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EDITORIAL NOTE

Intellectual Property is the key driver to propel the economic growth of a nation. Hence, understanding IP gains utmost significance not only from a business point of view but also from a socio-economic perspective. We as nationals of any country should be vigilant in protecting and defending our IP rights. However, there are multiple issues and challenges that need discussions, and reforms. The IP Press Law Review (IPPLR) is an initiative of The IP Press to extend our objectives of spreading awareness on the issues concerning intellectual property rights and related laws. It aims to promote study and research in the field of intellectual property laws in the form of academic literature. This issue reflects some of the key concerns of the Intellectual property regime both under national and international parlance. It is envisioned to embody some of the most brainstorming insights that help readers to grasp the discourse around contemporary developments in the field of Intellectual Property Law. Throughout the year, the editorial board has reviewed the papers with multiple rounds of editing to ensure quality and standard.

This issue presents intriguing issues and challenges pertaining to intellectual property law in the national as well as the international regime. The first paper encapsulates the protection of personality rights under Intellectual property laws and briefly presents the status of multiple jurisdictions. The second paper discusses a pertinent issue of protection of fictional characters that have been a cause of concern in many disputes. The author discusses the theoretical framework and analyses various tests laid down by the judiciary.

The third paper explores religion as a subject and object of the trademark. The author determines the legality of the trademark of religious symbols for private companies and religious organisations. The fourth paper presents a policy discussion on the overlap between trademark and functionality doctrine. The fifth submission deals with the congruence of intellectual property assets in combination and corporate restructuring wherein the author states that IP has immense power to help businesses to grow and hence its valuation becomes an important aspect of commercialization of IP. The sixth paper demonstrates how open-ended section 57 of the Copyright Act, 1957 is which leads to ambiguity. The author asserts reforms in the current provision of moral rights. The seventh paper discusses the recent dissolution of the intellectual property appellate board in the backdrop of the Tribunal Reform Bill, 2021. The eighth paper discusses the relevance of IP Due diligence and suggests quarterly checks and steps carry out the due diligence process to combat the closing down of businesses and lifelong losses. The ninth paper presents analyses of the patent denials in the biotechnology sector and their impact on the industry. The tenth paper presents an interesting analysis of trademarkability of non-conventional trademarks due to hindrances of graphical representation and discusses multiple judgements of the European courts. The last two items present an analysis of two landmark cases, one Monsanto case and two, Phonpe v. Bharatpe trademark tussle.

Happy reading!

- 1 PROTECTION OF PERSONALITY AND IMAGE RIGHTS- A COMPARATIVE ANALYSIS**
Lucy Rana, Shilpi Saran
- 12 ANALYSIS OF PROTECTION GIVEN TO FICTIONAL CHARACTERS AND ITS OWNERS IN COPYRIGHT LAW-**
Aishwarya Srivastava
- 33 TRIALS AND TRIBULATIONS OF TRADEMARKING RELIGION IN INDIA**
Pavitra Naidu
- 47 TRADEMARK ANALYSIS IN PERSPECTIVE OF THE FUNCTIONALITY DOCTRINE**
Konark Pratap Gupta
- 61 THE CONGRUENCE OF INTELLECTUAL PROPERTY ASSETS IN COMBINATION AND CORPORATE RESTRUCTURING-**
Shantanu Sharma, Prutha Bhavsar
- 73 MORAL RIGHTS AND ITS SHORTCOMINGS IN INDIA**
Vrishti Shami
- 81 JUSTIFYING THE DISSOLUTION OF THE INTELLECTUAL PROPERTY APPELLATE BOARD IN THE BACKDROP OF THE TRIBUNAL REFORM BILL, 2021**
Anirudha Sapre
- 97 IP DUE DILIGENCE: COMBATTING WINNER'S CURSE!-**
Harsha Aswani

- 118 DENIAL OF PATENTS IN THE BIO-TECHNOLOGY SECTOR AND ITS CONSEQUENCES ON INDUSTRY DEVELOPMENT**
Aryan Shah
- 129 NON-CONVENTIONAL MARKS: GRAPHICAL REPRESENTATIONS AND CONTEMPORARY PROBLEMS**
Doyita Mukherjee
- 142 MONSANTO CO V. STAUFFER CHEMICAL CO: THE EXPERIMENTAL USE EXCEPTION**
Anusrita Ranjan
- 146 A CRITICAL NOTE ON THE DELHI HIGH COURT'S RULING IN THE PHONEPE VERSUS BHARATPE TRADEMARK TUSSE**
Ritwik Guha Mustafi

TRADEMARK ANALYSIS IN PERSPECTIVE OF THE FUNCTIONALITY DOCTRINE

Konark Pratap Gupta*

ABSTRACT

Functionality is one of the most important doctrines, but it is also one of the most confused and unstable doctrine in the trademark regime. Functionality law would bar protection for the distinctive shape of a wrench if that shape substantially improves the leveraging ability of the wrench, and it would do so even if the use of the same shape by the defendant were likely to cause consumer confusion. However, not all trade dress are barred, and the functionality law challenge is to determine who is and who is not — and why.

This paper traces the history of the doctrine of Functionality, examines the different justifications stand. It argues that the muddled state of functionality law today stems from lack of clarity and rigor at the normative level. Courts and commentators do not focus carefully enough on the policy justifications for the rules they adopt; they stress the benefit of broad functionality without adequately considering its costs or appreciating the tricky practical problems involved in the formulating the administrable rule.

Keywords: - economics of trademark law, functionality doctrine, intellectual property, trademark law, trademark history, TrafFix Devices and trademark policy.

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1. INTRODUCTION

In modern trademark law, functionality is one of the most important doctrines, but it is also one of the most confused and unstable. The purpose of the doctrine, it is said, is to policing the boundary between, on the one hand, trademark and, on the other, patent and copyright, and to prevent trademark law from hindering competition on the product market. It achieves these objectives by blocking protection for source-identifying product features—so-called trade dress—when those features contribute to the product's functional performance. Modern functionality law, for example, would bar protection for the distinctive shape of a wrench if that shape substantially improves the leveraging ability of the wrench, and it would do so even if the use of the same shape by the defendant is likely to cause consumer confusion. However, not all trade dress is barred, and the functionality law challenge is to determine who is and who is not — and why.

This paper traces the history of the doctrine of functionality, examines the different justifications offered to support it, and analyses its political foundations critically. It argues that the muddled state of functionality law today stems from lack of clarity and rigor at the normative level. Courts and commentators do not focus carefully enough on the policy justifications for the rules they adopt; they stress the benefits of a broad functionality bar without adequately considering its costs or appreciating the tricky practical problems involved in formulating administrable rules. In particular, many defenders of a broad functionality bar cite the doctrine's role in enforcing a supposed "right to copy" any features not protected by patent or copyright. However, they invoke this right to copy without explaining how or why the alleged right can trump trademark policies.

This paper examines these policy arguments in a critical manner. It subjects the right to copy to careful analysis and concludes that, to determine the scope of the functionality bar, it is not actually a right at all, but rather a public domain policy to be balanced against trademark policies. Combining this public domain policy with trademark protection policies, the chapter outlines an analytical approach to designing optimal rules on functionality and proposes reforms that significantly alter existing law on functionality.

2. DEFINING TRADEMARK

A trademark referred to in S.2 (1) (zb) of the Trademarks Act means "a mark capable of being graphically represented and capable of distinguishing the goods or services of one person from those of others, including the shape of the goods, their packaging and the combination of colors." From a cursory reading of the same, it can be seen that the definition is quite open. Any mark, whether a word, device, brand, heading, letter, number, etc., may be registered as a trademark if it is capable of distinguishing one person's goods and services from another. Although the aforementioned whole finds place in the definition of a mark, there are certain marks such as smell and single colors that cannot be found in the Act.

However, they can still be protected and given the status of a mark. Functionality is one of the most important areas of trademark law, but also one of the most confusing and unsettled. The functionality doctrine bars, when applicable, trademark protection for source-identifying product features that contribute to a product's functional performance. For example, modern functionality law would bar protection for the distinctive shape of a wrench that significantly enhances the leveraging ability of the wrench, even when consumers associate the shape with the wrenches of the plaintiff and are likely to be confused by the use of the same shape by the defendant. However, this simple doctrine statement dissimulates a host of tricky normative and doctrinal issues. Courts and commentators disagree about what functionality means, why functional marks should not be protected, and how far the functionality bar should extend.¹

The functionality doctrine of the trademark works differently. The purpose of mark law is not to encourage innovation, but rather to protect source identification symbols used by consumers to access product quality information. As a result, there are no per se "subject-matter exclusions"; any kind of symbol can qualify for protection as long as it is capable of identifying source, including subject matter within the domains of patent and copyright. This means that trademark functionality is not about assigning subject matter properly. However, it is unclear what it is about. Some jurists argue that the main purpose of the doctrine is to promote competition on the product

¹ Most commentators agree that functionality law is a confusing mess today. See, e.g., Dinwoodie & Janis (2014) at 159–160 (noting that scholars disagree about much of functionality law but they all agree that "neither courts nor jurists have successfully formulated a consistent and workable approach to functionality").

market. Others argue that in enforcing a general right to copy, or at least a right to copy those features that were once patented, it has an important role to play. These disagreements at the policy level generate confusion at the level of doctrine.

A. Law in the U.S.

Trademarks in the United States are governed by the 1946 Lanham Act. As a pre-requisite for filing a trademark application, the Lanham Act does not require graphical representation. Unconventional marks in the U.S. are therefore easy to register. To put it simply, any mark that is non-visual in nature would only require a detailed verbal description for it to be considered for registration.²

B. Law in India

Both U.S. trademark law and the UK influence the Trademark Act, 1999. The functionality doctrine, which is an essential part of U.S. law, is also found in Indian trademark law. Similarly, for a mark to be granted registration in both Indian and UK law, graphical representation is mandatory.

Even if a mark is not inherently distinctive, it is still possible for brand owners to apply for a mark if the mark has acquired distinctive features due to its long-term use. This applies mostly to marks of color. It is not easy to establish the combination of colors or single colors as being inherently distinctive. The applicant must provide evidence during the application to show that the color or color combination is solely associated with them and designates their goods exclusively and the public associates the color with the goods of the application. The burden of proof is on the applicant to demonstrate that the color has acquired distinctive or secondary significance”.

3. HISTORY OF DOCTRINE OF FUNCTIONALITY

Functionality is the doctrine of the mark designed to deal with this issue. When applicable, the functionality doctrine bars protection for useful or aesthetically pleasing trade dress even when consumers are likely to be confused by using the same trade dress by the defendant. Much of the controversy over the scope of the doctrine has to do with what is required to bar protection beyond

²Harsimran Kalra, ‘Unconventional trademarks: the emergent need for a change’ (2010) Indian Law Journal <http://www.indialawjournal.org/archives/volume4/issue_1/article_by_harsimran.html>.

the fact that the feature serves some utilitarian or aesthetic purpose important to the product's value.³

In this paper, author examines the functionality doctrine's development (i.e., the rise) and collapse (i.e., the fall). Author describes an important common law battle, an effort that has resulted in a coherent, workable limitation on the protection of trademarks for non-traditional product identification. The doctrine produced by this struggle denied the protection of trademarks to the features of the product needed for free and vigorous competition. Under this competitive need standard, such features were considered functional. Although the "functional" label may have been somewhat misleading, when *TrafFix* was decided, "the competitive need standard was well established in federal courts".

Author identifies three possible solutions to the *TrafFix* problems. All three require that the *TrafFix* analysis be completely rejected. The first solution, and perhaps most obviously, is to return to the standard of functionality of the competitive need. This solution would essentially bring the law back to its pre-*TrafFix* state, although doing a little more would be helpful. The circuit courts were divided on how to deal with claims involving elements of an invention previously patented. A number of commentators have argued for a broad right to copy unpatented articles and particularly articles previously patented. The concern raised by these commentators is that the overbroad protection of trademarks for such articles could undermine the patent system's balance. Almost all courts rejected these arguments, but one, the Tenth Circuit Court of Appeals, adopted a special rule for cases involving previously patented articles involving commercial dress. Together with *TrafFix*, this isolated decision should be explicitly rejected and the competitive requirement standard applied as the sole limitation on the scope of mark protection for unpatented, distinctive product features. Finally, this first solution should also make it clear that aesthetic and utilitarian features do not need to be distinguished". The second solution requires the removal of functionality as an element of commercial dress claims and adopts a limited defence of functionality in its place. This proposal may be more controversial than the first, partly because it is so well established in

³ Courts sometimes express this point by distinguishing between de facto functionality and de jure functionality. See, e.g., *Vornado Air Circ. Sys., Inc. v. Duracraft Corp.* 58 F.3d 1498 (10th Cir. 1995). Trade dress is de facto functional when it is functional in the ordinary lay sense; that is, when it actually contributes to what the product is supposed to do. Trade dress is de jure functional when it is legally barred from trademark protection. Thus, de facto functionality is a necessary but not a sufficient condition for de jure functionality.

modern practice to treat functionality as an element of a trade dress infringement claim. Sometimes old habits die hard. However, there are good reasons for rejecting the established practice in this case.

A front-end filtering rule is the modern functionality rule. Trade dress claims are assessed by examining the overall design of the claimant's product. If the design is considered functional, the claim for trade dress fails. If the design is non-functional, no further analysis of the functionality issue will be carried out by the claim. This is a flawed approach. The functionality inquiry should examine the product of the defendant, or more specifically the parts of the product of the defendant copied from the product of the plaintiff. No party should be instructed to use the functional features of the product. On the other hand, where the plaintiff can demonstrate that their design is distinctive and the design of the defendant is likely to confuse consumers, a court should not walk away from the controversy, even if the overall design of the plaintiff is considered functional. To do so — and this is precisely what modern courts have done to find the functional design of a plaintiff — is to ignore the interest of the consumer in avoiding confusion. Where confusion is likely, the risk of confusion should be reduced or eliminated by taking some steps. The burden of such steps between the plaintiff and the defendant should be equitably allocated.

Author's second proposal, removing functionality as part of a business dress claim, may seem radical, but it is not. This proposal is based on the analysis of functionality carried out by the courts during the doctrine's early development. In the earliest cases of functionality, courts focused on the elements copied by a defendant and refused to order copying where those elements were found to be functional. However, the courts still placed an obligation on these defendants to take reasonable steps to distinguish their products from those of the plaintiffs. This lesson from the early cases was somehow lost when the courts started to treat functionality as an affirmative rather than a limited defense element. Author think that returning to the old rule would gain a lot.

Author's third proposal is a first two combination. Although author believe that the second proposal is a sufficient solution, it may be the most attractive solution. A front-end functionality rule would remain in place by combining the first two proposals to filter out bogus claims and applications to register fully functional designs as trademarks. The limited functionality defense would continue to play an important role in resolving disputes over litigated trade dress and provide the flexibility needed to best balance the competing interests at stake. Since this solution

offers the advantages of the second proposal while maintaining important parts of the modern approach to functionality, it may be more acceptable to the range of parties interested in reforming the doctrine of functionality.⁴

4. TYPES OF FUNCTIONALITY

A. Utilitarian Functionality

Courts will look to the following factors when determining utilitarian functionality:

- Whether a feature is essential to the use or purpose of the product; or
- Whether a feature affects the cost or quality of the product; or
- Whether granting of trademark for the exclusive use of the feature would put competitors at a significant non-reputation related disadvantage.⁵

As of 2014 the federal circuit courts are split on their utilitarian functionality analysis. Most circuits, such as the Fifth Circuit⁶ and the Sixth Circuit⁷ follow the Supreme Court's analysis in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*,⁸ which focuses on whether the feature is essential to the use or purpose of the product. The Federal Circuit in contrast focuses its analysis on whether permitting a product feature to be trademarked would impair competitors".⁹

B. Aesthetic Functionality

In the United States, the "functionality" doctrine exists to stop a party from obtaining exclusive trade dress or trademark rights in the functional features of a product or its packaging. The doctrine developed as a way to preserve the division between what trademark laws protects and areas that are better protected by patent or copyright law. Thus, the functionality doctrine serves to prevent trademark owners from inhibiting legitimate competition.

When the aesthetic development of the good is intended to enhance the design and make the product more commercially desirable, trademark protection may be denied because the consumer

⁴Mark Alan Thurmon, 'The Rise and Fall of Trademark Law's Functionality Doctrine' (2004) 56 Fla.L.Rev. 243.

⁵*Qualitex v. Jacobson Products* 514 U.S. 159 (1995).

⁶*German Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH* 289 F.3d 351 (5th Cir. 2002).

⁷*Antioch Co. v. Western Trimming Corp.* 347 F.3d 150 (6th Cir. 2003).

⁸532 U.S. 23 (2001).

⁹*Valu Engineering v. Rexnord Corp* 278 F.3d 1268 (Fed. Cir. 2002).

is drawn to the design. The distinctiveness of the mark serves to identify the product rather than the source, and trademark protection becomes inappropriate. The underlying theory as aesthetics become integrated with functionality, the resulting product strongly resembles product design, which may receive no trademark protection absent secondary meaning.¹⁰

This defense is generally seen in the fashion industry. Clothing brands can only be protected if they have acquired secondary meaning, and most of clothing design is held to be functional and is afforded no protection.¹¹

5. PURPOSE OF FUNCTIONALITY

The functionality doctrine reflects a tension between two interests.¹² One is the fundamental patent or copyright.¹³ The other is a producer's interests to protect its goodwill, which is embodied in symbols identifying the source of its goods.¹⁴ The trademark law formulates the functionality doctrine to balance these two interests. Courts have conceived two policy reasons for the functionality doctrine.¹⁵

The first rationale is to police the boundary between trademark law and patent law.¹⁶ Utility patent law is thought to be the only source that can grant exclusive rights to utilitarian features.¹⁷ An unpatented feature or expired patent is in the public domain, and thus competitors have "the right to copy".¹⁸

The Supreme Court has explained this rationale in *Qualitex*:

"The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for

¹⁰*Christian Louboutin S.A. v. Yves Saint Laurent America, Inc.* 778 F. Supp. 2d 445, 447–48 (S.D.N.Y. 2011).

¹¹*Wal-Mart Stores, Inc. v. Samara Brothers, Inc.* 529 U.S. 205 (2000).

¹²*In re Morton-Norwich Products, Inc.* 671 F.2d 1332, 1336-37 (C.C.P.A. 1982); see also *Brunswick Corp. v. British Seagull Ltd.* 35 F.3d 1527, 1530 (Fed. Cir. 1994).

¹³*Morton-Norwich* 671 F.2d at 1336.

¹⁴*ibid.*

¹⁵J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competitions* 7:63 (4th edn 2013).

¹⁶*ibid.*

¹⁷McCarthy (n 15).

¹⁸Mark P. McKenna, '(Dys)Functionality' (2011) 48 Hous. L. Rev. 823, 827-828.

a limited time, .after which competitors are free to use the innovation. If a product’s functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).”¹⁹

The second rationale is to preserve free and effective competition.²⁰ It is based on the policy that courts must preserve free and effective competition by ensuring competitors are able to copy features that is necessary to compete effectively.²¹ If granting trademark protection for a feature hinders others from competing effectively for the related product in the market, then that feature is functional.²² On the other hand, if the copier is possible to compete effectively without copying the feature, it is not functional.²³Courts, which rely on this rationale, emphasize “the need to copy” or “competitive necessity”.²⁴ This policy was emphasized in *In re Morton-Norwich*; the court stated that the policy reason of the functionality doctrine was not the right to slavishly copy articles which are not protected by patent or copyright, but the need to copy those articles, which is more properly termed the right to compete effectively.²⁵ The fulfilment of “the need to copy” or “competitive necessity” is usually guided by the availability of alternative designs.²⁶

Courts have different opinions on the relative importance of the two rationales,²⁷ which thereby affect their interpretation of the functionality doctrine as shown below. Furthermore, it is important to point out that modern courts that admit aesthetic functionality are based solely on that doctrine on the need to promote free and effective competition, but do not aim to distinguish between trademark law and patent or copyright law design.

¹⁹*Qualitex Co. v. Jacobson Products Co., Inc.* 514 U.S. 159, 164-165 (1995).

²⁰McCarthy (n 15).

²¹ibid.

²²Mitchell M. Wong, ‘The Aesthetic. Functionality Doctrine and the Law of Trade-Dress Protection’ (1998) 83 Cornell L.Rev. 1116, 1143.

²³*W.T. Rogers Co. v. Keene* 778 F.2d 334, 343 (7th Cir. 1985).

²⁴McKenna (n 18).

²⁵*In re Morton-Norwich Products, Inc.* 671 F.2d 1332, 1339(C.C.P.A. 1982).

²⁶Thurmon (n 4) 268.

²⁷McKenna (n 18) 824-825.

The functionality doctrine, which prohibits registration of functional product features, is intended to encourage legitimate competition by maintaining a proper balance between trademark law and patent law.

In other words, the functionality doctrine ensures that protection of utilitarian product features is properly sought through a utility patent of limited duration and not through a trademark registration's potentially unlimited protection. Once a utility patent expires, the invention covered by the patent enters the public domain and the functional features disclosed in the patent can then be copied by others—thereby encouraging progress in product design and manufacture. “Thus, even when the evidence establishes that consumers have come to associate a functional product feature with a single source, trademark protection will not be granted in light of the public policy reasons mentioned.”

6. FUNCTIONALITY & VARIOUS MARKS

Author will discuss whether specific considerations have been made when the general rules apply to non - traditional marks (other than the shape of goods).

A. Service Marks

Although rare in the context of service mark applications, examining attorneys are not foreclosed from refusing registration based on functionality. In *Duramax Marine, LLC v. R.W. Fernstrum & Co.*,²⁸ the Board held that a two-dimensional design of a marine heat exchanger (commonly known as a "keel cooler"), was not functional for manufacture of marine heat exchangers to the order and specification of others. It found "a significant difference between an application to register trade dress in the nature of product design as a mark for the product itself ... and an application to register a two-dimensional drawing that may look very much like such a product, but is used on labels, catalogs, brochures, and in various other ways as a mark for services;" and stated that "the inquiry regarding functionality may need to be decidedly different" in cases involving a service mark.

The record showed that the keel cooler depicted in the proposed mark was "identical, or nearly so" to the depiction of a keel cooler in applicant's expired patent; that opposer and at least one other party had been marketing keel coolers very similar to the proposed mark; and that the design sought

²⁸*Duramax Marine, LLC v. R.W. Fernstrum & Co.* 80 USPQ2d 1780, 1793 (TTAB 2006).

to be registered appeared in applicant's catalog of pre-manufactured keel coolers.²⁹ The Board framed the question at issue as "whether any manufacturer of the formerly patented item should be free to utilize, in advertising its goods for sale, a realistic depiction of the item," and stated that:

"We must balance against opposer's argument for the extension of existing case law on functionality to what is shown by the record to be long use of the keel cooler depiction by applicant in the manner of a logo. Further, opposer has not discussed whether, when custom manufacturing services are involved, we should still apply the Traffix test for functionality (a three-dimensional product design is functional if it is essential to the use or purpose of the product or if it affects the cost or quality of the product) to the product that results from purchasing the services, or whether the test should be adapted and focus on whether use of the two-dimensional design to be registered is essential to anyone who would provide the same service, or would, if unavailable, affect the cost or quality of the service."

The Board held that opposer had failed to justify an extension of existing law to cover the circumstances of this case, but stated that its decision "does not foreclose the extension of Traffix to service marks if circumstances in a future case warrant such an extension".³⁰

B. Non- Traditional Marks

In addition to product design and product packaging, the functionality doctrine has been applied to other non-traditional proposed marks, such as sound, color, and flavor, and the same Morton-Norwich analysis, discussed above, applies to these marks.³¹ In *re Florists' Transworld Delivery Inc.*,³²(finding the color black for floral packaging functional because there was a competitive need for others in the industry to use black in connection with floral arrangements and flowers in order to communicate a desired sentiment or occasion such as elegance, bereavement, or Halloween); In *re Pohl-Boskamp GmbH & Co.*,³³ (finding the flavor peppermint functional for nitroglycerin lingual spray based on evidence that peppermint oil, which imparts a flavour of peppermint, can

²⁹ *ibid.*

³⁰ *Duramax*, 80 USPQ2d at 1794.

³¹ *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1532, 32 USPQ2d 1120, 1123 (Fed. Cir. 1994), *cert. denied*, 514 U.S. 1050 (1995) (finding the color black for outboard motors functional because it provided competitive advantages such as ease of coordination with a variety of boat colors and reduction in the apparent size of the engines).

³² *In re Florists' Transworld Delivery Inc.* 106 USPQ2d 1784, 1791 (TTAB 2013).

³³ *In re Pohl-Boskamp GmbH & Co.* 106 USPQ2d 1042 (TTAB 2013).

improve the effectiveness of sublingual nitroglycerin spray); In *re Vertex Grp. LLC*,³⁴ (affirming the refusal to register an alarm sound emitted by personal security alarms in the normal course of operation without showing of acquired distinctiveness); *Saint-Gobain Corp. v. 3M Co.*,³⁵ (deep purple shade for coated abrasives held functional, the Board finding that coated abrasive manufacturers have a competitive need to use various shades of purple, including applicant's shade, and that in the field of coated abrasives, color serves a myriad of functions, including color coding, and the need to color code lends support for the basic finding that color, including purple, is functional in the field of coated abrasives having paper or cloth backing).

Examining lawyers should also consider the doctrine of functionality in relation to other non-traditional mark types, such as scent. For example, an application to register scent for an air freshener or an application to register the sound of a ring tone for downloadable ring tones must be rejected as functional, as the proposed marks are essential for the use or purpose of the goods.

7. SHOULD THIS FUNCTIONALITY DOCTRINE APPLY TO ALL KINDS OF TRADEMARKS?

A determination of functionality normally involves consideration of one or more of the following factors, commonly known" as the "Morton-Norwich factors":

- (1) "the existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered;
- (2) advertising by the applicant that touts the utilitarian advantages of the design;
- (3) facts pertaining to the availability of alternative designs; and
- (4) facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture."

Accordingly, the request for information by the examining attorney should relate to the Morton-Norwich factors and: (1) request the applicant to supply copies of any patent(s) or pending or abandoned patent application(s) ;(2) request the applicant to supply any available advertising, promotional or explanatory material relating to the goods/services, in particular any specific material relating to the proposed mark; (3) inquire whether alternative designs are available to the

³⁴*In re Vertex Grp. LLC* 89 USPQ2d 1694, 1700 (TTAB 2009).

³⁵*Saint-Gobain Corp. v. 3M Co.* 90 USPQ2d 1425, 1447 (TTAB 2007).

applicant; and (4) ask whether the features sought for registration make the product easier or cheaper to produce. The examining attorney should examine the specimen(s) for information relevant to the factors of Morton-Norwich and conduct independent research on the websites of applicants and competitors, industry practice and standards, and legal databases such as LexisNexis ®. The prosecutor may also consult the records of the USPTO patent.

It is not necessary to consider all the Morton-Norwich factors in every case. The Supreme Court held that "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."³⁶ It is important that the functionality inquiry focus on the utility of the feature or combination of features claimed as protectable trade dress.³⁷ Where the evidence shows that the overall design is functional, the inclusion of a few arbitrary or otherwise non-functional features in the design will not change the result.³⁸

In the limited circumstances where a proposed trade dress mark is not overall functional but contains insignificant functional elements, the examining attorney must issue a requirement for an amended drawing and allow the applicant to remove or delete the functional elements from the drawing or display them in broken or dotted lines to indicate that they are not characteristics of the mark.

Whether a product feature is "functional" should not be confused with whether it performs a "function" (i.e., it is de facto functional) or "fails to function" as a mark. Most objects, for example, perform a function, a bottle holds liquid and a lamp provides light. Only certain configurations are functional, however, allowing an object to work better.

8. CONCLUSION

In the US, the doctrine of functionality is broadly interpreted; aesthetic functionality in particular is interpreted on the basis of the competitive necessity test. Such wide interpretation allows the doctrine of functionality to apply to any kind of mark. After becoming distinctive through use, a

³⁶*TrafFix Devices, Inc. v. Mktg. Displays, Inc.* 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001).

³⁷*Morton-Norwich* 671 F.2d at 1338, 213 USPQ at 13.

³⁸*In re Becton, Dickinson & Co.* 675 F.3d at 1374, 102 USPQ2d at 1376; *Textron, Inc. v. U.S. Int'l Trade Comm'n* 753 F.2d 1019, 1025, 224 USPQ 625, 628-29 (Fed. Cir. 1985); *In re Vico Prods. Mfg. Co.* 229 USPQ 364, 368 (TTAB 1985).

sign with a functional feature as shown in U.S. cases could be registered, and its trademark protection would likely hinder fair competition.

Certain application of the functionality doctrine (e.g., application of aesthetic functionality to words or logos) in the United States is inappropriate for further consideration; on the other hand, functional signs other than shapes are also difficult to acquire distinctiveness through use, as such signs are rarely protected under patent or design rights and may be used by competitors at the same time. However, since the acquisition of distinctive features predominantly relies on consumer perception, a sign can still be distinguished through use, particularly by market-powered traders.