

No. 21-417

IN THE
Supreme Court of the United States

SULZER MIXPAC AG,

Petitioner,

v.

A&N TRADING COMPANY, ET AL.,

Respondents.

**On Petition For A Writ Of Certiorari
To The United States Court of Appeals
For The Second Circuit**

BRIEF IN OPPOSITION

JACK A. GORDON
JOSHUA B. KATZ
Counsel of Record
KENT, BEATTY & GORDON, LLP
Eleven Times Square
New York, New York 10036
(212) 421-4300
jbk@kbg-law.com

Counsel for Respondents

QUESTION PRESENTED

Whether the court of appeals correctly held that petitioner’s so-called “Candy Colors” trade dress—which petitioner describes as a system for color-coding dental mixing tips by size “to enable users to quickly select a mixing tip that matches the proper cartridge” and “simplify handling” (Pet.App.9a)—was functional and therefore ineligible for trademark protection.

CORPORATE DISCLOSURE STATEMENT

1. A&N Trading Company has no parent corporation and no publicly-held corporation owns 10% or more of its stock.

2. A&N Trading Co., Ltd. has no parent corporation and no publicly-held corporation owns 10% or more of its stock.

TABLE OF CONTENTS

	Page
QUESTION PRESENTED.....	i
CORPORATE DISCLOSURE STATEMENT	ii
INTRODUCTION.....	1
STATEMENT	4
A. Legal Background.....	4
B. Factual Background	6
C. Proceedings Below	10
REASONS FOR DENYING THE PETITION	14
I. The Second Circuit’s Decision Correctly Applied this Court’s Precedents and Does Not Conflict With Any Other Circuit	14
II. The Question Presented Was Neither Raised in Nor Considered by the Court of Appeals.....	21
CONCLUSION	22

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Acacia, Inc. v. NeoMed, Inc.</i> , 2012 WL 3019948 (C.D. Cal. July 23, 2012).....	3
<i>Acco Brands USA, LLC v. Comarco Wireless Techs., Inc.</i> , 2013 WL 843447 (N.D. Cal. Mar. 6, 2013).....	20
<i>Al-Site Corp. v. VSI Int’l, Inc.</i> , 174 F.3d 1308 (Fed. Cir. 1999).....	3
<i>Arlington Specialties, Inc. v. Urb. Aid, Inc.</i> , 847 F.3d 415 (7th Cir. 2017).....	19
<i>Bedford v. Hunt</i> , 3 F. Cas. 37 (C.C.D. Mass. 1817).....	16
<i>Bodum USA, Inc. v. A Top New Casting Inc.</i> , 927 F.3d 486 (7th Cir. 2019).....	19
<i>Bonito Boats, Inc. v. Thunder Craft Boats, Inc.</i> , 489 U.S. 141 (1989).....	4
<i>Car-Freshner Corp. v. D & J Distrib. & Mfg., Inc.</i> , 2015 WL 3385683 (S.D.N.Y. May 26, 2015)	3
<i>Carlisle Plastics, Inc. v. Spotless Enterprises, Inc.</i> , 984 F. Supp. 646 (E.D.N.Y. 1997)	20

TABLE OF AUTHORITIES – Continued

	Page(s)
<i>Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.</i> , 696 F.3d 206 (2d Cir. 2012)	1, 12
<i>Compcorp. v. Day-Brite Lighting, Inc.</i> , 376 U.S. 234 (1964).....	16
<i>Converse, Inc. v. Int’l Trade Comm’n Skechers U.S.A., Inc.</i> , 909 F.3d 1110 (Fed. Cir. 2018).....	19
<i>CTB, Inc. v. Hog Slat, Inc.</i> , 954 F.3d 647 (4th Cir. 2020).....	17
<i>Dastar Corp. v. Twentieth Century Fox Film Corp.</i> , 539 U.S. 23 (2003).....	4
<i>Dippin’ Dots, Inc. v. Frosty Bites Distrib., LLC</i> , 369 F.3d 1197 (11th Cir. 2004).....	3
<i>Envirotech Corp. v. Al George, Inc.</i> , 730 F.2d 753 (Fed. Cir. 1984).....	17
<i>Fabrication Enterprises, Inc. v. Hygenic Corp.</i> , 64 F.3d 53 (2d Cir. 1995)	11, 12
<i>Fuji Kogyo Co. v. Pac. Bay Int’l, Inc.</i> , 461 F.3d 675 (6th Cir. 2006).....	18

TABLE OF AUTHORITIES – Continued

	Page(s)
<i>Graham v. John Deere Co. of Kansas City</i> , 383 U.S. 1 (1966).....	4
<i>Home Builders Ass’n of Greater St. Louis v. L&L Exhibition Mgmt., Inc.</i> , 226 F.3d 944 (8th Cir. 2000).....	17
<i>I.P. Lund Trading ApS v. Kohler Co.</i> , 163 F.3d 27 (1st Cir. 1998).....	17
<i>In Re Integra Biosciences Corp.</i> , No. 87484450, 2022 WL 225424 (T.T.A.B. Jan. 24, 2022).....	20
<i>In re Levin</i> , 107 F.3d 30 (Fed. Cir. 1997).....	20
<i>Inwood Laboratories, Inc.</i> , 456 U.S.....	2, 6, 12
<i>Kasco Corp. v. Southern Saw Service Inc.</i> , 27 U.S.P.Q.2d 1501 (T.T.A.B. 1993).....	20
<i>Leapers, Inc. v. SMTS LLC</i> , 879 F.3d 731 (6th Cir. 2018).....	18
<i>Minemyer v. B-Roc Representatives, Inc.</i> , 678 F. Supp. 2d 691 (N.D. Ill. 2009).....	3

TABLE OF AUTHORITIES – Continued

	Page(s)
<i>Penn. Dep't of Corr. v. Yeskey</i> , 524 U.S. 206 (1998).....	21
<i>Qualitex Co. v. Jacobson Prods. Co., Inc.</i> , 514 U.S. 159 (1995).....	5, 12
<i>Saint-Gobain Corp. v. 3M Co.</i> , 90 U.S.P.Q.2d 1425 (T.T.A.B. 2007).....	20
<i>Spraying Sys. Co. v. Delavan, Inc.</i> , 762 F. Supp. 772 (N.D. Ill. 1991).....	3
<i>Stiftung v. Renishaw PLC</i> , 945 F.2d 1173 (Fed. Cir. 1991).....	17
<i>Tools USA & Equip. Co. v. Champ Frame Straightening Equip. Inc.</i> , 87 F.3d 654 (4th Cir. 1996).....	17
<i>TrafFix Devices, Inc. v. Mktg. Displays, Inc.</i> , 532 U.S. 23 (2001).....	<i>passim</i>
<i>Wal-Mart Stores, Inc. v. Samara Bros.</i> , 529 U.S. 205 (2000).....	5
<i>Warner Lambert Co. v. McCrory's Corp.</i> , 718 F. Supp. 389 (D.N.J. 1989)	3

TABLE OF AUTHORITIES – Continued

Page(s)

Statutes and Constitutional Provisions

35 U.S.C. §§ 1-3, 154(a)(2).....	4
U.S. Const. art. I, § 8, cl. 8.....	4

INTRODUCTION

Petitioner asks the Court to resolve a supposed circuit split about whether “any degree of utility” renders a trademark functional. Pet.i. Just a few months ago, this Court denied a petition seeking to present the same question, *Ezaki Glico Kabushiki Kaisha v. Lotte Int’l Am. Corp.*, No. 20-1817 (see Pet.18), and this case is an even worse candidate for certiorari than *Glico*. For starters, the Second Circuit didn’t even consider that question, because petitioner did not raise it. In *Glico*, the Third Circuit’s opinion at least had some language that charitably “could be interpreted” (Pet.12) as applying an any-degree-of-utility test. But here, the Second Circuit’s sole reference to “degree of utility” is a quote from the *district court*, which the Second Circuit mentioned only to criticize as “unclear because it failed to apply the test set forth in [*Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012)], and thus did not consider whether the colors affected the quality of the tips.” Pet.App.16a.

The Second Circuit’s *Louboutin* test, which the panel applied below, perfectly tracks this Court’s opinion in *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001), and does not conflict with any other circuit. Under *Louboutin*, “a product feature is considered to be ‘functional’ in a utilitarian sense if it is (1) ‘essential to the use or purpose of the article,’ or if it (2) ‘affects the cost or quality of the article.’”

Pet.App.13a; *see TrafFix Devices, Inc.*, 532 U.S. at 35 (“a product design which has a particular appearance may be functional because it is ‘essential to the use or purpose of the article’ or ‘affects the cost or quality of the article.’”) (quoting *Inwood Laboratories, Inc.*, 456 U.S. at 850 n.10). “[I]f a design feature would, from a traditional utilitarian perspective, be considered essential to the use or purpose of the article, or to affect its cost or quality, then the design feature is functional under *Inwood* and our inquiry ends.” Pet.App.16a. (quotation omitted). “If and only if a design feature is not functional in the traditional sense, do we move to the fact-intensive test where the feature must be shown not to have a significant effect on competition in order to receive trademark protection.” *Id.*; *see TrafFix Devices, Inc.*, 532 U.S. at 33 (“Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.”).

Applying that framework, the Second Circuit found that “the evidence ... firmly establishes that the colors signify diameter, which in turn assists users with selecting the proper cartridge for their needs,” thereby affecting their quality. Pet.App.15a. This compelling evidence, which the petition completely ignores, included (i) admissions by several Mixpac executives that its color-coding scheme simplifies handling and makes the mixing tips easier to use, (ii) Mixpac’s advertising which touts the utility of the color-coding, and (iii) third-party websites and materials manufacturers that rely on the color-coding scheme. Thus, the color-coding system “improve[s] the operation of the goods.” Pet.App.15a (quotation omitted).

Far from breaking new ground or splitting from other circuits, the Second Circuit's decision was merely one in a long line of cases holding that a color-coding system that helps users identify a characteristic of the product is functional.¹ Indeed, Mixpac fails to cite a single case that found such a color-coding system non-functional. In short, the Second Circuit's decision faithfully applied this Court's precedents, does not conflict with any other circuit, and is manifestly correct. The petition should be denied.

¹ See, e.g., *Dippin' Dots, Inc. v. Frosty Bites Distrib., LLC*, 369 F.3d 1197, 1203-04 (11th Cir. 2004) (ice cream color functional because it indicates flavor); *Minemyer v. B-Roc Representatives, Inc.*, 678 F. Supp. 2d 691, 699 (N.D. Ill. 2009) (colors functional where they "denote the sizes of the various couplers to allow ready identification"); *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1329 (Fed. Cir. 1999) ("color coding to indicate diopter strength" functional); *Spraying Sys. Co. v. Delavan, Inc.*, 762 F. Supp. 772, 781 (N.D. Ill. 1991), *aff'd*, 975 F.2d 387 (7th Cir. 1992) ("color coding as an identification system is clearly functional"); *Car-Freshner Corp. v. D & J Distrib. & Mfg., Inc.*, 2015 WL 3385683, at *3-7 (S.D.N.Y. May 26, 2015) (colors used to identify scent of car air fresheners are functional); *Acacia, Inc. v. NeoMed, Inc.*, 2012 WL 3019948, at *3 (C.D. Cal. July 23, 2012) (orange color functional because used to indicate medical device is intended for enteral use); *Warner Lambert Co. v. McCrory's Corp.*, 718 F. Supp. 389, 396-97 (D.N.J. 1989) (colors that indicate different flavors of mouthwash functional).

STATEMENT

A. Legal Background

1. The Patent Clause of the United States Constitution empowers Congress to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. Const. art. I, § 8, cl. 8. This clause “is both a grant of power and a limitation.” *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 5 (1966). It allows Congress to grant patent monopolies, but only for limited times and for “the stated constitutional purpose” of promoting science and useful arts. *Id.* at 5-6. Thus, “Congress may not create patent monopolies of unlimited duration, nor may it authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available.” *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989) (quoting *Graham*, 383 U.S. at 6). Consistent with this constitutional command, Congress has authorized patent protection only for useful inventions that are novel and not obvious, and only for limited times (generally 20 years). *See* 35 U.S.C. §§ 1-3, 154(a)(2).

2. Unlike the Patent Act, the “Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity.” *TrafFix Devices, Inc.*, 532 U.S. at 34. Rather, the Lanham Act exists “to make actionable the deceptive and misleading use of marks, and to protect persons engaged in commerce against unfair competition.” *Dastar Corp.*

v. Twentieth Century Fox Film Corp., 539 U.S. 23, 28 (2003). One type of mark eligible for protection under the Lanham Act is known as “trade dress,” a concept that “originally included only the packaging, or ‘dressing,’ of a product,” but in more “recent years” has expanded to “encompass the design of a product” as well. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209 (2000).

The expansion of trade dress to cover product designs has led this Court to be “careful to caution against misuse or overextension of trade dress.” *TrafFix Devices, Inc.*, 532 U.S. at 29. The Court has noted “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.*, 529 U.S. at 213.

3. The functionality doctrine is a vital safeguard against misuse or overextension of trade dress. As the Court has explained, the doctrine prevents trademark law from “allowing a producer to control a useful product feature.” *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 164 (1995). “It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, after which competitors are free to use the innovation.” *Id.* “If a product’s functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).” *Id.* at 164-65.

Under this Court’s “*Inwood* formulation,” which it refers to as the “traditional” rule, “a product design which has a particular appearance may be functional because it is ‘essential to the use or purpose of the article’ or ‘affects the cost or quality of the article.’” *TrafFix Devices, Inc.*, 532 U.S. at 35 (quoting *Inwood Laboratories, Inc.*, 456 U.S. at 850 n.10 (1982)). This test is disjunctive, so a design feature that meets any of the three criteria is functional, even if the other two criteria are absent.

Even if a design is not essential to use or purpose and affects neither cost nor quality, it may still be deemed to have aesthetic functionality if affording trade dress protection would place competitors at a “significant non-reputation-related disadvantage.” *Id.* But “[w]here the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.” *Id.* at 33.

B. Factual Background

1. The parties are competitors in the market for equipment that dentists use to take impressions of patients’ teeth and gums. To take an impression, the dentist mixes two types of component materials—a catalyst and a base—and uses the resulting compound to mold the impression. Prior to mixing, the base and catalyst materials are stored separately in a two-cylinder cartridge which is loaded into a mixing “gun.” When the gun’s trigger is squeezed, it extrudes the base and catalyst into a mixing tip attached to the nozzle of the cartridge. The mixing tip is a cylinder

with a series of alternating helixes that cause the materials to mix as they pass through the tip. The dentist then uses the resulting ejected compound to mold the impression.

As a popular dental textbook explains, the base and catalyst “materials are typically supplied in several consistencies (viscosities) to accommodate a range of impression techniques.” (CA2.JA.2649.) Thus, “mixing tips vary in their diameter, length (number of helical mixer elements), and the size of openings for a specific consistency.” (CA2.JA.2653.)

2. In the late 1990s, Mixpac began marketing a color-coded mixing system that it called the “S-System.” Its “[k]ey innovation,” one of the Mixpac inventors explained, was to use specially-designed inlets to connect the mixing tip and the cartridge. (CA2.JA.2622 ¶10) “Often the dental professional will not use the entire contents of a mixing cartridge,” and the S-System made reusing leftover material easier by “prevent[ing] the two materials from reacting and hardening at the cartridge end (by delaying the reaction until the materials join in the mixing tip) thereby avoiding the need to remove the hardened excess material” after each use. (*Id.*)

Mixpac obtained a utility patent (now expired) for the S-System entitled “Bayonet Fastening Device for the Attachment of an Accessory to a Multiple Component Cartridge or Dispensing Device.” (CA2.JA.2541.) This patent claims an improvement by which the “alignment of the accessory inlets to the cartridge outlets takes place in one position only to avoid cross contamination,” which is achieved “with a device wherein

said bayonet attachment means at the dispensing apparatus or cartridge and at the accessory have means for coded alignment of the accessory to the dispensing apparatus or cartridge.” (CA2.JA.2573.) Mixpac’s patent further discloses that “[w]hile the different widths of the bayonet lugs provide for a distinct coding means, it might be advantageous to enhance this effect by visualisation of the coding by optical means such as different colors” (CA2.JA.2580.)

As part of its patented S-System, Mixpac implemented its self-described “color coding system” to “enable users to quickly select a mixing tip that matches the proper cartridge.” (CA2.JA.2629 ¶14.) As Mixpac explained in written testimony: “The colors of the cartridge cap are matched to the mixing tip to indicate the proper size and mixing ratio for the dental materials.” (CA2.JA.2623 ¶13.) Mixpac’s advertising also touts the benefits of this color-coding system, stating: “In order to simplify handling, MIXPAC is using color-coded mixers and outlet caps. The color of the outlet cap used for a certain dental product identifies the mixer best suited for the product.” (CA2.JA.2468.)

Under Mixpac’s color-coding system, each color is used for a specific diameter of mixing tip. For example, yellow is used on tips with diameters of 4.2 millimeters, and a Mixpac executive admitted that in more than 20 years it has *never* made a yellow mixing tip for its cartridge system in any other diameter. (CA2.JA.720-21.) According to Mixpac, “[s]ince its introduction, the Mixpac System has enjoyed a nearly 100% market share for the 2-part static mixing dental market.” (CA2.JA.2630 ¶20; CA2.JA.2497 (“for at

least ten (10) years ... Mixpac's S-System has enjoyed a nearly 100% market share").)

3. To preserve its monopoly, Mixpac has waged a campaign of litigation against new entrants that offer products compatible with Mixpac's color-coding system. The avowed purpose of these suits is to preserve Mixpac's ability to charge monopoly prices. For instance, when seeking injunctive relief against competing products, Mixpac has urged courts to find irreparable harm because "[c]ustomers who have learned of the availability of infringing tips ... have pressured Mixpac to reduce its price to meet the lower price of the infringers, such as defendants," and "Mixpac will continue to receive pressure for price reduction unless defendants' products are removed from the market." (CA2.JA.2632 ¶37.)

Rather than wage a David and Goliath battle against Mixpac, many of the targeted competitors agreed to entry of consent judgments which included, as "Stipulated Facts," purported findings that Mixpac's Candy Color trade dress was non-functional and had acquired secondary meaning. (CA2.JA.1214.) Armed with this stipulated language in its consent judgments, Mixpac then sought to register its trade dress with the USPTO. The PTO initially refused the registration based on functionality and lack of secondary meaning. (CA2.JA.2582.) With respect to functionality, the PTO examiner cited numerous web sites "show[ing] that dental impression tips are color-coded with the color yellow denoting tips that are 4.2 millimeters (mm) in size." (*Id.*) For example, one web pages described mixing tips as "customarily color coded" with yellow denoting "Small (4.2mm)."

(CA2.JA.2595.) In response, Mixpac submitted copies of its consent judgments and represented that a “Federal Court ruled [Mixpac’s] claimed product configuration is non-functional and has acquired distinctiveness.” (CA2.JA.2485-86.) Relying on this misleading representation, the PTO issued registrations for the colors yellow, blue, green, pink, purple and brown, but as applied only to the “dome-façade” part of the mixing tip. (CA2.JA.863-73.) In the registrations, Mixpac expressly disclaimed “the stem and the corkscrew like element” of the mixing tip as “not part of the mark.” (CA2.JA.2610.)

4. The Greater New York Dental Meeting is a highly popular trade show held annually in New York City. Both Mixpac and A&N had booths at the 2016 show. (CA2.JA.650.) At A&N’s booth, it displayed a line of mixing tips with clear colorless caps, and colors on only the helical mixing elements. (CA2.JA.983-88.)

Mixpac’s lawyers descended on A&N’s booth and demanded removal of all mixing tips on display. Tony An, who had brought to the show copies of Mixpac’s trademark registrations, responded that the tips did not infringe Mixpac’s registrations, which claim color only on the caps and disclaim the mixing element as “not part of the mark.” (CA2.JA.69, 783-84.) Mixpac nevertheless insisted that neither A&N nor anyone else could use any of the colors, regardless of placement, and immediately filed suit.

C. Proceedings Below

1. The district court held a one-day bench trial on a largely stipulated record. All direct testimony was presented through written statements, followed by

live cross and redirect. At the end of the day, the district court announced its “tentative” findings. Regarding functionality, the district court began by stating “I’ve set out previously all of the relevant standards” and “think they’re all good law today,” apparently referring to the pre-*TrafFix* opinion in *Fabrication Enterprises, Inc. v. Hygenic Corp.*, 64 F.3d 53 (2d Cir. 1995), which the district judge wrote while sitting by designation on the Second Circuit. Pet.App.39a. Demurring that “it would take me the rest of the afternoon” to provide a complete analysis, the district court offered “the one point that I would quote is that in order to account for ... the risks of overdoing, in one direction or another, the functionality analysis ... a court must examine a number of variables,” including “the degree of functionality of the similar features of the product,” “the degree of similarity between the non-functional (ornamental) features of the competing products,” and “the feasibility of alternative designs that would not impair the utility of the product.” Pet.App.40a.

The district court then declared that “the degree of functionality here is small,” the “degree of similarity” was close enough to create “potential for confusion,” and “[m]ost important of all with respect to functionality is the fact that alternative designs are obviously and clearly available” and so it “is surely the case that a competitor could function in this market using different colors.” Pet.App.40a-41a. The district court cited no evidence for this last observation, nor did it attempt to explain how such a finding could be squared with Mixpac’s insistence that “[s]ince its introduction, the Mixpac System has enjoyed a nearly 100% market share for the 2-part static mixing dental

market.” (CA2.JA.2630 ¶20; see also CA2.JA.2497 (“for at least ten (10) years ... Mixpac’s S-System has enjoyed a nearly 100% market share”).) The court issued a permanent injunction and awarded \$2 million in statutory damages. Pet.App.32a.

2. The court of appeals unanimously reversed. The panel explained that the district court erred by relying exclusively on the pre-*TrafFix* opinion in *Fabrication Enterprises*, 64 F.3d 53, rather than the test set out in *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012). “In our Circuit,” the panel explained, “a product feature is considered to be ‘functional’ in a utilitarian sense if it is (1) ‘essential to the use or purpose of the article,’ or if it (2) ‘affects the cost or quality of the article.’” Pet.App.13a (quoting *Christian Louboutin S.A.*, 696 F.3d at 219 (quoting *Inwood Laboratories, Inc.*, 456 U.S. at 850 n.10)). Alternatively, a feature may be aesthetically functional “even if it is not essential to a product’s use or purpose and does not affect a product’s cost or operation.” Pet.App.14a. “In such instances, this Court considers whether ‘giving the markholder the right to use it exclusively would put competitors at a significant non-reputation-related disadvantage.’” *Id.* (quoting *Christian Louboutin S.A.*, 696 F.3d at 219-20 (quoting *Qualitex Co.*, 514 U.S. at 165)).

The panel accepted the district court’s finding that the colors do not affect cost, and declined to find in the first instance that they are essential to the use or purpose of the mixing tips (on which the district court made no finding). It did, however, conclude that the evidence “firmly establishes” that the colors affect

quality because they “signify diameter, which in turn assists users with selecting the proper cartridge for their needs.” Pet.App.15a. This evidence included:

- A declaration by a Mixpac Business Manager stating: “[T]o enable users to quickly select a mixing tip that matches the proper cartridge, [Mixpac] chose a unique and arbitrary color coding system ... colors of the cartridge cap are matched to the mixing tip to indicate the proper size and mixing ratio for the dental materials.” Pet.App.9a.
- A declaration by a Mixpac Area Sales Manager stating: “Mixpac uses a color code with its mixers to enable an end user to quickly identify the appropriate [t]ip that is matched with the same colored cartridge cap.” *Id.*
- Mixpac advertising materials asserting that “[i]n order to simplify handling MIXPAC is using color-coded mixers and outlet caps. The color of the outlet cap used for a certain dental product identifies the mixer best suited for th[e] product.” *Id.* at 14a-15a.
- The trial testimony of Mixpac’s Director of Technology and Innovation, whose “testimony on cross-examination (considered together with other evidence in the record) acknowledges that all yellow mixing tips are 4.2 millimeters in diameter, all teal mixing tips are 6.5 millimeters in diameter, and all blue mixing tips are 3.2 millimeters in diameter.” *Id.* at 8a-9a.

- “[W]ebsites advertise mixing tips based primarily on their color under Mixpac’s system. A website for Dental City, for example, advertises a bag of 48 pink mixing tips with 5.4 millimeter diameters, the same diameter as Mixpac’s pink mixing tips.” *Id.* at 15a.
- Materials manufacturers also rely on Mixpac’s color-coding scheme in their product use instructions. *Id.* at 10a. For example, 3M’s packaged instructions tell dentists to select which mixing tip to use based only on color: “attach a green mixing tip for the Imprint II Garant heavy body impression materials, a yellow mixing tip for the Imprint II Garant light body” (CA2.JA.2657.)

Having concluded that the colors were functional under the “affects quality” prong of *Inwood*, the panel did “not reach A&N’s arguments that the district court’s counterfeiting and infringement analyses were fatally flawed.” Pet.App.17a.

3. Mixpac’s motion for panel rehearing and rehearing en banc was denied without dissent. This petition followed.

REASONS FOR DENYING THE PETITION

I. The Second Circuit’s Decision Correctly Applied this Court’s Precedents and Does Not Conflict With Any Other Circuit

Mixpac contends that the Second Circuit created a 7-1 circuit split by failing to “treat a finding that a product feature has *some* utility as the beginning, not

the end, of the functionality analysis.” Pet.7 (emphasis in original). According to Mixpac, at least seven other circuits will allow a firm to perpetually monopolize a useful product feature, so long as the feature is only a little useful, such that its utility can be balanced away by weighing it against a medley of other factors. To the contrary, no circuit accepts that theory of functionality, which is foreclosed by this Court’s precedents, most notably *TrafFix*.

1. In *TrafFix*, the alleged trade dress was a traffic sign with a visible “dual-spring design” that kept it from toppling over in strong winds. 532 U.S. at 25-26. The manufacturer asserted this spring mechanism was unique to its signs and had acquired secondary meaning. The Sixth Circuit held that the design’s utility was not enough to find functionality; instead, “exclusive use of a feature must put competitors at a significant non-reputation-related disadvantage before trade dress protection is denied on functionality grounds.” *Id.* at 27-28. After observing that numerous alternative designs may be available, including, for example, designs that used three or four springs, as well as the option of hiding the dual-spring mechanism behind a box or frame, the Sixth Circuit reversed the district court’s grant of summary judgment and allowed the trade dress claim to proceed to trial on functionality. *Id.* at 27-28.

This Court unanimously reversed. The Court clarified that “[i]t is proper to inquire into a ‘significant non-reputation-related disadvantage’ in cases of aesthetic functionality, the question involved in *Qualitex*,” but “[w]here the design is functional under the

Inwood formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.” *Id.* at 33. Thus, utilitarian functionality is governed not by an indeterminate multi-factor balancing test, but by a bright line rule: If a feature is essential to the use or purpose of the product, or if it affects cost or quality, the feature is functional and hence ineligible for trade dress protection—period. *Id.* at 32-33. “Other designs need not be attempted.” *Id.* at 34. So while Mixpac faults the Second Circuit for declining to “consider either ‘other design possibilities’ or whether affording trademark protection would have ‘a significant effect on competition’” (Pet.11), that is exactly what *TrafFix* requires.

Nor can Mixpac’s proposed distinction between “degrees of utility” be reconciled with this Court’s patent cases. As the Court has repeatedly emphasized, the functionality doctrine ensures that trademark law does not “interfere with the federal policy, found in Art. I, s. 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain.” *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964). The Patent Clause of the Constitution allows Congress to grant patent protection to “science and useful arts” only “for limited times.” It draws no distinctions between “degrees” of usefulness, and certainly does not say that Congress may protect highly useful inventions for limited times, but less useful inventions in perpetuity. Similarly, the Patent Act has always been interpreted as governing any useful invention regardless of “degree.” *Bedford v. Hunt*, 3 F. Cas. 37, 37 (C.C.D. Mass. 1817) (Story, J.) (“The law, however,

does not look to the degree of utility; it simply requires, that it shall be capable of use”); *Stiftung v. Renishaw PLC*, 945 F.2d 1173, 1180 (Fed. Cir. 1991) (“An invention need not be the best or the only way to accomplish a certain result, and it need only be useful to some extent and in certain applications: “[T]he fact that an invention has only limited utility and is only operable in certain applications is not grounds for finding lack of utility.”) (quoting *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753, 762 (Fed. Cir. 1984)). Mixpac’s position would eviscerate the core purpose of the functionality doctrine by allowing perpetual “back-door” patents for useful designs that do not meet some arbitrary and hopelessly subjective degree-of-utility threshold.

2. Mixpac’s contention that there is a circuit split is based on outdated or misinterpreted cases. Several cases cited in the petition predate *TrafFix*, and, like the Sixth Circuit in that case, erroneously read *Qualitex* as making competitive necessity the sine qua non of functionality. See Pet.7-10 (citing *Home Builders Ass’n of Greater St. Louis v. L&L Exhibition Mgmt., Inc.*, 226 F.3d 944, 948 (8th Cir. 2000); *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 37 (1st Cir. 1998); *Tools USA & Equip. Co. v. Champ Frame Straightening Equip. Inc.*, 87 F.3d 654, 659 (4th Cir. 1996)). After *TrafFix* clarified that “competitive necessity” is “incorrect as a comprehensive definition,” 532 U.S. at 33, these courts have recognized that a trade dress need only satisfy any one prong of the *Inwood* formulation to be functional. See, e.g., *CTB, Inc. v. Hog Slat, Inc.*, 954 F.3d 647, 659 (4th Cir. 2020)

(stating that *TrafFix* precludes consideration of alternative designs where other evidence establishes a design’s utilitarian advantage).

The other cases Mixpac cites do not adopt its degree-of-utility theory, but instead address the distinction between what is sometimes referred to as de jure versus de facto functionality. See *Fuji Kogyo Co. v. Pac. Bay Int’l, Inc.*, 461 F.3d 675, 685 (6th Cir. 2006) (“In essence, de facto functional means that the design of a product has a function, i.e., a bottle of any design holds fluid. De facto functionality does not necessarily defeat registrability. De jure functionality means that the product has a particular shape because it works better in this shape.”) (quotations omitted).

For instance, Mixpac claims that in *Leapers, Inc. v. SMTS LLC*, 879 F.3d 731, 738-40 (6th Cir. 2018), “[a]lthough all agreed that knurling had some utility, there were unresolved factual issues regarding the degree of usefulness, the availability of alternative designs, and the reason the plaintiff selected the particular pattern.” Pet.9. But that case had nothing to do with whether knurling had enough utility to trigger the functionality doctrine. The plaintiff in *Leapers* did not claim the exclusive right to sell rifle scopes with knurling, which “allows users to grip the products more easily and to make fine-tuned adjustments.” 879 F.3d at 733. It claimed only “that it applies a purely ornamental design to the knurling on its rifle scopes and that *this* design—not knurling generally—constitutes its trade dress.” *Id.* at 738 (emphasis in original). The notion that it could have claimed a perpetual monopoly on “knurling generally” if only it were able to persuade a fact-finder that

knurling was useful but not *that* useful was so outlandish that no one even considered it.

Likewise, in *Converse, Inc. v. Int'l Trade Comm'n Skechers U.S.A., Inc.*, 909 F.3d 1110, 1114, 1124 (Fed. Cir. 2018), the Federal Circuit opined that “[a]ny functional benefit is derived from the presence of toe caps and bumpers generally, not the particular design of” Converse’s “multi-layered toe bumper featuring diamonds and line patterns.” Again, the court did not remotely suggest that Converse could have claimed the exclusive right to use toe caps and bumpers generally upon showing that they are only moderately useful.

The same goes for the coffeemaker handle in *Bodum USA, Inc. v. A Top New Casting Inc.*, 927 F.3d 486, 492 (7th Cir. 2019). As the Seventh Circuit explained there, “[w]hether it is more advantageous for a French press to have *a handle*, however, is not the pertinent inquiry; the question is whether there is an advantage to having *this designed handle*” (emphases in original). *See also, e.g., Arlington Specialties, Inc. v. Urb. Aid, Inc.*, 847 F.3d 415, 420 (7th Cir. 2017). (“The question is not, as plaintiff would have it, whether the claimed trade dress has ‘less utility’ than alternatives ... the right question is whether the design feature affects product quality or cost or is merely ornamental.”).

Finally, and contrary to the petition, the decision below is in harmony with the USPTO’s approach to functionality. Mixpac quotes the trademark examination manual that “whether a product feature is ‘functional’ should not be confused with whether that product feature performs a ‘function’” (Pet.20), but

this quote just refers to the same de facto/de jure distinction discussed above. See U.S. Patent & Trademark Office, Trademark Manual of Examining Procedures § 1202.02(a)(iii)(B). In fact, the PTO regularly grants utility patents for color-coding systems, confirming, once again, that the only lawful way to monopolize such a useful feature is through the patent system. See, e.g., *In re Levin*, 107 F.3d 30 (Fed. Cir. 1997); *Carlisle Plastics, Inc. v. Spotless Enterprises, Inc.*, 984 F. Supp. 646, 649 (E.D.N.Y. 1997); *Acco Brands USA, LLC v. Comarco Wireless Techs., Inc.*, 2013 WL 843447, at *2 (N.D. Cal. Mar. 6, 2013). And when confronted with attempts to trademark useful color-coding systems, the TTAB consistently rejects them as functional, without considering the “degree of utility.” See, e.g., *In Re Integra Biosciences Corp.*, No. 87484450, 2022 WL 225424, at *15 (T.T.A.B. Jan. 24, 2022) (affirming functionality refusal for color-coded pipettes); *Saint-Gobain Corp. v. 3M Co.*, 90 U.S.P.Q.2d 1425, 1426 (T.T.A.B. 2007) (coloring of coated abrasives functional because used “as an indicator of abrasive grit size”); *Kasco Corp. v. Southern Saw Service Inc.*, 27 U.S.P.Q.2d 1501, 1505 (T.T.A.B. 1993) (“Southern Saw’s various ‘color-keyed’ or ‘color-coded’ wrappers – including its green wrapper – serve to enable purchasers and users of the blades to quickly identify and distinguish one blade type from another. Thus, the various colored wrappers have a functional or utilitarian purpose.”).

In sum, neither the PTO nor any circuit court of appeals would allow Mixpac to monopolize its useful color coding system on the theory that its “degree of utility” was too small.

II. The Question Presented Was Neither Raised in Nor Considered by the Court of Appeals

Even if the question presented were certworthy in the abstract, this case is an inappropriate vehicle to decide it. Mixpac did not raise its any-degree-of-utility argument in its briefing below, and the Second Circuit did not consider it. As the Second Circuit noted, Mixpac chose not to engage with A&N's arguments about the "affects quality" prong of *Inwood*. Pet.App.17a ("Mixpac does not refute by evidence or argument that, because the colors on the tip correspond to the tip sizes, the color affects the quality of the product."). Instead, Mixpac adopted a strategy of pretending that the colors have no relation to size at all. See, e.g., Mixpac Pet. Panel Reh. & Reh. En Banc at 16 ("color does not indicate size—full stop."). In other words, Mixpac never argued that although its trade dress had some degree of utility, it was not enough utility for the functionality doctrine to apply. Consequently, the Second Circuit had no occasion to address that particular theory.

"Where issues are neither raised before nor considered by the Court of Appeals, this Court will not ordinarily consider them." *Penn. Dep't of Corr. v. Yeskey*, 524 U.S. 206, 212–13 (1998). This case presents no reason to depart from the Court's ordinary practice. Even accepting Mixpac's assertion that this case created a 7-1 split, the split would be less than a year old and has not had time to percolate. And if Mixpac were correct that the issue is frequently litigated in New York (Pet.7), then another case from the Second Circuit will appear soon enough; if one does not, it will

only confirm that Mixpac's petition was correctly denied.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

Jack A. Gordon
Joshua B. Katz
Counsel of Record
KENT, BEATTY & GORDON, LLP
Eleven Times Square
New York, New York 10036
(212) 421-4300
jbk@kbg-law.com

Counsel for Respondents

February 7, 2022