

No. 20-1817

IN THE
Supreme Court of the United States

EZAKI GLICO KABUSHIKI KAISHA, D/B/A EZAKI
GLICO CO., LTD. AND EZAKI GLICO USA CORP.,

Petitioners,

v.

LOTTE INTERNATIONAL AMERICA CORP.
AND LOTTE CONFECTIONARY CO. LTD.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

**AMICUS CURIAE BRIEF OF MONDELÉZ
GLOBAL LLC IN SUPPORT OF PETITIONERS**

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QUESTIONS PRESENTED

1. Whether this Court’s and numerous Circuits’ decades of jurisprudence—establishing that the doctrine of utilitarian functionality precludes trade dress protection only if a design is “essential to the use of purpose of the article” or “affects the cost or quality of the article”—can be reduced to a dictionary-definition test that asks only whether the design is “useful” and “nothing more,” as the decision below concluded.

2. Whether the Third Circuit’s equation of the word “useful” from the Patent Act with the word “functional” in the Lanham Act is at odds with Congress’s intent in the trademark statute and this Court’s and various Circuits’ interpretation of “functional”—and whether this equation disrupts the uniformity in trademark law Congress sought to create in enacting the Lanham Act and otherwise will render void (at least within the Third Circuit) iconic trade dresses that other Circuits have held protectable.

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INTEREST OF THE AMICUS CURIAE¹

Together with its affiliates and subsidiaries, *amicus curiae* Mondelēz Global LLC (“MDLZ”) makes biscuits (cookies, crackers, and salted snacks), chocolate, gum, and candy, as well as cheese, grocery, and powdered beverage products. MDLZ’s trademarks include *Cadbury* and *Toblerone* chocolate; *Oreo* and *belVita* biscuits; *Ritz* crackers; *Sour Patch Kids* candy; *Trident* gum; and *Tang* powdered beverages.

The trade dress of many MDLZ products, including the well-known “mountaintop” design of *Toblerone* chocolate bars, is registered on the Principal Register in the United States Patent and Trademark Office (“USPTO”). MDLZ refers to such intellectual property as material to its business in the company’s annual 10-K filings.²

If the decision of the court of appeals is permitted to stand, parties intentionally seeking to trade on the esteemed reputations and commercial magnetism of MDLZ’s trade

1. Pursuant to Rule 37.2(a), counsel of record for all parties received timely notice of *amici curiae*’s intent to file this brief. Counsel of record for all parties consented in writing to its filing. No counsel of record for any party authored this brief in whole or in part, and no person or entity other than *amici curiae* made a monetary contribution to the preparation or submission of this brief.

2. An affiliate of MDLZ, Generale Biscuit Glico France, is a member in a joint venture in Europe that manufactures biscuits using the trade dress at issue here. MDLZ’s interest as an *amicus curiae* in this case is directed to presenting the viewpoint of the owner of food and beverage trade dress without focus on any one of its marks or devices.

dress can do so in the Third Circuit with impunity so long as they conjure an argument that the trade dress at issue is “useful.” Such an argument is plainly possible with virtually any food product because food is handled, packaged, and consumed in portions or pieces. The Third Circuit’s reduction of the functionality doctrine to the single word “useful” violates this Court’s precedent and is at odds with that of every other Circuit to address the issue. Left unchecked, the Third Circuit’s precedent will jeopardize countless trade dress rights of iconic product configurations long recognized as protectable by other federal courts and the U.S. Patent and Trademark Office (“USPTO”). Such an outcome would defeat the consumer protection objectives of the Lanham Act, and unjustifiably deprive mark owners of the trade dress protection conferred by that statute.

SUMMARY OF THE ARGUMENT

This Court has held that trade dress should be held unprotectable under the doctrine of utilitarian functionality only when it is “essential to the use or purpose” of a product or “affects the cost or quality” of a product. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995). For example, a Coca-Cola bottle serves the “function,” in a lay sense, of holding liquid, and its curves may be “useful” to a consumer grasping it. But it is *not* “functional” in a trademark sense because a bottle can be any shape; and a single shape is not essential, dictated by necessity, superior in quality, or cheaper to manufacture. *See, e.g., Glob. Mfg. Grp. v. Gadget Universe.com*, 417 F. Supp. 2d 1161, 1169 (S.D. Cal. 2006) (“For example, the hour-glass shaped, green, fluted bottle of the Coca-Cola company is protected by trade dress. (‘Doubtless no symbol in the world is so readily recognized.’)” (citation omitted)).

The Third Circuit's decision in this case misstates the functionality doctrine and should be reviewed by this Court for at least three reasons. First, this Court repeatedly has held that the test for functionality is whether a design is "essential to the use or purpose of the article or if it affects the cost or quality of the article." *Inwood Lab'ys v. Ives Laby's*, 456 U.S. 844, 850 n.10 (1982); see also *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32-33 (2001); *Qualitex*, 514 U.S. at 165. The Third Circuit's test for functionality subverts this Court's precedent and creates an obvious Circuit split by "[r]eading functionality as usefulness," Pet. App. 9a, and holding that, for functionality to apply, "[t]he shape need only be useful," *id.* at 13a.

Second, the decision below not only is inconsistent with this Court's past holdings and the law in other Circuits, but it misunderstands the origin and role of the functionality doctrine. In the Lanham Act, Congress did *not* use the word "useful," but instead repeatedly used the term "functional." By importing the word "useful" from the Patent Act into the Lanham Act, the Third Circuit treats the Patent Act (and its protection of "useful" designs) as mutually exclusive of the Lanham Act (and its protection of brands or source indicators) when neither Congress nor this Court has treated them as necessarily exclusive of one another.

Third, the Lanham Act, codified at 15 U.S.C. §§ 1051-1114n, was enacted by Congress in 1946 to provide uniform, nationwide rights for owners of trademarks. This purpose is frustrated by the fracture in functionality jurisprudence created by the decision below.

Fourth, by ignoring decades of this Court’s precedent and limiting the functionality standard to a single word—“usefulness”—the decision below dramatically over-broadens the category of designs that are functional. If left uncorrected, the Third Circuit’s decision would virtually eliminate (at least in the Third Circuit) trade dress protection for product configurations and food and beverage products in particular by sweeping in every “useful” trade dress—like the Coca-Cola bottle.

ARGUMENT

I. THE THIRD CIRCUIT CREATED A CIRCUIT SPLIT BY SUBSTITUTING A DICTIONARY DEFINITION FOR THIS COURT’S ESTABLISHED FUNCTIONALITY PRECEDENT

Under the Lanham Act, a “trademark” may be “any word, name, symbol, or device” used by an owner “to identify and distinguish [its] goods.” 15 U.S.C. § 1127. This definition includes “trade dress”—that is, “the total image of a product” or its packaging, including “features such as size, shape, color or color combinations,” among others. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992).³

It is well settled that “trade dress protection may not be claimed for product features that are functional,”

3. Courts long have extended trade dress protection to the configurations of food items, including such iconic products as Goldfish crackers and Life Savers candies. *See Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208 (2d Cir. 1999); *Nabisco Brands, Inc. v. Conusa Corp.*, 722 F. Supp. 1287 (M.D.N.C.), *aff’d without op.*, 892 F.2d 74 (4th Cir. 1989).

TrafFix, 532 U.S. at 29, but that does not mean all products serving some use are thereby disqualified. In *Inwood Laboratories v. Ives Laboratories*, 456 U.S. 844 (1982), this Court held that “[i]n general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Id.* at 850 n.10. That is, “a functional feature is one the ‘exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.’” *TrafFix*, 532 U.S. at 32 (alteration in original) (quoting *Qualitex*, 514 U.S. at 165).

Federal courts routinely apply the *Inwood* test to evaluate the functionality of trade dress in product designs.⁴ Yet, notwithstanding this substantial body of established law, the Third Circuit mentioned *Inwood* only in passing, noting it was merely “[o]ne way” to evaluate functionality. Pet. App. 11a. Instead, that court turned to *Webster’s Dictionary* to ascribe to “functionality” its “ordinary meaning,” holding that a product feature is functional “as long as it is ‘practical, utilitarian’—in a word, useful. The word requires nothing more.” *Id.* at 9a (citation omitted). The Court’s singular focus on the word “use” in *Inwood* is ironic, given that it faulted Petitioners for focusing on the word “essential” in that same test. *See id.*

4. See, e.g., *Moldex-Metric, Inc. v. McKeon Prods., Inc.*, 891 F.3d 878, 882 (9th Cir. 2018); *Leapers, Inc. v. SMTS, LLC*, 879 F.3d 731, 736 (6th Cir. 2018); *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 161 (4th Cir. 2012). Indeed, the Third Circuit has in the past also applied *Inwood*. See *Ideal Toy Corp. v. Plawner Toy Mfg. Corp.*, 685 F.2d 78, 81 (3d Cir. 1982) (“The Supreme Court has recently reminded us that, in general, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” (citing *Inwood*, 456 U.S. at 850 n.10)).

As the Petition amply demonstrates, this singular focus on “useful” as the only test for utilitarian functionality also creates a direct Circuit split with the Second, Fourth, Fifth, Sixth, Seventh, Eighth, Ninth, Eleventh, and Federal Circuits, as well as with the USPTO. *See, e.g., Bodum USA, Inc. v. A Top New Casting Inc.*, 927 F.3d 486, 492 (7th Cir.) (holding functionality is *not* defined by “a product’s ‘function’ *in the everyday meaning of the term*” but is “a *term of art* used in trade dress law” (emphasis added)), *cert. denied*, 140 S. Ct. 675 (2019); *Frosty Treats, Inc. v. Sony Comput. Ent. Am., Inc.*, 426 F.3d 1001, 1007 (8th Cir. 2005) (observing that functionality should *not* be evaluated “*using the colloquial meaning of ‘functional’ rather than the specialized meaning that it has in trademark law*” (emphasis added); *Tools USA & Equip. Co. v. Champ Frame Straightening Equip. Inc.*, 87 F.3d 654, 659 (4th Cir. 1996) (“[T]he functionality inquiry . . . looks for features that are *not merely useful*, but rather essential to the use or purpose of the article.” (emphasis added)); *Warner Bros., Inc. v. Gay Toys, Inc.*, 724 F.2d 327, 331 (2d Cir. 1983) (“A design feature of a particular article is ‘essential’ only if the feature is *dictated* by the functions to be performed; a feature that merely accommodates a useful function is not enough.” (emphasis added)); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1343 n.4, 1337 (C.C.P.A. 1982) (expressly rejecting the “lay” definition of “functional” in favor of the “legal” definition of that term).

Even if this Court’s precedent—and the precedents of every Circuit other than the Third to address this issue—had not already defined the term “functional” as a term of art, “dictionaries must be used as sources of statutory meaning only with great caution.” *United States*

v. Costello, 666 F.3d 1040, 1043 (7th Cir. 2012). This is because “[d]ictionary definitions are acontextual, whereas the meaning of sentences depends critically on context, including all sorts of background understandings”—particularly in the field of law. *Id.* at 1044; *see also* *Washington County v. Gunther*, 452 U.S. 161, 199 (1981) (“Rather than make a fortress out of the dictionary, the Court should instead attempt to implement the legislative intent of Congress.” (citation omitted)). When this Court and other courts of appeals already have defined the term “functional,” the Third Circuit’s pivot to a lay person’s dictionary⁵ is difficult to understand. The effect, however, is to graft a vernacular definition of “functional” onto well-established and longstanding precedent interpreting that statutory term within the greater context of trademark law. Given the irreconcilable differences between these understandings, this Court should grant the Petition.

II. THE DECISION BELOW CONFLICTS WITH CONGRESS’S INTENT AND THE FOUNDATIONAL RELATIONSHIP BETWEEN PATENT AND TRADEMARK LAW

The Third Circuit’s reliance on a *Webster’s Dictionary* definition of functionality apparently derives from the court’s goals to “keep trademark law in its lane,” Pet. App. 8a, “explain[] how the Lanham Act fits with the Patent Act,” *id.* at 9a, and ensure “the two statutes rule

5. The Third Circuit did not consult *Black’s Law Dictionary*, which defines the term “functional feature” as “a product’s attribute that is essential to its use, necessary for its proper and successful operation, and utilitarian rather than ornamental in every detail.” *Functional Feature*, Black’s Law Dictionary (11th ed. 2019).

different realms,” *id.* at 10a. The decision therefore treats the two bodies of law as mutually exclusive, with “utility,” the patent law term of art, acting as the gatekeeper for both.⁶ Trademark law and patent law, however, are not mutually exclusive or two sides of the same coin. By defining functionality primarily to square patent and trademark law, the Third Circuit interpreted the doctrine in a way contrary not only to binding precedent from this Court, but also at odds with Congress’s intent behind the Lanham Act.

Under the Patent Act, “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition . . . may obtain a patent therefor . . .” 35 U.S.C. § 101. On the other hand, the Lanham Act does not employ the word “useful.” Instead, the person who asserts protection in an unregistered trade dress must prove that the matter sought to be protected is “not functional,” 15 U.S.C. §§ 1125(a)(3), 1125(c)(4)(A), while “[t]hat the mark is functional” is an affirmative defense to the evidence of mark validity represented by a federal registration on the Principal Register. *Id.* § 1115(b)(8).⁷ “[A] change in phraseology creates a presumption of a change in intent,” because ordinarily “Congress would not have used such

6. The decision also persistently highlighted the supposed anticompetitive aspects of trade dress law. In reality, however, “protection for trade dress exists to *promote* competition” by preventing distinctive trade dress from being “used in a manner likely to cause confusion as to the origin, sponsorship, or approval of the goods.” *TrafFix*, 532 U.S. at 28 (emphasis added).

7. Likewise, the trademark statute recognizes an affirmative defense that the mark is “functional,” not “useful.” 15 U.S.C. § 1115(b)(8).

different language . . . without thereby intending a change of meaning.” *Crawford v. Burke*, 195 U.S. 176, 190 (1904). Thus, “[i]n the context of . . . the Lanham Act, ‘functional’ is not synonymous with ‘utilitarian,’ nor is it the antonym of ‘ornamental.’” *Industria Arredamenti Fratelli Saporiti v. Charles Craig, Ltd.*, 725 F.2d 18, 19 (2d Cir. 1984).

In trademark law, the functionality doctrine exists to preclude one company from monopolizing a design or device necessary for others to compete effectively. *See* 1 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 7:64 (5th ed. 2009) (“*McCarthy*”).⁸ By focusing unnecessarily on explaining how the Patent Act fits with the Lanham Act, the Third Circuit oversimplifies the functionality doctrine to a question of “usefulness” alone. But this oversimplification ignores the unique terminology Congress used in each statute and attempts to override decades of precedent firmly grounded from Congress’s use of the term “functional” in the Lanham Act. As this Court has explained:

“In 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

8. This is similar to other limiting principles in trademark law, such as the manner in which the nominative fair use doctrine limits a trademark owner’s ability to preclude competitors from using its mark in comparative advertising, or the requirement that a mark must be distinctive before conferring rights in it. Finally, of course, a finding of infringement will not lie unless a defendant’s use has created a likelihood of confusion. *See* 1 *McCarthy* §§ 4:13, 4:17.

would put competitors at a significant non-reputation-related disadvantage.

Qualitex, 514 U.S. at 165 (quoting *Inwood*, 456 U.S. at 850 n.10).

Elsewhere, this Court has said the functionality doctrine “serves to assure that competition will not be stifled by the exhaustion of a limited number of trade dresses.” *Two Pesos*, 505 U.S. at 775. Indeed, the functionality doctrine in trademark law presupposes that as product designs become more functional, they become more similar in appearance. Thus, a finding of functionality may be appropriate if competitors must use one or two “best” designs to compete effectively. See *TrafFix*, 532 U.S. at 32 (“[I]t was acknowledged that the device ‘could use three springs but this would unnecessarily increase the cost of the device.’”); *Tyco Indus. v. Tiny Love, Ltd.*, 914 F. Supp. 1068, 1082 (D.N.J. 1996) (“[P]roduct configurations are deemed functional where only a limited number of viable alternatives exist or where the product configuration is the best or one of a few superior designs.”). In fact, this understanding of functionality predates the Lanham Act and harkens back to this Court’s earlier finding that the configuration of shredded wheat breakfast cereal was functional because “the cost of the biscuit would be increased and its high quality lessened if some other form were substituted for the pillow-shape.” *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 122 (1938).

In the utility patent context, however, the concept of “utility” does not depend on whether the “best” designs converge in appearance; instead, the test for patentability focuses on how a device operates, not on its appearance.

Thus, the disclosure of a related utility patent does not always mandate a finding of trade dress functionality. *See, e.g., McAirloads, Inc. v. Kimberly-Clark Corp.*, 756 F.3d 307, 313 (4th Cir. 2014) (distinguishing claims of related patent). Indeed, the Third Circuit reached just such a result in this case, rendering its attention to harmonizing patent and trademark law odd, to say the least. Pet. App. 17a (“Glico’s utility patent for a manufacturing method is irrelevant.”).

Asking the *patentability* question of whether a product configuration is “useful” fails to respect Congress’s distinct selection of the word “functional” instead of “useful,” and it fails to conduct the *trademark* functionality analysis this Court requires. In fact, the appearance of the word “use” in the phrase if it is “essential to the *use* or purpose of the article, or if it affects the cost or quality,” *Inwood*, 456 U.S. at 850 n.10 (emphasis added), necessarily means this Court has acknowledged that product configurations entitled to trade dress protection are often “useful” in some way. *See Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 213 (2000) (expressly acknowledging the same).⁹ By contrast, the decision below stops at: “*The shape need only be useful.*”

9. *See also Bodum USA*, 927 F.3d at 492 (“[T]o establish it has a valid trade dress, Bodum did not have to prove that something like a handle does not serve any function. It merely needed to prove that preventing competitors from copying the Chambord’s particular design would not significantly disadvantage them from producing a competitive and cost-efficient French press coffeemaker.”); *Bauer Lamp Co. v. Shaffer*, 941 F.2d 1165 (11th Cir. 1991) (per curiam) (holding the illumination it provided by a lamp did not render its configuration functional); *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-Le Coultre Watches, Inc.*, 221 F.2d 464 (2d Cir. 1955) (holding the usefulness of a clock to tell time did not disqualify its features from trade dress protection).

Pet. App. 13a (emphasis added). This Court should grant the Petition to review the Third Circuit’s error and determine whether consistency needs to be restored across the courts of appeals with respect to the functionality inquiry.

III. THE COURT SHOULD GRANT CERTIORARI TO RESTORE UNIFORMITY TO FEDERAL TRADEMARK LAW

Beyond conflicting with Congress’s intent in selecting the term “functional” (rather than “useful”) in the Lanham Act, the decision below frustrates Congress’s purpose of providing uniform, nationwide rights to trademark owners when it passed the Lanham Act in 1946. Congress designed the Lanham Act to provide a robust and consistent, national scheme of protection for trademarks, to “secur[e] to the [trademark] owner the good will of his business and protect[] the public against spurious and falsely marked goods.” S. Rep. No. 79-1333 (1946), *as reprinted in* 1946 U.S.C.C.A.N. 1274, 1274-75. As it became clear in the post-war era that “trade [in the United States] is no longer local, but is national,” protection of trademarks could no longer be provided by the inconsistent amalgam of local protections. *Id.* at 1277. As a result, “a sound public policy require[d] that trademarks should receive nationally the greatest protection that can be given them.” *Id.* The Senate Committee on Patents described this purpose as follows:

The purpose of this bill is *to place all matters relating to trademarks in one statute* and *to eliminate judicial obscurity*, to simplify registration and to make it stronger and more liberal, to dispense with mere technical

prohibitions and arbitrary provisions, to make procedure simple, and relief against infringement prompt and effective.

Id. at 1274 (emphasis added).

Courts have recognized that Congress’s purpose in federalizing trademark law in the Lanham Act was to create uniform, nationwide rights for a national economy. Not long after the Lanham Act’s passage, Judge Learned Hand recognized that it “put federal trademark law upon a new footing, . . . and created rights uniform throughout the Union, in the interpretation of which we are not limited by local law.” *S.C. Johnson & Son, Inc. v. Johnson*, 175 F.2d 176, 178 (2d Cir. 1949).

More recently, this Court acknowledged Congress’s goals by noting that “[n]ational protection of trademarks is desirable . . . because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.” *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985); *see also Two Pesos*, 505 U.S. at 781-82 (Stevens, J., concurring) (“The purpose of [the Lanham Act] is to protect legitimate business and the consumers of the country, [and] [o]ne way of accomplishing these dual goals was by creating uniform legal rights and remedies that were appropriate for a national economy.” (citation omitted)); *Inwood*, 456 U.S. at 861 n.2 (White, J., concurring) (noting purpose of the Lanham Act to “codify and unify” the common law of trademark protection).

When conflicting interpretations of the Lanham Act among the Circuits have matured in the past, this Court has granted certiorari to restore uniformity to the law. For

example, in its decision in *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004), the Court noted it had granted certiorari “to address a disagreement among the Courts of Appeals on the significance of likely confusion for a fair use defense to a trademark infringement claim, and the obligation of a party defending on that ground to show that its use is unlikely to cause consumer confusion.” *See id.* at 116; *see also Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003) (granting certiorari “because other Circuits have also expressed differing views about the ‘actual harm’ issue” under the Federal Trademark Dilution Act); *Qualitex*, 514 U.S. at 161 (noting that the Court granted certiorari because “[t]he Courts of Appeals have differed as to whether or not the law recognizes the use of color alone as a trademark”).

Uniform rights are particularly important in a marketplace increasingly characterized by brands with national and global reach. The current fractured state of the law frustrates Congress’ purpose, and the Court should take the opportunity presented by this case to resolve the split in the circuits and restore uniformity to the law.

IV. THE THIRD CIRCUIT’S DECISION WOULD NULLIFY INDISPUTABLY ICONIC PRODUCT CONFIGURATION TRADE DRESS OTHER JURISDICTIONS HAVE HELD PROTECTABLE

Last but certainly not least, the decision below essentially ends trademark protection for product configurations in the Third Circuit and places in jeopardy countless trade dress rights that other federal courts and the USPTO hold protectable—thus creating tremendous ambiguity and uncertainty for trade dress owners who market and sell their products nationally. These examples

illustrate protectable trade dresses that the decision below would render void merely because each is arguably “useful” or has “useful” features.



Adidas Am., Inc. v. Skechers USA, Inc., 890 F.3d 747, 754-55 (9th Cir. 2018) (adidas’s classic Stan Smith shoe held protected trade dress)

Ferrari S.P.A. v. Roberts, 944 F.2d 1235, 1239 (6th Cir. 1991) (Ferrari Testarossa and Daytona Spyder car designs held protected trade dress)



U.S. Trademark Reg. No. 3,105,591; *Blumenthal Distrib., Inc. v. Herman Miller, Inc.*, 963 F.3d 859, 867-68 (9th Cir. 2020), *cert. denied*, 141 S. Ct. 1514 (2021).

See Ideal Toy Corp. v. Chinese Arts & Crafts Inc., 530 F. Supp. 375 (S.D.N.Y. 1981)



Nabisco Brands,
722 F. Supp. at 1292.



Bodum USA,
927 F.3d at 492-94.

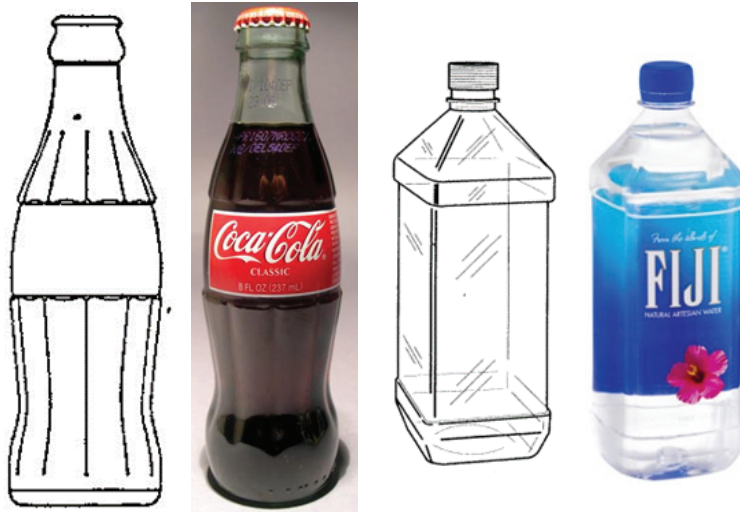


Gen. Motors Corp. v. Lanard Toys, Inc., 468 F.3d 405,
417 (6th Cir. 2006).

The adidas Stan Smith sneaker, Herman Miller’s Eames office chair, and the design of the Ferrari Testarossa sports car are among numerous iconic and extremely well-known product configuration trade dresses that consumers unquestionably associate strongly with a single source. Yet each shape could be considered—under the Third Circuit’s misguided rule—“in a word, useful.” Pet. App. 9a. For example, the arms of the Eames office chair function as a resting place for one’s elbows, and the seat and back

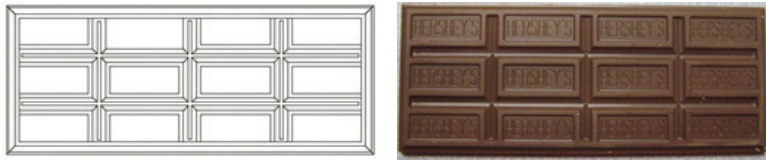
allow a person to sit, such that the chair's shape is "useful" under the Third Circuit's opinion. The decision below runs contrary to the obvious (and valuable) trade dress rights in well-known products and, therefore, should be corrected.

The Third Circuit's overly simplistic "usefulness" standard of functionality is especially pernicious for trade dress configuration among food and beverage products because, by necessity, these items must be handled and consumed in portions or pieces. Below are examples of such products whose trade dress protection might well be undermined if the decision below remains precedent.



U.S. Trademark Reg.
No 1,057,884

U.S. Trademark Reg.
No. 2,911,918; *Fiji Water
Co. v. Fiji Min. Water
USA, LLC*, 741 F. Supp. 2d
1165 (C.D. Cal. 2010).



U.S. Trademark Reg. No. 4,322,502



U.S. Trademark Reg.
No. 4,274,073



U.S. Trademark Reg.
No. 3,293,236



U.S. Trademark Reg.
Nos. 2,233,574; 2,665,061;
4,077,237

U.S. Trademark Reg.
No. 2,766,278



U.S. Trademark Reg. No. 2,078,468

For instance, applying the decision below, a court may well hold that a Coca-Cola bottle is “useful” because it is easier to hold than bottles of other shapes; that the square-shaped bottle used for Fiji water is “useful” because it is easier to package and ship than a typical cylindrical bottle; or that a Hershey’s chocolate bar is “useful” because it can be easily divided to share with friends. While any such “usefulness” argument may be considered in the proper functionality analysis under this Court’s precedent, none of them should prematurely end the analysis or be dispositive of functionality—as they would be under the Third Circuit’s flawed and dangerously simplistic reduction of the functionality test.

CONCLUSION

The decision below incorrectly ignores decades of this Court’s precedent—as well as the precedents of other Circuits—to adopt a single, simplistic word as the definition for “functional”: “useful.” While “useful” appears in the patent statute, Congress did not include that word in the Lanham Act, and it is a poor substitute for the functionality doctrine in trademark law. The Third Circuit’s decision creates a split among the Circuits and splinters the uniformity in trademark law Congress intended when it enacted the Lanham Act. Absent review, the decision below will jeopardize trade dress rights for previously protectable iconic product configurations. For these reasons, the Court should grant the Petition.

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