to the product, the fins would be considered functional.¹ Broadly speaking, a product feature is “functional” where exclusive use of that feature by a single producer “would put competitors at a significant non-reputation-related disadvantage.”² As befits that broad definition, the doctrine has been applied to both “utilitarian” advantages—such as strengthening fins on a plastic wall—and to product features that are so attractive or pleasing that they are said to be “aesthetically functional.”

As a policy lever, the functionality doctrine can become particularly important when private parties attempt to gain or maintain

¹ See, e.g., *Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH*, 289 F.3d 351, 358 (5th Cir. 2002) (particular arrangement of fins along the side of Eppendorf’s syringe product was functional because “fins of some shape, size or number are necessary to provide support for the flange and to prevent deformation of the product”).

² *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995); see also *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001) (quoting *Qualitex Co.*, 514 U.S. at 165).

market exclusivity through trademark law because they cannot (or can no longer) get such exclusivity through patent or copyright law. Such scenarios are worrisome for the simplest of reasons: copyright and patent are exclusive rights “for limited times,” while—to riff on a protected slogan—trademarks are forever.³

As befits a doctrine patrolling such ideologically charged territory, over the decades the functionality doctrine has been characterized as “in a state of disarray”;⁴ “fractured”;⁵ having “not enjoyed . . . clarity”;⁶ and “a mess.”⁷ And that is just utilitarian functionality. Aesthetic functionality case law is “even more scattered.”⁸ Charitably, the aesthetic functionality doctrine has “a somewhat checkered history”⁹ and lacks a “coherent jurisprudence”;¹⁰ more to the point, the doctrine is widely considered “a most controversial and ill-defined concept”¹¹ and even “an oxymoron.”¹²

³ “A Diamond is Forever” is the original DeBeers slogan that dates from 1947. See *A Diamond Is Forever. . . 50th Anniversary*, PR NEWSWIRE, <http://www.prnewswire.co.uk/cgi/news/release?id=12285> (last visited Mar. 19, 2015). In 1999, *Advertising Age* magazine named “Diamonds are Forever” the best advertising slogan of the twentieth century. *Ad Age Advertising Century: Top 10 Slogans*, ADVER. AGE (Mar. 29, 1999), <http://adage.com/article/special-report-the-advertising-century/ad-age-advertising-century-top-10-slogans/140156>. After many decades of use, it is now the subject of USPTO registration number 3376133, registered on January 29, 2008. See A DIAMOND IS FOREVER, Registration No. 3376133. The plural version, “Diamonds are Forever,” became the title of the seventh James Bond film (1971) and a hit theme song for the film sung by Shirley Bassey. DIAMONDS ARE FOREVER (Eon Productions 1971); Shirley Bassey, *Diamonds Are Forever (Main Title)*, on DIAMONDS ARE FOREVER (EMI Records 1971). Bassey’s classic became the subject of a remix project issued in 2001 including Groove Armada, the Propellerheads, and Kurtis Mantronik. SHIRLEY BASSEY, THE REMIX ALBUM . . . DIAMONDS ARE FOREVER (Netzwerk Records 2001). Perhaps some slogans really are forever.

⁴ Robert G. Bone, *Trademark Functionality Reexamined*, 7 J. LEGAL ANALYSIS (forthcoming 2015) (manuscript at 2) (on file with author) (“[T]he law of functionality today is in a state of disarray.”).

⁵ Mark P. McKenna, *(Dys)functionality*, 48 HOUS. L. REV. 823, 858 (2011).

⁶ *Eppendorf-Netheler-Hinz GmbH*, 289 F.3d at 355.

⁷ Mark Alan Thurmon, *The Rise and Fall of Trademark Law’s Functionality Doctrine*, 56 FLA. L. REV. 243, 244 (2004) (stating that functionality law is “a mess”); see also Amy B. Cohen, *Following the Direction of TrafFix: Trade Dress Law and Functionality Revisited*, 50 IDEA 593, 597–98 (2010) (“[M]any scholars have struggled to make sense of the *TrafFix* decision, and many courts have struggled to apply it. . . . In [the previous] five years, the case law has continued to be confused and inconsistent.”); Harold R. Weinberg, *An Alternate Functionality Reality*, 17 J. INTEL. PROP. L. 321, 323–24 (2010) (“[T]here is broad critical consensus that *TrafFix* made the functionality doctrine inconsistent, confusing, and opaque.”).

⁸ McKenna, *supra* note 5, at 824.

⁹ *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1064 (9th Cir. 2006).

¹⁰ *Id.* at 1068.

¹¹ A. Samuel Oddi, *The Functions of ‘Functionality’ in Trademark Law*, 22 HOUS. L. REV. 925, 951–62 (1985) (surveying the history of aesthetic functionality and concluding that “[f]rom the outset, ‘aesthetic functionality’ has proved to be a most controversial and ill-defined concept”).

¹² 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:81, at 7-298 (4th ed. 2014) [hereinafter MCCARTHY ON TRADEMARKS] (“‘Aesthetic functionality’ is an oxymoron. Ornamental aesthetic designs are the antithesis of utilitarian designs.” (footnote omitted)).

The basic message of this Article is that aesthetic functionality is a viable doctrine of trademark law, but it has suffered from both a poorly chosen moniker and from being an unrecognized battleground in the shift to trademarks as valuable intangibles in and of themselves. This Article proposes that the “classic” aesthetic functionality cases are actually about cognitive or psychological responses in consumers, not aesthetics *per se*. Based on that observation, I propose that aesthetic functionality should only be found by courts when the product feature at issue triggers a positive cognitive, psychological, or aesthetic response among a substantial composite of the relevant consumers *and* that response predates the trademark owner’s activities. This understanding of the doctrine makes aesthetic functionality a truer analog of utilitarian functionality and/or allows one to see aesthetic functionality cases more clearly as a subset of a broad functionality doctrine. (I see no purpose arguing whether functionality doctrine is a unitary whole or a beautiful diptych—as long as the cases are sensibly decided.)

Part I of this Article gives a brief introduction to the functionality doctrine, focusing on views about utilitarian functionality’s role in separating trademark and patent law. After placing aesthetic functionality within the broader functionality doctrine framework, Part I explores what the Supreme Court has told us about aesthetic functionality.

Part II begins with the notion that aesthetic functionality differs from utilitarian functionality in what Robert Bone calls “the heterogeneity of aesthetic preferences.” In fact, aesthetic functionality cases cover a wide range from situations in which aesthetic preferences may be somewhat heterogeneous to situations in which consumer preferences are quite consistent. And it is the latter cases where aesthetic functionality is a winning argument. This is because cases that have been understood as “aesthetic” functionality are better understood as functionality arising from *cognitive* or *psychological* responses of consumers. Indeed, many of the classic cases involve cognitive or psychological aspects of consumers that are either biologically based or very widely held because of acculturation, i.e., cases where there is *not* significant heterogeneity in consumer preferences.

Part III then explores how the aesthetic functionality doctrine has been a quiet battleground over what I will call the “valorization” of trademarks, i.e., the shift from trademarks from indicators of source to objects of value in and of themselves. Courts and commentators have been keenly aware of this shift—and how it has put considerable stress on the traditional framework of trademark law. But it has not been widely recognized how the valorization of trademarks has been a source of instability for aesthetic functionality. A set of aesthetic functionality

cases about social insignia and copyrighted characters sheds light on this doctrinal struggle.

These descriptive discussions provide the foundation for a more normative discussion in Parts IV and V. Part IV takes up the issue of aesthetic functionality's role vis-à-vis the interaction of trademark law with copyright and with design patent law. On this topic, I propose that there are important reasons why aesthetic functionality *should not* patrol the trademark/copyright frontier with the same rigor that utilitarian functionality patrols the trademark/utility patent frontier. It is a closer question whether (expired) design patents should be evidence of aesthetic functionality parallel to the *TrafFix* analysis for utility patents; Part IV makes the case both ways—and offers an alternative in which product features that were subject to a design patent have a fixed period before secondary meaning can be established, i.e., an “open season” in which they can be copied by competitors.

Part V then proposes that aesthetic functionality, properly construed, should arise only when a design or feature triggers a positive response from a substantial number of consumers based on widely shared cognitive, psychological, or aesthetic propensities of the consumer that existed *before* the design or trade dress was first created or used by the party claiming trademark rights. This account of aesthetic functionality will be disappointing to those so concerned about the expansion of intellectual property rights that they would use any and all doctrinal tools to push back against it. Still, as envisioned in Part V, aesthetic functionality would bar trademark rights in a wide range of product elements where exclusive rights would create significant nonreputational advantages—exactly what the Supreme Court has instructed.

I. FUNCTIONALITY DOCTRINE AND THE RISE OF “AESTHETIC FUNCTIONALITY”

Introducing the reader to trademark's functionality doctrine, one is reminded of the district court comment in 1982 that “[e]ven a summary of the law defining the various components of this concept would be voluminous.”¹³ Here I will try to offer only the briefest synopsis of utilitarian functionality, focusing on how utilitarian functionality is thought to police the frontier between patent and trademark laws. We will then turn to a more expansive account of aesthetic functionality as developed by lower courts and as recognized by the Supreme Court.

¹³ *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85, 95 (S.D. Iowa 1982).

A. Utilitarian Functionality

The utilitarian functionality doctrine has been ably explored both in treatises and scholarly commentary, so much so that I will only briefly review the doctrine and case law here.

Examples of utilitarian functionality seem to make the doctrine readily understandable. For example, the blue dot on Sylvania flash bulbs for cameras was found functional because a change in the dot's color was used to detect defective bulbs in the manufacturing process as well as bulbs which had developed air leakage after purchase.¹⁴ Similarly, the design of an aluminum fitting to join lengths of tubing together was denied trademark registration because the shape is precisely what made the tubes fit tightly together.¹⁵

If juridical tools have banner years, 1938 and 1982 were two for utilitarian functionality. In 1938, the Supreme Court had its first brush with the doctrine in *Kellogg Co. v. National Biscuit Co. (Nabisco)*, finding that the shape of Nabisco's shredded wheat biscuit was functional because "the cost of the biscuit would be increased and its high quality lessened if some other form were substituted for the pillow-shape."¹⁶ 1938 was also the year that the *Restatement of Torts*, in a view consonant with *Kellogg*, described the design of goods as "functional" if that design "affects their purpose, action or performance, or the facility or economy of processing, handling or using them."¹⁷

It is fair to say that the utilitarian functionality doctrine percolated in the courts for the ensuing decades until 1982, when the Court of Customs and Patent Appeals announced its *In re Morton-Norwich Products, Inc.* decision.¹⁸ Nowadays, *Morton-Norwich* is remembered for laying out its highly influential list of four factors to be considered in a utilitarian functionality analysis.¹⁹ But the decision also included a breezy review of functionality case law up to that point, presenting a doctrine that courts had described both as a matter of determining (1) what was "essential" to a product and (2) what must remain

¹⁴ *Sylvania Elec. Prods. v. Dura Elec. Lamp Co.*, 247 F.2d 730, 732 (3d Cir. 1957).

¹⁵ *In re Hollaender Mfg. Co.*, 511 F.2d 1186, 1189 (C.C.P.A. 1975).

¹⁶ 305 U.S. 111, 122 (1938).

¹⁷ RESTATEMENT (FIRST) OF TORTS § 742 (1938).

¹⁸ 671 F.2d 1332 (C.C.P.A. 1982).

¹⁹ The factors were whether (1) there is "an expired utility patent which disclose[s] the utilitarian advantage of the design"; (2) "the originator of the design touts its utilitarian advantages through advertising"; (3) "there are other alternatives available"; and (4) "a particular design results from a comparatively simple or cheap method of manufacturing the article." *Id.* at 1340-41.

unprotected to avoid the “hinderance of competition”—or, in a lovely melding of the two, what was “essential to effective competition.”²⁰

A few months later—in June 1982—the Supreme Court handed down *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*,²¹ a case where the trial court had found the coloring of pills to be functional. While the Court’s decision focused on the circuit court overstepping appropriate appellate review, the *Inwood Laboratories* opinion included a footnote telling us that “[i]n general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.”²² In *Qualitex Co. v. Jacobson Products Co.*,²³—a 1995 case where the issue was aesthetic functionality, discussed below—the Court reiterated the 1982 *Inwood* formulation with additional language that has become central to all functionality analysis:

“[I]n general terms, a product feature is functional,” and cannot serve as a trademark, “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,” that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.²⁴

Despite these brushes with the doctrine, the Supreme Court did not seriously take on utilitarian functionality until its 2001 decision in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*²⁵ In principle, the Court took the case to resolve a circuit split on the question “whether the existence of an expired utility patent forecloses the possibility of the patentee’s claiming trade dress protection in the product’s design.”²⁶ On this precise point, the Court held that a “utility patent is strong evidence that the features therein claimed are functional,” establishing a robust, but still rebuttable presumption that such a feature is functional.²⁷ From

²⁰ *Id.* at 1339–40 (quoting *Ives Labs., Inc. v. Darby Drug Co.*, 601 F.2d 631, 643 (2d Cir. 1979)) (internal quotation marks omitted).

²¹ 456 U.S. 844 (1982).

²² *Id.* at 850 n.10.

²³ 514 U.S. 159 (1995).

²⁴ *Id.* at 165 (quoting *Inwood Labs., Inc.*, 456 U.S. at 850 n.10).

²⁵ 532 U.S. 23 (2001).

²⁶ *Id.* at 28. The Fifth, Seventh, and Federal Circuits had held that an expired utility patent need not foreclose trademark protection, while the Tenth Circuit held that such an expired patent precludes trade dress protection. *Id.*

²⁷ *Id.* at 29. The Court went on to say:

If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one 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.

Id. at 29–30.

there, the Court moved onto a broader discussion of the functionality doctrine to address the Sixth Circuit's "misinterpretation of trade dress principles in other respects."²⁸

Citing its *Inwood/Qualitex* test that the issue is whether the "feature is one the 'exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage,'" the Court faulted the Sixth Circuit for having interpreted this test as "whether the particular product configuration is a competitive necessity."²⁹ Instead, the Court reiterated what it called the "traditional rule"—drawn from its 1982 *Inwood* footnote—that a "feature is also functional when it is essential to the use or purpose of the device or when it affects the cost or quality of the device."³⁰

Practically, the *TrafFix* Court's approach can cut off the need for evidence (or speculation) as to alternative designs³¹ once a feature is established as "the reason the device works[,] [o]ther designs need not be attempted." Theoretically, the Court's approach means that there could be some zone of product features that should be considered "functional" even if those features are not "necessary" for competition. Commentators have explored the potential interplay of *Kellogg*, *Inwood*, and *TrafFix* sufficiently that we need not spin out all the possibilities here.³²

B. *Different Ways to Police the Patent/Trademark Frontier*

Not surprisingly, there are different perspectives on what the Court was trying to do vis-à-vis utility patents and trademark law in *TrafFix*. On one view, the Court was simply speaking to the strong evidence that a utility patent provides in relation to the "traditional" *Inwood* test. A different interpretation is that the Court was not so concerned with the "traditional test" as to establish a clear framework for the relationship between patent and trademark law.³³

Judge Easterbrook gave us a bit of both possibilities in the 2010 *Jay Franco & Sons, Inc. v. Franek* dispute; on the one hand, perhaps the Court meant only that "utility patents serve as excellent cheat sheets

²⁸ *Id.* at 32.

²⁹ *Id.*

³⁰ *Id.* at 33.

³¹ *Id.* at 33–34 ("Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used.").

³² In addition to other sources cited here, see, e.g., Margreth Barrett, *Consolidating the Diffuse Paths to Trade Dress Functionality: Encountering TrafFix on the Way to Sears*, 61 WASH. & LEE L. REV. 79 (2004).

³³ See, e.g., Herbert Hovenkamp, *Innovation and the Domain of Competition Policy*, 60 ALA. L. REV. 103, 128 n.113 (2008) (describing the Court's *TrafFix* holding as "rejecting an attempt to lengthen the term of a patent by turning it into a trade dress claim").

because any design claimed in a patent is supposed to be useful.”³⁴ There is one simple reason to take this very narrow, evidentiary-guidepost view of *TrafFix*: the fact that a feature was recited in an *expired* patent does not mean that that feature is *still* functional. As Easterbrook noted, “technological change can render designs that were functional years ago no longer so.”³⁵ There are scores of features recited in nineteenth-century or early twentieth-century patents that simply are not efficient or even useful by the standards of counterpart products today; to say that these features cannot be protected as source indicators because they were recited in a 1910 or 1920 patent sounds a bit rigid.³⁶

On the other hand, Easterbrook also recognized that *TrafFix* can be understood to say that “the functionality doctrine polices the division of responsibilities between patent and trademark law by invalidating marks on useful designs.”³⁷ Mark McKenna calls this a “channeling doctrine,” i.e., to channel protection of certain kinds of innovation toward the patent system. McKenna writes:

On this view, functionality is a structural issue: features that are within the subject matter of patent law are, for that reason alone, illegitimate subjects of trademark law. These features fall outside of trademark law’s reach not because of the consequences of trademark protection for particular competitors, but to preserve the broader structure of the intellectual property system.³⁸

On this reading, *TrafFix* stands for the proposition that “patent law’s limits embed policy choices about competition values at a structural level” and that trademark law should honor those policy decisions “by refusing trademark protection to useful product features.”³⁹

³⁴ 615 F.3d 855, 857–58 (7th Cir. 2010).

³⁵ *Id.* at 859; *see also* *Eco Mfg. LLC v. Honeywell Int’l Inc.*, 357 F.3d 649, 653 (7th Cir. 2003) (“Thus what was once functional may half a century later be ornamental. Passage of time diminishes a utility patent’s significance.”).

³⁶ *See, e.g.,* *Adidas-Salomon AG v. Target Corp.*, 228 F. Supp. 2d 1192, 1194–95 (D. Or. 2002) (although evidence showed “that the flat sole of the Original Superstar was considered optimal for a performance basketball shoe in 1969,” the court accepted that the sole design was “considered optimal no longer”); *see also, e.g.,* *Adidas-Am., Inc. v. Payless Shoesource, Inc.*, 546 F. Supp. 2d 1029, 1084–85 (D. Or. 2008) (same analysis vis-à-vis shoe sole); *In re Zippo Mfg. Co.*, 50 U.S.P.Q.2d (BNA) 1852, 1855 (T.T.A.B. 1999) (reversing denial of registration for a lighter, and noting changed circumstances since a previous denial of registration on the basis of functionality); *In re Honeywell Inc.*, 8 U.S.P.Q.2d (BNA) 1600, 1604–05 (T.T.A.B. 1988); MCCARTHY ON TRADEMARKS, *supra* note 12, § 7:63, at 7-197 to 7-198.

³⁷ *Jay Franco & Sons, Inc.*, 615 F.3d at 857; *see also* *Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, 640 (6th Cir. 2002) (“Protection of functional product features is the province of patent law, which confers a monopoly over new product designs for a limited time only, after which competitors are free to copy at will.”).

³⁸ McKenna, *supra* note 5, at 834.

³⁹ *Id.* at 836; *see also* Mark A. Lemley & Mark P. McKenna, *Is Pepsi Really a Substitute for Coke? Market Definition in Antitrust and IP*, 100 GEO. L.J. 2055, 2061 (2012) (recognizing that

This seems a reasonable interpretation, but we would still have to decide what we want to mean when we say that trademark protection will not extend to product features “within the subject matter of patent law” or to “useful product features.” Useful product features could include (1) product features once covered by a (now expired) utility patent; (2) product features that could have been protected by a utility patent but no application was ever made; or (3) product features that, while useful, could not have been utility patented. A doctrine that considers (2) but not (3) to be functional will have judges occasionally having to determine whether something *would have been patented* during some prior period. On the other hand, the strongest doctrine—one that forecloses trademark protection for (1), (2), and (3)—could have a constitutional justification, i.e., that anything technologically “useful” counts as a “Discovery” for constitutional purposes, regardless of whether that innovation crosses the statutory thresholds set by the current patent law. Whichever of these options you prefer, *TrafFix* addresses only (1)—the relationship between patent and trademark law when product features were once covered by a utility patent.

A different interpretation of *TrafFix* is that it is not concerned with product features “within the subject matter of patent law” so much as with features *which have been claimed as protected under patent law*. For example, in its 1938 *Kellogg Co. v. Nabisco* decision, the Court explained that when a patent expires, “the product, the process and the machinery employed in making it, has been dedicated to the public”⁴⁰ and that, “upon expiration of the patents the form, as well as the name, was dedicated to the public”⁴¹—language that suggests *cause and effect* from the patent grant. In other words, the issue is not what things *should* be in the realm of patent law, but what things *have been* subject to exclusive patent rights and, therefore, should now be free to all.

There are actually two variations of this interpretation of *TrafFix*. In the first, the concern is about the patent “bargain” vis-à-vis individual actors: if you claimed and obtained utility patent rights for feature X,

TrafFix “downplay[ed]” preservation of competition in favor of channeling protection of useful product features to the patent system).

⁴⁰ 305 U.S. 111, 117 (1938). Although the phrase “right to copy” is not used, this is not to deny that the opinion is rich with the discussion of the public’s “right” to use the process, make the pillow shape, etc.

⁴¹ *Id.* at 119–20. In discussing the design patent, the Court also noted:

The design patent would have expired by limitations in 1909. In 1908 it was declared invalid by a district judge on the ground that the design had been in public use for more than two years prior to the application for the patent and theretofore had already been dedicated to the public.

Id. at 119 n.4. To me, this suggests, again, an action: introduction of the feature into commerce without seeking protection “dedicates” the feature to the public.

you told us it was technically valuable and after the patent expires, the technically valuable feature *X* is no longer yours.

An example of this is the Tenth Circuit's analysis in its 1995 *Vornado Air Circulation System, Inc. v. Duracraft Corp.* decision.⁴² Vornado sought trademark protection for its spiral—or arcuate—fan grill after a patent expired that had included the fan grill design. Vornado had “included the arcuate grill vane structure as an element of its patent claims and described the configuration as providing ‘an optimum air flow.’”⁴³ Vornado's own research subsequently established that “other grill structures worked as well as or better than the spiral grill” but instead of disclaiming that element of the existing patent, “Vornado sought and received a reissue patent that expanded its claims with respect to the grill.”⁴⁴ It is clear that the Tenth Circuit panel was motivated by a sense that Vornado, having elected patent protection for the spiral grill as a “significant inventive aspect of the invention” could no longer argue that that product feature was nonfunctional—even if it was actually a suboptimal design.⁴⁵

But the Tenth Circuit panel in *Vornado* also gives a different rationale, completely separate from the patentee's conduct, as to why once patented features should not fall under trademark protection: that people should not have to “do a competitive market analysis before adopting useful features from others' inventions once their patents expired.”⁴⁶ In other words, the patent records should provide one-stop research as to “the inventor's supply of ideas itself and freedom to experiment with them.”⁴⁷ The issue is not this *particular patentee's* actions, but that the patent system had been used by *someone*—meaning that there had been a government determination that the feature was at least “useful” and there is a public record that the feature is now freely available to all.⁴⁸ According to the *Vornado* panel:

⁴² 58 F.3d 1498 (10th Cir. 1995).

⁴³ *Id.* at 1510.

⁴⁴ *Id.* The court recited this story earlier in the opinion as well. *See id.* at 1500.

⁴⁵ *Id.* at 1510. This reading of the decision's reliance on the plaintiff's actions is bolstered by the court's discussion of the plaintiff's advertising. *Id.* at 1500 (“In its advertising, the company touted the grill as a ‘true achievement in aerodynamic efficiency,’ ‘the result of determinant ergonomic design,’ with ‘[u]nique AirTensity™ vortex action,’ accomplishing ‘a high degree of safety and functionality.’” (alteration in original)). After mentioning this “extensive advertising campaign” and “this patent history” on the “inventive significance” of the spiral grill, the panel wrote that it would “simply take Vornado at its word.” *Id.* at 1510.

⁴⁶ *Id.* at 1508.

⁴⁷ *Id.*

⁴⁸ In fact, the *Vornado* court's precise ruling is about *any* utility patent, not that the trademark claimant *had the utility patent*:

We hold that where a disputed product configuration is part of a claim in a utility patent, and the configuration is a described, significant inventive aspect of the invention, so that without it the invention could not fairly be said to be the same

*And if one of the ways to configure the product itself has been deemed important enough to the advance of technology for the government to grant a utility patent, we must find its value as a product feature to exceed its value as a brand identifier in all but the most unusual cases.*⁴⁹

Judge Easterbrook took a similar approach in his *Jay Franco* analysis,⁵⁰ in which the feature the plaintiff claimed as a trademark—a round shape for a sunbathing towel—had been recited in the patent claim of a third party, *and* the patent application had been filed two years after the plaintiff had begun marketing the feature. For Easterbrook, it did not matter that the patent was filed by someone else after the plaintiff had introduced his product, thus raising validity issues, or that the plaintiff's product would not technically infringe the patent. By itself, the patent claim's "coverage of a circular beach towel for sunbathing is enough to signal that a round-towel design is useful for sunbathers."⁵¹

Thus, while everyone agrees that utilitarian functionality helps keep patent and trademark apart, it remains up for grabs exactly how, when, and why functionality does this.

C. *Aesthetic Value, Functionality in Ornamentation, Aesthetic Functionality*

Written at a time when product features were protected only by unfair competition claims, the 1938 *Restatement of Torts* addressed trade dress protection with principles that allowed the copying of functional product features, stating that a product feature "is functional . . . if it affects [the products'] 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."⁵² Sections 741 and 742 of the *Restatement* were written in terms of what we today call utilitarian functionality, but the accompanying Comment included a very explicit discussion of functionality stemming from "aesthetic value":

When goods are bought largely for their aesthetic value, their features may be functional because they definitely contribute to that

invention, patent law prevents its protection as trade dress, even if the configuration is nonfunctional.

Id. at 1510 (citation omitted).

⁴⁹ *Id.* (emphasis added).

⁵⁰ 615 F.3d 855 (7th Cir. 2010).

⁵¹ *Id.* at 858.

⁵² RESTATEMENT (FIRST) OF TORTS § 742 (1938).

value and thus aid the performance of an object for which the goods are intended. . . . The determination of whether or not such features are functional depends upon the question of fact whether the prohibition of imitation by others will deprive the others of something which will substantially hinder them in competition.⁵³

This provided the germ for the aesthetic functionality doctrine which emerged, perhaps as early as a 1941 Eight Circuit case,⁵⁴ but certainly no later than a 1952 Ninth Circuit decision, *Pagliari v. Wallace China Co.*⁵⁵

At issue in *Pagliari* were patterns for dinnerware china that the Wallace China Company had marketed for many years under the names “‘Tweed,’ ‘Hibiscus,’ ‘Shadowleaf,’ and ‘Magnolia.’”⁵⁶ Defendants Pagliero Brothers were accused of both copying the patterns and using the Wallace pattern names.⁵⁷ The court found that “from the standpoint of the purchaser china satisfies a demand for the aesthetic as well as for the utilitarian, and the design on china is, at least in part, the response to such demand.”⁵⁸ In that context, the court concluded that the “attractiveness and eye-appeal of the design sells the [Wallace] china.”⁵⁹

The court denied relief to Wallace on the grounds that “[i]f the particular feature is an important ingredient in the commercial success of the product,” then that feature would be functional and “there is normally no right to relief.”⁶⁰ The appellate court also offered a description of a nonfunctional—hence protectable—feature as being one that “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.”⁶¹ In other words, the *Pagliari* standard was that a product feature is aesthetically functional “[i]f the particular feature is an important ingredient in the commercial success of the product,” or, even more broadly, if the product feature was “related to basic consumer demand in connection with the product.”⁶²

A broad *Pagliari*-like approach was applied by some courts in the 1970s and 1980s, but courts quickly realized that if aesthetic functionality boiled down to the low threshold question of whether a product feature was an “important ingredient” of that product, the only

⁵³ *Id.* § 742, cmt. a.

⁵⁴ *J. C. Penney Co. v. H. D. Lee Mercantile Co.*, 120 F.2d 949 (8th Cir. 1941).

⁵⁵ 198 F.2d 339 (9th Cir. 1952).

⁵⁶ *Id.* at 340.

⁵⁷ *Id.* at 340–41.

⁵⁸ *Id.* at 343.

⁵⁹ *Id.* at 343–44.

⁶⁰ *Id.* at 343.

⁶¹ *Id.*

⁶² *Id.*

trademarks that would be safe from a finding of aesthetic functionality would be those that *the consumer would want to remove as soon as she bought the product*, i.e., trademarks that are unattractive, off-putting, or dissonant.⁶³

Over the decades, this led to different attempts to narrow the test for aesthetic functionality, with increasing focus on some “analysis of whether the ‘use of [a design] feature is necessary for effective competition’”;⁶⁴ whether protection of a product feature “*significantly* undermines competitors’ ability to compete in the relevant market”;⁶⁵ and whether “alternative appealing designs or presentations of the product can be developed.”⁶⁶ This soberer approach recognized that “the policy predicate for the entire functionality doctrine stems from the public interest in enhancing competition.”⁶⁷ By the late 1980s, revision of the *Restatement of Unfair Competition* took the same approach. The *Third Restatement* observes that a “design is functional because of its aesthetic value only if it confers a significant benefit that cannot practically be duplicated by the use of alternative designs.”⁶⁸

A good pre-*Qualitex* example of the jurisprudence narrowing aesthetic functionality is the Seventh Circuit’s 1985 *W.T. Rogers Co. v. Keene* decision⁶⁹ in which Judge Posner considered an aesthetic functionality claim in relation to a hexagonal design for the ends of molded plastic stackable trays (of the kind that would be used on office desks). Based on the general standard that a design feature can be trademarked as long as “effective competition is possible without copying that feature,” the Seventh Circuit panel concluded that Roger’s particular hexagonal shape could be protected because “an infinity of geometrical patterns would remain open to competitors.”⁷⁰

⁶³ As J. Thomas McCarthy writes, “if the theory of ‘aesthetic functionality’ were the law, then the uglier and more repulsive the symbol, the less ‘functional’ it would be.” MCCARTHY ON TRADEMARKS, *supra* note 12, § 7:80, at 7-283. Of course, aesthetic functionality *is* the law, just not this unworkable version.

⁶⁴ *Villeroy & Boch Keramische Werke K.G. v. THC Sys., Inc.*, 999 F.2d 619, 621 (2d Cir. 1993) (alteration in original) (quoting *Wallace Int’l Silversmiths, Inc. v. Godinger Silver Art Co., Inc.*, 916 F.2d 76, 80 (2d Cir. 1990)).

⁶⁵ *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 222 (2d Cir. 2012).

⁶⁶ *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 519 (10th Cir. 1987).

⁶⁷ *Keene Corp. v. Paraflex Indus., Inc.*, 653 F.2d 822, 827 (3d Cir. 1981). The Third Circuit panel in *Keene* said this in the context of searching for a narrower test than *Pagliero*. See *id.* at 825–27.

⁶⁸ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17, cmt. c (1995).

⁶⁹ 778 F.2d 334 (7th Cir. 1985).

⁷⁰ *Id.* at 343. The court went on to note:

Keene could have chosen for his end panel an oval, a pentagon, a trapezoid, a parallelogram, an octagon, a rectangle covered with arabesques, or machicolated, or saw-toothed. . . . Rogers has chosen a particular hexagon as the shape for its end panels, and a hexagon moreover with a hole in it. The ensemble may well be distinct from a

Judicial opinions narrowing the scope of aesthetic functionality frequently mention creativity incentives/disincentives, i.e., the sorts of comments one would expect to find in a copyright case. For example, in 1981, the Third Circuit opined that trademark should not discourage the “use of a spark of originality which could transform an ordinary product into one of grace”;⁷¹ in 1982, Judge Nies on the Court of Customs and Patent Appeals noted that “[n]o principle of trademark law requires the imposition of penalties for originality, creativeness, attractiveness, or uniqueness of one’s product”;⁷² in 1987, the Tenth Circuit joined other courts in rejecting the “important ingredient” test “because it would be a disincentive to creative design”;⁷³ in 1991, a Second Circuit panel joined the chorus noting “[b]y allowing the copying of an exact design without any evidence of market foreclosure, the *Pagliari* test discourages both originators and later competitors from developing pleasing designs.”⁷⁴ While it is sensible to say that trademark law should not be a disincentive to creative or pleasing designs, obviously we must be cautious not to cast trademark law too much in copyright’s constitutional role of encouraging creativity.

D. *Aesthetic Functionality at the Supreme Court*

Often lawyers and law students first encounter aesthetic functionality in the Supreme Court’s 1995 *Qualitex Co. v. Jacobson Products Co.* decision.⁷⁵ In addition to the proposition that a single color can serve as a trademark, *Qualitex* is taught both for its elegant discussion of how a trademark is defined by what it does and for the Court’s presentation of the functionality doctrine, including the Court’s only extended discussion of aesthetic functionality.

Justice Breyer begins the *Qualitex* discussion of functionality by saying that the doctrine prevents any one producer from controlling “a useful product feature.” Here, “useful” almost certainly means in a utilitarian, mechanical sense: Justice Breyer immediately contrasts trademark law with patent law, giving a technological example (a patented light bulb) of a useful feature that cannot be protected with trademark law. The Court then riffs on its prior decision in *Inwood*

number of other hexagonally shaped end panels, and if so the options of competing manufacturers may be as a practical matter unlimited.

Id.

⁷¹ *Keene Corp.*, 653 F.2d at 825.

⁷² *In re DC Comics, Inc.*, 689 F.2d 1042, 1053 (C.C.P.A. 1982) (Nies, J., concurring).

⁷³ *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 518 (10th Cir. 1987).

⁷⁴ *Wallace Int’l Silversmiths, Inc. v. Godinger Silver Art Co., Inc.*, 916 F.2d 76, 80 (2d Cir. 1990).

⁷⁵ 514 U.S. 159 (1995).

Laboratories, i.e., that functionality occurs when there is a cost, quality, or essential characteristic that, if made exclusive, would give the trademark holder a significant nonreputational advantage.

Up until this point, the discussion could be understood as limited to utilitarian functionality, but *Qualitex* was about trademark rights in a single color, and the Court notes that “sometimes color plays an important role . . . in making a product more desirable.”⁷⁶ When the Court resumes its discussion of the functionality doctrine a few paragraphs later, it makes no attempt to separate utilitarian functionality from aesthetic functionality. Instead, the Court discusses four cases in which the color of a product was held to be functional,⁷⁷ and refers approvingly to the discussion in the *Restatement (Third) of Unfair Competition* that a design is “functional” when its “aesthetic value” confers “a significant benefit that cannot practically be duplicated by the use of alternative designs.”⁷⁸ The Court then gives us this poetic passage:

The upshot is that, where a color serves a significant nontrademark function—whether to distinguish a heart pill from a digestive medicine or to satisfy the “noble instinct for giving the right touch of beauty to common and necessary things,” courts will examine whether its use as a mark would permit one competitor (or a group) to interfere with legitimate (nontrademark-related) competition through actual or potential exclusive use of an important product ingredient.⁷⁹

In short, the unanimous *Qualitex* opinion is quite express in its view that trademark rights in the “right touch of beauty” in a product’s trade dress might “interfere with legitimate (nontrademark-related) competition”⁸⁰ and when that happens, the proper inquiry for courts is “whether the recognition of trademark rights would significantly hinder competition.”⁸¹ At the same time, the Court thought that its doctrinal position would “not discourage firms from creating esthetically pleasing mark designs, for it is open to their competitors to do the same.”⁸²

Qualitex stands as the Court’s only meaningful exposition on aesthetic functionality, although there was a sideways glance toward aesthetics in its broader discussion of functionality in the 2001 *Traffix*

⁷⁶ *Id.* at 165.

⁷⁷ *Id.* at 169–70. The cases are: *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1532 (Fed. Cir. 1994), *Nor-Am Chem. Co. v. O.M. Scott & Sons Co.*, 4 U.S.P.Q.2d (BNA) 1316, 1320 (E.D. Pa. 1987), *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85, 98 (S.D. Iowa 1982), *aff’d*, 721 F.2d 253 (8th Cir. 1983), as well as its own discussion of color in *Inwood*.

⁷⁸ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17, cmt. c (1995).

⁷⁹ *Qualitex Co.*, 514 U.S. at 170 (citation omitted).

⁸⁰ *Id.*

⁸¹ *Id.* (internal quotation marks omitted).

⁸² *Id.*

decision. As recounted above, the unanimous *TrafFix* decision reiterated its view that the *Inwood* approach should be applied vis-à-vis utilitarian functionality claims, but distinguished aesthetic functionality with the simple statement, “[i]t is proper to inquire into a ‘significant non-reputation-related disadvantage’ in cases of esthetic functionality, the question involved in *Qualitex*.”⁸³ The *TrafFix* Court also told us “[i]n *Qualitex* . . . esthetic functionality was the central question.”⁸⁴

To have a sense of how the aesthetic functionality doctrine has narrowed from *Pagliari* to our post-*TrafFix* day, consider two decisions three decades apart: the 1979 decision in *Famolare, Inc. v. Melville Corp.*⁸⁵ and the 2012 *Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.* case.⁸⁶ In the 1979 case, a Hawaii district court concluded that aesthetic functionality precluded the plaintiff from having trademark rights to shoe soles “consisting of multiple crests with troughs”⁸⁷ producing a “distinctive, wavy-bottom visual appearance”;⁸⁸ in 2012, the Second Circuit concluded that aesthetic functionality did not bar the plaintiff from having a “valid and enforceable” trademark in a “lacquered red outsole that contrasts with the adjoining portion of the shoe.”⁸⁹

The 1979 *Famolare* court squarely reached its conclusion that the wavy-bottom soles were not protectable on the grounds that “[p]laintiff concede[d] that members of the public purchase Famolare shoes because the distinctive appearance of the wavy-bottom soles appeals to them”⁹⁰ reasoning that, “[i]f the feature is intended to appeal to the consumer’s aesthetic values and is purchased for this reason, it is functional.”⁹¹

Of course, Louboutin’s red lacquer soles “appeal to the consumer’s aesthetic values,” and certainly are an important reason for purchasing Louboutin shoes. But the *Louboutin* panel was express in its disagreement with the line of cases to which *Famolare* belongs, considering that such reasoning “inevitably penalize[s] markholders for their success in promoting their products.” Instead, the appellate court repeated again and again the formula that the aesthetic functionality doctrine “prevents trademark law from inhibiting legitimate competition”;⁹² that the aesthetic functionality test is “whether ‘certain

⁸³ *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001).

⁸⁴ *Id.*

⁸⁵ 472 F. Supp. 738 (D. Haw. 1979).

⁸⁶ 696 F.3d 206 (2d Cir. 2012).

⁸⁷ *Famolare, Inc.*, 472 F. Supp. at 740.

⁸⁸ *Id.* at 741.

⁸⁹ *Christian Louboutin S.A.*, 696 F.3d at 228.

⁹⁰ *Famolare, Inc.*, 472 F. Supp. at 744.

⁹¹ *Id.*

⁹² *Christian Louboutin S.A.*, 696 F.3d at 218 (quoting *Nora Beverages, Inc. v. Perrier Grp.* of

features of the design are essential to effective competition in [the] particular market”;⁹³ and that “a mark is aesthetically functional, and therefore ineligible for protection under the Lanham Act, where protection of the mark *significantly* undermines competitors’ ability to compete in the relevant market.”⁹⁴

The simple *Pagliero/Famolare* question as to whether “aesthetic values” was an important reason for the purchase has been replaced by an analysis of “significant non-reputational disadvantage” that focuses primarily on competitive need. According to *TrafFix*, this inquiry into inhibition of competition is *primary* only when the functionality claim is based on aesthetic appeal but distinctly *secondary* when the issue is mechanical or technical advantage in a product feature.

E. *Doctrine Apart or Part of the Doctrine?*

Aesthetic functionality is treated as part and parcel of functionality doctrine in the *Restatement*, in both *Qualitex* and *TrafFix*, and in decisions that drift between utilitarian and aesthetic functionality, drawing little or no distinction between the two. Yet for some courts and commentators, aesthetic functionality remains a realm apart, sometimes obscure and doubted.

While the Second, Seventh, Tenth, and Eleventh Circuits have embraced aesthetic functionality, the Fifth Circuit seems to reject the doctrine entirely.⁹⁵ In a 2012 decision, the Sixth Circuit also remained coy about the doctrine, giving an interpretation of what the “dicta” in *Qualitex* “propose[s],” but stating that they had “not yet plainly stated which test we would apply under aesthetic functionality doctrine, or that we have even adopted aesthetic functionality doctrine at all.”⁹⁶ The Federal Circuit has also seemed hesitant to embrace the doctrine, although their hesitancy reads more like a terminological objection and/or deference to the late Judge Rich. If intercircuit inconsistency

Am., Inc., 269 F.3d 114, 120 n.4 (2d Cir. 2001)); *see also* *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 145 (2d Cir. 1997).

⁹³ *Christian Louboutin S.A.*, 696 F.3d at 220 (alteration in original) (quoting *Landscape Forms, Inc. v. Columbia Cascade Co.*, 70 F.3d 251, 253 (2d Cir. 1995)).

⁹⁴ *Id.* at 222.

⁹⁵ *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 487–88 (5th Cir. 2008) (arguing that the Supreme Court has recognized the aesthetic functionality doctrine only in dicta, and that therefore the Fifth Circuit’s long-standing rejection of the doctrine was not abrogated by *Qualitex* and *TrafFix*).

⁹⁶ *Maker’s Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 418 (6th Cir. 2012) (citations omitted). In the particular dispute before it, the Sixth Circuit panel said they would reach the same result “[e]ven assuming we were to recognize aesthetic functionality doctrine.” *Id.*; *see also* *Antioch Co. v. W. Trimming Corp.*, 347 F.3d 150, 155–56 (6th Cir. 2003) (questioning aesthetic functionality doctrine in the Sixth Circuit).

were not enough, over the years the Ninth Circuit has applied aesthetic functionality enthusiastically in some cases, denied its acceptance of the doctrine in other decisions, and now settled on acceptance.⁹⁷

Perhaps the most sustained doubts about the aesthetic functionality doctrine come from outside the courtroom in the form of the leading trademark law treatise, *McCarthy on Trademarks and Unfair Competition*.⁹⁸ Professor McCarthy characterizes the discussion and four case citations in *Qualitex* as “passing comments” that “might put some life in the fading theory of aesthetic functionality.”⁹⁹ McCarthy then recognizes that Justice Scalia also discusses “esthetic” designs in the 2000 *Wal-Mart Stores, Inc. v. Samara Bros.* decision, but characterizes Scalia’s reference to *Qualitex* as “cryptic[]”;¹⁰⁰ McCarthy also recognizes that Justice Kennedy’s 2001 *TrafFix* opinion characterized *Qualitex* as a case about aesthetic functionality, but says that Justice Kennedy’s remarks only “muddied the waters of the aesthetic functionality theory.”¹⁰¹

While the Fifth and Sixth Circuits are, *stricto sensu*, correct that the aesthetic functionality discussion in *Qualitex* was not necessary for the result, the Second Circuit is surely correct that “that the combined effect of *Qualitex* and *TrafFix* was to validate the aesthetic functionality doctrine as it had already been developed by” district and appellate courts.¹⁰²

⁹⁷ After starting the broad understanding of aesthetic functionality in *Pagliari v. Wallace China Co.*, 198 F.2d 339 (9th Cir. 1952), Ninth Circuit panels wandered across a spectrum of positions from denying aesthetic functionality exists doctrinally to applying the doctrine vigorously. In Mark McKenna’s description, “[t]he Ninth Circuit takes a different position on the doctrine nearly every time it comes up.” McKenna, *supra* note 5, at 849. The Ninth Circuit’s inconsistency over aesthetic functionality is explored in Part III.B, *infra*.

⁹⁸ MCCARTHY ON TRADEMARKS, *supra* note 12, § 7:80, at 7-277 (“[T]he Supreme Court has never directly addressed aesthetic functionality as a dispositive issue in a case” (emphasis added)).

⁹⁹ *Id.*

¹⁰⁰ *Id.* § 7:80, at 7-278 (internal quotation marks omitted) (discussing *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000)).

¹⁰¹ *Id.* Professor McCarthy seems especially concerned about Justice Kennedy’s statement that “aesthetic functionality was the central question” in *Qualitex*, calling the statement “amazing and incomprehensible.” *Id.* (internal quotation marks omitted); see also 1 ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 2A.04(5)(b) (2014). McCarthy and LaLonde are surely right that the “central question” in *Qualitex* was the basic issue of whether a single color could be protected as a trademark, but in fairness to Justice Kennedy, since there was no utilitarian functionality in the green-gold color of the dry cleaning pads, the argument was about “color depletion” and that argument from Jacobson was premised on color being aesthetically necessary to the product. In terms of functionality, that was the central question.

¹⁰² *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 221 (2d Cir. 2012). The court was, in fact, a little more self-congratulatory, viewing *Qualitex* and *TrafFix* as validating aesthetic functionality as developed in the Second Circuit. In any case, the Second Circuit view is certainly closer to the truth than the Sixth Circuit comment that “the Supreme Court has never directly addressed aesthetic functionality.” *Antioch Co. v. W. Trimming Corp.*, 347 F.3d 150, 155 (6th Cir. 2003).

Whatever the ambiguities and questions, Justice Breyer's *Qualitex* opinion, on behalf of a *unanimous* Court, expressly discusses the aesthetic functionality doctrine in a moderately long passage, relying on and referring to cases that were briefed by the petitioner and the U.S. Government; a few years later, Justice Scalia—usually not one of Breyer's doctrinal allies—refers favorably to the “esthetic appeal” considerations discussed in *Qualitex*; and the next year, Justice Kennedy, again on behalf of a *unanimous* Court, expressly states that *Qualitex* was a case about aesthetic functionality—and tells us that the approach *Qualitex* lays out is “proper.”¹⁰³

The Justices' words in *Wal-Mart* and *Traffix* were not “cryptic” and did not “muddy the waters”—they are, in fact, the kind of “repeated affirmance by the same court”¹⁰⁴ that are typically understood to strengthen the precedential power of a prior statement, demonstrating that the discussion in *Qualitex* was “considered dicta” that is “instructive of the Supreme Court's views” and, therefore, should be followed.¹⁰⁵

Perhaps much of the hesitation about “aesthetic functionality” is terminological and/or taxonomic. As to terminology, the entirety of the functionality doctrine is poorly named. Decades ago, Judge Posner noted that “utilitarian” should really describe all the functionality

¹⁰³ *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001) (“It is proper to inquire into a ‘significant non-reputation-related disadvantage’ in cases of esthetic functionality, the question involved in *Qualitex*. Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature. In *Qualitex*, by contrast, esthetic functionality was the central question, there having been no indication that the green-gold color of the laundry press pad had any bearing on the use or purpose of the product or its cost or quality.”).

¹⁰⁴ *Arrigo v. Commonwealth Cas. Co.*, 41 F.2d 817, 819 (D. Md. 1930).

¹⁰⁵ *Wright v. Morris*, 111 F.3d 414, 419 (6th Cir. 1997) (“We believe this [dictum] is instructive of the Supreme Court's views and cannot be dismissed out of hand. . . . Where there is no clear precedent to the contrary, we will not simply ignore the Court's dicta.”). We can add—and end with—a string citation of frequent Court of Appeals statements, in different formulations, that Supreme Court dicta should be given great weight. *See Gaylor v. United States*, 74 F.3d 214, 217 (10th Cir. 1996) (“While these statements are dicta, this court considers itself bound by Supreme Court dicta almost as firmly as by the Court's outright holdings, particularly when the dicta is recent and not enfeebled by later statements.”); *McCoy v. Mass. Inst. of Tech.*, 950 F.2d 13, 19 (1st Cir. 1991) (“We think that federal appellate courts are bound by the Supreme Court's considered dicta almost as firmly as by the Court's outright holdings, particularly when, as here, a dictum is of recent vintage and not enfeebled by any subsequent statement.”); *Nichol v. Pullman Standard, Inc.*, 889 F.2d 115, 120 n.8 (7th Cir. 1989) (court of appeals “should respect considered Supreme Court dicta”); *United States v. Underwood*, 717 F.2d 482, 486 (9th Cir. 1983) (court of appeals not at liberty to “disregard . . . guidelines” established by Supreme Court, albeit through dicta); *United States v. Bell*, 524 F.2d 202, 206 (2d Cir. 1975) (considered dictum “must be given considerable weight and can not be ignored in the resolution of [a] close question”); *Fouts v. Md. Cas. Co.*, 30 F.2d 357, 359 (4th Cir. 1929) (“[D]icta of the United States Supreme Court should be very persuasive.”).

cases;¹⁰⁶ Mark Lemley and Mark McKenna are surely correct that we would be better off understanding the cases we label as “utilitarian” functionality as about “mechanical” functionality.¹⁰⁷ (“Technical” functionality would work too.) Part II below similarly argues that the cases we call “aesthetic” functionality are more properly understood as cognitive or psychological functionality. But this Article does not advocate a terminological revision simply to avoid further confusion; we can keep calling these cases “aesthetic functionality” cases as long as we know what we are talking about.

II. AESTHETIC FUNCTIONALITY IS ABOUT COGNITIVE AND PSYCHOLOGICAL RESPONSES

That the aesthetic functionality law should be an uncontested element of federal trademark law does not mean that it needs to form part of a seamless whole with utilitarian or mechanical functionality. One could see utilitarian and aesthetic functionality as separate yet related doctrinal boxes. Or one could view the entirety of functionality case law as stretching across a spectrum in which our juridical tests are modulated for different fact patterns. What we know is that post-*Traffix*, the framework for aesthetic functionality *is* somewhat different from utilitarian functionality. Not surprisingly, different commentators have offered different reasons why.

For Mark McKenna, any doctrinal difference arises because aesthetic functionality issues do not directly implicate the policy objectives of patent law¹⁰⁸—or what we might recognize as “patent law” as the Framers understood it.¹⁰⁹ McKenna also speculates that judges

¹⁰⁶ *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 344–45 (7th Cir. 1985) (“‘utilitarian’ is ambiguous” in relation to functionality and “can mean anything which gives pleasure”).

¹⁰⁷ Lemley & McKenna, *supra* note 39, at 2063 (distinguishing between “aesthetic and mechanical functionality”).

¹⁰⁸ McKenna, *supra* note 5, at 854 (“It makes sense to differentiate these types of functionality because they interact with patent law in different ways: features related to mechanical function implicate a concern about overlap with the utility patent system, while features needed because of consumer expectations do not.”).

¹⁰⁹ That is, the Copyright and Patent Clause’s reference to “Inventors” and “Discoveries” indicate that those Framers who were thinking about intellectual property at all were thinking about technical inventions. See generally BRUCE W. BUGBEE, GENESIS OF AMERICAN PATENT AND COPYRIGHT LAW (1967); Justin Hughes, *Copyright and Incomplete Historiographies: Of Piracy, Propertization, and Thomas Jefferson*, 79 S. CAL. L. REV. 993, 1021–26 (2006); Adam Mossoff, *Who Cares What Thomas Jefferson Thought About Patents? Reevaluating the Patent “Privilege” in Historical Context*, 92 CORNELL L. REV. 953 (2007); Dotan Oliar, *Making Sense of the Intellectual Property Clause: Promotion of Progress as a Limitation on Congress’s Intellectual Property Power*, 94 GEO. L.J. 1771 (2006); Edward C. Walterscheid, *To Promote the Progress of Science and Useful Arts: The Background and Origin of the Intellectual Property Clause of the United States Constitution*, 2 J. INTELL. PROP. L. 1 (1994).

simply find that what is at stake in aesthetic functionality claims does not merit the extreme result of the utilitarian functionality doctrine, i.e., that the features or design are judged to be completely unprotected by trademark law.

In his thoughtful 2015 review of the functionality doctrine, Robert Bone unquestionably accepts aesthetic functionality, but implicitly treats the doctrine as a sort of separate bailiwick where the standards he develops for utilitarian functionality apply, except maybe they do not. Bone's general view is that "market competition can be impaired by protecting aesthetic trade dress just as much as it can by protecting utilitarian trade dress"¹¹⁰ but he recognizes two reasons that his preferred analysis may have to be adjusted for with aesthetic functionality: (1) the subjectivity and heterogeneity of aesthetic preference,¹¹¹ as well as (2) the "close connection between aesthetic value and source identification [devices]."¹¹²

"Heterogeneity" is certainly a characteristic—a fundamental characteristic—of aesthetic preferences overall, but it is considerably less characteristic of the aesthetic functionality case law. Aesthetic functionality cases involve a spectrum of consumer responses from those that might be called the truly *aesthetic* to those responses that are better understood as *psychological* or *cognitive*.

The argument here is neither that we should separate "cognitive" and "aesthetic" functionality nor that we need to rebrand aesthetic functionality (although that would not be a bad idea). My claim is only that what we have called "aesthetic" functionality can be better understood as functionality arising from how consumers process and respond to sensory inputs, based either on evolution or deeply rooted acculturation that may or may not be "aesthetic." This understanding can help us give more discipline to the doctrine going forward. Let's turn to some cases to explore these points.

A. "Matching" Aesthetic Functionality Cases

A classic introduction to aesthetic functionality—one that evidently resonated with the Supreme Court—is the 1982 case of *Deere & Co. v. Farmhand, Inc.*¹¹³ In *Deere*, the court allowed competitors in farm equipment to copy John Deere's signature green color in implements that would be used in combination with (and attached to) John Deere tractors. The grounds for this holding was that farmers

¹¹⁰ Bone, *supra* note 4 (manuscript at 56).

¹¹¹ *Id.* (manuscript at 56–57).

¹¹² *Id.* (manuscript at 56).

¹¹³ 560 F. Supp. 85, 98 (S.D. Iowa 1982), *aff'd*, 721 F.2d 253 (8th Cir. 1983).

making substantial capital investments in tractors would reasonably want attaching equipment to match in color.

John Deere had been using a particular shade of green for its farm tractors since 1955;¹¹⁴ the company took great pains to ensure the quality and consistency of the color¹¹⁵ and a survey introduced at trial showed that eighty percent of respondents identified the green shade with John Deere.¹¹⁶ A much smaller competitor, Farmhand, was in the business of selling “front end loaders” (loaders) that attach to the front chassis of a tractor and give the tractor a limited, bulldozer scoop capacity. Farmhand loaders were typically painted in red, but when the company introduced loader models specifically designed to fit the newest Deere tractors, Farmhand painted those loaders “the exact same shade of green as John Deere.”¹¹⁷

The court reviewed “abundant evidence at trial to the effect that farmers desire to ‘match’ their loaders to their tractors”¹¹⁸ and “conclude[d] that the doctrine of aesthetic functionality should apply to the dispute” and “that protection of John Deere green . . . would hinder Farmhand in competition.”¹¹⁹

Notice that the aesthetic preference here is *not* for the *color green* or a particular shade of green per se; it is an aesthetic preference for a “match” combined with the consumer having made a substantial capital investment on one side of the “match.” Farmhand had brought an antitrust counterclaim that the district court dismissed, but which would be completely understandable: *if* (1) farmers have a very strong preference for farm equipment that matches in color, and (2) *if* John Deere could control use of the color of its tractors across all attaching farm equipment. In that situation, farmers who had made the substantial capital investment in a John Deere tractor would arguably be a separate market for attaching farm equipment—a market in which John Deere would have created substantial barriers to entry because it supplies the expensive, capital good against which things must be matched.¹²⁰

¹¹⁴ *Id.* at 89.

¹¹⁵ *Id.*

¹¹⁶ *Id.* at 93.

¹¹⁷ *Id.* at 89.

¹¹⁸ *Id.* at 91–92 (“The farmers who testified either specifically stated that they desired their loader to match their tractor or at least recognized the visual impact of color combinations in farm machinery.”).

¹¹⁹ *Id.* at 98. But this apparent holding as to aesthetic functionality was actually not necessary to the result as the court, criticizing John Deere’s survey evidence, concluded that it was “unwilling to find that plaintiff has established a secondary meaning for the color John Deere green.” *Id.* at 99.

¹²⁰ This is the classic, if contested, “lock-in” problem in antitrust law. *Eastman Kodak Co. v. Image Technical Servs., Inc.*, 504 U.S. 451 (1992) (manufacturer of photocopiers could have significant market power in the replacement parts market for its machines, even though the

A simpler sort of “matching” situation occurs in a set of cases about architectural components: *L.D. Kichler Co. v. Davoil, Inc.*, a 1999 Federal Circuit decision;¹²¹ the Third Circuit’s 1981 *Keene Corp. v. Paraflex Industries, Inc.* decision;¹²² and the Trademark Trial and Appeal Board (T.T.A.B.) 2001 decision in *M-5 Steel Manufacturing, Inc. v. O’Hagin’s Inc.*¹²³ In *Kichler*, the plaintiff had obtained trademark registration for an antiqued, weathered finish for lighting fixtures which it called “Olde Brick,” which was “described as ‘rust-type’” and “color compatible with many interior finishes.”¹²⁴ The district court granted summary judgment to the defendant, reasoning that the Olde Brick finish could not be protected because of other fixture manufacturers’ need to use similar finishes to match existing building interiors.¹²⁵

Similarly, in *Keene v. Paraflex*, the issue was a modernist exterior lighting fixture, and the Third Circuit concluded that the fixture’s overall design could not be trademarked, because “part of its function includes its architectural compatibility with the structure or building on which it is mounted.”¹²⁶ The court of appeals therefore concluded that the fixture’s “design configuration, rather than serving merely as an arbitrary expression of aesthetics, is intricately related to its function.”¹²⁷

Finally, the most blatant of these cases is the 2001 *M-5 Steel v. O’Hagin’s* case in which O’Hagin sought to register trademarks that were essentially the shape of its products—metal roof vent covers that “mirror[ed] the shapes of the roof tiles made and sold by various unrelated roof tile manufacturers.”¹²⁸ This meant that a home with a Spanish tile roof could have a roof vent that matched the curvature of the roof tiles instead of being an apparent vent outlet. Deposition testimony for the opposition before the T.T.A.B. focused on how a typical “customer wants the vent to match the [roof] tile,”¹²⁹ that the

manufacturer had only twenty percent of the primary market for photocopiers); see HERBERT HOVENKAMP, FEDERAL ANTITRUST POLICY: THE LAW OF COMPETITION AND ITS PRACTICE § 3.3a, at 103–10 (4th ed. 2011).

¹²¹ 192 F.3d 1349 (Fed. Cir. 1999).

¹²² 653 F.2d 822 (3d Cir. 1981).

¹²³ 61 U.S.P.Q.2d (BNA) 1086 (T.T.A.B. 2001). The three federal court cases discussed in this section are all featured in the U.S. Government’s pleadings in *Qualitex*. Brief for the United States as Amicus Curiae Supporting Petitioner at 14–15, *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (No. 93-1577).

¹²⁴ *L.D. Kichler Co.*, 192 F.3d at 1351.

¹²⁵ While the appellate panel reversed and remanded for further determinations of fact, they recognized that “color compatibility” could produce de jure functionality where a claimed color “is one of a few colors that are uniquely superior for use in home decorating.” *Id.* at 1353.

¹²⁶ 653 F.2d at 826.

¹²⁷ *Id.* The trial court had received extensive evidence that the light fixtures’ “crisp clean lines match contemporary architectural styling” and that aesthetics play a significant part in the selection of light fixtures. *Id.* (internal quotation marks omitted).

¹²⁸ 61 U.S.P.Q.2d (BNA) at 1088.

¹²⁹ *Id.*

purpose of a curved vent cover was “to make it appear as a tile, a roof tile” and that “[o]nce it’s on the roof, and it’s painted, it’s very difficult to identify them as either vent or tile.”¹³⁰ On this record, the T.T.A.B. “agree[d] with opposer that applicant’s product designs are functional in the sense that these configurations blend in or match the roof tiles with which they are used better than alternative products.”¹³¹

Notice that *Kichler*, *Keene*, and *M-5 Steel* are like *Deere* in that the consumer has made a major capital investment in a physical good and wants to match products to that capital investment. *Kichler*, *Keene*, and *M-5 Steel* differ from *Deere* in that John Deere provided both the product (front loaders) *and* the capital good to which the product was being matched (tractors). But in all these cases, the product features found to be aesthetically functional give a distinct advantage for a market or a segment of a market.

Aesthetic functionality arising from “matching” can be broadened to include any colors that are neutral in relation to the product or product environments on which they are used. The chief examples would obviously be white, black, and grey (separate from their *cognitive* functionality, discussed below). But, as in *M-5 Steel*, this could include colors that matched red clay roof tiles. At the opposite end of our range of concern, the single color case law includes the extreme case where there was *absolutely no* matching possible: the Federal Circuit’s 1985 *In re Owens-Corning Fiberglas Corp.* decision.¹³² *In re Owens-Corning Fiberglas Corp.* concerned Owen-Corning’s claim to trademark protection for the pink color of its insulation. Since insulation, once installed, is not seen again (until the wall is torn open), there should be no practical “matching” concern.¹³³

B. *Cognitive and Psychological Functionality*

The “matching” cases lead us in the direction of disputes where what we widely call aesthetic functionality may be, *stricto sensu*, more “cognitive” or “psychological” than “aesthetic.” The perfect case to make this bridge is the 1994 *Brunswick Corp. v. British Seagull Ltd.* decision¹³⁴

¹³⁰ *Id.* at 1089.

¹³¹ *Id.* at 1097.

¹³² 774 F.2d 1116 (Fed Cir. 1985) (allowing registration of color pink for fiberglass insulation).

¹³³ As the Federal Circuit noted in a later case, “[i]ndeed, insulation in use is not open to general view at all. Owens-Corning alone undertook the additional, unnecessary step of coloring the insulation.” *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1531 (Fed. Cir. 1994). A very few readers, unable to wean themselves from first-year hypotheticals (or high school debate), will come up with counterexamples, e.g., the (rare) sensitivity of building tradesmen and demolition crews to color compatibility, etc. *De minimis non curat lex* may be the best answer to this sort of concern.

¹³⁴ 35 F.3d 1527.

in which Brunswick sought registration of the color black as a trademark for outboard motors manufactured by its Mercury Marine division.

The T.T.A.B refused this registration, finding that black in relation to outboard motors for boats was functional for two related but distinct reasons. The first reason was “because it is [a] color compatible with a wider variety of boat colors,” i.e., that “[t]he evidence show[ed] that people who buy outboard motors for boats like the colors of the motors to be harmonious with the colors of their vessels.”¹³⁵ The second reason was that “objects colored black appear smaller than they do when they are painted other lighter or brighter colors” and “people who buy outboard motors for boats . . . find it desirable under some circumstances to reduce the perception of the size of the motors in proportion to the boats.”¹³⁶ While being coy about the Federal Circuit’s embrace of “aesthetic functionality,”¹³⁷ Judge Rader’s opinion for the Federal Circuit upheld the T.T.A.B. ruling, accepting both rationales.¹³⁸

The first rationale is clearly the same as the *John Deere* and the architectural component cases: the consumer wants to match the product to something already owned by the consumer. This color “compatibility” seems to be about what we commonly call “aesthetics.” But the second rationale is not quite about aesthetics; it concerns how our sensory and neurological systems work. It seems to be the case that things in black (or extremely dark colors) *appear* smaller to us; as a species, we literally see them *less*. Not only are black clothes slenderizing, but studies seem to agree that black (or very dark) cars are more prone to accidents because they are less visible.¹³⁹ A law review

¹³⁵ *British Seagull Ltd. v. Brunswick Corp.*, 28 U.S.P.Q.2d (BNA) 1197, 1199 (T.T.A.B. 1993).

¹³⁶ *Id.*

¹³⁷ In what appears to be deference to Judge Rich’s views in *In re D.C. Comics*, Judge Rader’s analysis goes directly to the conclusion that each of the two reasons shows that black is needed for effective competition, without “aesthetic functionality” being needed as an intermediary concept. *Brunswick Corp.*, 35 F.3d at 1533 (“In this case, the Board did not improperly deny registration to Mercury merely because black served purely aesthetic functions. Color compatibility and ability to decrease apparent motor size are not in this case mere aesthetic features. Rather these non-trademark functions supply a competitive advantage. The Board properly analyzed Mercury’s use of black in terms of its non-trademark functions and its effect on competition.”).

¹³⁸ *Id.* at 1531–32. The T.T.A.B. also found that Brunswick Corp. had not established acquired distinctiveness in its Mercury division’s use of the color black, partly because “[t]he Board also found that Mercury’s use of black on outboard engines was not exclusive. Several of Mercury’s competitors in the outboard market had engines colored black or dark colors easily perceived as black.” *Id.* at 1530.

¹³⁹ See, e.g., STUART NEWSTEAD & ANGELO D’ELIA, MONASH UNIV. ACCIDENT RESEARCH CTR, REPORT NO. 263, AN INVESTIGATION INTO THE RELATIONSHIP BETWEEN VEHICLE COLOUR AND CRASH RISK 9 (2007) (showing that cars of dark colors—black, blue, green, grey, etc.—are associated with both higher crash risk and higher risk of severe crashes); Pablo Lardelli-Claret et al., *Does Vehicle Color Influence the Risk of Being Passively Involved in a Collision?*, 13 EPIDEMIOLOGY 721 (2002) (study concluding that darker cars such as grey, black, red, and blue have a higher risk of being in a collision).

article is not the place to sort out the exact parameters of this visual/perceptual bias, but if the bias exists, then the functionality we are talking about might be better understood as “cognitive” or “perceptual.”

Lawyers and legal academics need to be cautious in their scientific pronouncements, but the general point is that one kind of “aesthetic” functionality at issue in *Brunswick Corp.* was actually a matter of the operation of our neurological system—how we see things—not “aesthetic preferences” at all. That our visual and neurological system see black things as “smaller” is not much different from our visual and neurological system seeing reflective surfaces as brighter—and the 1963 *In re Pollak Steel Company* case in which a reflective area at the top of a farm fence post was held to be a “utilitarian coating” that was “inherently functional.”¹⁴⁰

We can go further and reasonably postulate that many of the responses at issue in “aesthetic” functionality cases are probably the result of evolution and some of the responses are undoubtedly the result of acculturation. In the case of the visibility of black objects, it is reasonable to believe that their low impact on our visual and cognitive awareness is the result of evolution. The same may apply to bright orange and yellow being used for extension cords, safety jackets, and hard hats: the attention-attracting power of these colors is just part of how our neurological and sensory systems evolved. And when a cognitive or perceptual response is the result of evolution, there will presumably be little “heterogeneity” across people.

In principle, cognitive biases that result from acculturation may be subject to more heterogeneity on the edges or across populations, but they can still have enough consistency in consumer responses for a sound aesthetic functionality claim. A set of such widely shared association(s) produced by acculturation are discussed in the T.T.A.B.’s 2013 *In re Florists’ Transworld Delivery, Inc.* decision¹⁴¹ in which the Board found the color black to be aesthetically functional in relation to packaging for floral arrangements because, depending on the circumstances, it would be “associated with stylish or formal events,” “in other contexts may connote grief or condolence” and in still other contexts “is a critical color in connection with Halloween displays.”¹⁴²

¹⁴⁰ *In re Pollak Steel Co.*, 131 U.S.P.Q. (BNA) 482, 483 (T.T.A.B. 1961), *aff’d*, 314 F.2d 566 (C.C.P.A. 1963) (“It is obvious from the facts adduced herein that the reflective coating utilized by applicant is inherently functional and that its placement at the uppermost portion of the post conforms to the commonly accepted practice of applying reflecting indicia to road signs and boundary markers for safety and protection purposes. Any device, the immediate aim of which is to serve a functional mission, cannot be granted the legal protection a registration achieves. To do otherwise would enable the registrant to pre-empt others from applying a utilitarian coating in any fashion.”).

¹⁴¹ 106 U.S.P.Q.2d (BNA) 1784 (T.T.A.B. 2013).

¹⁴² *Id.* at 1789.

Any one of these acculturated, widespread responses in consumers would have been enough for the T.T.A.B. to uphold the Trademark Examiner's conclusion that "there is a competitive need for others in the industry to use the color black in connection with floral arrangements and flowers."¹⁴³

Cases involving the "aesthetic" functionality of colors can offer a grab bag of things we might guess are the result of long-term conditioning of homo sapiens and more recent acculturation. A good example is the 1989 New Jersey district court case *Warner Lambert Co. v. McCrory's Corp.*,¹⁴⁴ where the court found that in the mouthwash market, particular colors are strongly associated with particular flavors: an amber colored liquid signifies a medicinal-tasting product, blue signifies peppermint, green signifies mint, and red signifies a cinnamon flavor.¹⁴⁵

Perhaps humans learned long ago to associate particular green tones with mint flavor, but the other associations are surely more recent and more culturally contingent. The connection between cinnamon and red (a color which cinnamon is not) and between amber color and medicinal taste are surely of recent vintage, passed between generations of Americans through acculturation, not gene code. Indeed, "amber" colors may signify medicinal taste only to Americans and only in relation to products we would ingest; amber color might—for other products and a wider range of people in developed economies—signify *caution*.

For other examples of both evolution and acculturation, consider *Dippin' Dots, Inc. v. Frosty Bites Distribution, LLC*, a case in which the Eleventh Circuit concluded that certain colors for ice cream were "functional because [they] indicate[] the flavor of the ice cream, for example, pink signifies strawberry, white signifies vanilla, brown signifies chocolate, etc."¹⁴⁶ Indeed, the red-pink spectrum so very much signifies strawberry flavor that even natural and organic ice cream

¹⁴³ *Id.* at 1791.

¹⁴⁴ 718 F. Supp. 389 (D.N.J. 1989).

¹⁴⁵ *Id.* at 396.

¹⁴⁶ 369 F.3d 1197, 1203–04 (11th Cir. 2004). In *Dippin' Dots*, it is fair to say that the court found both technical functionality and aesthetic functionality, although it did not completely clearly distinguish these conclusions. The size and shape of the Dippin' Dots ice cream pieces was technically functional, as the result of the previously patented process. *Id.* at 1206 ("Likewise, the shape of dippin' dots is functional because dripping the ice cream composition into the freezing chamber, as described in Patent '156, creates a 'bead' that facilitates the product's free flowing nature. . . . Moreover, a DDI product brochure states that the spherical shape is a result of the Patent '156 process and allows the 'quick, yet even freeze that is so important to the taste and consistency of the product.'" (citations omitted)). This is akin to the Shredded Wheat pillow in *Kellogg v. Nabisco*. The color of the ice cream was clearly aesthetically functional, as discussed in the text above. The size of the dippin' dot was also apparently aesthetically functional as a matter of how the product tasted. *Id.* ("Size is also functional in this case because it contributes to the product's creamy taste, which would be different in a larger 'dot.'").

makers try to achieve pink tones, despite the fact that cooked strawberries become greyish. Among these colors, some might be more the result of evolution and some more the result of acculturation—presumably humanoids have been eating red berries a lot longer than they have been consuming processed chocolate or identifying the flavor of the *Vanilla planifolia* plant with the color white.

Finally, consider the color blue. The mental association we have between medium and darker blues with nighttime (and sleep) may be a matter of evolution—or simply each individual’s experience (which the individual would have even living in Robinson Crusoe isolation). In contrast, the perception of blue as a masculine color—versus pink as a feminine color—is a nurtured and a fairly recent part of our shared psychology.¹⁴⁷ In between the two, the measured comfort of shoppers in blue environments may be both evolution and acculturation—current studies show that blue makes people more comfortable in public environments like stores, but not why.

Saying that the cognitive or perceptual response should be “widespread” does not mean that the response needs to be one hundred percent among the general population or even among relevant consumers. A cognitive or perceptual response common to a substantial composite of the relevant consumers should be enough; a response common to a quarter of them might be enough. In other words, orange flavoring for medicines that are ingested counts as a preexisting response even if a court “cannot definitively say that orange is the most popular flavor” but only that “it certainly would appear on the short list of most popular flavors.”¹⁴⁸

The point of all this is to see that much of what has been labeled “aesthetic functionality” involves consumer preferences that manifest perceptual and cognitive biases developed over the long course of evolution and/or acculturation. Much of the consumer biases reflected in aesthetic functionality cases are so rooted in our evolution or acculturation that the consumer would suffer cognitive dissonance if the bias were not followed. In contrast, when we ask people their favorite color for personal clothing, the heterogeneity we associate with true aesthetic choices comes to the fore—some people prefer red, some green, some orange, etc. We will return to this topic with a more normative focus in Part V.

¹⁴⁷ JO B. PAOLETTI, PINK AND BLUE: TELLING THE BOYS FROM THE GIRLS IN AMERICA (2012); Susan Stamberg, *Girls Are Taught To ‘Think Pink,’ But That Wasn’t Always So*, NPR (Apr. 1, 2014, 3:08 AM), <http://www.npr.org/2014/04/01/297159948/girls-are-taught-to-think-pink-but-that-wasnt-always-so> (describing temporary show at the Boston Museum of Fine Arts showing male use and identification with pink at different points before World War II).

¹⁴⁸ *In re N.V. Organon*, 79 U.S.P.Q.2d (BNA) 1639, 1646 (T.T.A.B. 2006).

III. AESTHETIC FUNCTIONALITY AS A BATTLEGROUND FOR THE VALORIZATION OF TRADEMARKS

No change in trademark law or the underlying fundamentals of marketing has been more fundamental or more “macro” than the increasing treatment of trademarks as valuable intangibles in and of themselves. Trademarks have traditionally been viewed as indicators of source of production, not things of value in and of themselves. Any exclusive right to control commercial use of these indicators of source was, therefore, “appurtenant to” control of the source of production itself.

But everyone who studies, practices, or applies trademark law—from judges to the U.S. Patent and Trademark Office (USPTO)—has come to understand that trademarks are increasingly valuable qua symbols, i.e., that an increasing portion of the utility of consumption comes from possessing the trademark as opposed to possessing just the good to which the trademark is attached.¹⁴⁹ This is particularly true with consumer goods trademarks, famous trademarks, and prestige trademarks. I will call this the “valorization” of trademarks. Certainly the dilution cause of action manifests acceptance of the trademark as value in and of itself,¹⁵⁰ but other doctrinal developments also arguably reflect the valorization of trademarks, i.e., post-sale confusion, initial interest confusion, and even the extension of trademark protection to trade dress.

Far from being a *result* of the valorization of trademarks, the aesthetic functionality doctrine has been a *battleground* in this valorization; much of the doctrinal instability in aesthetic functionality comes from trademarks becoming valuable in and of themselves. We have already discussed how courts rejected the low threshold of whether

¹⁴⁹ *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1067 (9th Cir. 2006) (“Famous trademarks have assumed an exalted status of their own in today’s consumer culture that cannot neatly be reduced to the historic function of trademark to designate source.”). For classic accounts, see Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 *YALE L.J.* 1717 (1999) and Sigmund Timberg, *Trade-marks, Monopoly, and the Restraint of Competition*, 14 *LAW & CONTEMP. PROBS.* 323, 326 (1949) (describing evolution of trademark from indicator of source to “a more far-reaching significance as the conservator of independent property rights created by advertising”).

¹⁵⁰ H.R. REP. NO. 104-374, at 3 (1995), *reprinted in* 1996 U.S.C.C.A.N. 1029, 1030 (“[D]ilution recognizes . . . the commercial value and aura of the mark itself, protecting [it] from those who would appropriate the mark for their own gain.”); *see also* Laura A. Heymann, *Naming, Identity, and Trademark Law*, 86 *IND. L.J.* 381, 418 (2011) (“As a result, the harm at the center of an anti-dilution suit is injury to the trademark qua trademark rather than an injury relating to the acquisition of goods or services offered under the mark.”); Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 *EMORY L.J.* 367, 371 (1999) (describing expansion of trademark law as “focused on a trademark’s value not merely as a device for conveying otherwise indiscernible information concerning a product . . . but as a valuable product in itself”).

the trademark “contributes” to the “value” of the product. But when the trademark *is* the thing the consumer seeks out and *is* the principal source of value for the consumer, decision makers still struggle to find sensible explanations as to why aesthetic functionality should not apply.

Cases involving fashion houses are an obvious place to look for this struggle, but let us instead consider the difficulties courts have faced in two pairs of cases, each with a Federal Circuit and Ninth Circuit exemplar. One pair concerns familiar fictional characters, and one pair concerns social identifiers.

A. *Aesthetic Functionality and Social Identifiers*

Many commentators have had intuitions about what is causing the valorization of trademarks, but Barton Beebe has provided probably the most complete and convincing account of why this is happening. In Beebe’s account, the diffusion of what Beebe identifies as “copying technology”¹⁵¹ reduces the ability of individuals to “gain rank over or equal to others”¹⁵² through variations in material conditions, i.e., through differentiation of levels of absolute utility. In other words, if everyone can purchase silk clothing, new cars, and burgundy-style red wines by the case, possession of such material goods no longer distinguish.

This equalization of true material conditions shifts some of the drive for social distinction back to “signs,” but a meritocratic, capitalist society no longer has robust mechanisms for social distinction through fixed class rank bolstered by sumptuary laws.¹⁵³ The “way out,” so to speak, is that we perpetuate “consumption-based social distinction” through exclusive rights in easily identified features of goods used to create rarity in those goods, such features being word trademarks, image trademarks, and product design.¹⁵⁴

¹⁵¹ Barton Beebe, *Intellectual Property Law and the Sumptuary Code*, 123 HARV. L. REV. 809, 832 (2010). By this, he means not just reprographic technology, but the whole range of human capacity to replicate production, whether it is Korean workers imitating the stitching on a Chanel bag or Oregon vintners mimicking production conditions for Burgundy pinot noir wines. *Id.* at 830–31.

¹⁵² *Id.* at 826.

¹⁵³ Beebe provides a succinct account drawn from the literature:

A society’s sumptuary code is its system of consumption practices, akin to a language (or at least “a set of dialects”), by which individuals in the society signal through their consumption their differences from and similarities to others. Laws that seek to control and preserve this code are sumptuary laws.

Id. at 812 (footnotes omitted).

¹⁵⁴ *Id.* at 837; see also Jeremy N. Sheff, *Veblen Brands*, 96 MINN. L. REV. 769, 794–804 (2012) (with status goods, trademarks convey information not only about the goods, but about the people, particularly the social classes and groups, that consume them).

Beebe's analysis provides not just an account for the valorization of trademarks generally, but also for the increasing protection of product features themselves; as long as those product features are easily seen and recognized by consumers, the features become sumptuary cues—and we have cause to regulate them to enforce social differentiation.

Following those insights, let us consider some cases where the plaintiff sought to enforce, through trademark law, exclusive control of signs that establish social distinction—and was challenged on aesthetic functionality grounds. Consistent with the theme of this paper, the functionality at issue—cues of social group and rank—is not really “aesthetic.” As the Ninth Circuit said in a 1991 case involving handbags, “[s]ince the products are largely carried on the person, a consumer’s interest in the prestige afforded by carrying a certain bag may overshadow that person’s sense for the purely aesthetic.”¹⁵⁵

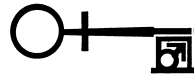
In the 1977 *In re Penthouse International Ltd.* dispute,¹⁵⁶ Penthouse sought a trademark registration for its key symbol embodied in cuff links, tie fasteners, bracelets, and charms for charm bracelets;¹⁵⁷ the USPTO had already registered single or triple versions of the key symbol for puzzles, posters, and jewelry boxes.¹⁵⁸ In refusing the registration, the trademark examining attorney stated:

(D)esigns of jewelry are considered to be functional in nature because it is the design of the jewelry that appeals to purchasers, and a particular piece of jewelry is purchased because of its design. Thus * * * the jewelry design would not be regarded as an indication of origin in applicant, but rather would be a design whose attractiveness and eye-appeal “sell” the goods.¹⁵⁹

¹⁵⁵ *Vuitton et Fils S.A. v. J. Young Enters.*, 644 F.2d 769, 773 (9th Cir. 1981).

¹⁵⁶ 565 F.2d 679 (C.C.P.A. 1977).

¹⁵⁷ The “key” uses the gender symbols derived from the classical symbols for Venus and Mars with the female symbol forming the main bow and shank of the key and the male symbol forming the pins or bit.



¹⁵⁸ *Id.* at 680. Versions of the key symbol were presumably registered for many other things, but these are the products and classes mentioned in the opinion.

¹⁵⁹ *Id.* (alterations in original). As to the second part that a “jewelry design would not be regarded as an indication of origin,” that is consistent with the view later expressed by the Supreme Court in *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000). As in *Wal-Mart*, that initial disposition of consumers would not foreclose the development of secondary meaning. *Id.* It is the first part of this statement that is the actual *Pagliero* vintage aesthetic functionality conclusion. *Pagliero v. Wallace China Co.*, 198 F.2d 339, 343–44 (9th Cir. 1952).

The Trademark Trial and Appeals Board upheld this conclusion, embracing a broad view of aesthetic functionality.¹⁶⁰

Penthouse understandably took the view that “ornamentation of a special nature” could serve as an indicator of source “even though it may also create a desire to purchase.”¹⁶¹ This, of course, is the nub of the problem: in a society where the trademarks have sumptuary meaning and convey status, tribe, and grouping, trademarks may both indicate source and not only “appeal to purchasers” but be the *principal* reason that a particular piece of jewelry, clothing, or accessory is purchased at all.

On appeal, the Court of Customs and Patent Appeals (C.C.P.A.) neither accepted nor expressly rejected aesthetic functionality (“functionality in ornamentation”). The court noted, in the parlance we would use today, that *de facto* functionality and source-indicating trademark status “are not in every case mutually exclusive” and that “mere possession of a function (utility) is not sufficient reason to deny protection.”¹⁶² Relevant as this reasoning was, it did not focus on the narrower, true problem: that the key symbol not only had “a function (utility),” the key symbol was—for the likely consumer—the *principal value and function* of this particular jewelry, perhaps the *only value* in this particular jewelry.

Four years later, a Ninth Circuit panel decided what became the poster child for the dangers of aesthetic functionality, *International Order of Job’s Daughters v. Lindeburg & Co.*¹⁶³ The International Order of Job’s Daughters (the Order) had a spotty record in licensing jewelry manufacturers to use its name and emblem—presumably on jewelry that would principally appeal to members of the Order.¹⁶⁴ That spotty record extended to the Order’s treatment of the defendant, which had requested a license, been refused, been granted a license, and later had its license revoked.

It seems clear that when a person bought and wore jewelry with the Order’s insignia she was using the jewelry as a social indicator, a cue in a sumptuary code, and as a kind of certification or collective mark,

¹⁶⁰ *In re Penthouse Int’l*, 565 F.2d at 680. At the time and at the USPTO/CCPA, aesthetic functionality seems to have gone under the moniker “functionality in ornamentation.” *In re Mogen David Wine Corp.*, 328 F.2d 925, 931 (C.C.P.A. 1964); *id.* at 932 (Rich, J., concurring).

¹⁶¹ *In re Penthouse Int’l*, 565 F.2d at 680.

¹⁶² *Id.* at 681.

¹⁶³ 633 F.2d 912, 917 (9th Cir. 1980).

¹⁶⁴ Just from the appellate opinion, we can infer that there was substantial evidence that the International Order of Job’s Daughters (the Order) did not seriously and consistently patrol use of its name or emblem. *Id.* at 914 (“Some [of the 31,000 retailers selling jewelry bearing the name and/or emblem of the Order] sell jewelry manufactured by . . . licensees; others sell jewelry manufactured by jewelers not licensed by the organization.”). The defendant requested a license from the Order, was refused, was later granted a license, and shortly after that had the license cancelled by the Order. *Id.*

signaling her membership in the Order. But the court focused on the defendant's use of the mark: "[r]esolution of this issue turns on a close analysis of the way in which Lindburg is using the Job's Daughters insignia."¹⁶⁵ Concluding that these two uses were quite different, the court held that with Lindeburg's use—in manufacturing and distributing the jewelry—"the name and emblem are functional aesthetic components of the jewelry."¹⁶⁶ The *Job's Daughters* panel was completely aware that this reasoning could sweep in the trademarks of "the schools we attend, the landmarks we have visited, the sports teams we support, [and] the beverages we imbibe." If I purchase a Cincinnati Reds t-shirt because it says Cincinnati Reds, then by the lights of *Job's Daughters*, the manufacturer and distributor used the Reds trademarks in an aesthetically functional way.

There are some other important things to note about the *Job's Daughters* exegesis. First, the opinion does not cleanly separate proof of secondary meaning and a finding of aesthetic functionality. After reciting the various trademarks above that "emblazon" our "jewelry, clothing, and cars" the court continues "it would be naive to conclude that the name or emblem is desired because consumers believe that the product somehow originated with or was sponsored by the organization the name or emblem signifies."¹⁶⁷ The court continues:

That is, even if the Job's Daughters' name and emblem, when inscribed on Lindeburg's jewelry, served primarily a functional purpose, it is possible that they could serve secondarily as trademarks if the typical customer not only purchased the jewelry for its intrinsic functional use and aesthetic appeal but also inferred from the insignia that the jewelry was produced, sponsored, or endorsed by Job's Daughters. . . . Accordingly, a court must closely examine the articles themselves, the defendant's merchandising practices, and any evidence that consumers have actually inferred a connection between the defendant's product and the trademark owner.¹⁶⁸

¹⁶⁵ *Id.* at 917.

¹⁶⁶ The court was very clear in seeing two different sorts of uses of the insignia:

[M]embers of Job's Daughters wear the jewelry to identify themselves as members. In that context, the insignia are trademarks of Job's Daughters. But in the context of this case, the name and emblem are functional aesthetic components of the jewelry, in that they are being merchandised on the basis of their intrinsic value, not as a designation of origin or sponsorship. It is not uncommon for a name or emblem that serves in one context as a collective mark or trademark also to be merchandised for its own intrinsic utility to consumers.

Id. at 918.

¹⁶⁷ At this point, the court discusses and expresses strong disagreement with the Fifth Circuit's decision protecting professional sports logos. *Bos. Prof'l Hockey Ass'n v. Dall. Cap & Emblem Mfg.*, 510 F.2d 1004, 1010 (5th Cir. 1975); see *Int'l Order of Job's Daughters*, 633 F.2d at 918–19.

¹⁶⁸ *Int'l Order of Job's Daughters*, 633 F.2d at 919 (citation omitted).

A reasonable, if charitable, reading of all this is that the court was only treating the defendant's use of the trademark as a "functional aesthetic component" as strong evidence against there being secondary meaning, but other evidence could establish such secondary meaning and consumer confusion (something which seemed doubtful given the Order's inconsistency in licensing).

In *Job's Daughters* the inconsistency of the International Order's licensing practices undermined the otherwise tolerable conclusion—which is common in sports insignia cases—that insignia purchasers would both purchase the jewelry/apparel for the insignia and believe the jewelry/apparel is licensed by the entity associated with the insignia. If one is uncomfortable with the outcome of the sports insignia cases, that discomfort is likely to be rooted in an aesthetic functionality intuition.

In some fact patterns—which would include sports insignia cases—the role of social indicator (identifying with an institution or group) may blur with the role of source indicator (of manufacture, sponsorship, or affiliation). In the 1993 *Black Dog Tavern Co. v. Hall* case,¹⁶⁹ the trial court turned back a functionality defense with language that was tellingly ambiguous on this count: "[t]he evidence proffered by plaintiff clearly establishes that people buy Black Dog T-shirts precisely because they associate them with plaintiff's establishments";¹⁷⁰ but this might just as well have been "because they associate" themselves "with plaintiff's establishments."

One final aspect of the *Job's Daughters* analysis merits our attention: by clearly separating Lindeburg's use of the Order's insignia from how consumers use the insignia, the opinion is really an early example of the "trademark use" defense. This is not the place to enter into the debate over this controversial argument,¹⁷¹ but it should be clear that it would have sweeping effects on trademark law in aesthetic functionality fact patterns.

Many considered that the *Job's Daughters* decision was buried, if not killed off, until it returned from the crypt in the next Ninth Circuit decision we will consider.

¹⁶⁹ 823 F. Supp. 48 (D. Mass. 1993).

¹⁷⁰ *Id.* at 53 (emphasis added).

¹⁷¹ For advocacy of the trademark use defense, see Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669 (2007) and Eric Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 EMORY L.J. 507 (2005). For a critique of the defense, see Graeme B. Dinwoodie & Mark D. Janis, *Confusion over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597 (2007). The Second Circuit roundly rejected the trademark use defense in *Rescuecom Corp. v. Google Inc.*, 562 F.3d 123 (2d Cir. 2009). See also Margreth Barrett, *Internet Trademark Suits and the Demise of "Trademark Use,"* 39 U.C. DAVIS L. REV. 371 (2006).

B. *Aesthetic Functionality and (Copyrighted) Characters*

For anyone who doubts the general “valorization” of trademarks, there would still be the problem of trademarks rights being claimed for images that have already been on the market as copyrighted works; in these cases, there is no question that a party is seeking to drape trademark rights over a bit of the cultural landscape that has proven valuable in and of itself. Again, the Court of Customs and Patent Appeals and the Ninth Circuit provide us with examples.

In 1982, the *In re DC Comics, Inc.*¹⁷² litigation reprised the *In re Penthouse International* case as the T.T.A.B. and C.C.P.A. squared off yet again over aesthetic functionality. In the *DC Comics* case, the T.T.A.B. had refused registration of “particular drawings of three characters, Superman, Batman, and Joker, as trademarks for toy dolls,”¹⁷³ the dolls themselves being representations of Superman, Batman, and Joker. The T.T.A.B. reasoned:

It is our opinion that the designs of the three dolls involved in this appeal are quintessentially utilitarian. A child who wants to playact with dolls an adventure involving the character “Superman” or the character “Batman” or the character “Joker” would simply not be satisfied with any doll that was not a replica of the appropriate character. The customary dress, accoutrements and facial expression of the character are indispensable elements of the commercial appeal of the product. Thus, these features are commercially functional.¹⁷⁴

On appeal, the C.C.P.A. noted that the Board’s reasoning “obscure[d] the distinction between utilitarian and aesthetic functionality.”¹⁷⁵ Seeing no “utilitarian” functionality in the “ornamental features common to both the dolls and appellant’s drawings,” the appellate court found “no merit in the argument that, by virtue of the aesthetic features identified by the board, appellant’s drawings are unable to perform as trademarks for toy dolls.”¹⁷⁶

As to aesthetic functionality as a doctrine, the C.C.P.A. took the opportunity to disagree expressly with the broad view that “functional

¹⁷² 211 U.S.P.Q. (BNA) 834 (T.T.A.B., 1981), *rev’d*, 689 F.2d 1042 (C.C.P.A. 1982).

¹⁷³ *In re DC Comics, Inc.*, 689 F.2d at 1043.

¹⁷⁴ *In re DC Comics, Inc.*, 211 U.S.P.Q. (BNA) at 837. As described by the Court of Customs and Patent Appeals, “the Board reasoned that the features in question were ‘indispensable elements of the commercial appeal of the product’ and, therefore, were ‘commercially functional’ facets of the dolls that could not be used to designate source.” *In re DC Comics, Inc.*, 689 F.2d at 1045.

¹⁷⁵ *In re DC Comics, Inc.*, 689 F.2d at 1045. In his concurrence, Judge Rich similarly concluded that “in formulating its opinion, the TTAB clearly intermingled the concepts of utilitarian functionality and what has been termed ‘aesthetic functionality.’” *Id.* at 1048 (Rich, J., concurring).

¹⁷⁶ *Id.* at 1045 (majority opinion) (internal quotation marks omitted).

features” are any aspects of a product that are “an important ingredient in the commercial success of the product.”¹⁷⁷ Citing the *In re Penthouse* decision, the court found “no merit in the argument that, by virtue of the aesthetic features identified by the board, appellant’s drawings are unable to perform as trademarks for toy dolls.”¹⁷⁸ In his concurrence, Judge Rich was more blunt in his doubts about aesthetic functionality as a whole.¹⁷⁹ For the Federal Circuit’s predecessor, aesthetic functionality could not be used to stop trademark rights over a valuable copyrighted character if the character had truly become an indicator of source.

The Ninth Circuit’s turn on this particular point came three decades later in its 2011 *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.* case,¹⁸⁰ a litigation over control of the Betty Boop cartoon character. The plaintiff in the litigation was Fleischer Studios, an entity formed by the family of Betty Boop’s creator, Max Fleischer, to regain and then exploit the rights to his iconic character. Unfortunately for the Fleischer heirs, their recovery of the copyright rights to Betty Boop was incomplete.¹⁸¹ Both the trial court and the court of appeals concluded that Fleischer had no copyright rights to assert against A.V.E.L.A., an entity also licensing Betty Boop images to third parties.

As to Fleischer’s claim to trademark rights, the trial court also concluded that Fleischer had not provided timely evidence that it owned either registered or common law rights in Betty Boop, but the appellate panel decided to strike out in a different direction. Relying on the *Job’s Daughter* decision, Judge Wallace concluded that all the trademark arguments raised by the parties were “mooted”¹⁸² and that there could be no trademark claim against the defendant because “A.V.E.L.A. is not using Betty Boop as a trademark, but instead as a functional product”¹⁸³ and that the Betty Boop name and image “were functional aesthetic components of the [defendant’s] product, not trademarks.”¹⁸⁴

This surprising conclusion—the issue was neither briefed nor argued by the parties—triggered a wave of criticism, including petitions

¹⁷⁷ *Id.* (“[W]e consider such a broad definition to be at odds with this court’s precedent in this area.”).

¹⁷⁸ *Id.*

¹⁷⁹ *Id.* at 1050 (Rich, J., concurring) (“[I]t is arguable that there is no ‘doctrine’ of aesthetic functionality which stands alone, without consideration of the more traditional source identification principles of trademark law.”).

¹⁸⁰ 636 F.3d 1115 (9th Cir.), *withdrawn and superseded on denial of reh’g*, 654 F.3d 958 (9th Cir. 2011).

¹⁸¹ *Id.* at 1117. Max Fleischer had transferred the Betty Boop character and cartoons to Paramount, who had subsequently seemed to sell off the assets, but in one contract in the chain of title Paramount seemed to retain rights to the *character*, although it had transferred various “photoplays.” *See id.*

¹⁸² *Id.* at 1122.

¹⁸³ *Id.* at 1124.

¹⁸⁴ *Id.*

for rehearing by the plaintiff and four amici parties that had not previously been involved in the case.¹⁸⁵ The U.S. Government even considered wading into the litigation.¹⁸⁶ In response to the criticism, the panel withdrew the opinion and replaced it with an opinion that makes absolutely no mention of functionality.¹⁸⁷ For a moment, it appeared that aesthetic functionality was poised to wipe out trademark rights in visual characters, a set of intangibles particularly valuable in and of themselves, but that moment was short lived.

IV. AESTHETIC FUNCTIONALITY AND TRADEMARK'S FRONTIERS WITH COPYRIGHT AND DESIGN PATENTS

As we discussed above, the Court's analysis in *TrafFix* is widely viewed as trying to demarcate more clearly the frontier between patent and trademark law, i.e., to ensure that enduring trademark rights are not established over product features that were protected by "limited times" patent law. Part I.B explored different interpretations of the Court's intent, but there is no question that a fairly bright line between trademarks and utility patents was the Court's desired outcome.¹⁸⁸

The question is whether aesthetic functionality should serve the same role in ensuring that trademark law does not provide enduring protection for product features that were subject to the limited times protection of copyright or design patent law. In fact, this might be the *first* question we need to answer for a normative account of aesthetic functionality. In *TrafFix*, the Court declined to engage the issue.¹⁸⁹

¹⁸⁵ MCCARTHY ON TRADEMARKS, *supra* note 12, § 7:80, at 7-292 to 7-293.

¹⁸⁶ The author was involved in USPTO discussions on whether to seek interagency approval for the U.S. Government to file an amicus brief in the case.

¹⁸⁷ *Fleischer Studios, Inc. v. A.V.E.L.A. Inc.*, 654 F.3d 958 (9th Cir. 2011). The case was remanded to Judge Audrey Collins who subsequently issued an opinion that could be criticized as politically and doctrinally tone deaf. Judge Collins thought "[a]lthough the Ninth Circuit withdrew *Fleischer I* and remanded the case, the reasoning set forth in *Fleischer I* is nevertheless sound and applicable." *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 925 F. Supp. 2d 1067, 1073 (C.D. Cal. 2012). She proceeded to uphold the aesthetic functionality defense, relying heavily on *International Order of Job's Daughters* and reasoning that "the Betty Boop mark as adapted from the restored Betty Boop posters is a decorative component: it is part and parcel of the aesthetic design of those goods." *Id.* at 1074; see also BARTON BEEBE, TRADEMARK LAW: AN OPEN-SOURCE CASEBOOK 232 (2014) ("[T]he district court decided that it preferred the reasoning in the withdrawn opinion and found that the *defendant's* use of the Betty Boop character was aesthetically functional. . .").

¹⁸⁸ Certainly this is how many lower courts have understood utilitarian functionality, both before and after *TrafFix*. See, e.g., *Stormy Clime Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 977-78 (2d Cir. 1987) ("Courts must proceed with caution in assessing claims to unregistered trademark protection in the design of products so as not to undermine the objectives of the patent laws.").

¹⁸⁹ *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 35 (2001) ("TrafFix and some of its *amici* argue that the Patent Clause of the Constitution, of its own force, prohibits the holder of an expired utility patent from claiming trade dress protection. We need not resolve this question.

For readers concerned about the steady expansion of intellectual property or readers simply wary of private parties that use or attempt to use trademark law to establish “perpetual” copyright or design protection, the answer may be ‘yes.’¹⁹⁰ But the picture is actually quite complex.

A. *The Trademark/Copyright Frontier*

Initially, we should distinguish copyright protection from design patent protection. Obviously, the relationship between trademark and copyright law differs greatly from the relationship between trademark and utility patent law. Volumes can be written on the interaction of copyright and trademark law,¹⁹¹ but our inquiry here is more focused. The question is: with intangibles that are or were protected by copyright, would we want a per se rule or a strong presumptive evidentiary rule (as in *TrafFix*) that expired copyright rights should bar trademark protection on aesthetic functionality grounds?

The easiest way to see that such a rule would be problematic is to consider the large category of trademarks that surely constitute “original expression” under copyright law but which were *created to be trademarks*: visual images of Elsie the Cow (1936), Uncle Ben (1943), Smokey Bear (1944), Tony the Tiger (1951), Cap’n Crunch (1963), the M&M characters; the audiovisual sequences of film studios like the MGM roaring lion (1924); the red Pegasus of Mobil Oil, Ronald McDonald (1963); and corporate logos like those of Starbucks (1971)

If, despite the rule that functional features may not be the subject of trade dress protection, a case arises in which trade dress becomes the practical equivalent of an expired utility patent, that will be time enough to consider the matter.” (citations omitted)).

¹⁹⁰ For example, Elizabeth Rosenblatt proposes using the genericity doctrine to “eliminate the ability to claim trademark rights in literary characters and character names that have entered the copyright public domain.” Elizabeth L. Rosenblatt, *The Adventure of the Shrinking Public Domain*, 86 U. COLO. L. REV. 561, 625 (2015). But she does not extend this proposal to “visual or hybrid characters.” *Id.* at 625 n.301. Concentrating almost exclusively on the problems posed by people claiming rights to “Sherlock Holmes,” Rosenblatt recognizes that even for names of literary characters, they should have the capacity to become trademarks for goods and services other than “expressive goods and services.” *Id.* at 626. Starbucks will be relieved, but her approach would still create problems for bands like Titus Andronicus and Steppenwolf, which offer “expressive services” and are named after characters from works in or soon to be in the public domain. See WILLIAM SHAKESPEARE, *TITUS ANDRONICUS*; HERMANN HESSE, *STEPHENWOLF* (1927).

¹⁹¹ For example, trademark law protects original slogans, titles, and word marks—words and short phrases of the sort to which our current copyright law denies protection. See 37 C.F.R. § 202.1(a) (2004) (Copyright Office regulations provide that copyright subject matter excludes “[w]ords and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents”). For an exploration of the reasons for the black-letter rule against copyright over titles and slogans, see Justin Hughes, *Size Matters (or Should) in Copyright Law*, 74 *FORDHAM L. REV.* 575, 612–13 (2005).

and Brooks Brothers (1850).¹⁹² All of these are enduring trademarks—marks whose commercial use may outlast any copyright protection. But we have no policy reason at all that any of these should lose their trademark protection when any copyright rights expire.

One way out of this would be to draw a distinction between original images/features that are created *for the purposes of being a trademark* and original images/features that were *later adopted as trademarks*. This would draw a line between the image of Tony the Tiger on one side and, on the other, the image of Tinkerbell, a character first created for the *Peter Pan* film, but later used by the Walt Disney Company for many years to represent the “magic” of Disney.

Perhaps this kind of distinction would work, but after we did this we would still be left with a quandary at a most basic level: why would we bar a party developing trademark rights over a small piece of original expression that *was* copyrighted and then fell into the copyright public domain when we definitely *allow* the same party to develop and perfect trademark rights over material in the copyright public domain that was never protected by copyright (such as a hieroglyphic or a well-known ancient statute) or material that our copyright law just keeps in the copyright public domain (such as short phrases, single words¹⁹³)?

Separately, there are some fundamental differences between patent law and copyright law that could affect our calculus of how trademark protection should interact with copyright. First, as discussed above, one can view some of the utilitarian functionality cases as driven by a sense that once the plaintiff chose the strong, limited times protection of patent law the plaintiff should not get a second round of IP protection via trademarks. That same thinking does not apply to copyright law simpliciter. Since copyright protection arises automatically, the graphic designer embarking on creating a new, original trademark for her clients cannot easily avoid the limited times protection of copyright law.

Second, copyrights and patents differ greatly in what the intellectual property owner has asserted and what the government has recognized. The applicant for a utility patent asserts the subject of her application is useful and nonobvious. The copyright holder—even the person who registers her copyright—asserts no such thing; if she ‘claims’ anything at all, it is only that her expression is original, not that it will be useful, valuable, good, helpful to society, or even aesthetically pleasing. And, as the *Vornado* court observed, a patent (whether utility or design) means that the design advance has been “deemed important

¹⁹² *About Us*, BROOKS BROTHERS, <http://www.brooksbrothers.com/about-us/about-us,default.pg.html> (last visited Mar. 21, 2015).

¹⁹³ See generally Hughes, *supra* note 191 (exploring doctrines against copyright in short phrases).

enough . . . for the government to grant a . . . patent.”¹⁹⁴ With copyright, there is no corresponding government decision—and no corresponding databases that would tell people when the expression has fallen into copyright’s public domain.¹⁹⁵

All this relates to copyright simpliciter. Perhaps the reasons to draw a strong line between trademark and patent may have more traction where the holder of the copyright/trademark had taken affirmative steps to enjoy the protection of the copyright system, i.e., enforcing the copyright during the copyright term (law suits, cease and desist letters). But, again, we should not penalize the holder of the Tony the Tiger image trademark who threatens a counterfeiter with both trademark *and* copyright infringement. Competent counsel representing Starbucks or MGM will sue for both trademark *and* copyright violations. So, *perhaps*, we could look to see if the plaintiff had a track record of enforcing its copyright *without asserting trademark rights* until it later decided to claim trademark protection as well. In sum, the complexities of the overall trademark/copyright relationship suggest to me that a *TrafFix*-like rule for expired copyrights does not have much purchase.¹⁹⁶

We can add to this mix the observations of this Article that the “aesthetic functionality” cases on which we can all agree are actually cases about cognitive and psychological responses among consumers that predate the putative trademark holder’s activities (the visually diminishing aspect of the color black, the taste cues of colors like pink). While a utility patent constitutes a claim that the patented feature is *useful*, a copyright has no bearing on whether the copyrighted design or image has any connection to a widespread cognitive or psychological bias among consumers. On the view of aesthetic functionality proposed here, such a connection would be rare—and should only be determined on a case-by-case basis, not a strong *TrafFix*-style presumption.

B. *The Trademark/Design Patent Frontier*

This moves us to the question of the relationship between trademark protection and design patent protection.

One could take the view that “patents are patents” and apply the *TrafFix* strong evidence standard to expired design patents vis-à-vis

¹⁹⁴ *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1510 (10th Cir. 1995).

¹⁹⁵ This last point may change with substantial improvements in either government and/or private databases as to what materials have fallen out of copyright and into the public domain.

¹⁹⁶ MCCARTHY ON TRADEMARKS, *supra* note 12, § 6:5 (concluding that it is “erroneous and a nonsequitur to state that merely because a picture is out of copyright, it is therefore ‘in the public domain’ and may be freely copied by anyone for any purpose,” and that “[s]uch a picture may have achieved trademark significance by use as a symbol of origin by another”).

aesthetic functionality. Arguably in favor of that view is the Court's 1938 *Kellogg v. Nabisco* decision: the expiration of a design patent covering Nabisco's pillow shape for shredded wheat biscuits was a separate and independent grounds for why Nabisco could not prevail in an unfair competition claim against Kellogg for copying the pillow shape.¹⁹⁷ Judge Richard Cudahy summarized this view nicely in a 1993 case:

Yet there is no basis for treating the subject matter of design and utility patents differently: if functional matter not protected by a utility patent is available for all to copy, then it follows that ornamental or aesthetic designs not protected by design patents are also free for everyone to copy.¹⁹⁸

But Cudahy wrote these words in dissent, and his reasoning—based on the patent statute—is certainly subject to criticism.¹⁹⁹ In fact, courts in recent years have seemed to view an expired design patent as substantially less troubling than an expired utility patent in any functionality analysis.²⁰⁰ To complicate matters, the *TrafFix* Court distinguished “ornamental aspects [or] features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs,” saying that those might be protectable trade dress. While this comment was clearly intended to focus the presumptive effect of an expired *utility* patent's actual claims, the

¹⁹⁷ *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111 (1938). First, the Court described how the utility patents had expired and that the pillow shape was “the form in which shredded wheat was made under the basic patent” where “[t]he patented machines used were designed to produce only the pillow-shaped biscuits.” *Id.* at 119. Then the Court noted, “[a]nd a design patent was taken out to cover the pillow-shaped form,” “[h]ence upon expiration of the patents the form, as well as the name, was dedicated to the public.” *Id.* at 119–20 (footnote omitted). Because “patents” is plural, the Court treats utility and design patents as having the same effect on dedicating the disclosed material to the public upon the patent's expiration.

¹⁹⁸ *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 648 (7th Cir. 1993) (Cudahy, J., dissenting).

¹⁹⁹ Cudahy continued:

Design and utility patents are created by the same law, 35 U.S.C. §§ 1–376 (1984). There is nothing in the patent law itself that would allow a distinction to be made between design and utility patents for purposes of extending trademark protection to one but not to the other. To the contrary, the law applicable to utility patents applies to design patents as well: “The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”

Id. (citation omitted). But our concern is the relationship between the trademark statute and the patent statute, a question that is not obviously resolved by the internal logic of the patent statute.

²⁰⁰ As Judge Cudahy himself observed, “[t]he ‘functionality’ doctrine has proved to be at best an extremely fuzzy border between design patent and trademark law.” *Id.* at 649; see *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 337 (7th Cir. 1985) (finding “no necessary inconsistency between the two modes of protection”); *In re Mogen David Wine Corp.*, 328 F.2d 925, 930 (C.C.P.A. 1964) (reasoning that when a design patent expires, “trademark rights do not extend it”); see also *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 604 (S.D.N.Y. 1996) (“A design patent is analytically distinct from a protectable trade dress, and industrial products may qualify for both kinds of protection without violating the policy goals of either patent or trade dress law.”).

comment tantalizes as to how the Court would view the same ornamentation had it been the subject of an expired design patent.

This is where we should return to the different ways to interpret *TrafFix* laid out in Part I.B. If the issue is keeping different fields of intellectual property asunder, then we have a very different context with design patents than with utility patents. The subject matter of utility patent claims can otherwise only be protected by trade secrecy law—and the election of patent protection makes a definitive choice between the two. But the subject matter of design patents can often also be protected by copyright: double protection is arguably the norm and the copyright protection will already last a better part of a century beyond the design patent.

These differences suggest that if our goal is to “channel” intangible subject matter to the “correct” IP category, the case for keeping trademarks away from the subject matter of design patterns is less compelling. This norm of copyright protection continuing beyond the design patent’s expiration also undercuts a *Vornado*-like argument that the expired (design) patent records would tell a competitor what is in the public domain.

On the other hand, if the issue is the “patent bargain,” then one could argue that where the design patentee now seeking trademark rights over a once-patented product feature, they should be in the same boat as a utility patentee. In the “bargain” analysis, the point is not for us to “channel” innovations to the right box, but that the patentee—and putative trademark holder—channeled herself.

C. *How to Prevent Perpetual Copyrights (and Perpetual Design Patents)*

Readers may rightly be concerned that any principle for the copyright/trademark frontier (or design patent/trademark frontier) with less strength than the *TrafFix* utility patent standards risks—in Justice Scalia’s *Dastar Corp. v. Twentieth Century Fox Film Corp.* formulation—“a species of perpetual patent and copyright, which Congress may not do.”²⁰¹ This is a legitimate worry, but as a sound bite it does not tell us the contours of the concern.

Let’s start with the proposition that we are untroubled by images and devices that are created *to be trademarks*, are introduced onto the market as such, and perhaps are concurrently protected (or could be protected) by copyright law. As we discussed, this is the Tony the Tiger image, the Starbucks emblem, and the MGM roaring lion. I will assume

²⁰¹ 539 U.S. 23, 37 (2003).

that no one considers enduring trademark protection of these trademarks to raise a real concern about “perpetual copyrights.” Instead, our focus should be those features where the creator of the feature initially *elected* another form of intellectual property and *not* trademark protection. These are the features, designs, or devices that were initially, proactively protected with copyright or design patent law and, then, sometime later, the owner also sought trademark rights.

Assuming the Court’s *Wal-Mart Stores, Inc. v. Samara Bros.* decision establishes that *product* features can never be inherently distinctive, product features will only acquire trademark status through the acquisition of secondary meaning. If we are concerned about trademark claims being used to create perpetual design patents, we could adopt a bright-line rule that the clock on the acquisition of secondary meaning does not begin until the “first generation” of intellectual property rights expire. If, after an “open season” period, the holder of the expired first generation IP rights remains the sole source of the product with the feature, we can be reasonably comfortable that the device is *not* needed for competition. If we are concerned that some companies would invest massively to acquire secondary meaning quickly—that is, shortening the “open season”—we could even adopt a rule that secondary meaning in a feature once protected by a design patent cannot be proven until five years of substantially exclusive use.

The virtue of this proposal is that if the design, feature, or device crosses some threshold of value to consumers, once the design patent expires, others will enter the market: there will be no substantially exclusive use on which to base secondary meaning. To understand this better, consider a 1999 observation by Glynn Lunney:

Under present doctrine, neither black jeans nor two-piece swimwear would qualify as functional, in the sense of superior to the preexisting color or style, when first introduced. Yet, assuming on that basis that no anticompetitive losses would result from assigning the exclusive right to produce such apparel color or style to its originator is foolhardy.²⁰²

I think Lunney is wrong about “present doctrine”: Under the existing case law (and the view proposed here), black as a color for jeans *would be* functional—because black is known to make objects seem smaller, it has a tremendous functionality for human body parts. But let’s assume that Lunney is correct in his premise that the functionality doctrine *by itself* would not prevent trademark rights over the color black in relation to jeans or the two-piece bikini form in relation to women’s swimwear “when first introduced.”

²⁰² Lunney, *supra* note 150, at 478 (footnote omitted).

As long as these product features cannot be inherently distinctive—the Supreme Court’s teaching in *Wal-Mart Stores, Inc. v. Samara Bros.*—then as long as these design aspects are copied by competitors within a short time frame there is never going to be the exclusive use necessary to the development of secondary meaning.²⁰³ Conversely, if we are dealing with a product feature that no one copies for a five-year period after the expiration of a design patent (or any other intellectual property to which we want to apply this rule), then there is substantially less likelihood that the product feature is needed for competition. As the T.T.A.B. said in a 2000 case concerning an application to register a particular shade of red for vacuum cleaners, “[t]he lack of demonstrated third-party use of a red color on hand-held vacuum cleaners provides further support for the position that others do not need that color in order to compete effectively in the marketplace.”²⁰⁴

In real life these fact patterns are rare—at least as the subject of litigation—but something along these lines was at issue in the disagreement between the between T.T.A.B. and the C.C.P.A. in the 1964 *In re Mogen David Wine Corp.* case.²⁰⁵ Mogen David had a design patent on a distinctive decanter bottle, issued in 1950 and set to expire in April 1964.²⁰⁶ It had used the decanter bottle for its wine since November 1956 and sought trademark registration of the trade dress. As described by the appellate court:

The board concluded that issuance of the registration sought by appellant would be inimical to the rights of others conditioned under the patent grant to make fair use of the subject matter after expiration of the patent and would thereby, in effect, extend the monopoly of the patent contrary to the intent and purpose of the patent law.²⁰⁷

In response, the C.C.P.A. panel took the relationship between a design patent and trademark rights head on, concluding that trademark

²⁰³ See, e.g., *Perk Scientific, Inc. v. Ever Scientific, Inc.*, No. Civ.A. 05-1406, 2005 WL 851078, at *3 (E.D. Pa. Apr. 11, 2005) (concluding *Wal-Mart* prohibits a finding of inherent distinctiveness in a beverage’s flavoring and composition; competitor brought same flavored products to market in “less than two years”).

²⁰⁴ *White Consol. Indus. v. Royal Appliance Mfg.*, 2000 WL 713972, at *6 (T.T.A.B. 2000). Royal Appliance Mfg. sought registration of a particular shade of red (PMS 186) for hand-held vacuum cleaners, having marketed its own red-colored DIRT DEVIL vacuum cleaner since 1994. The T.T.A.B. further reasoned that “[s]ome vague expectation that the color red might become ‘popular’ at some unidentifiable point in the future is far from sufficient to demonstrate the existence of a ‘significant’ competitive disadvantage.” *Id.* at *5. The case is a disposition that is considered not citable as precedent of the T.T.A.B.

²⁰⁵ 328 F.2d 925.

²⁰⁶ *Id.* at 926 n.2 (“Des.Pat. No. 158,213 issued Apr. 18, 1950 for a term of 14 years.”).

²⁰⁷ *Id.* at 927.

rights would not “‘extend’ the patent monopoly”;²⁰⁸ that there was nothing in the patent or trademark statutes requiring the T.T.A.B.’s approach;²⁰⁹ and that the “cessation of the patentee’s right to exclude held under the patent law” did not “guarantee[] to anyone the absolute right to copy the subject matter.”²¹⁰

But, in fact, the T.T.A.B.’s precise ruling was that the question whether the decanter bottle had acquired secondary meaning in its eight years of use by Mogen David “c[ould] be considered, if at all, only after the expiration of the design patent”;²¹¹ it also appears that the T.T.A.B. was of the view that exclusive use of a design during the period of a design patent should not be considered as “trademark use”—producing the result that I am suggesting: that the clock on establishing secondary meaning would start *only when the design patent expired*.²¹²

Reasoning along these lines can also be found in *Canadian Shredded Wheat Co. v. Kellogg Co.*,²¹³ the Privy Council’s decision in the Canadian dispute that paralleled *Kellogg v. Nabisco*. Anticipating the Supreme Court’s decision that would come a few months later, the Law Lords concluded that the term “shredded wheat” had been used by its inventor to describe and name the new product, so that protection of SHREDDED WHEAT as a trademark “would be attempting by registering the name of the patented product to prolong the patent monopoly: and this may not be done.”²¹⁴

Nonetheless, the Privy Council confronted a claim from the plaintiff “that in the interval between the expiry of the patent in 1914 and the registration of the trade mark in 1928, no one else . . . had manufactured the patented product, and that the words had in fact become distinctive of its manufacture.”²¹⁵ Writing for the Law Lords, Lord Russell actually accepts the possibility that once a patent expires, if no one else produces the product, the descriptive name could become a source identifier, but he is very doubtful that this would actually happen.²¹⁶ So, too, if for many years no one except one producer used a

²⁰⁸ *Id.* at 930 (“In our opinion, trademark rights, or rights under the law of unfair competition, which happen to continue beyond the expiration of a design patent, do not ‘extend’ the patent monopoly.”).

²⁰⁹ *Id.* at 931 (“To hold, as did the board, that an existing design patent precludes even distinctive marks from registration would be tantamount to writing an exception into the statute excluding consideration of use during the life of a design patent. This we cannot do.”).

²¹⁰ *Id.* at 930.

²¹¹ *Id.* at 928.

²¹² *Id.* at 930.

²¹³ [1938] 2 D.L.R. 145 (Can. Ont. P.C.).

²¹⁴ *Id.* at 5.

²¹⁵ *Id.* at 6.

²¹⁶ As the U.S. Supreme Court would later conclude, Lord Russell of Killowen had found that “shredded wheat” was what we would call “generic” or something close to it. He points out that “shredded wheat” was not only “descriptive of the product both as to its composition and its appearance” but also “the name given by the inventor to [the] new product.” *Id.* at 10. In the case

product feature formerly protected by a design patent or copyright, that should substantially raise our comfort level that the design feature could become a source indicator without serious loss to the public domain.

V. SENSIBLE AESTHETIC FUNCTIONALITY DOCTRINE AND MODERN
MARKETING

Just as we have overlooked how some of what we call “aesthetic functionality” is better described as “cognitive” or “psychological,” we have also overlooked an important distinction relevant to the valorization of trademarks: whether the aesthetic appeal of the claimed feature arises from *preexisting* biases among consumers *or* whether the preference arises from the activities of the putative trademark holder and its predecessors. When the consumers have specific biases in favor of the claimed trademark that predate the efforts of the putative trademark holder, courts are on the surest grounds in applying aesthetic functionality: in those cases, the court should ask “whether the recognition of trademark rights would significantly hinder competition.” But where the aesthetic appeal is actually the achievement of the trademark holder or its predecessors, courts should be hesitant to use aesthetic functionality to deny trademark rights—precisely because building such aesthetic appeal is endemic to modern marketing, building brands, and, yes, the emergence of trademarks as valuable in and of themselves.

A. *Preexisting Consumer Response Versus Trademark-Created
Consumer Response*

A series of examples may be the best way to understand the proposal that aesthetic functionality should require that the product feature appeals to cognitive, psychological, or aesthetic biases in consumers that exist *regardless of (and prior to) anything the trademark*

of a term that was simply descriptive when a patent expired, Lord Russell entertained that it was “conceivable” for the descriptive term to become a source indicator if no one else used it—and that this was even true with a term that was the name of the goods. He wrote:

It is conceivable that in the case of a patent, long ago expired, the evidence might possibly establish that the name had become distinctive of a particular manufacturer rather than descriptive of the goods, with the result that other manufacturers of the goods could be compelled to adopt some means of effectively distinguishing their goods from those of the particular manufacturer. But difficult as such a case is to prove in the case of a descriptive word, it must be additionally difficult in the case where a word is the name of goods as well as being descriptive of those goods.

Id. at 14.

creator or owner has done. The colors brown and yellow may be aesthetically functional in relation to pancake syrups because those are the colors we associate with maple syrup; blue is functional as a packaging color for nighttime medicines because we associate blue with night and sleeping. Similarly, perhaps octagonal shapes are cognitively functional in relation to products that promise to halt or arrest something (weeds, termites, dandruff, lice)—because consistent street signage in the United States since the 1920s has conditioned Americans to associate octagons with stopping something. For some feature of a product to be “aesthetically functional,” the feature should appeal to a fairly specific cognitive or perceptual bias that consumers had *before* the trademarked image’s creation or use.

Contrast this with an example of a product feature that was once mechanically functional but became purely stylistic or aesthetic: the Lincoln Mark trunk “hump.” In the 1960s through the 1980s, Ford Motor Company marketed a car—the Lincoln Continental “Mark” series—with a distinctive trunk lid spare-tire hump.²¹⁷ The hump traced back to the 1939 Lincoln, which had an exterior-mounted spare tire. After World War II, the “Mark II” integrated the spare tire into the trunk, producing a trunk lid with a distinctive “hump.”²¹⁸

According to one car enthusiast, the Mark II (1956–1958) was “the last time[] a spare tire was truly underneath the hump.” (See Image 1 below.) When the spare tire was moved to a more sensible place (under the trunk storage area), the hump was retained for *decades* as a signature stylistic aspect of the car. Image 2 below shows the 1973 model of the car with a large, but purely cosmetic spare tire hump. As new models were introduced, “the vestigial hump got smaller and more subtle.”²¹⁹ Indeed, in its last version—in the 1990s—the hump was just a stylistic echo of its functional origins.

There is no question that this feature—the rounded trunk lid hump—lost its mechanical functionality after 1958. There is also little question that this feature became distinctive of Ford’s Lincoln Continental “Mark” products. Indeed, it seems reasonable to think that, but for Ford’s efforts, a spare-tire-hiding hump might easily have been associated with *inexpensive* cars, not a high-end luxury model. But it is

²¹⁷ *Lincoln Continental Mark VI*, WIKIPEDIA, http://en.wikipedia.org/wiki/Lincoln_Continental_Mark_VI (last updated Jan. 23, 2015, 11:01 PM). My thanks to Dean Weber, archivist at Ford Motor Company, for discussions on the history of the trunklid “hump” in the Continental Mark series.

²¹⁸ According to Ford’s Vice President for Design, the feature is commonly called the “Continental hump.” Email from Dean Weber, Vice President, Ford Motor Co., to author (Jan. 20, 2015, 11:53 AM) (on file with author).

²¹⁹ *The Evolution of the Lincoln Trunk Lid Hump*, TAMERLANE’S THOUGHTS (Oct. 8, 2008), <http://karakullake.blogspot.com/2008/10/evolution-of-lincoln-trunk-lid-hump.html>. See this blog for a series of photos.

also true that there was a market for “Continental kits,”²²⁰ that were sold to consumers in order to retro-fit Thunderbirds, Cadillacs, and other cars with humped trunk lids—suggesting at least some “aesthetic” market for humped trunk lids.

Does the existence of these “kits” and consumer demand to outfit other models with trunk humps establish that the trunk hump was “aesthetically functional”? I think the answer has to be no—on the grounds that this aesthetic did not exist until Ford established it. This is quite different than a consumer preference for blue coloring in relation to nighttime medicine, black as a size-diminishing color for unsightly equipment, or a circle as an attractive shape for a beach towel (or anything else). To the degree that the trunk hump was an aesthetic cue for luxury, this psychological response among American drivers was a creation of Ford Motor Company’s marketing efforts—and *not* a basis for a finding of aesthetic functionality.



*Image 1: 1956 Lincoln Continental Mark II
Photo courtesy of Ford Motor Company*

²²⁰ *Continental Mark II*, WIKIPEDIA, http://en.wikipedia.org/wiki/Continental_Mark_II (last updated Feb. 19, 2015, 9:25 PM). For car enthusiasts, there is a long history in how Ford branded and sold Lincolns versus Continentals, but Ford Motor Company’s Continental division was later absorbed into its Lincoln division so that “Lincoln” became the house brand and “Continental” or “Continental Mark V” became the product brand.



Image 2: 1973 Lincoln Continental Mark V
Photo credit: Stephen Boskett

Among the actual cases, examples where the putative trademark holder created the aesthetic appeal of the product feature it claims might include *Truck Equipment Service Co. v. Fruehauf Corp.*²²¹ in which the plaintiff had created a unique-looking grain trailer and “[t]he appearance of the trailer was intended to be its principal selling point.”²²² Similarly, in the 1977 *In re Penthouse International* case, Penthouse had created the appeal of its female/male key symbol. (One could argue that the male and female symbols—dating back to ancient Greece—have an aesthetic appeal predating the Penthouse’s efforts, but the key symbol itself was unique and new.)

In the Ninth Circuit’s 2006 *Au-Tomotive Gold, Inc. v. Volkswagen of American, Inc.* decision,²²³ the defendant was copying the VOLKSWAGEN and AUDI trademarks for automobile accessories, particularly license plate frames and key chains. When Volkswagen refused to license its trademarks for such use, Au-Tomotive Gold

²²¹ 536 F.2d 1210 (8th Cir. 1976).

²²² *Id.* at 1218. In this case, the Eighth Circuit panel considered only a utilitarian functionality analysis and easily concluded that the copied aspects of the grain trailer were not functional in that sense: “The evidence is consistent with the conclusion that the sloping-end walls of the Cornhusker 800, arbitrarily designed for the purpose of identification, were no more than merely incidentally functional.” *Id.*

²²³ 457 F.3d 1062 (9th Cir. 2006).

proceeded anyway.²²⁴ The court recognized that these products met the *Pagliari* standard in that consumers purchased the products *for the trademarks*, but also understood that “[t]he demand for Auto Gold’s products is inextricably tied to the trademarks themselves” and that this was one of many situations where “consumer demand is difficult to quarantine from the source identification and reputation-enhancing value of the trademarks themselves.”²²⁵ In such circumstances, the panel found that the trademarks were not functional.²²⁶ Instead of Professor McKenna’s critical perspective on the *Au-Tomotive Gold* analysis,²²⁷ I believe that there was a principled reason for withholding aesthetic functionality in this case: a cognitive, psychological, or aesthetic response in consumers that is the result of the trademark holder’s efforts is not the stuff of functionality, but rather the stuff of modern marketing.

Contrast these cases with *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.* in which the Sixth Circuit held that design elements in the Abercrombie style—certain words (“performance,” “genuine brand,” “authentic”), primary color combinations, and “symbols like lacrosse sticks and the ski patrol cross”—were functional and could not be trademarked.²²⁸ Certainly the specific aesthetic appeal of these words, color combinations, and symbols was something that predated Abercrombie’s use.

To consider another example, Ann Bartow has given the hypothetical of a company that seeks trademark protection for the design of “purple batwing capes”; she reasons that such a design would be aesthetically functional because of “the quirkily appealing sartorial appearance of an incorrigible bohemian artist or an extra . . . from the set of a Harry Potter movie.”²²⁹ The analysis here agrees: to the degree that purple batwing capes have aesthetic and psychological appeal because of their long-standing association with bohemian lifestyles, royalty, or luxury,²³⁰ those consumer responses ante-date anything done

²²⁴ It has obtained licenses from several other car manufacturers. *Id.* at 1065.

²²⁵ *Id.* at 1074.

²²⁶ *Id.* (quoting RESTATEMENT (FIRST) OF TORTS § 742, cmt. a (1938) (“A feature which merely associates goods with a particular source may be, like a trade-mark or trade name, a substantial factor in increasing the marketability of the goods. But if that is the entire significance of the feature, it is non-functional; for its value then lies only in the demand for goods associated with a particular source rather than for goods of a particular design.”)).

²²⁷ McKenna, *supra* note 5, at 856 (“The court’s inability to see this distinction was driven by a combination of its mistaken view that aesthetic functionality is the opposite of source indication and the misimpression that differences in use context do not matter to the source indication question.”).

²²⁸ 280 F.3d 619, 643 (6th Cir. 2002).

²²⁹ Ann Bartow, *Counterfeits, Copying and Class*, 48 HOUS. L. REV. 707, 721 (2011).

²³⁰ Classical authors writing about the expensive process of producing “Tyrian purple” include Aristotle, Theopompus, Pliny the Elder, and Julius Pollux. *Tyrian Purple*, WIKIPEDIA, http://en.wikipedia.org/wiki/Tyrian_purple (last updated Mar. 7, 2015, 11:56 AM). Later, the

by the party claiming trademark protection; that would be the sound basis for finding aesthetic functionality.

Finally when we speak of a preexisting aesthetic response, we have to mean a fairly specific aesthetic, cognitive, or psychological response *in a broad range of the relevant (consumer) group*. The preexisting aesthetic disposition in some people for Baroque architecture and in some for Brutalist architecture is not the sort of aesthetic functionality that should count. When we speak of utilitarian or mechanical functionality, we are concerned with a level of universal, general effects—and we should require the same for aesthetic functionality. In other words, when there is actually what Robert Bone identifies as “heterogeneity of aesthetic preferences” that should, as a general rule, undermine a finding of aesthetic functionality.

This plays out in the case of single colors: there will be some colors/shades that will be aesthetically functional because they are neutral in relation to the product class or the product’s environment; black and white would be the obvious examples (separate from their *cognitive* functionality). Other colors will not “match” anything particularly well; indeed, they might even be discordant to the product or the product’s environment. There might be a small percentage of the population that *loves* a particular color, but that should not indicate aesthetic functionality. For example, in *Unique Sports Products, Inc. v. Ferrari Importing Co.*, the claimed trademark was the color light blue in relation to “grip tape for sports rackets.”²³¹ The court’s conclusion that light blue color was not functional makes sense given that tennis rackets typically have black grips and racket heads come in a variety of color combinations. The fact that a small subset of tennis players may have a personal fancy for light blue should not change that result; the preexisting aesthetic, cognitive, and psychological responses that concern us should be ones across a broad range of the consumers in question.

Similarly, the preexisting aesthetic response among consumers must be fairly *specific* in relation to the claimed mark. We cannot bar *beautiful* trademarks on the grounds that consumers have a general predisposition for the beautiful, no matter what the Supreme Court has

production and use of purple was associated with the imperial court in the Byzantine Empire. See AMY BUTLER GREENFIELD, *A PERFECT RED: EMPIRE, ESPIONAGE, AND THE QUEST FOR THE COLOR OF DESIRE* 20–21 (2005) (discussing how “imperial purple” was “one of the preeminent symbols of power and prestige in the classical world”); DAVID JACOBY, *Silk in Western Byzantium Before the Fourth Crusade*, in *TRADE, COMMODITIES AND SHIPPING IN THE MEDIEVAL MEDITERRANEAN* (1997).

²³¹ No. 1:09-CV-660-TWT, 2011 WL 5156798, at *1 (N.D. Ga. Oct. 27, 2011). In a prior settlement agreement with a different party, the plaintiff’s “light blue” had been described in relation to twelve Pantone colors. *Id.* at *2. The court had also determined in a prior ruling that the plaintiff’s light blue trademark was not functional. *Id.*

said about a “touch of beauty.” Consider the somewhat confusing treatment of aesthetic functionality in the 2013 *Apple, Inc. v. Samsung Electronics Co.* litigation.²³² The evidence showed that Apple had chosen the design of the iPhone for aesthetic reasons and that “the beauty of the iPhone is a factor in its success.”²³³ On this basis, Samsung argued—in *Pagliero* style—that the iPhone design was aesthetically functional. The court rejected this argument not on doctrinal grounds, but on the grounds that Samsung had argued just the opposite—that “few consumers are primarily motivated by design considerations such as aesthetics” elsewhere in the case.²³⁴ On the basis of “the limited role of aesthetics in purchasing decisions,” the court found that “Samsung did not need to infringe Apple’s trade dress in order to compete with the iPhone.”²³⁵

The implication is that if aesthetics played a big role in smartphone purchasing decisions (as many of us think), Samsung could have “need[ed] to infringe Apple’s trade dress in order to compete with the iPhone.” The flaw is in thinking that if something is *one of many ways* to meet the *general* consumer aesthetic for a “touch of beauty” we would have an aesthetic functionality situation. That neither is nor should be the aesthetic functionality case law. Aesthetic functionality should bar protection of the iPhone shape only when we can say that before the iPhone existed consumers had a preexisting bias *for that particular shape*.

B. Using Aesthetic Functionality to Patrol for Overbroad Claims

Aesthetic functionality focused on *preexisting* cognitive, psychological, or aesthetic responses can help us curb lawyers’ overbroad trademark claims to product features.²³⁶ Simply put, when trademark claims get too broad they tend to claim features that directly connect to preexisting cognitive or psychological propensities among consumers.

A good example of this is the Sixth Circuit’s 2012 decision in *Maker’s Mark Distillery, Inc. v. Diageo North America, Inc.*,²³⁷ a lawsuit concerning Jose Cuervo’s imitation of Maker Mark’s distinct red dripping wax covering the cap and neck of its bourbon bottles. Maker’s

²³² 920 F. Supp. 2d 1079 (N.D. Cal. 2013).

²³³ *Id.* at 1096.

²³⁴ *Id.*

²³⁵ *Id.*

²³⁶ *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 115 (2d Cir. 2001) (trade dress does not protect “overbroad or ‘generic’” product features); *see also* *New Colt Holding Corp. v. RJG Holdings of Fla., Inc.*, 312 F. Supp. 2d 195, 203 (D. Conn. 2004).

²³⁷ 679 F.3d 410 (6th Cir. 2012).

Mark had applied red dripping wax to its bottles since 1958 and had received a federal trademark registration in 1985 for the trade dress, described as a “wax-like coating covering the cap of the bottle and trickling down the neck of the bottle in a freeform irregular pattern.”²³⁸ There was no question that Maker’s Mark²³⁹ had succeeded in making the dripping red wax into a source identifier and indeed perhaps “one of the most recognizable branding symbols in the world.”²⁴⁰ The Sixth Circuit upheld the trial court’s order enjoining Cuervo “from using red dripping wax on the cap of a bottle in the sale, offering for sale, distribution or advertising of Cuervo tequila products.”²⁴¹

What is useful for us is that the *Maker’s Mark* litigation points out how an aesthetic functionality problem can depend on the *scope* or *breadth* of trademark protection being claimed. Although sealing a bottle with wax is no longer an efficient, functional packaging technique, it is certainly still *aesthetically attractive*. Such packaging can elicit a psychological response that a product is *old* (either this particular exemplar or its recipe) or *traditional* (the recipe or production technique). This aesthetic response to dripping wax predates Maker’s Mark’s commercial activities.

But in *Maker’s Mark*, the plaintiff stipulated that it only sought to protect its trade dress as *red dripping wax*. This allowed both the district court and the appellate court to rebuff Cuervo’s aesthetic functionality claim on the grounds that “[t]here is more than one way to seal a bottle with wax to make it look appealing”²⁴² and that “red wax is not the only pleasing color of wax . . . nor does it put competitors at a significant non-reputation related disadvantage to be prevented from using red dripping wax.”²⁴³ In other words, the stipulation helped distinguish a general, preexisting aesthetic response from the consumer response that Maker’s Mark had engendered through over half a century of marketing.

Another example is the 1990 *Wallace International Silversmiths, Inc. v. Godinger Silver Art Co.* case in which the Second Circuit found that the plaintiff could not claim trademark rights to a baroque pattern design for silverware.²⁴⁴ The court’s result clearly turned on Wallace’s claimed trademark being too broad:

²³⁸ Registration No. 1370465; see 679 F.3d at 417. During the litigation with Diageo, Maker’s Mark stipulated that it only sought to protect the trade dress in relation to red colored wax. *Id.*

²³⁹ 679 F.3d at 414.

²⁴⁰ *Id.* at 421 (quoting a *Business Week* article from 2002) (internal quotation marks omitted).

²⁴¹ *Id.* at 417 (internal quotation marks omitted).

²⁴² *Id.* at 418.

²⁴³ *Id.* at 418–19 (alteration in original).

²⁴⁴ 916 F.2d 76 (2d Cir. 1990).

In the instant matter, Wallace seeks trademark protection, not for a precise expression of a decorative style, but for basic elements of a style that is part of the public domain. As found by the district court, these elements are important to competition in the silverware market.²⁴⁵

These “elements,” are important to competition in the silverware market because there was a substantial, acculturated, preexisting response among consumers for ornate, baroque decorative styles. It is certainly not all consumers, but it is a substantial group. The Second Circuit panel went on to say “if Wallace were able to show secondary meaning in a precise expression of baroque style, competitors might be excluded from using an identical or virtually identical design.”²⁴⁶ In short, the trademark claim failed because the plaintiff was trying to “monopolize too broad an aesthetic category.”²⁴⁷

The *Jay Franco* case offers a third example. Having held that the round design of a beach towel was technically functional, Judge Easterbrook turned to aesthetic functionality. He concluded, quite correctly, that the plaintiff “want[ed] a trademark on the circle” and reasoned that “granting a producer the exclusive use of a basic element of design (shape, material, color, and so forth) impoverishes other designers’ palettes,”²⁴⁸ i.e., would put other designers at a nonreputational disadvantage. This is part and parcel of the more general rule that “the more rudimentary and general the element . . . the more likely it is that restricting its use will significantly impair competition.”²⁴⁹

We can add that “the more rudimentary” a design feature is, the more likely the aesthetic or cognitive appeal of the feature—at the claimed level of protection—predates any creative, promotional, or marketing efforts by the party claiming trademark rights. In short, the broader, more general the claim of trademark rights—such as in a basic shape or a range of colors—the more likely the aesthetic appeal is of a broad sort that existed before the trademarked feature appeared on the

²⁴⁵ *Id.* at 81.

²⁴⁶ *Id.* at 82.

²⁴⁷ *Krueger Int’l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 606 (S.D.N.Y. 1996) (then-Judge Sotomayor describing the *Wallace* decision).

²⁴⁸ *Jay Franco & Sons, Inc. v. Franek*, 615 F.3d 855, 860 (7th Cir. 2010).

²⁴⁹ *Id.* A 2007 trademark decision of the European Court of Justice (ECJ) could also be interpreted this way. In Case C-321/03, *Dyson Ltd. v. Registrar of Trade Marks*, 2007 E.C.R. I-00687, the Court of Justice of the European Union held that the vacuum cleaner company Dyson could not register as a trademark “any kind of transparent collecting bin . . . irrespective of its shape” because such a broad characteristic was a “mere property of the product concerned” and would give an “unfair competitive advantage.” *Id.* ¶¶ 38–39.

market: that produces a more appropriate context for a court to find aesthetic functionality.

C. *The “Matching” Cases and Market Definition Issues*

It is time to return to the “matching” cases, particularly *Deere & Co. v. Farmhand, Inc.* Does my proposal change the result in that case? The “aesthetic” for green farm equipment did not predate John Deere’s extensive use of the color. In fact, prior to Deere’s commercial success, there might have been a cognitive functionality basis in favor of farm equipment that was red, orange, or yellow, i.e., that would be easy to see against verdant fields.

On the other hand, the instinct to match the colors or styles of things used together—the “farmers desire to ‘match’ their loaders to their tractors”—is an aesthetic or cognitive response that predates John Deere’s efforts. The problem is that if “matching” is broadly acceptable as a foundation for aesthetic functionality, it could cut back trademark protection far beyond what *Pagliero* would have done. Once a girl buys one Barbie doll, she will want that doll’s playmates to match; once a woman buys one Gucci bag with its distinctive red/green/beige stripe, she may want shoes and other accessories to match.

We could limit “matching” aesthetic functionality to capital investment situations of the kind we have already discussed, i.e., that in *Deere* and the architectural cases the consumer has already made (or is making) a substantial capital investment and what competitors need to match or coordinate their products with that capital investment should be open to all.

As we discussed above, it is apparent that this is really an argument about distinct markets for competition. (In that sense, it is no surprise that the defendant in *Deere* had brought an antitrust counterclaim.) Along those lines we could try to draw rough notions of the capital investment already made that would establish a discrete market. This issue has been argued in terms of replacement goods. Decades after *Pagliero*, aesthetic functionality in china patterns was litigated to a different result in the Second Circuit’s 1993 *Villeroy & Boch Keramische Werke K.G. v. THC Systems, Inc.* decision.²⁵⁰ The defendant argued that if it was unable to copy the plaintiff’s china patterns it would be unable to provide replacement china to institutions that had made a large initial investment in dinnerware.²⁵¹ Viewed charitably, the appellate panel’s

²⁵⁰ 999 F.2d 619 (2d Cir. 1993).

²⁵¹ *Id.* at 621 (“THC’s claim that hotels typically buy china once every seven years and that they are foreclosed from providing replacement china to hotels using the Basket design without copying the Basket pattern is not enough to meet the market foreclosure test for functionality.”).

response was that the defendant had not shown that replacement china was a separate market.²⁵²

The replacement goods argument figured much more prominently in the Seventh Circuit's *W.T. Rogers Co. v. Keene* case, where the defendant argued that it should be able to copy Rogers' hexagonal design for stackable office trays because "the decor compatibility of stacked trays requires that any manufacturer of such trays be allowed to use the same shaped end panel as any other."²⁵³ Judge Posner's response was, essentially, that the sunk capital investment was not enough to establish a separate market: stacking trays "are cheap items and if someone came along with a more elegant design many office managers would be willing to replace an entire stack on some, perhaps all, of the desks in the office."²⁵⁴ Posner's very word choice demonstrated that he did not think the demand for replacement and supplemental trays was a discrete market.²⁵⁵

But Posner also concluded that the problem could not be cabined this way and that any argument "about décor compatibility . . . is an open Sesame to trademark infringement." In the spirit of the Barbie and Gucci examples I gave earlier Posner wrote:

[A] feature is not functional merely because, if someone happens to own an item that has the feature, he might want any other item displayed or connected with it to have the identical feature so that the two items would look alike, would be a matched pair.²⁵⁶

In fact, the "replacement goods" argument is just the iceberg tip of a broader argument that trademarks—or *some* trademarks—become product categories and markets unto themselves.²⁵⁷ This puts us in an apparent antinomy: the exclusive rights of trademark law are intended to foster product differentiation but at some point product

²⁵² *Id.* ("The long term nature of the buying patterns in the hotel china market may make it difficult for THC to persuade a hotel to switch to a new pattern once it has started with the Basket design, but THC has not made the necessary showing that it is at a significant competitive disadvantage in making the initial sale without the basket pattern.").

²⁵³ 778 F.2d 334, 343 (7th Cir. 1985). The court noted "[t]he premise of the argument is that a stack of trays with differently shaped ends would be ugly." *Id.*

²⁵⁴ *Id.* at 344.

²⁵⁵ *Id.* ("[A]s an office's existing stack wears out or as new companies spring up or new offices are built a new manufacturer with a differently shaped end panel will find a ready market. Rogers was able to enter the market successfully with a tray shaped differently from the then dominant rectangular shape; why should other producers have greater difficulty?" (emphases added)).

²⁵⁶ *Id.* at 346–47. Posner's own example is matching Rolls-Royces. *Id.* at 344.

²⁵⁷ Lemley & McKenna, *supra* note 39, at 2065 ("[T]o the extent [functionality] decisions are based on conclusions about competitive need for a feature, courts must engage in market definition. . . . And courts appear to define markets in these cases entirely by their own intuition."); see also Erin M. Harriman, *Aesthetic Functionality: The Disarray Among Modern Courts*, 86 TRADEMARK REP. 276, 300 (1996) (recognizing market definition issues are both key and difficult); Diana Elzey Pinover, *Aesthetic Functionality: The Need for a Foreclosure of Competition*, 83 TRADEMARK REP. 571 (1993).

differentiation arguably creates distinct markets that are de facto controlled by trademark holders, giving us an incentive to weaken or eliminate the trademarks' exclusive rights to foster competition in those discrete markets. How to handle this broad problem of trademark law is beyond the scope of this Article, although my own intuition is that product differentiation of the sort fostered by trademark law rarely creates distinct markets, i.e., that Pepsi and Coke *do* compete in the same market.

In the specific context of the "matching" cases the poster child question is whether *John Deere* involved a preexisting cognitive disposition (to "match" products) or a cognitive disposition fostered by John Deere's own marketing (a preference for 'John Deere green'). The answer has to be that the preexisting bias that counts for aesthetic functionality must be fairly specific, i.e., there must be a specific "fit" between the preexisting bias and the claimed trademark. Any other view of "matching" aesthetics creates the problems we discussed for Barbie dolls, fashion wear, china patterns, stackable office trays, sports insignias, and automobile accessories. This conclusion might put the *John Deere* decision in doubt, but better to question one district court case than a group of well-reasoned appellate decisions.²⁵⁸

CONCLUSION

In 1985, Richard Posner expressed doubt that any "simple rule" could be devised to decide aesthetic functionality cases.²⁵⁹ This is in part because the doctrine is quite poorly named: classic "aesthetic functionality" cases are less about "a search for subjective impulses"²⁶⁰ or "the heterogeneity of aesthetic preferences" and more about longstanding cognitive, perceptual, and psychological biases lining up closely with product features over which parties claim trademark rights. The inability to devise a "simple rule" is also rooted in aesthetic functionality claims being a battleground for trademarks that are valuable intangibles, in and of themselves.

If aesthetic functionality is to be a stable and sensible doctrine, we have to decide how it will respond to this valorization of trademarks, whether it is Tony the Tiger's image, the interlocking Gucci Gs, sports

²⁵⁸ See, e.g., *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062 (9th Cir. 2006).

²⁵⁹ *W.T. Rogers Co.*, 778 F.2d at 340 ("It is doubtful that any simple rule could be devised to decide these cases.").

²⁶⁰ *Vuitton et Fils S.A. v. J. Young Enters.*, 644 F.2d 769, 774 (9th Cir. 1981) ("It is almost tautological to say that any inquiry into aesthetics requires a search for subjective impulses, difficult to quantify or specify.").

team mascots, or a car trunk “hump” that once signaled a spare tire underneath. Saying that these trademarks are aesthetically functional is simply untenable—because that would wipe out much of modern marketing, branding, and trademark law.

The alternative proposed here is a vigorous aesthetic functionality doctrine that prevents private parties from gaining market advantages that arise from exploiting widely-shared, preexisting cognitive, psychological, or aesthetic responses among consumers. This explanation fits the vast bulk of the case law, stabilizes the doctrine, and gives us a sensible tool for trademark law moving forward.