Reexamining Two Pesos, Qualitex, & Wal-Mart: A Different Approach ... Or Perhaps Just Old Abercrombie Wine in a New Bottle?

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**Introduction**

In *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, the United States Supreme Court held that, in order for a product design to be protectable under § 43(a) of the Lanham Act, the product design must first acquire a secondary meaning.¹ Writing for the Court, Justice Scalia, reasoned that consumers, as a rule, do not expect a product’s design to serve as an indicator of source. The Court stated that product designs, like colors, do not ordinarily operate as source indicators, and that is why the Court established its rule that a product design must acquire a secondary meaning as a precondition to receipt of trade dress protection.² Professor Dinwoodie, writing a year earlier, bluntly asserted that the Supreme Court’s underlying assumption of fact was untrue:

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² “In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs — such as a cocktail shaker shaped like a penguin — is intended not to identify the source, but to render the product itself more useful or more appealing.” *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213 (2000). See Graeme Dinwoodie, *The Death Of Ontology: A Teleological Approach To Trademark Law*, 84 Iowa L. Rev. 611, 613 (1999)(hereinafter “Dinwoodie, *The Death of Ontology*)”("Trademark law regulates only a particular form of meaning. It deals merely with symbols that identify the source of a product and distinguish that [p]roduct from others, and it extends such symbols protection solely against confusing imitation.”)(footnotes omitted). *See also* J. Thomas McCarthy, *McCarthy ON TRADEMARKS AND UNFAIR COMPETITION §§ 8:1-8:4 (4th Ed. 2012)*[hereinafter “McCarthy ON TRADEMARKS”].
[M]any courts adhere to, and implement doctrinally, the premise that shapes almost never identify source. This may at present be largely inaccurate, but the rigid embedding of social and competitive premises unreflective of new visual realities threatens to make trademark law in those courts wholly unresponsive to evolving social and competitive realities.  

Briefly stated, “secondary meaning” in trademark law, refers to the convergence of psychological and sociological phenomena. Secondary meaning arises when an appreciable number of relevant consumers has established a cognitive link between the mark and a particular source. Thus, whether secondary meaning exists is a question of fact.

The *Wal-Mart* case separates the universe of trade dress into at least two (and perhaps three) subcategories. The Court acknowledged that, as a rule, trade dress may be protectable without proof of secondary meaning; the Court cites its *Two

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4 See Bonanza Press, Inc. v. Arrow Intern., Inc., 2010 WL 2196112 at 3 (W.D.Wash. 2010)(“A product's design has acquired secondary meaning if there is a 'mental association by a substantial segment of consumers and potential customers 'between the alleged mark and a single source of the product.'”)(citations omitted); Predator Intern., Inc. v. Gamo Outdoor USA, Inc., 669 F.Supp.2d 1235, 1246-47 (D.Colo. 2009)(explaining the analysis by which courts assess whether a mark has acquired secondary meaning); Shell Trademark Management B.V. v. Warren Unilube, Inc., 765 F.Supp.2d 884, 895 (S.D.Tex. 2011)(explaining secondary meaning and describing analysis of secondary meaning); Fiji Water Co., LLC v. Fiji Mineral Water USA, LLC, 741 F.Supp.2d 1165, 1177 (C.D.Cal. 2010)(defining secondary meaning); Amazing Spaces, Inc. v. Metro Mini Storage, 608 F.3d 225, 247 (5th Cir. 2010)(“Secondary meaning occurs when, in the minds of the public, the primary significance of a mark is to identify the source of the product rather than the product itself.”)(citations omitted); Olem Shoe Corp. v. Washington Shoe Co. 2010 WL 1370823 at 1 (S.D.Fla. 2010)(defining secondary meaning); Thoip v. Walt Disney Co., 736 F.Supp.2d 689, 703 (S.D.N.Y. 2010). See also *McCarthy on Trademarks* §15:7 (“As an elusive intellectual synthesis of psychology and law, secondary meaning has been defined in many ways throughout the years.”).
5 *McCarthy on Trademarks* §15:29 (“Whether or not a designation has acquired secondary meaning is a question of fact, not an issue of law.”).
Pesos decision for that proposition. Furthermore, the Court distinguishes between two subcategories of trade dress: product design versus product packaging. Product packaging, according to the Court, may operate as protectable trade dress without a showing of secondary meaning because, like word trademarks, consumers are prone readily to associate the external accoutrements of a product’s package with source identification. On the other

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6 “Two Pesos unquestionably establishes the legal principle that trade dress can be inherently distinctive, see, e.g., id., at 773, 112 S.Ct. 2753, but it does not establish that product-design trade dress can be.” Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 215 (2000)(citing Two Pesos, Inc. v. Taco Cabana, Inc. 505 U.S. 763 (1992)).

7 “The breadth of the definition of marks registrable under § 2, and of the confusion-producing elements recited as actionable by § 43(a), has been held to embrace not just word marks, such as “Nike,” and symbol marks, such as Nike’s “swoosh” symbol, but also “trade dress” – a category that originally included only the packaging, or “dressing,” of a product, but in recent years has been expanded by many Courts of Appeals to encompass the design of a product.” Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 209 (2000)(citations omitted). See Note, Dorota Niechwiej Clegg, Aesthetic Functionality Conundrum and Traderight: A Proposal for a Foster Home to an Orphan of Intellectual Property Laws, 89 IOWA L. REV. 273, 275 (2003)(“Trade dress is the conceptual progeny of trademarks. It consists in the product's image and the totality of appearance that the product presents to the consumer. Like trademarks, trade dress aims to distinguish the product's source from those of other similar products on the market.”)(footnotes omitted)[hereinafter “Clegg, Aesthetic Functionality Conundrum and Traderight”]. Interestingly, Professor Dinwoodie had praised both the Two Pesos and Qualitex decisions for not resorting to hinging their analyses on the subject matter. Dinwoodie, The Death Of Ontology, 84 Iowa L. Rev. 611, 651 (1999)(“Both Supreme Court opinions also suggest a second fundamental principle, namely, that the parameters of trademark rights should not be determined by ontological classification of the subject-matter comprising the mark.”)(footnote omitted).

8 “Consumers are therefore predisposed to regard those symbols [i.e., word marks and product packaging] as indication of the producer, which is why such symbols “almost automatically tell a customer that they refer to a brand,” and “immediately ... signal a brand or a product ‘source,’ ”. Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 212-13 (2000)(internal citations omitted).
hand, the Court states that consumers do not readily associate a product’s design with source identification. ⁹

The Court cites no authority for its statements – factual conclusions – regarding consumer associations and how and whether, psychologically speaking, consumers react to a product’s design in a manner that is materially different from the ways that they react to product packaging. Absent empirical data, such as research or consumer surveys that demonstrate consumer psychological associations or reactions, it is remarkable that the Court was willing to unilaterally arrive at such a conclusion; especially when that conclusion is central to its holding. “It is a fact of life that thinking or talking about doing empirical research is much more fun than actually doing it.” ¹⁰ The Court apparently engaged in armchair psychology in this instance. Nevertheless, the Wal-Mart case establishes the rule of law that the design of a product must acquire a secondary meaning in order to operate as protectable trade dress under § 43(a) of the Lanham Act. ¹¹ Justice Scalia offers an example of a cocktail shaker in the shape of a penguin. A penguin-shaped cocktail shaker – a product design – would have to acquire a secondary meaning

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⁹ “It seems to us that design, like color, is not inherently distinctive.” Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 212 (2000). See Olem Shoe Corp. v. Washington Shoe Co. 2010 WL 1370823 at 1 (S.D.Fla. 2010)(“Wal-Mart Stores held that a trade dress is protectible only on a showing of secondary meaning, because the design will invariably serve purposes other than source identification.”)(citing Wal-Mart).


in order to be protectable as trade dress under § 43(a). Thus, assume that the Penguin Corporation begins selling a cocktail shaker in the shape of a penguin. If the consuming public, or rather, an appreciable number of relevant consumers of cocktail shakers, comes to associate a penguin-shaped cocktail shaker as emanating from the Penguin Corporation (i.e., the source of penguin-shaped cocktail shakers), Justice Scalia’s reasoning suggests that the Penguin Corporation may own that trade dress and may prohibit others from selling penguin-shaped cocktail shakers that are confusingly similar.

Part I of this Article examines the *Wal-Mart* decision in light of the general principles of trade dress law that the Court established in *Qualitex Co. v. Jacobson Products Co.*, *Inc.* and *Two Pesos, Inc. v. Taco Cabana, Inc.*, the two precedents that forged the Supreme Court’s general, pertinent doctrinal rules. Part II considers these cases using the conceptual tools of utilitarian functionality and aesthetic functionality, and suggests that these perspectives, coupled with traditional trademark analysis, offer a more effective and efficient method of analysis than the Court’s approach in *Wal-Mart*. Part III offers additional suggestions to improve the analysis in cases like *Wal-Mart*, explaining the similarities between the trademark doctrines of utilitarian functionality and aesthetic functionality and the copyright doctrines of conceptual separability and the idea-expression dichotomy. The Conclusion briefly summarizes the *Wal-Mart* holding, the reasons why it is preferable to analyze *Wal-Mart* in terms of traditional trademark

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12 “In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs – such as a cocktail shaker shaped like a penguin – is intended not to identify the source, but to render the product itself more useful or more appealing.” *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213 (2000).


categories along with utilitarian and aesthetic functionality, and why using the analogies of copyright’s conceptual separability and idea-expression analyses can simplify and improve decision-making in cases involving issues like those presented in Wal-Mart.¹⁵

I. Two Pesos, Qualitex, & Wal-Mart

A. The Abercrombie Continuum

In one of the most famous American trademark opinions, Abercrombie & Fitch Co. v. Hunting World Inc., Judge Friendly charted the course for the most fundamental, traditional principles of trademark analysis.¹⁶ He explained that all putative trademarks exist on a continuum stretching from “generic” (weakest) to “fanciful” (strongest). In between those polar extremes lie points labeled “descriptive,” “suggestive,” and “arbitrary.”¹⁷ In order to determine whether any given putative mark may operate as a valid, legal trademark, we must determine where it lies on the Abercrombie continuum. In order to arrive at this determination, we must consider the relationship between the putative mark and the product that it represents. Assessing the cognitive link or mental

¹⁵ Professor Dinwoodie has emphasized the importance of recognizing various cultural, social, and psychological factors that necessitate serious legal analysis in cases involving trademark protection for visual elements: “Information is transmitted, and meaning received, through the use of pictorial and spatial imagery rather than (or, at least, in addition to) the lexical form.” Dinwoodie, The Death Of Ontology, 84 Iowa L. Rev. 611, 641-42 (1999).
¹⁶ 537 F.2d 4 (2d Cir.1976). See McCarthy, McCarthy on Trademarks § 11:2 “Spectrum of distinctiveness of marks — Placement of candidates on the spectrum.”
¹⁷ See Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd., 187 F.3d 363, 369 (4th Cir. 1999)(discussing the Abercrombie analysis). To be sure, attaching meaning to these terms is not always easy. Legal philosophers have recognized that defining terms has been one of the most difficult tasks of jurisprudence. See e.g., Hall, Jerome, Foundations of Jurisprudence 82 (1973)(“[O]rdinary words are used in a technical sense, and it requires a great deal of study, in effect a legal education, to understand how those terms are used.”).
association between those two – the putative mark and the product – forms the heart of the Abercrombie analysis.\textsuperscript{18} Symbolism and abstract thinking are the essential keys to this inquiry. Judge Motz of the Fourth Circuit Court of Appeals has provided the following summary example:

For example, the trade name “Pet Store” for a shop that sold pets would be generic. The word “penguin,” by contrast, would be descriptive when used in the name of a shop that specialized in items relating to a certain polar species; suggestive when denominating an air conditioning company; and arbitrary when the name of a book publishing company. (If the book publisher wanted a fanciful mark, it could use a made-up word, like “Penquell.”).\textsuperscript{19}

Putative marks that are generic can never operate as valid trademarks because, by definition, they are merely the common descriptive terms for products, and therefore cannot distinguish one producer’s products from another. The word “apple” communicates a message to people who know enough English to know that the word “apple” symbolizes a specific kind of fruit. Thus, the word “apple” is generic as applied to that specific kind of fruit, and it, therefore, cannot operate as a valid trademark for that fruit. This rule prohibiting trademark protection for generic symbols prevents any one producer from excluding competitors. Competitors must be allowed to use generic

\textsuperscript{18} MCCARTHY ON TRADEMARKS § 11:64 (“The distinctivness of a mark cannot be determined in the abstract, but only by reference to the goods or services upon which the mark is used.”)(footnote omitted).
\textsuperscript{19} Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd., 187 F.3d 363, 369 (4\textsuperscript{th} Cir. 1999). Apparently Judge Motz shares an affection (along with Justice Scalia) for penguins – at least as illustrative hypotheticals in trademark cases. \textit{See also} MCCARTHY ON TRADEMARKS §11:77 (“For example, in the author’s opinion, the word ‘apple’ would be arbitrary when used on personal computers, suggestive when used in ‘Apple-A-Day’ on vitamin tablets, descriptive when used in ‘Tomapple’ for combination tomato-apple juice and generic when used on apples.”)(footnote omitted).
symbols to advertise. Otherwise consumers would be deprived of essential information needed to have market choices.

At the opposite end of the continuum, “fanciful” marks are the strongest as trademarks. Fanciful marks are, for example, words that someone has invented or made up (“coined”), such as Judge Motz’s hypothetical word “Penquell.” Such words, because they have not previously existed in the social lexicon, are incapable of having any association with a product. Some standard examples of fanciful marks are “KODAK” for photographic equipment and “VIAGRA” for drugs. Because fanciful words have no socio-linguistic history, they are the opposite of generic terms. Presumably, unlike generic words, there is absolutely no need for either competitors in advertising their goods or consumers in trolling the marketplace in search of goods to employ or have access to fanciful symbols.

Working our way back along the continuum from strongest (“fanciful”) to weakest (“generic”), “arbitrary” marks are also relatively strong. Like fanciful marks, there is no logical, cognitive association between an “arbitrary” symbol and its product. But we generally categorize marks as “arbitrary” when the mark already existed in our lexicon (i.e., it was not coined or invented). Hence, the word “apple” used as a trademark for music products such as records, CD’s, or MP3 files would be arbitrary since there is no

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20 McCarthy on Trademarks § 11:8. See Id. at § 11:15 (“Fanciful marks consist of ‘coined’ words that have been invented or selected for the sole purpose of functioning as a trademark.”)(footnote omitted).

21 McCarthy on Trademarks § 11:11 (“Arbitrary marks comprise those words, symbols, pictures, etc., that are in common use but which, when used with the goods or services in issue, neither suggest nor describe any ingredient, quality or characteristic of those goods or services.”)(footnote omitted).
logical connection between music and the standard meanings (e.g., typically a specific kind of fruit) associated with the word “apple.”

“Suggestive” marks are those that require a leap of imagination or a connecting-of-the-dots. As a rule we categorize a mark as “suggestive” if an ordinary consumer, upon learning the nature of the product, after having heard the trademark, would say something like “oh…hahaha…I get it.” Perhaps on occasion a consumer might make a good guess and guess the nature of the goods after perceiving the suggestive stimulus. Although post hoc appreciation of the association might be amusing, as a rule, courts say that the imagination test is the hallmark of a “suggestive” mark.22 “ESKIMO PIE” for a kind of ice cream and Judge Motz’s hypothetical “PENGUIN” brand air conditioner are good examples of suggestive marks.

Lastly, “descriptive” marks present two unique analytical problems. Courts commonly state that a putative mark is “descriptive” if it immediately relates the nature, contents, or characteristics of its associated product.23 For example, the phrase “two all-beef patties, special sauce, lettuce, cheese, pickles, onions, on a sesame seed bun” immediately relates the contents of McDonald’s famous “Big Mac” hamburger. Hence, that phrase is descriptive. One of the unique analytical problems related to descriptive marks is the problem of drawing a line between a putative mark that is “descriptive” versus a putative mark that is “generic.” The line is not always clear-cut, but it is an

22 McCarthy on Trademarks §11:67 (“The more imagination that is required on the potential customer’s part to get some direct description of the product from the designation, the more likely the designation is suggestive, not descriptive.”)(footnote omitted); Id. §11:66 (“The descriptive-suggestive borderline is hardly a clear one. Its exact location in any given situation is hazy and only subjectively definable.”). See also Id. § 11:62.
23 McCarthy on Trademarks § 11:16.
incredibly important line. It is incredibly important because, as has been explained, a putative mark that is deemed “generic” cannot operate as a valid trademark. On the other hand, a putative mark that is deemed “descriptive” may operate as a valid trademark. The catch is that, in order to operate as a valid trademark, a descriptive mark must first acquire a secondary meaning. Acquisition of secondary meaning is a precondition to being recognized as a valid trademark in the case of descriptive terms. The secondary meaning requirement for descriptive marks leads us to the second analytical problem; namely, drawing the line between “descriptive” versus “suggestive.” The Abercrombie rubric categorizes fanciful, arbitrary, and suggestive marks as “inherently distinctive.” By definition, inherently distinctive marks are capable of distinguishing the mark’s owner’s products without secondary meaning (i.e., inherently). On the other hand, descriptive marks are the only Abercrombie category that requires proof of secondary meaning as a condition precedent to receiving trademark protection. Thus, if a putative mark is deemed merely “suggestive” as it relates to its product, it automatically may serve as a valid trademark. But if, on the other hand, a putative mark is deemed “descriptive,” it must acquire secondary meaning before it may operate as a valid trademark.

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24 McCARTHY ON TRADEMARKS § 11:25.
B. Two Pesos (Tade Dress) & Qualitex (Colors)

Prior to its decision in Wal-Mart, the Supreme Court, in two landmark cases, had established two fundamental rules regarding the relationship between trade dress and secondary meaning. In 1992 Justice White’s opinion in Two Pesos v. Taco Cabana held that trade dress was protectable under § 43(a) of the Lanham Act even if the trade dress had not first acquired a secondary meaning. In simple terms, Justice White reasoned that, like traditional word trademarks, trade dress, protected under § 43(a), ought to be analyzed using the Abercrombie rubric. Justice White’s opinion logically concludes that trade dress, at least conceptually, ought to be analyzed in the same manner. Justice White explained:

Where secondary meaning does appear in the statute, 15 U.S.C. § 1052 (1982 ed.), it is a requirement that applies only to merely descriptive marks and not to inherently distinctive ones. We see no basis for requiring secondary meaning for inherently distinctive trade dress protection under

26 “We granted certiorari to resolve the conflict among the Courts of Appeals on the question whether trade dress that is inherently distinctive is protectible under § 43(a) without a showing that it has acquired secondary meaning. 502 U.S. 1071, 112 S.Ct. 964, 117 L.Ed.2d 130 (1992). We find that it is, and we therefore affirm.” Two Pesos, Inc. v. Taco Cabana, Inc. 505 U.S. 763, 767 (1992)(footnote omitted). See Clegg, Aesthetic Functionality Conundrum and Traderight, 89 IOWA L. REV. 273, 286 (2003)(citing Two Pesos for the proposition that trade dress may be inherently distinctive).

27 “There is no persuasive reason to apply to trade dress a general requirement of secondary meaning which is at odds with the principles generally applicable to infringement suits under § 43(a).” Two Pesos, Inc. v. Taco Cabana, Inc. 505 U.S. 763, 770 (1992). See Vanessa Bowman Pierce, If it Walks Like a Duck and Quacks Like a Duck, Shouldn’t it Be a Duck?: How a “Functional” Approach Ameliorates the Discontinuity Between the “Primary Significance” Tests for Genericness and Secondary Meaning, 37 New Mexico L.Rev. 147 (2007) (noting the difficulties that courts encounter when trying to categorize marks)[hereinafter “Pierce, If it Walks Like a Duck”].

28 “If a verbal or symbolic mark or the features of a product design may be registered under § 2, it necessarily is a mark ‘by which the goods of the applicant may be distinguished from the goods of others,’ 60 Stat. 428, and must be registered unless otherwise disqualified. Since § 2 requires secondary meaning only as a condition to registering descriptive marks, there are plainly marks that are registrable without showing secondary meaning.” Two Pesos, Inc. v. Taco Cabana, Inc. 505 U.S. 763, 772 (1992).
§ 43(a) but not for other distinctive words, symbols, or devices capable of identifying a producer's product.\textsuperscript{29}

Thus, \textit{Two Pesos} established the rule that fanciful, arbitrary, or suggestive trade dress operates as a protectable trademark without proof of secondary meaning.

In 1995 Justice Breyer’s opinion in \textit{Qualitex} held that color may operate as a trademark.\textsuperscript{30} In short, the Court reasoned that color easily fits within the statutory subject matter in the Lanham Act’s definition of a trademark: “any word, name, symbol, or device….\textsuperscript{31} This case put to rest the debate regarding the protectability of colors as trademarks that had raged for decades.\textsuperscript{32} One of the most interesting aspects of \textit{Qualitex}, however, is that the Court’s holding is not, in reality, so simple. The “wrinkle” in the case is that Qualitex’s green-gold color had, as a matter of fact, acquired a secondary

\textsuperscript{29} Two Pesos, Inc. v. Taco Cabana, Inc. 505 U.S. 763, 774 (1992).
\textsuperscript{30} Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159, 160 (1995)(“We conclude that, sometimes, a color will meet the ordinary legal trademark requirements. And, when it does so, no special legal rule prevents color alone from serving as a trademark.”). \textit{See McCarthy on Trademarks} §§ 7:39 and 7:44.
\textsuperscript{31} “Both the language of the Act and the basic underlying principles of trademark law would seem to include color within the universe of things that can qualify as a trademark. The language of the Lanham Act describes that universe in the broadest terms. It says that trademarks “include[e] any word, name, symbol, or device, or any combination thereof.’ § 1127. Since human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive.” Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159, 162 (1995).
\textsuperscript{32} “The courts of Appeals have differed as to whether or not the law recognizes the use of color alone as a trademark.” Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159, 161 (1995)(citing cases). Professor Bartow has vigorously argued that the decision was wrongly decided. \textit{See} Bartow, \textit{The True Colors of Trademark Law}, 97 KENT. L.J. 263 (2008-09)(“The Supreme Court was wrong to facilitate this abuse of trademark powers when it decided in \textit{Qualitex} v. Jacobson Products Co. that colors alone could constitute protectable trademarks.”)(footnote omitted); \textit{Id. at} 271 (“It is the position of this author that the \textit{Qualitex} case was wrongly decided. It is endemically problematic because the opinion resulted in de facto lawmaking that expanded the scope of trademark law without adequately considering the competitive functional roles that product design features, like color, play.”).
meaning. The Court’s opinion does not clearly explain precisely how and/or when that
determination was made. But the Ninth Circuit’s opinion below explicitly noted that the
District Court, the original fact-finder, had expressly found that Qualitex’s unique green-
gold color had acquired a secondary meaning:

[T]he district found that the trade dress of the press pad had acquired
secondary meaning. **** The evidence showed: Qualitex has sold its
“SUN GLOW” press pad with a green-gold color for over 30 years. The
company has spent over $1.6 million in advertising and promoting its
press pads in magazines and at trade shows, and nearly all advertising and
promotion have highlighted the green-gold color of the pad. Qualitex has
run advertisements featuring the press pad's green-gold color on a monthly
basis for the last 30 years in a leading magazine aimed at the dry cleaner
market. There was evidence that readers of a trade publication associated
the green-gold color with Qualitex.33

Thus, the Supreme Court accepted that the green-gold color had acquired a secondary
meaning.34 There are several sentences in the Qualitex opinion itself that suggest that the
Court intended to hold that color alone may operate as a protectable trademark if, and
only if, the color has first acquired a secondary meaning. And, in fact, Justice Scalia’s
opinion in Wal-Mart interprets Qualitex in this manner.35 For example the Qualitex
Court stated: “But, over time customers may come to treat a particular color on a product
or its packaging (say, a color that in context seems unusual, such as pink on a firm’s

33 Qualitex Co. v. Jacobson Products Co., Inc., 13 F. 3d 1297, 1304 (9th Cir. 1994). See
2009)(discussing In re Owens-Corning Fiberglas Corp., 774 Fed. 2d. 1116, 1122 (Fed.
Cir. 1985)). See also Wong, The Aesthetic Functionality Doctrine, 83 CORNELL L. REV.
1116, 1137 (1998)(discussing In re Owens-Corning Fiberglas Corp., 774 Fed. 2d. 1116,
1122 (Fed. Cir. 1985), noting “the Federal Circuit held that the color pink, when applied
to insulation, was not functional because there was no benefit to be derived from the use
of that color.”)(emphasis added).
35 Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 211 (2000)(“Indeed, with
respect to at least one category of mark – colors – we have held that no mark can ever be
inherently distinctive.”)(citing Qualitex).
insulating material or red on the head of a large industrial bolt) as signifying a brand.”

“[O]ne might ask, if trademark law permits a descriptive word with secondary meaning to act as a mark, why would it not permit color, under similar circumstances, to do the same?” “We cannot find in the basic objectives of trademark law any obvious theoretical objection to the use of color alone as a trademark, where that color has attained ‘secondary meaning’ and therefore identifies and distinguishes a particular brand (and thus indicates its ‘source’). But it is worthwhile to note that there are other sentences in the opinion which do not necessarily convey this same restrictive viewpoint. For example: “We conclude that, sometimes, a color will meet ordinary legal trademark requirements. And, when it does so, no special legal rule prevents color alone from serving as a trademark.” “We hold now that there is no rule absolutely barring the use of color alone…. “ Thus, to the extent that Justice Breyer actually intended to impose a requirement of secondary meaning for colors to operate as protectable trademarks, the opinion created new law in more ways than one. The obvious new law was that colors now could operate as protectable trademarks. But the less obvious law was that color trademarks, like descriptive marks, were henceforth subject to the same requirement regarding proof of secondary meaning. In this regard, Qualitex flies squarely in the face of Justice White’s statements in Two Pesos, wherein he expressed reticence and caution

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40 Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159, 162 (1995). Professor McCarthy notes this ambiguity in Qualitex regarding whether secondary meaning ought to be a precondition for colors to serve as valid trademarks, and discusses pre-Wal-Mart cases that had split on this very issue. Professor McCarthy expresses the opinion that the Wal-Mart interpretation is the correct one. See McCARTHY ON TRADEMARKS § 7:44.
about imposing a secondary meaning requirement on putative trademarks other than
descriptive marks.\footnote{41} Justice Scalia’s opinion in \textit{Wal-Mart} adopts this restrictive
interpretation of \textit{Qualitex}, and uses it as a fulcrum upon which to justify the Court’s
decision to impose the exact same secondary meaning requirement on product designs.\footnote{42}

\textbf{C. Wal-Mart (Product Design)}

In \textit{Wal-Mart}, the products at issue were children’s clothing with a variety of child-
friendly motifs, such as rainbows, unicorns, trains, friendly bears, and the like. The Court
ruled that, because Samara Brothers’ clothing designs had not acquired a secondary
meaning, the designs were not protectable under § 43(a).\footnote{43} The Court distinguished the

\footnote{41}“There is no persuasive reason to apply to trade dress a general requirement of
secondary meaning which is at odds with the principles generally applicable to
infringement suits under § 43(a).” \textit{Two Pesos, Inc. v. Taco Cabana, Inc.} 505 U.S. 763,
requirement that applies only to merely descriptive marks and not to inherently
distinctive ones. We see no basis for requiring secondary meaning for inherently
distinctive trade dress protection under § 43(a) but not for other distinctive words,
symbols, or devices capable of identifying a producer's product.”). \textit{See also Aurora
World, Inc. v. Ty Inc.}, 719 F.Supp.2d 1115, 1150 (C.D.Cal. 2009)(discussing the
requirement of secondary meaning). Legal philosophers have suggested that Judicial
consistency is important. \textit{See e.g., Hall, Jerome, Foundations of Jurisprudence} 68
(1973)(“Since it is highly improbable that he [i.e., Kelsen] means to assert that judges are
always consistent, his theory is ethically normative in implying that judges \textit{should} be
consistent.”)(emphasis original).

\footnote{42} \textit{Wal-Mart Stores, Inc. v. Samara Bros., Inc.}, 529 U.S. 205, 211 (2000)(“Indeed, with
respect to at least one category of mark – colors – we have held that no mark can ever be
inherently distinctive.”)(citation omitted). \textit{See also Wal-Mart Stores, Inc. v. Samara
Bros., Inc.}, 529 U.S. 205, 212 (2000)(“ We held that a color could be protected as a
trademark, but only upon a showing of secondary meaning.”). \textit{See also Predator Intern.,

\footnote{43}“We hold that, in an action for infringement of unregistered trade dress under § 43(a)
of the Lanham Act, a product's design is distinctive, and therefore protectible, only upon
a showing of secondary meaning.” \textit{Wal-Mart Stores, Inc. v. Samara Bros., Inc.}, 529 U.S.
205, 216 (2000).
Taco Cabana restaurant décor that had been at issue in Two Pesos, saying that the restaurant décor was either more equivalent to product packaging or, perhaps, some additional subcategory (the Court resorts to the Latin phrase “tertium quid” – some third kind of thing) that perhaps does not fit neatly into the designation of either product packaging or product design.\textsuperscript{44} In Two Pesos the Court had concluded that a restaurant’s décor could be protectable trade dress “based on a finding of inherent distinctiveness, without proof that the trade dress ha[d] secondary meaning.”\textsuperscript{45}

Thus, the Wal-Mart Court established the rule that not all things that can be characterized as trade dress may be inherently distinctive. The Court concedes that some trade dress, such as product packaging and the Taco Cabana restaurant décor, may be protectable as trade dress without a showing of secondary meaning (\textit{i.e.}, those types of trade dress may be inherently distinctive as fanciful, arbitrary, or suggestive).\textsuperscript{46} Nevertheless, the Wal-Mart Court also established that trade dress that falls within the subcategory of product design may only be protectable under § 43(a) upon proof that the design has acquired a secondary meaning.\textsuperscript{47} The Wal-Mart Court, as was mentioned,\textsuperscript{48}

\begin{flushleft}
\textsuperscript{44} \textit{Two Pesos} is inapposite to our holding here because the trade dress at issue, the decor of a restaurant, seems to us not to constitute product design. It was either product packaging — which, as we have discussed, normally is taken by the consumer to indicate origin — or else some tertium quid that is akin to product packaging and has no bearing on the present case.” Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 215 (2000).
\textsuperscript{45} “The issue in this case is whether the trade dress of a restaurant may be protected under § 43(a) of the Trademark Act of 1946 (Lanham Act), 60 Stat. 441, 15 U.S.C. § 1125(a) 1982 ed.), based on a finding of inherent distinctiveness, without proof that the trade dress has secondary meaning.” Two Pesos, Inc. v. Taco Cabana, Inc. 505 U.S. 763, 764-65 (1992)(footnote omitted).
\end{flushleft}
draws an analogy to the use of colors as trademarks. The Court cites its decision in
*Qualitex* for the proposition that colors may serve as trademarks but only upon proof that
the color in question has first acquired a secondary meaning.\(^{49}\) In *Qualitex*, as was noted,
the Court accepted that Qualitex’s green-gold color had acquired a secondary meaning
among consumers of dry cleaning press pads.\(^{50}\) The Court stated: “Having developed
secondary meaning (for customers identified the green-gold press pad color as
Qualitex’s), it identifies the press pads’ source.”\(^{51}\) The *Wal-Mart* Court actually
explained its rule regarding product design (*i.e.*, its rule that proof of a secondary
meaning is a condition precedent to trade dress protection of a product design under §
43(a)) by drawing an analogy between colors and product designs, stating that consumers
are not inclined to equate colors with source indication nor are consumers inclined to
equate product design with source indication.\(^{52}\)

Thus, the Court has carved out two significant exceptions to the traditional tenets of
trademark law. Traditional trademark law, as explained by Judge Friendly in
*Abercrombie*, recognizes that putative trademarks may be analyzed in terms of “strength”

\(^{48}\) See supra text accompanying note 35.
\(^{52}\) "In the case of product design, as in the case of color, we think consumer
predisposition to equate the feature with the source does not exist. Consumers are aware
of the reality that, almost invariably, even the most unusual of product designs – such as a
cocktail shaker shaped like a penguin – is intended not to identify the source, but to
render the product itself more useful or more appealing.” Wal-Mart Stores, Inc. v.
Samara Bros., Inc., 529 U.S. 205, 213 (2000).
or “distinctiveness.” In fact, the Two Pesos decision discusses Judge Friendly’s analysis in Abercrombie, and explicitly relies on it. The Abercrombie case, as was mentioned, made it clear that only descriptive marks need a showing of secondary meaning in order to be protectable. As was suggested, if, in fact, the Qualitex Court intended to impose a per se secondary meaning requirement for colors, the opinion certainly could have been more direct and clear. Nevertheless, the Wal-Mart Court, as is their prerogative, refines or interprets the Qualitex holding in precisely this way.

D. Colors, Other Non-Word Marks, & the Abercrombie Continuum: Additional Considerations

But there is certainly a case to be made for the proposition that colors, like other types of trademarks – words, names, symbols, or devices, or combinations thereof – ought not be subject to a secondary meaning requirement, but rather ought to be analyzed using the traditional Abercrombie analysis in the same manner that Justice White suggested for trade dress, in general, in Two Pesos. At this point it is sufficient to suggest one simple

56 See supra text accompanying notes 39-40.
57 “Indeed, with respect to at least one category of mark-colors-we have held that no mark can ever be inherently distinctive.” Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 211 (2000)(citation omitted).
58 “The Fifth Circuit was quite right in Chevron, and in this case, to follow the Abercrombie classifications consistently and to inquire whether trade dress for which
example. The color green, like any symbol, may be arbitrary, suggestive, descriptive, or
generic, depending on the product with which a putative trademark owner wishes to use
it.\footnote{For purposes of this discussion, I assume that the variety of shades of green that has
been used by someone at some time, although theoretically infinite, renders it unlikely
that there could be a shade that would be considered “fanciful.”} Using the \textit{Abercrombie} rubric, we might conclude that green would be arbitrary as a
color mark for hammers, suggestive for a website devoted to the psychological effects of
envy, either descriptive (or probably even generic) for mint-flavored foods, and generic
for the sale of green paint.\footnote{Professor Bartow has explained this concept thoughtfully: \textquotedblleft The Hershey Company\textquoteright s
use of brown in the wrapper of its famous Hershey Bar, and in the packaging of so many
of its other products, communicates chocolate. Color can also communicate messages
other than product ingredients per se. Continuing in the context of candy, the color red is
associated with certain flavors: strawberry and cherry, which are as red as the fruits are
when ripened on the tree or vine, and cinnamon, which is a far duller brown in its natural
state. Red can also signal peppermint, such as in a traditional striped candy cane, even
though the peppermint leaves from which the flavor is derived are bright green.
Wintergreen flavored Lifesaver candies, however, are white. Colors provide information
the consumers want (green candies are unlikely to be orange or cherry flavored) even if it
is imperfect or incomplete (green candies may be spearmint flavored, or the color may
denote lime). The interference with this communication that can be caused by color-alone
trademarks is one more argument against having them.\textquotedblright } The \textit{Acercrombie} analysis relies on cognitive association.

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\end{footnotesize}
The stronger the public’s cognitive association is between any given symbol and a product or service, the weaker that symbol is in terms of trademark strength. That’s why generic words cannot operate as valid trademarks. The public’s cognitive association between a generic word and the product is so strongly linked that, upon hearing or seeing the generic word, the public automatically associates that word with a specific product or service.61 Because anyone who sells products and services ought to be entitled to use generic words in order to advertise, trademark law prohibits any one seller from gaining exclusive control over generic words. In the case of descriptive words, the same general reasoning applies. Although the line between generic words versus descriptive words is not always clear, unlike generic words that can never operate as trademarks, descriptive words may operate as trademarks if the putative trademark owner can prove that the descriptive word has acquired a secondary meaning. The drafters of Lanham Act established the rule that descriptive words could only operate as trademarks if the public had acquired a new cognitive association that linked the descriptive word with a particular producer (i.e., a secondary meaning) in addition to the ordinary, cognitive association that it (i.e., the public) previously had between the descriptive word and the product or service (i.e, the primary meaning).62

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61 See Dinwoodie, The Death Of Ontology, 84 Iowa L. Rev. 611, 633 (1999)(“The grant of trademark rights in a verbal mark typically does not make it significantly more difficult for a competitor to produce a rival product; restricting the words by which the competitor may identify its product does not limit the ways in which the competitor may design its product.”).

62 See MCCARTHY ON TRADEMARKS, Chapter 15 “Secondary Meaning”. §15:5 (“The prime element of secondary meaning is a mental association in buyers’ minds between the alleged mark and a single source of the product.”).
Presumably, once we understand how the *Abercrombie* analysis applies to words, we can also apply the analysis to other kinds of trademarks such as names, symbols, devices, and combinations thereof; and presumably even colors. Although the analysis may be more challenging to apply to non-word marks, as Justice White stated in *Two Pesos*, it makes perfect sense to do so.\(^{63}\) Colors, sounds, scents, and trade dress such as product packaging and product designs are all means by which a producer may communicate to the public that that particular product emanates from that particular producer.\(^{64}\) That is really what makes a trademark a trademark. A trademark is a message from the producer to the public: “I made this product!”\(^{65}\) If the message that the public perceives is something else, especially something about the content, quality, or innate nature of the product, such as “this product is mint-flavored,” “this product is green paint,” or “this is Baroque-style silverware,” then the symbol cannot automatically operate as a trademark. Descriptors can only operate as trademarks upon proof of secondary meaning and generic terms can never operate as trademarks. This principle is true whether the putative mark is a word, name, symbol or device.

\(^{63}\) “There is no persuasive reason to apply different analysis to the two. The ‘proposition that secondary meaning must be shown even if the trade dress is a distinctive, identifying mark, [is] wrong, for the reasons explained by Judge Rubin for the Fifth Circuit in Chevron.’” *Two Pesos*, Inc. v. *Taco Cabana*, Inc. 505 U.S. 763, 773 (1992)(quoting Blau Plumbing, Inc. v. *S.O.S. Fix–It*, Inc., 781 F.2d 604, 608 (7th Cir. 1986)).

\(^{64}\) See Dinwoodie, *The Death Of Ontology*, 84 Iowa L. Rev. 611, 618 (1999)(noting that the Supreme Court is “willing to recognize that packaging, design features, colors, sounds and even smells can also accomplish that role.”)(footnote omitted); *Id.* at 621 (“Consumers clearly identified the carbonated soft drink produced by the Coca-Cola Company as much from the shape of the bottle in which it was contained as by the word COKE ® emblazoned on the side of the bottle.”)(footnote omitted). *See also* Bartow, *The True Colors of Trademark Law*, 97 KENT. L.J. 263, 265-66 (2008-09)(discussing pros and cons of non-linguistic marks, such as sounds and scents).

\(^{65}\) See Dinwoodie, *The Death Of Ontology*, 84 Iowa L. Rev. 611, 653 (1999)(“trademark law concerns the meaning of symbols to consumers.”)(footnote omitted).
E. Ashley Furniture: The Road Not Taken

In 1999, Judge Motz of the Fourth Circuit Court of Appeals wrote an opinion in *Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd.*, applying the Abercrombie analysis to a product design. Judge Motz recounted the Abercrombie analysis, and then explained that *Two Pesos* dictated that this same approach ought to apply to product configurations.

For two decades, the Abercrombie analysis has guided litigants and courts in determining “inherent distinctiveness” in trademark cases. In 1992, the Supreme Court in *Two Pesos* described Abercrombie as the “classic formulation” of inherent distinctiveness. Moreover, the *Two Pesos* Court held that the court of appeals had been “quite right” in “follow[ing] the Abercrombie classifications consistently” to determine “whether trade dress for which protection is claimed under § 43(a) is inherently distinctive.”

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66 187 F.3d 363 (4th Cir. 1999). This is a well-reasoned opinion. See Gilmore, Grant, *The Ages of American Law* 16 (1977)(“Judges are trained to explain the reasons for their decisions. They may not always be successful, but the opinions of our better judges set a model for rational and humane discourse which the rest of us can only envy.”). But see Rohit A. Sabnis, *Product Configuration Trade Dress and Abercrombie: Analysis of Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd.*, 1 MINN. INTELL. PROP. REV. 183 (2000)(criticizing the opinion on several grounds).

67 “In 1976, Judge Friendly articulated a methodology in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir.1976), that has been cited, quoted, and applied in numerous subsequent trademark cases to determine inherent distinctiveness. A court applying the Abercrombie analysis asks whether the trademark in question is (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, or (5) fanciful.” Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd., 187 F.3d 363, 369 (4th Cir. 1999)(citations omitted).

68 Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd., 187 F.3d 363, 370 (4th Cir. 1999)(citations omitted); See Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd., 187 F.3d 363, 371 (4th Cir. 1999)(“In sum, we hold that the Abercrombie categories, as *Two Pesos* suggests, provide the appropriate basic framework for deciding inherent distinctiveness in product configuration cases.”).
She also explained why this approach was logical. In short, Judge Motz recognized what Justice Scalia in *Wal-Mart* did not. There is no need to create artificial rules dependent on the classification of a putative mark as product configuration as opposed to product packaging, or any other category of word, name, symbol, or device. The Fourth Circuit frankly stated: “the creation of a new rule to be applied only to product configuration would comport neither with the language of the statute nor with the [Supreme] Court's preference for uniformity.” The *Abercrombie* continuum provides the basic tools necessary, and the functionality doctrine provides a safety net to ensure that neither the utilitarian nor aesthetic features of a product’s configuration are protected as trademarks or trade dress.

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69 Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd., 187 F.3d 363, 370 (4th Cir. 1999)(“Furthermore, contrary to suggestions made by courts that would limit the application of *Abercrombie*, it is not inherently impossible, illogical, or anomalous to apply the *Abercrombie* categories to product configuration. The configuration of a banana-flavored candy, for example, would be generic if the candy were round, descriptive if it were shaped like a banana, suggestive if it were shaped like a monkey, arbitrary if it were shaped like a trombone, and fanciful if it were formed into some hitherto unknown shape.”)(citations omitted). See Russ VerSteeg, *Iguanas, Toads, and Toothbrushes: Land Use Regulation of Art as Signage*, 25 GA. L. REV. 437, 470-487 (1991)(In this article, among other things, I discussed the possibility of applying the *Abercrombie* rubric to three-dimensional sculpture (*i.e.*, works of art). I believed then as I do now that such abstract thinking as it relates to symbolism for purposes of trademark analysis can be useful. Judge Motz’s views expressed in *Ashley Furniture* appear consistent with my views).


71 Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd., 187 F.3d 363, 375 (4th Cir. 1999)(“The rule that a product feature is unprotectable if it is functional, however, fully safeguards competitors from the danger that a producer will, through trade dress law, obtain a monopoly over a useful product feature when the alternatives are limited.”)(citing Two Pesos). For more discussion regarding functionality see infra Part II.
In *Ashley Furniture*, the court examined the potential protectability of one of Ashley’s furniture suite designs (the “Sommerset Suite”). Judge Motz candidly acknowledged that the district court below had been faced with a challenge:

In its careful opinion, the district court properly recognized that courts have differed as to how to determine inherent distinctiveness where, as here, the trade dress at issue is the product's configuration or design rather than its packaging. This question has bedeviled courts because determining inherent distinctiveness typically requires verbalizing a judgment about the visual character of the product.\(^\text{72}\)

On appeal, the Fourth Circuit held that the district court was wrong to have granted summary judgment on the basis that Ashley had not presented sufficient evidence regarding whether its design was inherently distinctive.\(^\text{73}\) Using the *Abercrombie* continuum as its basis for analysis, the court held that it was possible for a jury to conclude that the design in question was either arbitrary for fanciful.\(^\text{74}\) Judge Motz relied on *Two Pesos* as authority for the court’s approach (i.e., applying the *Abercrombie* continuum to product design), and explained that the doctrine of functionality (both utilitarian and aesthetic) would serve as a safeguard.\(^\text{75}\)

Of particular additional importance, the opinion also explains how *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.* lends additional aid in evaluating whether a product

\(^{72}\) Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd., 187 F.3d 363, 369 (4th Cir. 1999).

\(^{73}\) Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd., 187 F.3d 363, 368 (4th Cir. 1999).

\(^{74}\) Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd., 187 F.3d 363, 374 (4th Cir. 1999)(“[T]he evidence here supports a possible finding that the Sommerset's total overall image was arbitrary or fanciful and therefore inherently distinctive. A factfinder could reasonably conclude that the total image created by the Sommerset's neo-Roman design has no more to do with bedroom furniture than a penguin does with a publishing company.”).

\(^{75}\) Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd., 187 F.3d 363, 375 (4th Cir. 1999).
configuration may be protectable as valid trade dress. In Seabrook the court established that many visual images and symbols are simply so commonplace that they fail to operate as valid trademarks because consumers perceive such symbols not as source identifiers but rather as perfunctory geometric shapes that are not protectable by trademark law. Arguably, such trite symbols are either generic or aesthetically functional. Judge Motz cited Seabrook for the proposition that many such ordinary symbols would be excluded from trademark protection as generic. To be sure, the functionality doctrine will preclude many such putative marks. The court noted: “Because the functionality requirement adequately safeguards the competitive use of aesthetic features, we see no reason for altering the inherent distinctiveness doctrine to limit protection of such

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76 Seabrook Foods, Inc. v. Bar-Well Foods Ltd., 568 F.2d 1342 (C.C.P.A.1977). The Fifth Circuit has interpreted Seabrook as creating a test that is distinct from Abercrombie, whereas the Fourth Circuit in Ashley Furniture interprets Seabrook as establishing an analysis that may be used in conjunction with Abercrombie. See Amazing Spaces, Inc. v. Metro Mini Storage, 608 F.3d 225, 243-47 (5th Cir. 2010).

77 Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd., 187 F.3d 363, 371 (4th Cir. 1999)(“The Seabrook court explained that in determining inherent distinctiveness a court looks to whether the alleged trade dress is “a ‘common’ basic shape or design,” “unique or unusual in a particular field,” or “a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods.” Seabrook makes plain that a product's overall design cannot be found inherently distinctive if it constitutes a “well-known” or “common” design, even if that design had not before been “refine[d]” in precisely the same way. Rather, to qualify as inherently distinctive a design must be “unique or unusual” in the “particular field” at issue.”)(citations omitted). See also McCarthy on Trademarks § 7:33 (“Ordinary geometric shapes such as circles, ovals, squares, etc., even when used as a background for other marks, are regarded as nondistinctive and protectable only upon proof of secondary meaning.”)(footnote omitted).

78 See infra Part II. E. regarding the close relationship between genericity and functionality.


80 Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd., 187 F.3d 363, 371 (4th Cir. 1999)(“we think it likely that, by and large, the crucial question in product configuration cases will be the question that Seabrook helps answer: whether an alleged trade dress can be considered arbitrary or fanciful or whether it must be ruled generic.”).
features.” And, although Judge Motz acknowledged that applying the \textit{Abercrombie} analysis poses challenges for non-verbal marks, she explained that the analysis is, nevertheless, both workable and appropriate.\footnote{Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd., 187 F.3d 363, 370 (4th Cir. 1999).}

Of course it is possible that a fact-finder could conclude that the eye-appeal of the Sommerset Suite design was the principal consumer motivation. If so, like the Baroque design discussed below in \textit{Wallace International Silversmiths, Inc. v. Godinger Silver Art Co., Inc.} and like the children’s clothing designs in \textit{Wal-Mart}, the aesthetic functionality doctrine might, indeed, serve as a gatekeeper to prevent the suite design from receiving trade dress protection. But Judge Motz’s recognition that there is no need to establish a rule isolating product designs for special treatment deserves serious consideration. The approach of Judge Motz and the Fourth Circuit in \textit{Ashley Furniture}

\footnote{Ashley Furniture Industries, Inc. v. Sangiacomo N.A. Ltd., 187 F.3d 363, 376 (4th Cir. 1999).}
offers a more reasoned approach than that of Justice Scalia and the Supreme Court in *Wal-Mart*.

II. Utilitarian Functionality & Aesthetic Functionality Make The *Wal-Mart* Tripartite Analysis Unnecessary

A. Overview

Part I explained that, by the time that the *Wal-Mart* dust had settled, trademark law was changed. Justice Scalia’s opinion created new doctrine. In the wake of *Wal-Mart*, three categories of putative trademarks are now protectable only upon proof of a secondary meaning: 1) descriptive marks; 2) colors; and 3) product designs. This “*Wal-Mart* tripartite analysis” teaches that when faced with a putative trademark that is descriptive, a color, or a product design, a decision-maker must refuse trademark protection unless the descriptive mark, color, or product design has acquired a secondary meaning. Part II suggests that requiring proof of secondary meaning for colors and product designs is unnecessary and antithetical to the general rules and goals of trademarks. Rather, against a backdrop of the traditional *Abercrombie* analysis, the doctrines of utilitarian functionality and aesthetic functionality provide better analytical tools to use when determining whether a color or a product design ought to operate as a trademark. Professor Dinwoodie also has argued that applying a functionality analysis

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84 “The last thing that trademark law needs is more doctrine.” Dinwoodie, *The Death Of Ontology*, 84 Iowa L. Rev. 611, 702 (1999)(footnote omitted). See also Gilmore, *Grant, The Ages Of American Law* 111 (1977)(“The values of an unjust society will reflect themselves in an unjust law. The worse the society, the more law there will be. In Hell there will be nothing but law, and due process will be meticulously observed.”).

85 Others have recognized the importance of functionality in modern trademark law. See e.g., Dinwoodie, *The Death Of Ontology*, 84 Iowa L. Rev. 611, 617 (1999)(“trademark protection should depend upon whether the particular symbolic matter identifies the
is preferable to making decisions based on classifications of subject matter: “A candid acknowledgement of the real calculus being performed in functionality analysis might bring some transparency to trademark litigation, and reduce purported reliance on increasingly obtuse doctrinal distinctions and tests that consume the attention of litigants and courts to no great effect on the outcome of a case.”86 Relying on functionality provides an easier method of decision-making, and will strengthen the public domain better than the Wal-Mart tripartite analysis.

B. Utilitarian Functionality

It is black letter law that elements or components of a putative trademark or trade dress that are functional in a utilitarian sense cannot operate as a valid trademark or valid trade dress.87 The Restatement (Third) of Unfair Competition articulates the doctrine:

source of a product (i.e., whether the matter is ‘distinctive’), and upon whether protection of a particular symbol would accord the producer a practical monopoly and prevent effective competition by others (i.e., whether the matter is ‘functional’). See also Id. at 699-701 (advocating “a unitary test of functionality” that does not necessarily separate utilitarian functionality from aesthetic functionality. This Article takes a similar philosophical position, nevertheless, it addresses and discusses these two aspects of functionality in separate sections.

87 “The functionality doctrine…forbids the use of a product’s feature as a trademark where doing so will put a competitor at a significant disadvantage because the feature is ‘essential to the use or purpose of the article’ or affects [its] cost or quality.” Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159, 169 (1995)(quoting Inwood v. Ives Laboratories, Inc., 456 U.S. at 850, n. 10). “[A] functional feature is one which competitors would have to spend money not to copy but to design around.” Kohler Co. v. Moen Inc., 12 F.3d 632, 643 (7th Cir. 1993)(citing W.T. Rogers, 778 F.2d at 339, Schwinn Bicycle, 870 F.2d at 1188–89 and Service Ideas, Inc. v. Traex Corp., 846 F.2d 1118, 1123 (7th Cir.1988); Fiji Water Co., LLC v. Fiji Mineral Water USA, LLC, 741 F.Supp.2d 1165, 1172-73 (C.D.Cal. 2010)(defining functionality). See generally MCCARTHY ON TRADEMARKS Chapter IV “Functionality,” Id. §§ 7:67-78 (utilitarian functionality sections). See also In re Morton-Norwich Products, Inc. 671 F.2d 1332 (C.C.P.A. 1982); Note, Mitchell Wong, The Aesthetic Functionality Doctrine And The
A design is “functional” ...if the design affords benefits in the manufacturing, marketing, or use of the goods or services with which the design is used, apart from any benefits attributable to the design’s significance as an indication of source, that are not practically available through the use of alternative designs.  

One of the principal reasons for this bedrock rule is that functional elements or components must be protected in American law, if at all, by a utility patent not by trademark law. Judge Cudahy of the Seventh Circuit has explained the rationale succinctly: “functionality...seeks to protect the integrity of the utility patent system by excepting from configuration trademarks those products for which trademark protection would result in a perpetual monopoly inconsistent with the utility patent laws.” In our

Law Of Trade Dress Protection, 83 CORNELL L. REV. 1116, 117 (1998)(“the courts have held that the ‘functional’ features on a product can never be protected under trade-dress law.”)(footnote omitted)(hereinafter “Wong, The Aesthetic Functionality Doctrine”); Id. at 1119, 1120 (reviewing definitions of functionality); Id. at 1131 (“a feature is functional ‘if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.’”) (footnote omitted); Samuel Oddi, The Functions of Functionality, 22 HOUST. L.REV. 925 (1985); Pierce, If it Walks Like a Duck, 37 New Mexico L.Rev. 147, 181 (2007)(“the functionality doctrine attempts to balance the reputation-related interest of the trademark holder with the competitive interests of her competitors. When the asserted trademark comprises useful features of the product at issue, the balance falls on the side of the competitors.”); Mark Alan Thurmon, The Rise and Fall of Trademark Law’s Functionality Doctrine, 56 Fla. L. Rev. 243, 245 (2004)(“A functional product feature cannot be protected as a trademark.”)(footnote omitted)[hereinafter “Thurmon, The Rise and Fall”]; Id. at 282-84 (discussing Judge Rich’s opinion in In re Morton-Norwich Products); Clegg, Aesthetic Functionality Conundrum and Traderight, 89 IOWA L. REV. 273, 277 (2003).

88 Restatement (Third) of Unfair Competition §17.
89 Kohler Co. v. Moen Inc., 12 F.3d 632, 647 (7th Cir. 1993)(Cudahy, J., Dissenting). (citing Vaughn Mfg. Co. v. Brikam Int'l Inc., 814 F.2d 346, 349 (7th Cir.1987)) (“The defense exists because granting exclusive rights to functional features of products is the domain of patent, not trademark, law.”). See Aurora World, Inc. v. Ty Inc., 719 F.Supp.2d 1115, 1146 (C.D.Cal. 2009); McCARTHY ON TRADEMARKS § 7:63 (“Functionality is a potent public policy, for it trumps all evidence of consumer identification of source....”); Id. § 7:64 (“It is the functionality rule that demarcates the boundary between utility patent law on the one side and the domain of trademark and trade dress law on the other.”)(footnote omitted). See also Wong, The Aesthetic
intellectual property scheme, United States law recognizes that new, useful, and
nonobvious inventions and discoveries must be protected by patent law.® Patent
protection grants to a patentee a monopoly that lasts for twenty years from the date of
filing a patent application.® That twenty-year period is a fixed duration unlike trademark
or trade dress protection which may be renewed ad infinitum for successive ten-year
periods.® In addition, patent protection grants a broad scope of protection that allows a
patentee to prevent others from using the patented invention and even any invention that


® 35 U.S.C. §§ 101, 102, and 103; Sabnis, Product Configuration, 1 MINN. INTELL.
PROP. REV. 183, 189 (2000)(“The functionality requirement prevents trademark law,
which seeks to promote competition by protecting the goodwill of a source, from
inhibiting competition by granting exclusive rights to a functional product feature. It is
the province of patent law to give an inventor a limited exclusive right to practice the
useful, inventive aspects of a product in exchange for its creation and disclosure to the
public. Nevertheless, the patent owner's right to exclude competition from these product
features is not granted without first satisfying four stringent requirements: the inventor
must show that the invention is useful, novel, non-obvious, and described in a way that
enables others to make and use it.”)(footnotes omitted).
is the functional equivalent of it. On the other hand, trademark and trade dress protection afford an owner a right to prevent others from using marks or trade dress that is confusingly similar or, in the case of famous marks, trademark and trade dress protection prohibits dilution caused by blurring or tarnishing. These differences between patent protection versus trademark and trade dress protection are the principal reasons why we carefully police the border line between that which we protect by patent and that which we protect by trademark or trade dress.

In order to help us police this border, courts have developed a systematic mode of analysis in order to determine whether elements, components, or aspects of a putative trademark or trade dress are functional. As a rule, something is functional if it essential to achieving utilitarian objectives or if it has a significant effect on the cost or quality of a product. The Qualitex Court explained:

“[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.

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94 35 U.S.C. §§ 1114 (1), 1125 (c).
95 See Kohler Co. v. Moen Inc., 12 F.3d 632, 637 (7th Cir. 1993)(“Although patent rights are limited in duration by statute, trademark rights may continue as long as the mark is used to distinguish and identify. Significantly, while a patent creates a type of monopoly pricing power by giving the patentee the exclusive right to make and sell the innovation, a trademark gives the owner only the right to preclude others from using the mark when such use is likely to cause confusion or to deceive. See 1 McCarthy on Trademarks § 2.05[1].”).
96 “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.” Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159, 164 (1995).
Thus, if something is necessary to the operation of a device or product, it may be considered functional and, therefore, incapable of being protectable as a trademark or trade dress.

C. Aesthetic Functionality

Aesthetic functionality, a closely-related doctrine, rests upon the principle that there are some products that consumers select and purchase primarily for their visual appeal rather than for their utilitarian advantages. Two foundational cases that illustrate the doctrine of aesthetic functionality are *Pagliero v. Wallace China Co.* and *Wallace Int’l Silversmiths, Inc. v. Godinger Silver Art Co.* In *Pagliero*, the defendant had copied

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98 “[W]here an ornamental feature is claimed as a trademark and trademark protection would significantly hinder competition by limiting the range of adequate alternative designs, the aesthetic functionality doctrine denies such protection.” Wallace International Silversmiths, Inc. v. Godinger Silver Art Co., Inc., 916 F. 2d. 76, 81 (2d Cir. 1990)(citing the Third Restatement of the Law, Unfair Competition (Preliminary Draft No. 3), Ch. 3, § 17(c) at 213–14). See McCarthy on Trademarks §§ 7:79-7:83 (aesthetic functionality sections). See also Sabnis, Product Configuration, 1 Minn. Intell. Prop. Rev. 183, 189 (2000)(“The aesthetic functionality doctrine further seeks to protect competition by recognizing that in some instances non-useful or decorative product features should be denied trade dress protection. Courts have recognized that in some cases, competitors need to copy strictly decorative product features in order to be able to compete effectively.”)(footnote omitted); Samuel Oddi, *The Functions of Functionality*, 22 Houston L. Rev. 925, 93 (1985)(citing the definition from the First Restatement of Torts; Thurmon, *The Rise and Fall*, 56 Fla. L. Rev. 243, 303-308 (2004)(discussing aesthetic functionality).


100 916 F.2d 76 (2d. Cir. 1990). See discussion of this case in McCarthy on Trademarks § 7:80.
several of Wallace’s china patterns and sold the copied designs on hotel dinnerware.  

Principally, the attractive nature of the china patterns motivated buyers. Judge Orr emphasized:

These criteria require the classification of the designs in question here as functional. Affidavits introduced by Wallace repeat over and over again that one of the essential selling features of hotel china, if, indeed, not the primary, is the design. The attractiveness and eye-appeal of the design sells the china. Moreover, 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.

Judge Orr clearly articulated the rationale for the rule of aesthetic functionality:

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

Consequently, the Ninth Circuit held that the china patterns were not operating as trade dress but rather were necessary components of the aesthetic features required in the market (i.e., it was “an important ingredient in the commercial success of the product”). Thus, the court ruled that the design was “a functional feature of the

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101 Pagliero v. Wallace China Co., 198 F.2d 339, 340 (9th Cir. 1952).
102 Pagliero v. Wallace China Co., 198 F.2d 339, 343-44 (9th Cir. 1952)(footnotes omitted).
103 Pagliero v. Wallace China Co., 198 F.2d 339, 343 (9th Cir. 1952)(footnotes omitted).
104 “It seems clear that these designs are not merely indicia of source, o[r] that one who copies them can have no real purpose other than to trade on his competitor’s reputation. On the contrary, to imitate is to compete in this type of situation.” Pagliero v. Wallace China Co., 198 F.2d 339, 344 (9th Cir. 1952). See also Wong, The Aesthetic Functionality
One commentator broadly interprets this case to mean that “[i]f a feature renders a product desirable for any reason other than association with a source or sponsor, then it is ‘functional’ (i.e., serves a function other than identification of source).”

In *Wallace Int’l Silversmiths, Inc. v. Godinger Silver Art Co.*, the defendant sold tableware, in a Baroque pattern that resembled the plaintiff’s; the defendant’s tableware was much less expensive. Judge Winter approvingly cited *Pagliero* for the proposition that design elements that are necessary to compete in a given market cannot be protected by trade dress law. To be sure, in order for a 20th century manufacturer to compete in the market for Baroque-style tableware, the manufacturer was obliged to embellish its products with certain design elements that conveyed or communicated “Baroque” to potential purchasers; a manufacturer must convince buyers that the tableware fits the criteria necessary to be categorized or considered “Baroque.” Presumably the design elements necessary to evoke Baroque-ness cannot be protectable as trade dress. The court explained: “The ‘Baroque’ curls, roots and flowers are not ‘mere indicia of source.’

*Doctrine*, 83 CORNELL L. REV. 1116, 1139 (1998) (“A feature that affects market demand for reasons other than the reputation of its source is presumed to be an aspect which ought not be monopolized by trademark.”)(footnote omitted); *Id.* at 1161 (“Aesthetic functionality seeks to partition designs protectable by trademark from those protectable by copyrights and utility patents.”).  


Instead, they are requirements to compete in the silverware market.”¹⁰⁹ Indeed, the District Court Judge, “Judge Haight found that the similarities between the Godinger and Wallace designs involved elements common to all baroque-style designs used in the silverware market.”¹¹⁰ The Wallace court, concluded, therefore, “that, where an ornamental feature is claimed as a trademark and trademark protection would significantly hinder competition by limiting the range of adequate alternative designs, the aesthetic functionality doctrine denies such protection.”¹¹¹ In this regard, refusing trademark protection on the basis of aesthetic functionality shares the underlying policy of refusing trademark protection on the basis of utilitarian functionality. As Professor Oddi notes:

> there has been general agreement that a feature of a product which affects its utility or its efficiency of use or manufacture is not the proper subject matter of trademark. The policy rationale underlying the denial of trademark protection on the basis of ‘utility’ or ‘efficiency functionality’ is that competitors would be hindered in competition if they could not copy features which affect the efficiency or utility of the product upon which consumer demand is based.¹¹²

In a recent California case involving the issue of aesthetic functionality as it relates to plush toys, the district court remarked:

> Unlike logos, the aesthetic features of plush toys…are essential selling features of the toys. Comparing logos and company names, on the one hand, and plush toys and china patterns, on the other, aids in discerning

¹⁰⁹ Wallace International Silversmiths, Inc. v. Godinger Silver Art Co., Inc., 916 F. 2d. 76, 78 (2d Cir. 1990)(citing Pagliero v. Wallace China Co., 198 F.2d 339, 344 (9th Cir. 1952)).
¹¹¹ Wallace International Silversmiths, Inc. v. Godinger Silver Art Co., Inc., 916 F. 2d. 76, 81 (2d Cir. 1990)(citing Third Restatement of the Law, Unfair Competition (Preliminary Draft No. 3), Ch. 3, § 17(c) at 213–14.)
what constitutes an “aesthetic purpose wholly independent of any source-identifying function.” A manufacturer or designer has an incentive to make a china pattern or plush toy aesthetically pleasing because that drives the consumer's decision to buy the plate or toy. Such designs are, therefore, functional. By contrast, aesthetically pleasing as a logo may be, it merely identifies the source of the product.\textsuperscript{113}

\textbf{D. Traffix Issues}

In \textit{Traffix Devices, Inc. v. Marketing Displays, Inc.}, the Supreme Court, in dictum, articulated the rules of utilitarian functionality and aesthetic functionality in a manner that appeared to have altered their technical definitions somewhat.\textsuperscript{114} Although it is unlikely that the dictum from this case will materially affect the applicability of suggestions made in this Article, it is, nevertheless, worthwhile to consider the potential changes created by \textit{Traffix}. The \textit{Traffix} Court held that an expired patent on the company’s dual spring-support of a road sign was strong evidence of the utilitarian functionality of the design.\textsuperscript{115} In explaining the applicable law regarding functionality, the Court noted: “a functional

\textsuperscript{114} 532 U.S. 23 ((2001). See Thurmon, The Rise and Fall, 56 Fla. L. Rev. 243, 250 (2004)(“The \textit{Traffix} Court held that product features with aesthetic value require different treatment than features with utilitarian value. The competitive need standard…still applies to aesthetic features, but a different standard applies to utilitarian features. Though courts are divided on exactly what the utilitarian standard is, it is clear that more designs will be deemed functional, and thus denied trademark protection, under this standard than under the competitive need standard. The distinction between aesthetics and utility, therefore, is now extremely important.”)(footnotes omitted); Harold R. Weinberg, \textit{Trouble with Traffix}, 9 J. INTELL. PROP. L. 1 (2001)(criticizing the \textit{Traffix} Court’s treatment of “functionality”).
\textsuperscript{115} Traffix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23, 29 ((2001) (“A prior patent, we conclude, has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features therein claimed are functional.”); Id. at 30 (“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.”). See MCCARTHY ON TRADEMARKS § 7:89.
feature is one the ‘exclusive use of [which] would put competitors at a significant non-
reputation-related disadvantage.’” And citing both Qualitex and Inwood Laboratories,
Inc. v. Ives Laboratories, Inc., Justice Kennedy wrote 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. The Qualitex
decision did not purport to displace this traditional rule. Instead, it quoted

the rule as Inwood had set it forth. It is proper to inquire into a ‘significant
non-reputation-related disadvantage’ in cases of esthetic functionality, the
question involved in Qualitex.118

Some commentators and courts have expressed concern that this dictum from the Traffix
decision may have created one rule for utilitarian functionality and a separate rule for
aesthetic functionality; but whether courts have or will embrace this distinction remains
open to question.119 Some recent cases suggest that courts have not adopted Traffix as a
total departure from prior definitions of “functionality,” and that initial worries of a
rewriting of the law of functionality have not been realized. For example the Court of
Appeals of Texas recently stated:

119 See MCCARTHY ON TRADEMARKS § 7:80 (Commenting on Traffix, Professor
McCarthy remarks: “Justice Kennedy further muddied the waters of the aesthetic
functionality theory.”)(footnote omitted); Id. (“Justice Kennedy’s confusing dictum in
Traffix only further clouded and obscured the issue whether aesthetic functionality is in
fact to be given any weight.”)(footnote omitted); Thurmon, The Rise and Fall, 56 Fla. L.
Rev. 341-364 (2004)(advocating that courts ought to return to a standard focused on
competitive need as the benchmark for determining functionality, and that the same
standard ought to apply to both utilitarian and aesthetic functionality); Clegg, Aesthetic
Functionality Conundrum and Trademark, 89 IOWA L. REV. 273, 278 (2003); Id. at 290-
302 (2003)(discussing the potential changes to the definition of “functionality” that
Traffix may have brought about); Weinberg, Trouble with Traffix, 9 J. INTELL. PROP. L. 1,
6 (2001)(“Traffix may cause other trouble as well. For example, it needlessly states two
functionality standards, one for useful design features and one for aesthetic design
features.”).
Generally, a product is functional if it (1) is essential to the use or purpose of the article, or (2) affects the cost or quality of the article. If the asserted trade dress is not functional under this initial test, courts may also consider the “competitive necessity” test of whether the exclusive use of the feature or design “would put competitors at a significant non-reputation-related disadvantage.”

Citing Traffix, the Texas court said: “Without objection, the jury was instructed that ‘[a] product feature is considered functional if it is essential to the use or purpose of the product or if it affects the cost or quality of the product.’” But other courts have interpreted Traffix as having established a new rule. For example in Atlas Equipment Co., LLC v. Weir Supply Group, Inc. the Washington District Court quoted Traffix for the proposition that “competitive necessity is the proper inquiry in cases of ‘[a]esthetic functionality,’ such as where the color of a product is at issue,” and thus reasoned that “[t]he present case is not a case of aesthetic functionality and, thus, there is no need to analyze the competitive necessity” of the product design. The Ninth Circuit also has interpreted Traffix as permitting an inquiry into competition in cases involving aesthetic functionality.

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E. Relationship Between Functionality and Genericity

At this juncture it will be useful to consider the relationship between the concepts of functionality and genericity. The Wallace opinion explicitly connects the dots between these two concepts:

Wallace may not exclude competitors from using those baroque design elements necessary to compete in the market for baroque silverware. It is a first principle of trademark law that an owner may not use the mark as a means of excluding competitors from a substantial market. Where a mark becomes the generic term to describe an article, for example, trademark protection ceases. 125

Thus, the court “perceive[d] no distinction between a claim to exclude all others from use on silverware of basic elements of a decorative style and claims to generic names, basic colors or designs important to a product's utility.” 126 Similarly Judge Cudahy, dissenting in Kohler Co. v. Moen Inc., stated: “What is at stake here is the right to copy the thing itself — that is, to copy its configuration or design. The configuration or design of a product is as generic as the name of the product.” 127

As trademark law concepts, they are intimately related. No one may claim the exclusive right to a generic symbol because all competitors in any given market must have the freedom to use generic symbols in order to convey truthful information to potential buyers. Similarly, no one may claim the exclusive right to the functional elements of a product because, absent patent protection, all competitors in a given market

125 Wallace International Silversmiths, Inc. v. Godinger Silver Art Co., Inc., 916 F. 2d. 76, 81 (2d Cir. 1990)(citations omitted). See Pierce, If it Walks Like a Duck , 37 New Mexico L.Rev. 147, 183-187 (2007)(explaining the strong similarity between the concept of genericity and functionality, citing illustrative cases and scholarship).
127 Kohler Co. v. Moen Inc., 12 F.3d 632, 647 (7th Cir. 1993)(Cudahy, J., Dissenting).
must have the freedom to use the functional elements of a product. In one sense these concepts blur into one. For example, relying again on the simple example of the word “apple,” if used in association with the fruit that we typically refer to as an apple, we would certainly say that the word “apple” is generic for a particular kind of fruit. But we might also say that the word “apple” is functional in the sense that the word functions to convey meaning that is truthful; it communicates to potential buyers the precise nature of the product. But when used in conjunction with computer products, the word “apple” is arbitrary. Consider also non-word symbols such as shapes and scents. An apple shape □ could be considered generic if used as an advertisement for the sale of the fruit itself; and it could be considered functional, because it functions to communicate to potential buyers that that particular type of fruit is being offered for sale.128 The same apple shape □ could

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128 See Application of McIlhenny Co., 278 F.2d 953, 957 (C.C.P.A. 1960) (“It has long been the law that a mere pictorial representation of goods cannot be registered as a trademark for the reason that it is descriptive of the goods and does not indicate origin.”)(citations omitted); McCarthy on Trademarks §§ 7:36-7:37 (Professor McCarthy explains that a picture of a product may be considered “generic.”); Id. § 11:16:50 (“In the same way that pictorial nonword designations can become generic of a product or service, so can such symbols be descriptive of a product or service. For example, a picture that is merely a representation of the goods themselves is regarded as merely descriptive of the goods. Some images may be as descriptive of a product as are words. For example, a pine-tree shape of an air freshener describes the piney scent of the product. Or, an image may be so widely used and so closely associated with a product or service that it is the equivalent of descriptive words. Such descriptive images should be free for all merchants to use unless one has achieved secondary meaning in a particular embodiment of the image.”)(footnotes omitted); Id. § 8:6:50 (“The courts have held that a package or product shape can lack protection as being ‘generic’ if the trade dress is defined as a mere product theme or style of doing business or is such a hackneyed or common design that it cannot identify a particular source.”)(citing Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc. 58 F.3d 27 (2d Cir. 1995), Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc., 280 F.3d 619 (6th Cir. 2002), and Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery, 150 F.3d 1042 (9th Cir. 1998)(Professor McCarthy’s comment about this case is as follows: “the Ninth Circuit found that the concept of a picture of a grape leaf on a bottle of wine was a generic designation and not a protectable mark.”). See also Samuel Oddi, The Functions of Functionality, 22 Houst.
be considered descriptive if used in association with apple-flavored yogurt; and it would probably be functional, because it would function to communicate the product’s flavor to potential buyers. And, again, as was the case with the word “apple,” the shape \( \Box \) would be arbitrary when used in conjunction with computer products. Similarly, an apple scent could be considered generic if used in association with the fruit itself; or it could be considered functional, in the sense that the odor functions in a manner that communicates to potential buyers the nature of the product. An apple scent could be considered descriptive if used in association with apple-flavored gum; and it could also be considered functional because it functions to communicate the flavor. On the other hand, an apple scent would be arbitrary if used in connection with computer products, and would be non-functional.\(^{129}\)

\(^{129}\) See McCarthy on Trademarks § 7:36 (“[A] picture of an apple and a half, with a drop flowing from the half apple, is descriptive of apple juice because it immediately conveys the message of what the product is.”); Bartow, The True Colors of Trademark Law, 97 Kent. L.J. 263, 265 (2008-09) (“Smells, however, present descriptive challenges. Odor based marks can be textually described (e.g., sewing thread with “a high impact, fresh, floral fragrance reminiscent of Plumeria blossoms”), but aromas can be difficult to efficiently reproduce. Unless the scented product or package or a reasonable facsimile is available, the metes and bounds of a trademarked stench are conceptually amorphous. Two people might agree that their noses detect the fragrance of baking bread, or the stink of rotting fruit, but beyond these general descriptions, reducing an airborne bouquet to language is tricky.”)(footnote omitted).
F. Proper Application of the Doctrine of Functionality Makes the Wal-Mart Tripartite Analysis Unnecessary

There is no need to create a special rule, requiring proof of secondary meaning, for colors and product designs. As Judge Motz suggested in Ashley Furniture, when used in conjunction with the Abercrombie analysis, utilitarian functionality and aesthetic functionality serve the same purpose, and serve that purpose better. In the case of colors, a color is functional (or perhaps generic or descriptive) if it immediately conveys a cognitive association in the minds of relevant consumers between itself and the product. For example, arguably the color brown for chocolate milk is either generic or aesthetically functional. The brown color of the milk immediately conveys chocolate flavor to consumers. Similarly, in Wal-Mart, the children’s clothing motifs that Justice Scalia characterized as “product design” were aesthetically functional, because a principal factor motivating consumer purchases was the desire to buy clothing that bore attractive, playful artwork. In a recent California case involving the issue of aesthetic functionality as it relates to plush toys, the court remarked:

Unlike logos, the aesthetic features of plush toys…are essential selling features of the toys. Comparing logos and company names, on the one hand, and plush toys and china patterns, on the other, aids in discerning what constitutes an “aesthetic purpose wholly independent of any source-identifying function.” A manufacturer or designer has an incentive to

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130 See supra Part I.E.
132 See Bartow, The True Colors of Trademark Law, 97 KENT. L.J. 263, 268 (2008-09) (“And there can be no trademark protection when a color has a function, which it always will when it is a product feature.”)(footnote omitted); Id. at 272-74 (explaining the high likelihood that colors will be functional in nearly all contexts); MCCARTHY ON TRADEMARKS § 7:49 (“Functional uses of color are not protectable”)(Professor McCarthy provides numerous examples of functional colors from case law). See also Aurora World, Inc. v. Ty Inc., 719 F.Supp.2d 1115, 1150 (C.D.Cal. 2009)(discussing the functionality of colors in specific cases).
make a china pattern or plush toy aesthetically pleasing because that drives the consumer's decision to buy the plate or toy. Such designs are, therefore, functional.\(^\text{133}\)

Colors, like cuteness and cute visual images, routinely lend attractiveness to products. When consumers want products because they like the colors, the colors are not operating as indicators of source. The Colorado District Court in *Predator Intern., Inc. v. Gamo Outdoor USA, Inc.*, explained that the red-colored tip on air gun pellets functioned in precisely this manner: “That the tips look ‘cool’ and that the shape and red tip combined might be ‘interesting’ to consumers does not establish that the red tip has achieved secondary meaning as a source identifier. Instead, it appears that the red tip has an aesthetic quality, one which competitors, in the absence of secondary meaning, are free to copy.”\(^\text{134}\)

The same may be said about ordinary product shapes. It is common for consumers to react positively to shapes that may be merely mundane yet aesthetically pleasing. In a 2012 case involving the shape of tequila bottles, the California District Court noted: “To the extent that the… plaintiffs define their trade dress to be a trapezoidal-shaped bottle, this Court agrees with the...defendants that there is no inherent distinctiveness. A trapezoid is the sort of intuitive, ‘ordinary geometric shape’ that courts generally ‘regard [...] as non-distinctive and protectable only upon proof of secondary meaning.’”\(^\text{135}\) In a similar manner, rather than needing to characterize the clothing motifs at issue in *Wal-

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Mart as product designs or a tertium quid, a more efficient and preferable mode of analysis would be simply to hold that the clothing motifs were – just as the functional features of plush toys or a trapezoidal bottle – aesthetically functional, and not protecable at all. Interpreting the Samara Brothers designs as aesthetically functional would prevent the designs from operating as trademarks even if the manufacturer were to present proof that they had acquired a secondary meaning. Secondary meaning is irrelevant vis-à-vis functionality. Thus, recognizing the Samara Brothers’ designs as aesthetically functional would strengthen the public domain by preventing such designs from ever garnering trademark protection.

The same could be said for Justice Scalia’s hypothetical penguin-shaped cocktail shaker. Consumers, presumably, would be motivated to purchase such products because of the artwork – their desire to have a shaker in the shape of a cute Arctic bird. Because a penguin-shaped cocktail shaker is aesthetically functional, it also would be incapable of acquiring trademark status even if its manufacturer were to make a prima facie showing of secondary meaning. Consequently, in the absence of a design patent, competitors would be free to sell penguin-shaped cocktail shakers so long as they did not infringe the manufacturer’s copyright. Presumably others would be free to copy the idea of a penguin-shaped shaker so long as they do not copy the manufacturer’s expression.

136 See McCarthy on Trademarks § 7:63 (“For functional items, no amount of evidence of secondary meaning…will create a right to exclude.”)(footnote omitted); 15 U.S.C. § 1125(a)(3)(“In a civil action for trade dress infringement…the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.”).
137 See 35 U.S.C. § 171 (“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefore….“); McCarthy on Trademarks § 7:90 (“Nature of design patent”).
138 See infra Part III. C.
the court in *Aurora World, Inc. v. Ty Inc.*, remarked regarding the functionality of plush toys, “[i]t is the toys' aesthetics that drive the consumer to purchase them; this functionality exists independent of its source-identifying function.” 139 This is the same principle that allowed Godinger to manufacture Baroque tableware. 140 Courts will have an opportunity to employ a less burdensome approach if they analyze cases like *Wal-Mart* not as cases involving product designs that require proof of secondary meaning as an antecedent to protection, but rather as cases involving artistic features that may or may not be aesthetically functional. Not only is the analysis itself simpler but it also increases the likelihood of strengthening the public domain as well. 141

Consider in addition, for example, a case such as *Two Pesos*. In *Two Pesos*, the jury below had determined that the restaurant décor at issue was not functional. 142 The Court emphasized that the appellate court had reached the same conclusion. 143 When considered in light of the doctrine of aesthetic functionality, it is entirely possible that

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140 *Sere supra* text accompanying notes 107-112.
141 See Dinwoodie, *The Death Of Ontology*, 84 Iowa L. Rev. 611, 704 (1999) (“The conceptual role for the functionality doctrine is not to cut a broad swathe through trade dress protection but rather to facilitate courts’ ‘careful and reasoned’ assessment of the effects that individual instances of protection will have on competition. Functionality is to operate as a scalpel, not a scimitar.”)(footnote omitted).
142 “The jury’s answers were: Taco Cabana has a trade dress; taken as a whole, the trade dress is nonfunctional; the trade dress is inherently distinctive; the trade dress has not acquired a secondary meaning in the Texas market….” *Two Pesos, Inc. v. Taco Cabana, Inc.* 505 U.S. 763, 766 (1992)(footnotes omitted). It should be noted that it was the jury that had the authority to decide whether the trade dress was functional: “All courts have held that the enquiry as to functionality is a question of fact.” *McCARTHY ON TRADEMARKS* § 7:71 (footnote omitted).
143 “Both courts thus ruled that Taco Cabana's trade dress was not descriptive but rather inherently distinctive, and that it was not functional.” *Two Pesos, Inc. v. Taco Cabana, Inc.* 505 U.S. 763, 770 (1992).
that factual determination was ill-advised or, perhaps, just plain wrong. In any event, it was certainly not a foregone conclusion. Arguably, certain artistic elements of a restaurant’s décor may, in many circumstances, prove to be functional, or perhaps generic or descriptive. Restaurant patrons typically, for example, associate pictures on a restaurant’s wall of locations in Greece (e.g., Athens famous Acropolis, Greek islands, and the like) as aesthetically functional elements. As has been suggested, we might even regard such décor as generic. Other ethnic cuisines readily come to mind. Chinese dragons, photos of sites of readily-identifiable places in Italy such as the leaning tower of Pisa, the Coliseum, and the like, serve the same purposes, and may easily be construed as generic motifs or aesthetically functional for purposes of trademark and trade dress protectability. In Two Pesos, the Court, quoting the Fifth Circuit’s opinion, explained:

“Taco Cabana describes its Mexican trade dress as

a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals. The patio includes interior and exterior areas with the interior patio capable of being sealed off from the outside patio by overhead garage doors. The stepped exterior of the building is a festive and vivid color scheme using top border paint and neon stripes. Bright awnings and umbrellas continue the theme.”

To be sure, arguably some, if not many or all, of these elements of Taco Cabana’s putative trade dress were descriptive, generic, or functional. As a practical matter, “dining and patio areas decorated with artifacts, bright colors, paintings and murals” of Mexican and Southwestern themes simply are not distinctive; these motifs are as


commonplace (i.e., generic, descriptive, or functional) as a Greek key and murals of the Acropolis are for Greek restaurants. It would be incredible if one restaurant were legally able to monopolize such standard elements of restaurant décor.

The rationale for requiring proof of secondary meaning as a prerequisite for descriptive marks is sound. Congress forged that requirement as part of the Lanham Act.\textsuperscript{146} The Wal-Mart tripartite analysis artificially separates colors and product designs from other putative trademarks and trade dress, and establishes a rule that they, like descriptive marks, must acquire a secondary meaning before they may be considered valid trademarks. Without empirical data as support, the Wal-Mart Court unilaterally assumed that colors and product designs do not automatically communicate source to potential consumers. In truth, word marks and product packaging do not necessarily communicate source to potential buyers either. The Abercrombie analysis teaches that we can only determine whether word marks and product packaging may operate as valid trademarks or trade dress \textit{after we have first analyzed them contextually}. In order to analyze them contextually, a factfinder must juxtapose them with the products that the putative marks represent and then determine the cognitive links, or associations, in the minds of an appreciable number of relevant consumers, between the putative mark and the product. It is only by applying that analysis that a factfinder can accurately determine whether the word mark or product packaging (i.e., the putative mark) is generic (or functional), descriptive, suggestive, arbitrary, or fanciful.

The same analysis ought to work for colors and product designs. Colors and product designs that are generic or functional cannot operate as protectable trademarks or trade

\textsuperscript{146} 15 U.S.C. § 1052.
dress under any circumstances.\textsuperscript{147} Otherwise, colors and product designs that are
descriptive may operate as protectable trademarks or trade dress upon proof of secondary
meaning. When analyzing colors and product designs as potential trademarks, a focus on
the \textit{Abercrombie} analysis, coupled with utilitarian functionality and aesthetic
functionality — rather than applying \textit{Wal-Mart}’s tripartite per se rule of secondary
meaning — will both improve the efficiency of analysis and strengthen the public
domain.

III. Analytical Similarities Between Functionality, Conceptual Separability, and
Idea-Expression

A. Overview

Both judges and commentators have written a great deal about utilitarian functionality
and aesthetic functionality.\textsuperscript{148} “The crux of functionality has variously been described as
whether a feature is ‘superior or optimal’, ‘essential to the use or purpose of the article,’
or ‘an important ingredient in the product’s success…..’”\textsuperscript{149} Distilled to its essentials, an
analysis of utilitarian functionality is an effort to separate certain non-protectable
elements, or aspects, of a putative mark from other elements or aspects that are

\textsuperscript{147} See Bartow, \textit{The True Colors of Trademark Law}, 97 KENT. L.J. 263, 264 (2008-
09)(“Colors always add aesthetic value, and often communicate messages unrelated to
commercial source.”).
\textsuperscript{148} See e.g., Samuel Oddi, \textit{The Functions of Functionality}, 22 HOUST. L.REV. 925 (1985);
Harold R. Weinberg, \textit{Trademark Law, Functional Design Features, and the Trouble with
Traffic}, 9 J. INTELL. PROP. L. 1 (2001); Pierce, \textit{If it Walks Like a Duck}, 37 New Mexico
L.Rev. 147 (2007); Thurmon, \textit{The Rise and Fall}, 56 Fla. L. Rev. 243 (2004); Clegg,\n\textit{Aesthetic Functionality Conundrum and Traderight}, 89 IOWA L. REV. 273 (2003);Wong,\n\textit{The Aesthetic Functionality Doctrine}, 83 CORNELL L. REV. 1116 (1998); Dinwoodie, \textit{The
Death Of Ontology}, 84 Iowa L. Rev. 611 (1999). \textit{See also} Dinwoodie, \textit{The Death Of
\textsuperscript{149} Dinwoodie, \textit{The Death Of Ontology}, 84 Iowa L. Rev. 611, 686 (1999).
protectable by trademark or trade dress law. In particular, elements that promote mechanical or utilitarian objectives are considered “functional” and therefore are not protectable as trademarks.\(^{150}\) Elements that operate to communicate a cognitive link between the putative mark and the producer are, at least theoretically, protectable as trademarks or trade dress. In a similar manner, the aesthetic functionality inquiry also requires that we endeavor to separate certain non-protectable elements, or aspects, of a putative mark from protectable elements or aspects. In particular, elements that are necessary to communicate a particular style (\textit{e.g.}, the Baroque-style in \textit{Wallace v. Godinger}) or elements that communicate a general idea or concept (\textit{e.g.}, the children’s clothing motifs and even Justice Scalia’s hypothetical penguin-shaped cocktail shaker in \textit{Wal-Mart}) are not protectable, whereas ornamental elements that are not essential to conveying a style, concept, or general idea are theoretically protectable as trademarks because they may communicate a cognitive association between the product and the producer that is distinct from the style, concept, or general idea.

Fortunately, lawyers and judges schooled in Intellectual Property are familiar this mode of analysis, because it is precisely the same mode of analysis involved in Copyright law’s issues of conceptual separability and the idea-expression dichotomy. For pictorial, graphic and sculptural works, copyright protection is available for such works insofar as their artistic elements are concerned but not for their utilitarian elements.\(^{151}\) In simple terms, this is the functionality doctrine at work in copyright law. One commentator has explained this obvious connection clearly:

\(^{150}\text{See supra text accompanying notes 87-88.}\)

\(^{151}\text{17 U.S.C. §101 (definition of “Pictorial, graphic, and sculptural works”).}\)
Although copyright functionality is not identical to trademark functionality, they operate on the same basic principles. A design that has utility may not receive copyright protection because it is “functional.” Thus, the design can, at most, be patented. Because a patent’s duration is shorter than that of copyright, the operation of copyright functionality confirms the theory that a feature’s functionality limits the duration of protection that feature may receive. Moreover, copyright’s functionality enables copyrightable products to be separated from patentable products.\textsuperscript{152}

The Copyright Act expressly states this principle of conceptual separability,\textsuperscript{153} and the judiciary, in several famous cases such as \textit{Mazer v. Stein},\textsuperscript{154} \textit{Carol Barnhart Inc. v. Economy Cover Corp.},\textsuperscript{155} and \textit{Bandir Int’l, Inc. v. Cascade Pacific Lumber Co.},\textsuperscript{156} has interpreted it thoughtfully. The idea-expression dichotomy employs the same analytic process in an effort to draw a line between protectable expression versus unprotectable ideas. The Copyright Act articulates this rule,\textsuperscript{157} and well-known cases, such as \textit{Baker v. Selden},\textsuperscript{158} Judge Learned Hand’s classic opinion in \textit{Nichols v. Universal Pictures Corp.},\textsuperscript{159} and \textit{Herbert Rosenthal Jewelry Corp. v. Kalpakian}\textsuperscript{160} have explained the doctrine and its application.

\textsuperscript{153} 17 USC. § 101 (definition “pictorial, graphic, and sculptural works”).
\textsuperscript{154} 347 U.S. 201 (1954).
\textsuperscript{155} 773 F.2d 411 (2d Cir. 1985).
\textsuperscript{156} 834 F. 2d 1142 (2d Cir. 1987).
\textsuperscript{157} 17 U.S.C. § 102 (b).
\textsuperscript{158} 101 U.S. (11 Otto) 99 (1879).
\textsuperscript{159} 45 F.2d 119 (2d Cir. 1930).
\textsuperscript{160} 446 F.2d 738 (9th Cir. 1971).
B. Conceptual Separability Analysis

The United States Copyright Act expressly protects “pictorial, graphic, and sculptural works” as a distinct category of “works of authorship,” and, therefore, protectable, copyrightable subject matter.161 The Act defines “pictorial, graphic, and sculptural works” as follows:

‘Pictorial, graphic, and sculptural works’ include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.162

This provision of the Copyright Act is relevant to trade dress because product packaging frequently contains two-dimensional pictorial and/or graphic material, and because a product’s design (i.e., its overall shape or configuration) may be considered a three-dimensional sculptural work. The Act expressly draws a line between the artistic features of pictorial, graphic, and sculptural works versus the utilitarian features of such works. Courts have successfully applied this principle. The landmark case that established this tenet, well before its statutory embodiment, was Mazer v. Stein.163 Mazer involved statuettes of dancers that were being used as a lamp bases. The principal issue in the case

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162 17 U.S.C. §101 (definition of “pictorial, graphic, and sculptural works”) (emphasis added).
was whether the product’s design – its human-dancer-shape – was protected by copyright law. According to Justice Reed:

   This case involves the validity of copyrights obtained by respondents for statuettes of male and female dancing figures made of semivitreous china. The controversy centers around the fact that although copyrighted as ‘works of art,’ the statuettes were intended for use and used as bases for table lamps, with electric wiring, sockets and lamp shades attached.164

The defendant argued that, because the statuettes served as a lamp bases, they were functional. The United States Supreme Court recognized the need to separate the artistic elements of the shape from the functional elements. The artistic features that were required to communicate human form to a viewer were theoretically protectable by copyright, whereas the features that enabled the device to enclose wires and support a light bulb and lamp shade were not protectable by copyright because they were utilitarian. Citing the Copyright Office Regulations in force at the time,165 the Court remarked that “artistic articles are protected in ‘form but not their mechanical or utilitarian aspects.’”166

    Carol Barnhart Inc. v. Economy Cover Corp.,167 involved mannequins. This case is especially interesting and potentially instructive in terms of trademark analysis because the issues actually relate to both utilitarian and aesthetic functionality. The plaintiff had created four mannequin shapes: two naked torsos (male and female) and two clothed torsos (one with a traditional men’s button-down, collared shirt and the other with a

167 773 F.2d 411 (2d Cir. 1985).
buttoned women’s blouse).\textsuperscript{168} The Second Circuit addressed the question of whether these mannequin shapes were copyrightable. The district judge below had granted the defendant’s motion for summary judgment on grounds that the mannequins were “utilitarian articles not containing separable works of art, and thus are not copyrightable.”\textsuperscript{169} The Second Circuit affirmed.\textsuperscript{170} Judge Mansfield framed the question: “Since the four Barnhart forms are concededly useful articles, the crucial issue in determining their copyrightability is whether they possess artistic or aesthetic features that are physically or conceptually separable from their utilitarian dimension.”\textsuperscript{171} The court, in a footnote, quoted at length the House Report that accompanied the 1976 Copyright Act:

A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statute or carving is used to embellish an industrial product or, as in the \textit{Mazer} case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee’s intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane,

\textsuperscript{168} The bones of contention are four human torso forms designed by Barnhart, each of which is life-size, without neck, arms, or a back, and made of expandable white styrene. Plaintiff’s president created the forms in 1982 by using clay, buttons, and fabric to develop an initial mold, which she then used to build an aluminum mold into which the poly-styrene is poured to manufacture the sculptural display form. There are two male and two female upper torsos. One each of the male and female torsos is unclad for the purpose of displaying shirts and sweaters, while the other two are sculpted with shirts for displaying sweaters and jackets. All the forms, which are otherwise life-like and anatomically accurate, have hollow backs designed to hold excess fabric when the garment is fitted onto the form.” 773 F.2d 411, 412 (2d Cir. 1985).

\textsuperscript{169} 773 F.2d 411, 412 (2d Cir. 1985); 773 F.2d 411, 412 (2d Cir. 1985). ("[T]he district court determined that since the Barnhart forms possessed no aesthetic features that could exist, either physically or conceptually, separate from the forms as utilitarian articles, they were not copyrightable.").

\textsuperscript{170} 773 F.2d 411, 412 (2d Cir. 1985).

\textsuperscript{171} 773 F.2d 411, 414 (2d Cir. 1985).
ladies' dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and independence from ‘the utilitarian aspects of the article’ does not depend upon the nature of the design — that is, even if the appearance of an article is determined by esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the over-all configuration of the utilitarian article as such.\textsuperscript{172}

According to the court, “Congress has explicitly refused copyright protection for works of applied art or industrial design which have aesthetic or artistic features that cannot be identified separately from the useful article. Such works are not copyrightable regardless of the fact that they may be ‘aesthetically satisfying and valuable.’”\textsuperscript{173} The court, thus, concluded: “Applying these principles, we are persuaded that since the aesthetic and artistic features of the Barnhart forms are inseparable from the forms' use as utilitarian articles the forms are not copyrightable.”\textsuperscript{174}

It is clear just how much the court’s analysis resembles the trademark examination of aesthetic functionality without actually using that term. According to the court, “[i]n the case of the Barnhart forms…the features claimed to be aesthetic or artistic, \textit{e.g.}, the life-size configuration of the breasts and the width of the shoulders, are inextricably intertwined with the utilitarian feature, the display of clothes. Whereas a model of a human torso, in order to serve its utilitarian function, must have some configuration of

\textsuperscript{174} 773 F.2d 411, 418 (2d Cir. 1985).
the chest and some width of shoulders.” As a practical matter, indeed, a merchant selling clothing could offer her wares without displaying samples on mannequins. In addition, someone selling clothing could use mannequins that merely approximate human shape, with no additional anatomical or artistic elements to identify gender or anything but the most simple and utilitarian body shape. Presumably, one may envision such mannequins in the most rudimentary, unvarnished approximation of human form (and presumably such plainly-shaped mannequins exist). Presumably such mannequins would be devoid of individualistic human features, and would be considered entirely functional in a utilitarian sense. But, as the opinion implies, a merchant selling men’s shirts and women’s blouses could use the naked Carol Barnhart torsos to display such clothing. And, similarly, someone selling outer-ware, such as sweaters, coats, or jackets could use the clothed Carol Barnhart torsos to display that type of clothing. As the Second Circuit remarked when discussing this later in *Bandir Int’l, Inc. v. Cascade Pacific Lumber Co.*: “the distinctive features of the torsos — the accurate anatomical design and the sculpted shirts and collars — showed clearly the influence of functional concerns.”

*Bandir Int’l, Inc. v. Cascade Pacific Lumber Co.* involved the copyrightability of a ribbon-shaped bicycle rack; “a bicycle rack made of bent tubing that is said to have originated from a wire sculpture.” The Second Circuit determined that the ribbon-shape could not be separated from the utilitarian purpose of the rack to allow storage of multiple bicycles. Judge Oakes quoted with approval Professor Robert Denicola’s now-famous article: “Professor Denicola points out that although the Copyright Act of 1976

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175 773 F.2d 411, 419 (2d Cir. 1985).
176 834 F. 2d 1142, 1145 (2d Cir. 1987).
177 834 F. 2d 1142 (2d Cir. 1987).
178 834 F. 2d 1142, 1143 (2d Cir. 1987).
was an effort ‘to draw as clear a line as possible,’ in truth ‘there is no line, but merely a spectrum of forms and shapes responsive in varying degrees to utilitarian concerns.’”

Judge Oakes then captured the essence of professor Denicola’s analysis:

To state the Denicola test in the language of conceptual separability, if design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists.  

Thus, the court determined that the utilitarian elements of the ribbon-shape were incapable of existing separately from the putative artistic elements: “Applying Professor Denicola's test to the RIBBON Rack, we find that the rack is not copyrightable. It seems clear that the form of the rack is influenced in significant measure by utilitarian concerns and thus any aesthetic elements cannot be said to be conceptually separable from the utilitarian elements.” Interestingly, the Second Circuit recently cited both *Traffix* and *Bandir* in virtually the same breath in analyzing the issues of trade dress protection and functionality for a watch design.

Admittedly, the analysis employed in copyright law to determine conceptual separability for pictorial, graphic, and sculptural works is not an exact mirror image of the analysis in trademark law to assess functionality and aesthetic functionality. Judge

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180 834 F. 2d 1142, 1145 (2d Cir. 1987).


Newman, dissenting in Carol Barnhart, noted a slight distinction, and Judge Oakes in Bandir mentioned this distinction as well. Nevertheless, although the ultimate questions may vary in a nuanced manner, the similarities between the methods of examination far outnumber and outweigh the minor differences. Thus, when confronted with issues that require courts to apply the doctrines of functionality and aesthetic functionality in the context of trademarks or trade dress, courts will benefit from borrowing the analytical sorting mechanisms used in precedent cases involving conceptual separability in copyright law.

C. Idea-Expression Analysis

The Copyright Act articulates the principle that copyright protects expression but not ideas: “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.” The classic, chestnut case that established this principle is Baker v. Selden. The issue in Baker centered on the scope of copyright protection in “a book, entitled ‘Selden's Condensed Ledger, or Book-keeping Simplified,' the object of which was to exhibit and explain a peculiar system of book-keeping.” The Court presented the question as follows: “whether the exclusive property in a system of book-keeping can be claimed, under the law or copyright, by means of a book in which that system is

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184 834 F. 2d 1142, 1148 (2d Cir. 1987).
explained?” Justice Bradley made it clear that the defendant was free to borrow the plaintiff’s ideas and methods, because the scope of the plaintiff’s copyright did not extend to the overall “plan”: “[t]he copyright of a book on book-keeping cannot secure the exclusive right to make, sell, and use account-books prepared upon the plan set forth in such book.” Subsequently, judges have labored to articulate a workable process by which to determine what elements of a work may be protectable by copyright versus those elements that represent merely the plan or general idea, and thus, are not copyrightable.

The venerable Judge Learned Hand authored several opinions that have provided useful insight into this process. One such opinion is Nichols v. Universal City Studios. In Nichols Judge Hand set the stage: “The plaintiff is the author of a play, ‘Abie’s Irish Rose,’ which it may be assumed was properly copyrighted….The defendant produced publicly a motion picture play, ‘The Cohens and The Kellys,’ which the plaintiff alleges was taken from it.” In holding that the defendant’s movie did not infringe the plaintiff’s play, Judge Hand explained that, like Baker v. Selden, the scope of the plaintiff’s copyright did not encompass either the plaintiff’s ideas or macroscopic structure:

Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his ‘ideas,’ to which, apart from their expression, his property is never
extended. Nobody has ever been able to fix that boundary, and nobody ever can.\textsuperscript{192}

To be sure, Judge Hand here identified an important aspect of the idea-expression analysis. In determining where the line ought to be drawn between idea and expression, we must realize that, by definition, the idea falls on the most general end of a continuum and the expression falls on the most specific end of the same continuum. Elements necessary to communicate a general idea are not protectable by copyright because others are free to copy an author’s ideas. But elements that go beyond what is necessary to communicate the idea are protectable because others do not need to use such elements — elements that are not dictated by the idea itself. When a copyist takes elements that are not dictated by the general idea, she takes elements that may comprise an author’s protectable expression. Conceptually, this is precisely the analysis involved in the trademark inquiry regarding both genericity and functionality where elements necessary to communicate the nature of the product (genericity) or the style or general idea (aesthetic functionality) are not protectable.\textsuperscript{193}

\textsuperscript{192} 45 F.2d 119, 121 (2d Cir. 1930)(internal citations omitted). This has come to be known as Judge Hand’s “abstractions test.”
\textsuperscript{193} See Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc. 58 F.3d 27, 33 (2d Cir. 1995)(Writing for the court, Judge Newman expressly recognized this very analogy: “Drawing the line between “ideas” or “concepts” on the one hand and “concrete expressions” on the other may sometimes present close questions. Often a helpful consideration will be the purpose of trade dress law: to protect an owner of a dress in informing the public of the source of its products, without permitting the owner to exclude competition from functionally similar products. The line-drawing task is analytically no different than applying Learned Hand’s “abstractions” test in the copyright field, see Nichols v. Universal Pictures Corp. to distinguish an unprotectable idea from a protectable expression of the idea. The level of generality at which a trade dress is described, as well as the fact that a similar trade dress is already being used by manufacturers of other kinds of products, may indicate that that dress is no more than a concept or idea to be applied to particular products.)(citations omitted).
Herbert Rosenthal Jewelry Corp. v. Kalpakian\textsuperscript{194} represents, in many respects, one of the most useful copyright cases to consider for purposes of this discussion. The plaintiff sold pieces of jewelry, pins in the shape of a bee.\textsuperscript{195} The defendant made and also sold bee-shaped pins. Thus, the Ninth Circuit Court of Appeals was asked to analyze the scope of the copyright for the product’s design, the object’s shape. Judge Browning succinctly stated the rule: “A copyright…bars use of the particular ‘expression’ of an idea in a copyrighted work but does not bar use of the ‘idea’ itself. Others are free to utilize the ‘idea’ so long as they do not plagiarize its ‘expression.’”\textsuperscript{196} In sum, the court reasoned that “[a] jeweled bee pin is therefore an ‘idea’ that defendants were free to copy.”\textsuperscript{197} What is especially significant, is that the court recognized that the artistic elements that were necessary to communicate “bee-ness” (\textit{i.e.}, the \textit{idea} of a bee) were not protectable within the scope of copyright law. This is exactly the same reasoning that the Wallace v. Godinger court used when it determined that the artistic elements of the plaintiff’s silverware that were necessary to communicate “Baroque-ness” were not protectable within the scope of trademark or trade dress law. In this regard, the Baroque “style” is analogous to the idea of a bee-shaped pin. In Herbert Rosenthal Jewelry, Judge Browning noted that the overlap of appearance between the plaintiff’s and defendant’s pins was due to the elements necessary to evoke the concept of a bee. Thus, since the scope of the plaintiff’s copyright could not extend to the elements necessary to evoke the idea of a bee, there was no infringement. According to the court, “[t]here is no greater

\textsuperscript{194} 446 F.2d 738 (9th Cir. 1971).
\textsuperscript{195} 446 F.2d 738, 739 (1971)(“Plaintiff charged defendants with infringing plaintiff’s copyright registration of a pin in the shape of a bee formed of gold encrusted with jewels.”).
\textsuperscript{196} 446 F.2d 738, 741 (1971).
\textsuperscript{197} 446 F.2d 738, 742 (1971).
similarity between the pins of plaintiff and defendants than is inevitable from the use of jewel-encrusted bee forms in both.”

Conclusion

Justice Scalia’s opinion in Wal-Mart fashioned new law. In order for a product design to serve as protectable trade dress or as a trademark, that design must first acquire a secondary meaning. Such a rule is both unnecessary and unwarranted. It is unnecessary because proper application of the traditional Abercrombie rubric and the doctrines of utilitarian functionality and aesthetic functionality serve the same purpose, only better. The Court justifies its new law, in part, by remarking that, like colors, product shapes rarely automatically communicate source identification – in a trademark sense – to consumers. According to the Court: “In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs — such as a cocktail shaker shaped like a penguin — is intended not to identify the source, but to render the product itself more useful or more appealing.”

Features that “render the product itself more useful and appealing” are, by definition, either functional in a utilitarian sense or aesthetically functional. The Wal-Mart rule is unwarranted because it actually confuses the pivotal issue in such cases and because it fails to protect the public domain adequately. The pivotal issue in such cases is whether the elements of a product’s design (i.e., the design for which the putative mark owner

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198 446 F.2d 738, 742 (1971). See also Samuel Oddi, The Functions of Functionality, 22 HOUST. L.REV. 925, 955-56 (1985)(discussing several cases denying trademark protection for jewelry designs based on aesthetic functionality).

seeks protection) communicate source-identification or whether they perform a utilitarian objective or communicate a style, genre, or idea. If those elements perform a utilitarian objective, they are functional in a utilitarian sense. If they communicate a style, genre, or idea, they are functional in an aesthetic sense. The Wal-Mart tripartite test shifts the court’s focus to the issue of secondary meaning rather than the most pertinent questions; namely, the Abercrombie analysis and functionality. Secondary meaning is irrelevant when a putative mark is generic or functional. It is only relevant when a putative mark is descriptive. Artificially categorizing colors and product shapes as “descriptive” is unprincipled logic. The Wal-Mart tripartite analysis leaves the door open for aesthetically functional colors and designs to gain trademark protection if the owner succeeds in proving secondary meaning. This would rob the public domain at the expense of competitors who have a legitimate interest in retaining the right to use functional colors and designs. Over-emphasis on secondary meaning in cases involving colors and product designs may serve as a decoy that distracts the decision-maker from the more important functionality, genericity, and descriptiveness inquiries.

Professor Dinwoodie recognized the importance of analyzing putative trademarks and trade dress using the Abercrombie principles and the functionality doctrine as opposed to their “ontological status.” Dinwoodie, The Death Of Ontology, 84 Iowa L. Rev. 611, 652-53 (1999)(“The Qualitex Court acknowledged that it is distinctiveness, ‘the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve [the] basic purposes [of trademark protection].’”) And it is the concept of functionality that prevents trade dress protection from inhibiting the competition it is intended to promote or frustrating the purpose of the patent law with which it co-exists. Modern trademark analysis must therefore focus on the purposes of protection—both what trademark is intended to do (protect source-identification) and what it is not intended to do (impede competition or serve as a surrogate for patent law). Conceptual inquiries directly implementing these limited purposes of trademark set the parameters of protection.”)

See supra note 136 and accompanying text.
The experience of the judiciary’s construction of the Copyright principles of conceptual separability and the idea-expression dichotomy offers guidance in the process of analyzing functionality and aesthetic functionality in the context of product shapes. Using these analogues, courts will be able better to assess the protectability of product shapes as trademarks or trade dress. As is true in applying the idea-expression dichotomy when dealing with two and three-dimensional works of art, the task will not always be easy. Judge Hand expressed this eloquently and insightfully:

Obviously, no principle can be stated as to when an imitator has gone beyond copying the “idea,” and has borrowed its “expression.” Decisions must therefore inevitably be ad hoc. In the case of designs, which are addressed to the aesthetic sensibilities of an observer, the test is, if possible, even more intangible. No one disputes that the copyright extends beyond a photographic reproduction of the design, but one cannot say how far an imitator must depart from an undeviating reproduction to escape infringement. In deciding that question one should consider the uses for which the design is intended, especially the scrutiny that observers will give to it as used.²⁰²

Judge Friendly explained the most important and essential principles of trademark law in *Abercrombie & Fitch v. Hunting World*. Justice White reminded us of the soundness of those principles in *Two Pesos* when he said that “[t]here is no persuasive reason to apply to trade dress a general requirement of secondary meaning which is at odds with the principles generally applicable to infringement suits under § 43(a).”²⁰³ Punctuating his point, a point that both Justices Breyer and Scalia seem to have missed later, he stated without equivocation:

Where secondary meaning does appear in the statute, 15 U.S.C. § 1052 (1982 ed.), it is a requirement that applies only to merely descriptive marks and not to inherently distinctive ones. We see no basis for requiring secondary meaning for inherently distinctive trade dress protection under

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²⁰² *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).
§ 43(a) but not for other distinctive words, symbols, or devices capable of identifying a producer's product.204

Justice Breyer may have veered slightly off-course in Qualitex if he actually meant to create a per se rule, requiring colors to acquire a secondary meaning as a condition precedent to being protectable as trademarks. But in Wal-Mart Justice Scalia plainly took a wrong turn when he laid down the law that secondary meaning is explicitly required for both colors and product shapes to qualify for status as trademarks or trade dress. Ignoring the teachings of Abercrombie for colors and product shapes makes no sense. Admittedly, one of the problems with analyzing the trade dress protectability of product designs, as occurs so often with many legal problems, is that “what seems to be a simple question turns out to be a very large array of problems that involve whole philosophies of law and an inevitable degree of subjectivity.”205 The analysis suggested in this Article will require abstract thinking rather than reliance on concrete subject matter categorization. But such metaphysical, abstract reasoning often lies at the heart of sound intellectual property analysis. This is nothing new. Historically speaking, some of the earliest human writing used the symbolism of an object’s shape to convey linguistic meaning.206 It is time for the judiciary to recalculate its position, acknowledge Wal-Mart as an unfortunate lapse of attention, and apply a functionality analysis within the context of the Abercrombie rubric when asked to determine whether a color or product shape qualifies for trademark or trade dress protection.

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204 Two Pesos, Inc. v. Taco Cabana, Inc. 505 U.S. 763, 774 (1992)(emphasis added).
206 See GARDINER, SIR ALAN, EGYPT OF THE PHARAOHS 19-26 (1961), and supra note 128 regarding the Ancient Egyptian use of “ideograms.”

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