

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*

REPLY BRIEF FOR PETITIONER

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The Second Circuit broke new ground, categorically excluding from trademark protection product features with any degree of utility. Respondent A&N agrees that the Second Circuit eschewed a “multi-factor balancing test” and rested its decision on the view that the trademark here “assist[ed] users.” Br. in Opp. 13, 16 (quoting Pet.App.15a). That holding split with seven other circuits, which view a product feature’s usefulness as only the beginning, not the end, of the functionality inquiry.

A&N does not dispute that the test for functionality was outcome-determinative. And A&N does not dispute that the Second Circuit’s ruling is important, threatens to upend settled expectations, and invites forum-shopping. As *amici* trademark professors and major international intellectual-property organizations confirm, the Second

Circuit’s rule undermines innumerable trademarks and creates the inconsistency in trademark law the Lanham Act was enacted to prevent. IACC Br. 5, 18; INTA Br. 12, 20; Profs. Br. 2, 16. The decision below encourages infringers to copy long-established trademarks, then sue in the Second Circuit to invalidate them. Everyday marks that serve some purpose—from the black and copper on Duracell’s batteries (which identify the terminals) to the wax on Maker’s Mark bottles (which protects the cork)—are at risk. This Court’s intervention is necessary to maintain national uniformity on one of the most frequently litigated issues in trademark law.

A&N (at 15-17) defends the decision below as an application of this Court’s precedents concerning the permissibility of trademarking product features subject to patent protection. But the Second Circuit did not frame its holding in those terms, and that patent-specific rule does not apply here. A&N (at 18-19) also tries to muddle the split by describing some circuits as applying a different “de jure versus de facto functionality” test. This is semantics. Some courts use “de facto functionality” to describe the minimal utility that does not preclude trademark protection. The Second Circuit’s refusal to acknowledge any such minimal utility directly conflicts with those decisions.

A&N (at 21) claims that the Second Circuit did not actually decide whether any degree of utility automatically renders product features ineligible for trademark protection. But that issue occupies most of the court’s opinion.

I. The Circuits Are Deeply Split

The Second Circuit invalidated Mixpac’s Candy Colors® trademark based on a *per se* rule: Any usefulness precludes trademark protection. *See* Pet.App.17a. That

“inflexible bright-line rule” conflicts with the approach of seven circuits. Profs. Br. 4; *see* Pet. 7-11. Those circuits consider usefulness alongside other factors, including the product’s advertising, alternative designs, and impact on price.

1. A&N agrees on one side of the split: The Second Circuit’s decision rested solely on its view that Mixpac’s Candy Colors® “signify diameter, which in turn assists users with selecting the proper cartridge for their needs.” Br. in Opp. 13 (quoting Pet.App.15a). In other words, Candy Colors® purportedly serve a function, and that function precludes trademark protection. A&N (at 1) notes that the Second Circuit never described its rule in terms of “degree of utility.” But as A&N (at 1) then acknowledges, the panel rejected the district court’s view that a “‘small’ ‘degree of functionality’” was permissible. Pet.App.16a.

A&N tellingly does not dispute that the decision below creates a split between the Nation’s two largest forums for trademark litigation: the circuits covering New York and California. *Moldex-Metric, Inc. v. McKeon Products, Inc.*, holds that a product that served some “function”—there, bright-green earplugs highly visible during safety checks—could still qualify for trademark protection. 891 F.3d 878, 887 (9th Cir. 2018). Instead of ending its analysis with the color’s utility, the Ninth Circuit considered “whether the design yields a utilitarian advantage,” “whether alternative designs are available,” “whether advertising touts the utilitarian advantages of the design,” and “whether the particular design results from a comparatively simple or inexpensive method of manufacture.” *Id.* at 880 n.2. But in the Second Circuit, bright green’s usefulness at safety checks would doom trademark protection.

A split on a central question of trademark law between the Second and Ninth Circuit alone warrants this Court’s review. One third of all trademark cases arise in California and New York. Administrative Office of the U.S. Courts, *Just the Facts: Intellectual Property Cases—Patent, Copyright, and Trademark* (Feb. 13, 2020), <https://tinyurl.com/5bt52xvd>. Functionality is one of the most frequently litigated defenses in trademark law. Pet. 15-16. Trademark holders should not have to fear that a mark protected in California will be invalidated in New York.

2. Six other circuits—the First, Fourth, Sixth, Seventh, Eighth, and Federal Circuits—all treat a product’s usefulness as one factor in the functionality analysis. Pet. 7-11. “A majority of the circuit courts of appeal, . . . treats the usefulness, or utility, of a claimed trade dress as a consideration in the utilitarian functionality inquiry, but not a dispositive one.” Profs. Br. 4.

a. A&N does not dispute that the First, Fourth, and Eighth Circuits’ decisions conflict with the decision below. Instead, A&N (at 17) insists that *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001), abrogated these cases. *TrafFix*, however, did not “change[] the law of functionality.” *Valu Eng’g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276 (Fed. Cir. 2002); *infra* p. 9. *TrafFix* considered only the narrow issue of the “effect of an expired patent on a claim of trade dress infringement.” 532 U.S. at 29. Thus, when considering product features *not* covered by expired patents, pre-*TrafFix* precedents still reflect the law. The many post-*TrafFix* cases cited in the petition (which A&N ignores) confirm this. Pet. 8-11.

First Circuit: Before *TrafFix*, the First Circuit held that “[t]he fact that a product contains some functional elements does not, . . . preclude Lanham Act protection.” *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 37 (1st

Cir. 1998). That court has not decided a functionality case since *TrafFix*, but district courts in that circuit continue to apply that rule. *E.g.*, *Rimowa Distrib., Inc. v. Travelers Club Luggage, Inc.*, 217 F. Supp. 3d 400, 414 (D. Mass. 2016); *Mark Bric Display Corp. v. Joseph Struhl Co.*, 2003 WL 21696318, at *5 (D.R.I. July 9, 2003); *see SoClean, Inc. v. Sunset Healthcare Sols.*, 2021 WL 3605013, at *7 (D. Mass. Aug. 13, 2021), appeal filed, No. 21-2311 (Fed. Cir.).

Fourth Circuit: Both before and after *TrafFix*, the Fourth Circuit has considered multiple factors relevant to functionality, including “the existence of utility patents,” “advertising focusing on the utilitarian advantages of a design,” alternative designs, and “the effect of the design on manufacturing.” *McAirlaids, Inc. v. Kimberly-Clark Corp.*, 756 F.3d 307, 313 (4th Cir. 2014); *accord CTB, Inc. v. Hog Slat, Inc.*, 954 F.3d 647, 657-58 (4th Cir. 2020); *Tools USA & Equip. Co. v. Champ Frame Straightening Equip., Inc.*, 87 F.3d 654, 659 (4th Cir. 1996).

A&N (at 17) claims that *CTB* displaced this standard and adopted the Second Circuit’s *per se* rule. But *CTB* cited all four factors with approval and applied two of them. 954 F.3d at 657-58, 660. The court simply found one factor—the availability of alternative designs—inapplicable when a utility patent covers the design. *Id.* at 662-64. Outside of that context, the Fourth Circuit recognizes that “*TrafFix* did not alter [its] precedents that look to the availability of alternative designs.” *McAirlaids*, 756 F.3d at 312.

Eighth Circuit: Before *TrafFix*, the Eighth Circuit held “[t]he fact that the feature at issue serves some function is not enough” to make the feature functional. *Home Builders Ass’n v. L&L Exhibition Mgmt., Inc.*, 226 F.3d 944, 948, 949 (8th Cir. 2000) (citation omitted). After *TrafFix*, the Eighth Circuit continues to recognize that a

product is not functional just because it “serves a purpose.” *Frosty Treats, Inc. v. Sony Comput. Ent. Am. Inc.*, 426 F.3d 1001, 1007 (8th Cir. 2005).

b. A&N (at 18-19) dismisses decisions of the Sixth, Seventh, and Federal Circuits as irrelevant because they involve “de jure versus de facto functionality,” not minimal utility.

That is a distinction without a difference. “De jure functionality” is another way of saying that a trademark meets the legal test for “functionality” and is therefore not registrable. *See Fuji Kogyo Co. v. Pac. Bay Int’l, Inc.*, 461 F.3d 675, 685 (6th Cir. 2006). “De facto functionality” refers to “functionality” as the man on the street would understand it: “that the design of a product has a function.” *Id.* (quoting *Valu Eng’g*, 278 F.3d at 1274). When these circuits hold that “de facto functionality does not necessarily defeat registrability,” *id.* (quoting *Valu Eng’g*, 278 F.3d at 1274), all they mean is that a design having *some* utility does not make the design “functional” for trademark-law purposes. Instead, these courts go on to consider various factors, just like their sister circuits. *See id.* That rule squarely splits with the decision below, which held that some function is the be-all-end-all.

To illustrate:

- The Sixth Circuit has held that the pattern on a rifle scope could qualify for trademark protection even though having a pattern served some function (making the rifle easier to grip). *Leapers, Inc. v. SMTS, LLC*, 879 F.3d 731, 738 (6th Cir. 2018).
- The Seventh Circuit has held that the handle design of a French press coffeemaker could be non-functional even though a coffeemaker’s handle of course has a “‘function’ in the everyday meaning of the term.”

Bodum USA, Inc. v. A Top New Casting Inc., 927 F.3d 486, 492 (7th Cir. 2019).

- And the Federal Circuit has held that Converse All Star’s iconic toe cap could be non-functional even though toe caps serve a purpose (protecting the toe). *Converse, Inc. v. Int’l Trade Comm’n*, 909 F.3d 1110, 1124 (Fed. Cir. 2018).

Those cases all would come out differently in the Second Circuit. Rifle grips, coffeemaker handles, and toe caps, like color-coded mixing tips, serve some purpose. If bare utility were the *sine qua non* of functionality, courts could stop there. Instead, in each case, other circuits weighed that degree of utility against various factors. The Second Circuit should have done the same here. Even if color-coded mixing tips make the product better (by helping dentists pick the right tip), other factors, like ready alternatives to Mixpac’s fanciful Candy Colors®, cut against functionality. Only the Second Circuit refuses to consider such factors.

The consensus in other circuits is unsurprising. Most product “designs necessarily have some underlying function.” IACC Br. 8. If some usefulness were enough to defeat trademark protection, scores of familiar marks will be at risk. Profs. Br. 8-10.

II. This Case Is a Clean Vehicle

1. A&N (at 1) fleetingly contends that this case presents a worse candidate for review than *Ezaki Glico Kabushiki Kaisha v. Lotte International America Corp.*, 986 F.3d 250 (3d Cir.), *cert. denied*, 142 S. Ct. 420 (2021). But the Third Circuit’s decision in *Glico* was ambiguous. The court both suggested that any degree of utility suffices *and* acknowledged that functionality considers factors like advertising that “touts a feature’s usefulness,” utility patents, and alternative designs. *Id.* at 258. Courts

have since read *Glico* as approving a multi-factor test. *E.g., SoClean, Inc.*, 2021 WL 3605013, at *7. The Second Circuit offered no such equivocation.

2. A&N (at 21) argues that the Second Circuit did not decide the question presented. That is baffling, particularly because A&N elsewhere describes the Second Circuit as deeming Candy Colors® functional “because they ‘signify diameter, which in turn assists users with selecting the proper cartridge for their needs.’” Br. in Opp. 13 (quoting Pet.App.15a). That *per se* rule—some function suffices—is cleanly presented here.

Mixpac relied at trial on the standard functionality factors, including manufacturing costs, advertisements, and competitive alternatives. D. Ct. Dkt. 122, at 19-22. The district court weighed these factors, alongside the degree of functionality, and deemed Candy Colors® nonfunctional. Pet.App. 10a, 22a, 40a-41a. On appeal, Mixpac argued that the district court properly distinguished “usefulness” and “functionality.” C.A. Appellee Br. 31. A&N itself (at 13-14) points to trial evidence, like advertising and alternative designs, that would be relevant in seven other circuits. The Second Circuit considered none of that, treating bare usefulness as enough.

In short, there is no need to await another Second Circuit decision. *Contra* Br. in Opp. 21-22. Delay would simply enable further “erosion of trade dress protection.” INTA Br. 4. Seven other circuits are not going to come around to the Second Circuit’s view. And the Second Circuit’s position is firm. Mixpac sought en banc review, pointing out the novel split, and that petition was denied. En Banc Pet. 10-11. The decision below invites forum-shopping that will disrupt the Lanham Act’s uniform trademark system. Profs. Br. 2, 16. The decision below also leaves trademark holders unprotected in the Second

Circuit, disrupting settled expectations and prior investments. IACC Br. 5. The time to intervene is now.

III. The Decision Below Is Wrong

The Second Circuit’s *per se* rule conflicts with this Court’s trademark precedents. This Court has already recognized that a product feature that serves some purpose can still be non-functional. *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 165-66 (1995), held that the color of a dry-cleaning pad could qualify for trademark protection even though color served a purpose (“avoid[ing] noticeable stains”). Instead of adopting a bright-line rule, the Court emphasized that “ordinary legal trademark requirements” applied. *Id.* at 161. Yet the Second Circuit treated the minimal utility of a color-coding scheme as the end of the analysis. Pet. 6, 11-12, 17-20; IACC Br. 16-18; INTA Br. 12; Profs. Br. 6-12.

1. A&N does not attempt to reconcile the decision below with *Qualitex*. Instead, A&N (at 14-16) presents this Court’s later decision in *TrafFix* as a sea change in functionality law. But *TrafFix* did not silently overrule *Qualitex*, an opinion *TrafFix* cited with approval. 532 U.S. at 32-33. Rather, *TrafFix* considered the “effect of an expired patent on a claim of trade dress infringement.” *Id.* at 29. This Court held that an expired utility patent is “strong evidence of functionality.” *Id.* at 29-30. *TrafFix* did not address any other factor in the functionality analysis. *Id.* at 29-32. Had *TrafFix* endorsed the Second Circuit’s bright-line rule, the Court’s analysis would have been different. If a “modicum of utility” made a design functional, the utility patent in *TrafFix* would have been “dispositive of functionality, rather than merely strong evidence of it.” Profs. Br. 7.

A&N’s reliance (at 1-2) on *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850 n.10 (1982),

fails as well. *Inwood* set out “[i]n general terms” what it means for a design to be functional: If the design “is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Id.* Mixpac does not dispute that. This case is about how to determine whether a design meets that definition: a bright-line rule or a holistic inquiry.

2. A&N (at 3 & n.1, 20) also suggests that the court below applied some sort of color-specific rule. But the Second Circuit did not confine its holding that way, instead stating it was applying the functionality test “[i]n our Circuit.” Pet.App.13a. Regardless, any color-specific rule would defy *Qualitex*, which applied “ordinary” trademark law to color. 514 U.S. at 161. A&N’s contrary position relies exclusively on cases that themselves considered multiple factors¹ or declined protection for inherent product features, like colors that represented flavor, resulted from the manufacturing process, were requested by the customer, or were industry standard.² Br.

¹ *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 1329 (Fed. Cir. 1999); *Spraying Sys. Co. v. Delvan, Inc.*, 762 F. Supp. 772, 781-82 (N.D. Ill. 1991); *Saint-Gobain Corp. v. 3M Co.*, 90 U.S.P.Q.2d 1425, 1446-48 (T.T.A.B. 2007); *Warner Lambert Co. v. McCrory’s Corp.*, 718 F. Supp. 389, 396-97 (D.N.J. 1989).

² *Dippin’ Dots, Inc. v. Frosty Bites Distrib., LLC*, 369 F.3d 1197, 1203-04 (11th Cir. 2004) (flavor); *Car-Freshner Corp. v. D&J Distrib. & Mfg., Inc.*, 2015 WL 3385683, at *5 (S.D.N.Y. May 26, 2015) (scent); *Saint-Gobain*, 90 U.S.P.Q.2d at 1443-46 (manufacturing process); *Minemyer v. B-Roc Representatives, Inc.*, 678 F. Supp. 2d 691, 699 (N.D. Ill. 2009) (customer request); *Acacia, Inc. v. NeoMed, Inc.*, 2012 WL 3019948, at *3 (C.D. Cal. July 23, 2012) (industry standard); *In re Integra Biosciences Corp.*, 2022 WL 225424, at *17 (T.T.A.B. Jan 24, 2022) (same); *Kasco Corp. v. S. Saw Serv., Inc.*, 27 U.S.P.Q.2d 1501, 1505 (T.T.A.B. 1993) (same).

in Opp. 3 & n.1, 20. *But see* INTA Br. 14, 19 & n.5; Profs. Br. 11.

Those holdings do not support the Second Circuit’s *per se* rule. True, color *can* be functional when inherent to the product or industry. An ice cream company cannot trademark that chocolate is brown. *Dippin’ Dots*, 369 F.3d at 1203-04. But it does not follow that any arbitrary color scheme is functional just because *a* color is useful. Otherwise, bright-green earplugs (good for safety checks) and green-gold cleaning pads (good for hiding dirt) could not be trademarked, contrary to decisions of this Court and other circuits. *Qualitex*, 514 U.S. at 165-66; *Moldex-Metric*, 891 F.3d at 887.

3. A&N (at 16-17) argues that trademark protection for designs with some utility would undermine patent law. But patent and trademark have different requirements. A&N’s aside (at 20) that the Patent and Trademark Office has sometimes granted utility patents for color-coding systems is therefore irrelevant. To be eligible for a patent, an invention must “satisf[y] the requirements of novelty, nonobviousness, and utility.” *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150 (1989). Trademark protection is available only for product features that, in addition to being nonfunctional, are “inherently distinctive” or have “acquired distinctiveness through secondary meaning.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 773, 769 (1992). Although the functionality doctrine helps distinguish trademark and patent law, this Court has eschewed the Second Circuit’s bright line. *Qualitex*, 514 U.S. at 165-66. Designs that serve some function can still protect consumers from confusion—the goal of trademark law. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003).

CONCLUSION

The petition for a writ of certiorari should be granted.

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