

UCL Institute of Brand & Innovation Law
12 February 2020

UCL

What is the function of functionality in trade mark law?

Mark P McKenna
John P. Murphy Foundation Professor of Law, Notre
Dame Law School, USA

34

Functionality: The US Experience

Mark P. McKenna
John P. Murphy Foundation Professor of Law

 UNIVERSITY OF
NOTRE DAME
The Law School

35

Protection for Unpatented Designs



Right to Copy vs. Need to Copy

36

Right to Copy



Both zithers are adapted for the use of patented sheets of music, but the zithers are not patented. Under such circumstances the defendant has the same right that the plaintiff has to manufacture instruments in the present form, to imitate the arrangement of the plaintiff's strings or the shape of the body. **In the absence of a patent the freedom of manufacture cannot be cut down under the name of preventing unfair competition.**

It is true that a defendant's freedom of action with regard to some subsidiary matter of ornament or label may be restrained, although a right of the same nature with its freedom to determine the shape of the articles which it sells.



Flagg Mfg. v. Holway,
178 Mass. 83 (1901)

37

Need to Copy



In the first place it appears that the oval shape adopted by the plaintiff was uncommon, although not entirely novel, and that it was uneconomical, and less convenient and satisfactory generally for the cutting of slices for all kinds of uses than the shapes generally adopted. **There was nothing to show that the defendants' business interests required the combination of this shape with the same size, color and general visual appearance that had become associated with the plaintiff's trade in this Creamalt bread.**



These that the defendants adopted had been combined to distinguish the plaintiff's Creamalt bread, and it was the duty of other manufacturers to recognize this fact. **Not, indeed, to the abandonment of their right to do what was reasonably necessary to success in the management of their own business; but to the extent of so conducting their business as not unreasonably and unnecessarily to interfere with the plaintiff's business through deception of the public.**

George G. Fox Co. v. Hathaway, 199 Mass. 99 (1908)

38

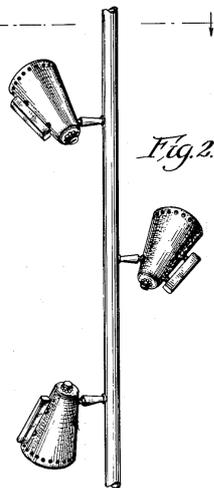
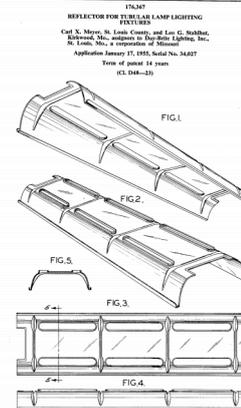


Fig. 2.

United States Patent Office Des. 176,367
Patented Dec. 15, 1952



Hence, upon expiration of the patents the form, as well as the name, was dedicated to the public.

An unpatented article, like an article on which the patent has expired, is in the public domain and may be made and sold by whoever chooses to do so.

But if the design is not entitled to a design patent or other federal statutory protection, then it can be copied at will.

39

In Re Morton-Norwich



Utilitarian means superior in function or economy of manufacture which *superiority is determined in light of competitive necessity to copy*

1. A utility patent that discloses the utilitarian advantages of the design
2. Advertising materials in which the originator of the design touts its utilitarian advantages
3. Facts tending to establish the unavailability to competitors of alternative designs
4. Facts indicating that the design results from a comparatively simple or cheap method of manufacturing the product or container



40

Functionality in *Qualitex*



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.



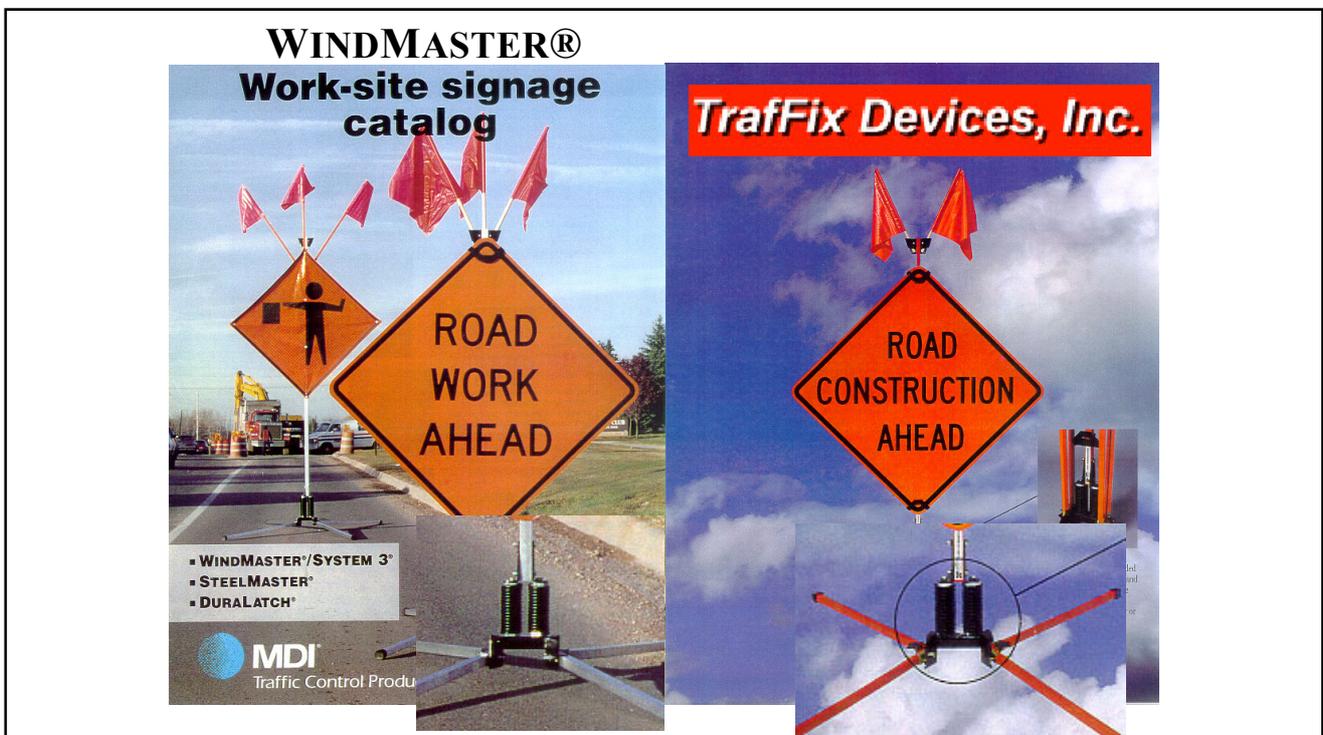
41

Functionality in *Qualitex*



The upshot is that, where a color serves a significant non-trademark 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 (non-trademark-related) competition through actual or potential exclusive use of an important product ingredient.

42



43

Functionality in *TrafFix*



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

It is proper to inquire into a “significant non-reputation-related disadvantage” in cases of aesthetic functionality; where the design is functional [because it is essential to the use or purpose or affects cost or quality] there is no need to proceed further to consider if there is a competitive necessity for the feature.

- Expired utility patent has “vital significance” and creates a strong inference of functionality
- Inference can be overcome by showing design feature is *ornamental, incidental, or arbitrary*.

44

TrafFix and Alternative Designs



There is no need ... to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. The dual-spring design is not an arbitrary flourish in the configuration of MDI’s product; it is the reason the device works. Other designs need not be attempted.

45

Post-*TrafFix* Issues

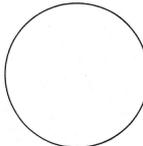
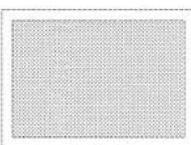
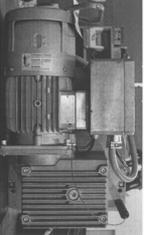


- Is the *TrafFix* test one test or two?
- What does it mean for features to be “essential to the use or purpose” of an article?
 - Role of alternative designs?
 - Relationship to “arbitrary, incidental, or ornamental”?

46

Emerging Consensus?



			
5th Circuit	6th Circuit	Federal Circuit (applying 9th Circuit law)	Federal Circuit
			
11th Circuit	7th Circuit	7th Circuit	4th Circuit
			
3d Circuit		9th Circuit	7th Circuit

47

Not so Fast ...



(1) the existence of a utility patent, expired or unexpired, that involves or describes the functionality of an item's design element; (2) the utilitarian properties of the item's unpatented design elements; (3) advertising of the item that touts the utilitarian advantages of the item's design elements; (4) the dearth of, or difficulty in creating, alternative designs for the item's purpose; (5) the effect of the design feature on an item's quality or cost.

48

Post-*TrafFix* Issues



- Is the *TrafFix* test one test or two?
- What does it mean for features to be “essential to the use or purpose” of an article?
 - Role of alternative designs?
 - Relationship to “arbitrary, incidental, or ornamental”?
- How, and at what level of specificity, must the features be disclosed in a utility patent in order for the patent to have “vital significance”?

49

McAirlaids & Georgia Pacific



50

Post-*TrafFix* Issues



- Is the *TrafFix* test one test or two?
- What does it mean for features to be “essential to the use or purpose” of an article?
 - Role of alternative designs?
 - Relationship to “arbitrary, incidental, or ornamental”?
- How, and at what level of specificity, must the features be disclosed in a utility patent in order for the patent to have “vital significance”?
- **Aesthetic functionality and design patents?**

51



52

Jay Franco & Sons



“Fashion is a form of function.”

53

Louboutin v. YSL

