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

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

Cover Page Footnote

Professor VerSteeg teaches Intellectual Property, Sports Law, Sales, Torts, and legal history courses at New England Law | Boston. The author would like to thank Dean John F. O'Brien and the New England Law | Boston Board of Trustees who funded research for this article through the Honorable James Lawton Summer Research Stipend (2012). He would also like to thank the editors and staff of the Fordham Intellectual Property, Media and Entertainment Law Journal for their contributions.

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

Russ VerSteeg*

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INTRODUCTION

In *Wal-Mart Stores, Inc. v. Samara Bros.*, 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.² The Court stated that product designs, like colors, do not ordinarily operate as source indicators,³ 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.⁴ Professor

¹ See *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 216 (2000) (“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 [sic], only upon a showing of secondary meaning.”); see also *Predator Int’l, Inc. v. Gamo Outdoor USA, Inc.*, 669 F. Supp. 2d 1235, 1244 (D. Colo. 2009) (applying *Wal-Mart Stores* for the proposition that § 43(a) of the Lanham Act provides a “cause of action against any person whose use of a word, symbol or device is likely to cause confusion regarding the source or origin of the plaintiff’s goods.”) (citations omitted).

² *Wal-Mart Stores, Inc.*, 529 U.S. at 213 (reasoning that “[i]n the case of product design . . . consumer predisposition to equate the feature with the source does not exist.”).

³ *Id.*

⁴ *Id.* at 216; see Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 IOWA L. REV. 611, 614 (1999) (“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 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8:1 (4th ed. 2012) [hereinafter MCCARTHY ON TRADEMARKS] (explaining that a plaintiff asserting

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Dinwoodie, writing a year earlier, bluntly asserted that the Supreme Court's underlying assumption of fact was untrue:

[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 unreceptive to evolving social and competitive realities.⁵

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 have established a cognitive link between the mark and a particular source.⁶ Thus, whether secondary meaning exists is a question of fact.⁷

a trade dress infringement claim must first prove that the trade dress is either “inherently distinctive or has acquired distinctiveness through secondary meaning.”)

⁵ Dinwoodie, *supra* note 4, at 645.

⁶ See *Bonanza Press, Inc. v. Arrow Int'l, 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); *Shell Trademark Mgmt. B.V. v. Warren Unilube, Inc.*, 765 F. Supp. 2d 884, 895 (S.D. Tex. 2011) (“With regard to ‘secondary meaning,’ courts inquire into ‘the public’s mental association between the mark and the alleged mark holder’ to determine whether ‘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); *Fiji Water Co. v. Fiji Mineral Water USA, L.L.C.*, 741 F. Supp. 2d 1165, 1177 (C.D. Cal. 2010) (“A trade dress has secondary meaning when ‘in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself.’”) (citations omitted); *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); see also MCCARTHY ON TRADEMARKS, *supra* note 4, § 15:7 (“As an elusive intellectual synthesis of psychology and law, secondary meaning has been defined in many ways throughout the years. For example, secondary meaning has been said to be created in a mark . . . when an ‘association in the minds of a substantial portion of the consuming public of the trademark with the product of the alleged proprietor’ is created[.]”) (footnote omitted).

⁷ MCCARTHY ON TRADEMARKS, *supra* note 4, § 15:29 (“Whether or not a designation has acquired secondary meaning is a question of fact, not an issue of law.”).

The *Wal-Mart* case separates the universe of trade dress into at least two (and perhaps three) subcategories.⁸ The Court acknowledged that, as a rule, trade dress may be protectable without proof of secondary meaning.⁹ The Court cites its *Two Pesos* decision for that proposition.¹⁰ Furthermore, the Court distinguishes between two subcategories of trade dress: product design versus product packaging.¹¹ Product packaging, according to the Court, may operate as protectable trade dress without a showing of secondary meaning because, as with word marks, consumers are prone readily to associate the external accoutrements of a product's package with source identification.¹² On the other hand, the Court states that consumers do not readily associate a product's design with source identification.¹³

⁸ See generally *Wal-Mart Stores, Inc.*, 529 U.S. 205.

⁹ *Id.* at 215 (reasoning that *Two Pesos* “unquestionably establishes the legal principle that trade dress can be inherently distinctive, but it does not establish that *product-design* trade dress can be.”) (internal citation omitted).

¹⁰ *Id.* (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773 (1992)).

¹¹ *Id.* at 209.

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.

Id. (citations omitted); see Dorota Niechwiej Clegg, Note, *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).

¹² *Wal-Mart Stores, Inc.*, 529 U.S. at 212–13 (“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.’”) (internal citations omitted).

¹³ See *id.* at 213 (“It seems to us that design, like color, is not inherently distinctive.”); see also *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 protectable [sic] only on a showing of secondary meaning, because the design will invariably serve purposes other than source identification.”) (citing *Wal-Mart Stores, Inc.*, 529 U.S. at 213, 216).

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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.¹⁴ 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.”¹⁵ 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.¹⁶ Justice Scalia offers an example of a cocktail shaker in the shape of a penguin.¹⁷ A penguin-shaped cocktail shaker—a product design—would have to acquire a secondary meaning in order to be protectable as trade dress under § 43(a).¹⁸ 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

¹⁴ *Wal-Mart Stores, Inc.*, 529 U.S. at 213 (concluding that in the case of product designs, “consumer predisposition to equate the feature with the source does not exist,” but providing no citations of authority for that finding).

¹⁵ GRANT GILMORE, *THE AGES OF AMERICAN LAW* 89 (1977).

¹⁶ *Wal-Mart Stores, Inc.*, 529 U.S. at 216; see *E & J Gallo v. Proximo Spirits, Inc.*, 2012 WL 273076, at *10 n.3 (E.D. Cal. 2012) (citing *Wal-Mart Stores, Inc.*, 529 U.S. at 216); *Bonanza Press, Inc. v. Arrow Int’l, Inc.*, 2010 WL 2196112, at *3 (W.D. Wash. 2010) (“[A] trademark is protectable only upon a showing of secondary meaning.”) (citing *Wal-Mart Stores, Inc.*, 529 U.S. at 216); see also Clegg, *supra* note 11, at 287 (“The Court [in *Wal-Mart Stores*] ruled that the unqualified protection of inherently distinctive trade dress applied only to product packaging trade dress features, namely, the physical characteristics of the vehicle in which the product is sold.”).

¹⁷ *Wal-Mart Stores, Inc.*, 529 U.S. at 213 (“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.”).

¹⁸ *Id.*

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.¹⁹

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.*²⁰ and *Two Pesos, Inc. v. Taco Cabana, Inc.*,²¹ 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 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*.²²

¹⁹ See *id.* at 212–13 (The Court explains that although product color or design is not inherently distinctive, a product's design can be protected when customers come to treat the product as coming from a specific source. Applying this reasoning, a hypothetical penguin-shape design for a cocktail shaker can be protectable only once the consumer public has associated that design with the specific source.).

²⁰ 514 U.S. 159 (1995).

²¹ 505 U.S. 763 (1992).

²² See, e.g., Dinwoodie, *supra* note 4, at 641–42 (emphasizing 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.").

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.*,²³ Judge Friendly charted the course for the most fundamental, traditional principles of trademark analysis. He explained that all putative trademarks exist on a continuum stretching from “generic” (weakest) to “fanciful” (strongest).²⁴ In between those polar extremes lie points labeled “descriptive,” “suggestive,” and “arbitrary.”²⁵ In order to determine whether any given putative mark may operate as a valid, legal trademark, one must determine where it lies on the *Abercrombie* continuum.²⁶ In order to arrive at this determination, one must consider the relationship between the putative mark and the product that it represents.²⁷ Assessing the cognitive link or mental association between those two—the putative mark and the product—forms the heart of the *Abercrombie* analysis.²⁸ 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:

²³ 537 F.2d 4 (2d Cir. 1976).

²⁴ *Id.* at 9; see *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (explaining the “classic formulation set out by Judge Friendly” in *Abercrombie* as a spectrum from “generic” to “fanciful”) (citation omitted).

²⁵ See *Ashley Furniture Indus., Inc. v. SanGiacomo N.A.*, 187 F.3d 363, 369 (4th Cir. 1999) (“A court applying the *Abercrombie* analysis asks whether the trademark in question is (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, or (5) fanciful.”) (citing *Perini Corp. v. Perini Const., Inc.*, 915 F.2d 121, 124 (4th Cir. 1990)). 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., JEROME HALL, 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.”).

²⁶ See *Ashley Furniture Indus.*, 187 F.3d at 369.

²⁷ See *id.* (describing the specific relationship that exists between a product and a mark for generic, descriptive, suggestive, arbitrary, and fanciful trademarks, respectively).

²⁸ MCCARTHY ON TRADEMARKS, *supra* note 4, § 11:64 (explaining that “[t]he distinctiveness 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).

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.”)²⁹

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 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

²⁹ *Ashley Furniture Indus.*, 187 F.3d at 369; see also MCCARTHY ON TRADEMARKS, *supra* note 4, at 11:71 (“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).

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“VIAGRA” for the pharmaceutical product.³⁰ Because fanciful words have no socio-linguistic history, they are the opposite of generic terms.³¹ 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.³² Like fanciful marks, there is no logical, cognitive association between an “arbitrary” symbol and its product.³³ But we generally categorize marks as “arbitrary” when the mark already existed in our lexicon (i.e., it was not coined or invented).³⁴ Hence, the word “apple” used as a trademark for music products such as records, CDs, or MP3 files would be arbitrary since there is no logical connection between music and the standard meanings (e.g., typically a specific kind of fruit) associated with the word “apple.”³⁵

“Suggestive” marks are those that require a leap of imagination or a connecting-of-the-dots.³⁶ 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”

³⁰ See generally MCCARTHY ON TRADEMARKS, *supra* note 4, §§ 11:8, 11:5 (“‘Fanciful’ marks consist of ‘coined’ words that have been invented or selected for the sole purpose of functioning as a trademark.”) (footnote omitted).

³¹ See *id.* § 11:5.

³² See *id.* § 11:14.

³³ See *id.* § 11:11.

³⁴ See *id.* (“Arbitrary marks comprise those words, symbols, pictures, etc., that are in common linguistic 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).

³⁵ *Id.*

³⁶ See *id.* § 11:67.

mark.³⁷ “ESKIMO PIE” for a kind of ice cream and Judge Motz’s hypothetical “PENGUIN” brand air conditioner are good examples of suggestive marks.³⁸

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.³⁹ 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.⁴⁰ 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.”⁴¹ The line is not always clear-cut, but it is an incredibly important line.⁴² It is incredibly important because, as has been explained, a putative mark that is deemed “generic” cannot operate as a valid trademark.⁴³ On the other hand, a putative mark that is deemed “descriptive” may operate as a valid trademark.⁴⁴ The catch is that, in order to operate as a valid trademark, a descriptive mark must first acquire a secondary meaning.⁴⁵ Acquisition of secondary meaning is a precondition to being recognized as a valid trademark in the case of descriptive terms.⁴⁶ The secondary meaning requirement for descriptive marks leads us to the second analytical problem; namely, drawing the line between

³⁷ *See id.* (“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 give situation is hazy and only subjectively definable.”); *Id.* § 11:62 (“A distinction developed in the law whereby a mark which merely suggested some quality or ingredient of goods was labeled [sic] as ‘suggestive, distinguishing it from descriptive marks.’”).

³⁸ *See id.* § 14:7; *see also* Ashley Furniture Indus., Inc. v. SanGiacomo N.A., 187 F.3d 363, 369 (4th Cir. 1999).

³⁹ *See* MCCARTHY ON TRADEMARKS, *supra* note 4, § 11:16.

⁴⁰ *See id.* § 7:22 n.18.

⁴¹ *See id.* § 12:20.

⁴² *See id.* § 11:66.

⁴³ *See id.* § 12:2.

⁴⁴ *See id.* § 11:25.

⁴⁵ *See id.*

⁴⁶ *See id.* 15.2

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“descriptive” versus “suggestive.”⁴⁷ The *Abercrombie* rubric categorizes fanciful, arbitrary, and suggestive marks as “inherently distinctive.”⁴⁸ By definition, inherently distinctive marks are capable of distinguishing the mark owner’s products without secondary meaning (i.e., inherently).⁴⁹ 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.⁵⁰ Thus, if a putative mark is deemed merely “suggestive” as it relates to its product, it automatically may serve as a valid trademark.⁵¹ 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.⁵²

B. Two Pesos (*Trade 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.⁵³ In 1992, Justice White’s opinion in *Two Pesos, Inc. v. Taco Cabana, Inc.* 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.⁵⁴ In simple terms, Justice White reasoned that, like traditional word trademarks, trade dress, protected under

⁴⁷ See *id.* § 11:26.

⁴⁸ See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (“The latter three categories of marks, because their intrinsic nature serves to identify a particular source of a product, are deemed inherently distinctive and are entitled to protection.”); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976).

⁴⁹ See *Two Pesos, Inc.*, 505 U.S. at 768–69; *Thoip v. Walt Disney Co.*, 736 F. Supp. 2d 689, 703 (S.D.N.Y. 2010).

⁵⁰ See *Two Pesos, Inc.*, 505 U.S. at 769.

⁵¹ See MCCARTHY ON TRADEMARKS, *supra* note 4, § 11:2.

⁵² See *id.*

⁵³ See *id.* §§ 8:8, 8:12.5.

⁵⁴ See *Two Pesos, Inc.*, 505 U.S. at 767 (“We granted certiorari to resolve the conflict among the Courts of Appeals on the question whether trade dress that is inherently distinctive is protectible [sic] under § 43(a) without a showing that it has acquired secondary meaning . . . We find that it is, and we therefore affirm.”) (footnote omitted) (citation omitted); see also Clegg, *supra* note 11, at 286 (citing *Two Pesos* for the proposition that trade dress may be inherently distinctive).

§ 43(a), ought to be analyzed using the *Abercrombie* rubric.⁵⁵ Justice White's opinion logically concludes that trade dress, at least conceptually, ought to be analyzed in the same manner.⁵⁶ 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 § 43(a) but not for other distinctive words, symbols, or devices capable of identifying a producer's product.⁵⁷

Thus, *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 *Qualitex* held that color may operate as a trademark.⁵⁸ 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

⁵⁵ See *Two Pesos*, 505 U.S. at 770 ("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)."); see also 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 N.M. L. REV. 147 (2007) (noting the difficulties that courts encounter when trying to categorize marks).

⁵⁶ See *Two Pesos, Inc.*, 505 U.S. at 772.

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.

Id.

⁵⁷ *Id.* at 774.

⁵⁸ See *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 161 (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."); MCCARTHY ON TRADEMARKS, *supra* note 4, §§ 7:39, 7:44.

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device”⁵⁹ This case put to rest the debate regarding the protectability of colors as trademarks that had raged for decades.⁶⁰ One of the most interesting aspects of *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 meaning.⁶¹ 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. As summarized by the Ninth Circuit:

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

⁵⁹ See *Qualitex Co.*, 514 U.S. at 162.

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.

Id.

⁶⁰ See *Qualitex Co.*, 514 U.S. at 161 (“The Courts of Appeals have differed as to whether or not the law recognizes the use of color alone as a trademark.”) (citations omitted). Professor Bartow has vigorously argued that the decision was wrongly decided. See Ann Bartow, *The True Colors of Trademark Law: Greenlighting a Red Tide of Anti Competition Blues*, 97 KY. L.J. 263 (2008–09) (“The Supreme Court was wrong to facilitate this abuse of trademark powers when it decided in *Qualitex v. Jacobson Products Co.* that colors alone could constitute protectable trademarks.”) (citation omitted); *id.* at 271 (“It is the position of this author that the *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.”).

⁶¹ See *Qualitex Co.*, 514 U.S. at 166.

leading magazine aimed at the dry cleaner market. There was evidence that readers of a trade publication associated the green-gold color with *Qualitex*.⁶²

Thus, the Supreme Court accepted that the green-gold color had acquired a secondary meaning.⁶³ 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.⁶⁴ 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 insulating material or red on the head of a large industrial bolt) as signifying a brand."⁶⁵

[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").⁶⁶

⁶² *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 13 F.3d 1297, 1304 (9th Cir. 1994); *see Predator Int'l, Inc. v. Gamo Outdoor USA, Inc.*, 669 F. Supp. 2d 1235, 1247 (D. Colo. 2009) (discussing *In re Owens-Corning Fiberglas Corp.*, 774 Fed. 2d. 1116, 1122 (Fed. Cir. 1985)); Mitchell M. Wong, Note, *The Aesthetic Functionality Doctrine and the Law of Trade-Dress Protection*, 83 CORNELL L. REV. 1116, 1137 (1998) (discussing *In re Owens-Corning Fiberglas Corp.*, 774 Fed. 2d. 1116, 1122 (Fed. Cir. 1985), and 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).

⁶³ *See Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 166 (1995).

⁶⁴ *See 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 Co.*, 514 U.S. at 162–63).

⁶⁵ *Qualitex Co.*, 514 U.S. at 163.

⁶⁶ *Id.*

But it is worthwhile to note that there are other sentences in the opinion that 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.”⁶⁷ “We hold now that there is no rule absolutely barring the use of color alone”⁶⁸ 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 about imposing a secondary meaning requirement on putative trademarks other than descriptive marks.⁶⁹ Justice Scalia’s opinion in *Wal-Mart* adopts this restrictive interpretation of *Qualitex*, and uses it as a fulcrum upon which to justify the Court’s decision to impose

⁶⁷ *Id.* at 161.

⁶⁸ *Id.* at 162. 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, *supra* note 4, § 7:44.

⁶⁹ See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 770 (1992) (“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).”).

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 § 43(a) but not for other distinctive words, symbols, or devices capable of identifying a producer’s product.

Id. at 774; 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. See, e.g., JEROME HALL, 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 *should* be consistent.”).

the exact same secondary meaning requirement on product designs.⁷⁰

C. Wal-Mart (*Product Design*)

In *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).⁷¹ The Court distinguished the 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.⁷² 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."⁷³

⁷⁰ *Wal-Mart Stores, Inc. v. Samara Bros.*, 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); *see id.* at 212 ("We held that a color could be protected as a trademark, but only upon a showing of secondary meaning."); *see also* *Predator Int'l, Inc. v. Gamo Outdoor USA, Inc.*, 669 F. Supp. 2d 1235, 1246 (D. Colo. 2009).

⁷¹ *Wal-Mart Stores, Inc.*, 529 U.S. at 216 ("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 [sic], only upon a showing of secondary meaning.")

⁷² *Wal-Mart Stores, Inc.*, 529 U.S. at 215.

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.

Id.

⁷³ *Two Pesos, Inc.*, 505 U.S. at 764–65 ("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.") (footnote omitted).

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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 (i.e., those types of trade dress may be inherently distinctive as fanciful, arbitrary, or suggestive).⁷⁴ 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.⁷⁵ The *Wal-Mart* Court, as was mentioned,⁷⁶ draws an analogy to the use of colors as trademarks. The Court cites the *Qualitex* decision for the proposition that colors may serve as trademarks but only upon proof that the color in question has first acquired a secondary meaning.⁷⁷ 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.⁷⁸ 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."⁷⁹ In *Wal-Mart*, the 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.⁸⁰ The Court stated that consumers are not inclined to equate colors with source indication nor are consumers inclined to equate product design with source indication.⁸¹

⁷⁴ *Wal-Mart Stores, Inc.*, 529 U.S. at 215.

⁷⁵ *See id.* at 216; *see also* Clegg, *supra* note 11, at 287–88 ("Thus, current standards for determining the trade dress's distinctiveness hinge upon its classification as product packaging or product design.") (footnote omitted).

⁷⁶ *See supra* text accompanying note 35.

⁷⁷ *Wal-Mart Stores, Inc.*, 529 U.S. at 212.

⁷⁸ *See* *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 166 (1995); *see also supra* note 33 and accompanying text.

⁷⁹ *Qualitex Co.*, 514 U.S. at 166.

⁸⁰ *Wal-Mart Stores, Inc.*, 529 U.S. at 213.

⁸¹ *Id.*

In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does

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” or “distinctiveness.”⁸² In fact, the *Two Pesos* decision discusses Judge Friendly’s analysis in *Abercrombie*, and explicitly relies on it.⁸³ The *Abercrombie* case, as was mentioned, made it clear that only descriptive marks need a showing of secondary meaning in order to be protectable.⁸⁴ As was suggested, if the *Qualitex* Court had in fact intended to impose a per se secondary meaning requirement for colors, the opinion certainly could have been more direct and clear.⁸⁵ Nevertheless, the *Wal-Mart* Court, as is their prerogative, refines or interprets the *Qualitex* holding in precisely this way.⁸⁶

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. Rather they 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*.⁸⁷

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.

Id.

⁸² *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976); *see supra* text accompanying notes 16–24.

⁸³ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773 (1992); *see* *Amazing Spaces, Inc. v. Metro Mini Storage*, 665 F. Supp. 2d 727, 735 (S.D. Tex. 2009) (explaining genericity and the *Abercrombie* categories). This was affirmed in part, reversed in part, and remanded in *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225 (5th Cir. 2010); *see also* Clegg, *supra* note 11, at 285–88 (discussing the *Abercrombie* spectrum of distinctiveness).

⁸⁴ *Abercrombie & Fitch Co.*, 537 F.2d at 8; *see supra* note 45.

⁸⁵ *See supra* text accompanying notes 60–61.

⁸⁶ *Wal-Mart Stores, Inc.*, 529 U.S. at 211 (“Indeed, with respect to at least one category of mark-colors-we have held that no mark can ever be inherently distinctive.”).

⁸⁷ *Two Pesos, Inc.*, 505 U.S. at 773.

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At this point it is sufficient to suggest one simple 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.⁸⁸ Using the *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, descriptive (or probably even generic) for mint-flavored foods, and generic for the sale of green paint.⁸⁹ The *Abercrombie* analysis relies on cognitive

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 protection is claimed under § 43(a) is inherently distinctive. If it is, it is capable of identifying products or services as coming from a specific source and secondary meaning is not required. This is the rule generally applicable to trademarks, and the protection of trademarks and trade dress under § 43(a) serves the same statutory purpose of preventing deception and unfair competition. 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*.”

Id. (citing *Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 608 (CA7 1986)). Professor Dinwoodie refers to the approach of treating words and symbols as equals for purposes of trademark analysis an “assimilationist model,” and he refers to the type of analysis that the *Wal-Mart* court later used (i.e., analyzing putative trademarks based on subject matter) as a “categorical model.” See Dinwoodie, *supra* note 4, at 656, 663.

⁸⁸ 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.”

⁸⁹ See Bartow, *supra* note 60, at 285.

The Hershey Company’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

association.⁹⁰ 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 is 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.⁹¹ 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).⁹²

communication that can be caused by color-alone trademarks is one more argument against having them.

Id. (footnote omitted); see MCCARTHY ON TRADEMARKS, *supra* note 4, § 7:52 ("Color as generic or descriptive indication"). Presumably there could be instances where a color also could be "deceptively misdescriptive." See 15 U.S.C. § 1052 (e) (2006) (e.g., brown-colored milk that is actually strawberry-flavored rather than chocolate-flavored).

⁹⁰ *Abercrombie & Fitch Co.*, 537 F.2d at 9 (explaining that terms may switch from one category to another over time, based on the way that certain people use and understand it via their cognitive association).

⁹¹ See Dinwoodie, *supra* note 4, at 633 ("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.").

⁹² See MCCARTHY ON TRADEMARKS, *supra* note 4, § 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.").

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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.⁹³ 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 a particular product emanates from that particular producer.⁹⁴ That is really what makes a trademark a trademark. A trademark is a message from the producer to the public: “I made this product!”⁹⁵ 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.

E. Ashley Furniture: *The Road Not Taken*

In 1999, Judge Motz of the Fourth Circuit Court of Appeals wrote a well-reasoned opinion in *Ashley Furniture Industries, Inc. v. Sangiacomo N.A.*, applying the *Abercrombie* analysis to a

⁹³ See *Two Pesos, Inc.*, 505 U.S. at 773 (“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*.”) (quoting *Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 608 (7th Cir. 1986)).

⁹⁴ See *Dinwoodie*, *supra* note 4, at 618 (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*, *supra* note 60, at 265–66 (discussing the pros and cons of non-linguistic marks, such as sounds and scents).

⁹⁵ See *Dinwoodie*, *supra* note 4, at 653 (“[T]rademark law concerns the meaning of symbols to consumers.”) (footnote omitted).

product design.⁹⁶ Judge Motz recounted the *Abercrombie* analysis,⁹⁷ 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.”⁹⁸

She also explained why this approach was logical.⁹⁹ In short, Judge Motz recognized what Justice Scalia in *Wal-Mart* did not.¹⁰⁰

⁹⁶ 187 F.3d 363, 373 (4th Cir. 1999).

⁹⁷ *Ashley Furniture Indus., Inc.*, 187 F.3d at 369 (“In 1976, Judge Friendly articulated a methodology in *Abercrombie* 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.”) (citations omitted).

⁹⁸ *Id.* at 370; *see also id.* at 371 (“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.”).

⁹⁹ *Id.* at 370.

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. *Id.* (citations omitted); *see* Russ VerSteeg, *Iguanas, Toads and Toothbrushes: Land-Use Regulation of Art as Signage*, 25 GA. L. REV. 437, 472–75 (1991) (discussing the possibility of applying the *Abercrombie* rubric to three-dimensional sculpture (i.e., works of art), to show 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 this view. *See Ashley Furniture Indus., Inc.*, 187 F.3d at 371.

¹⁰⁰ *See Ashley Furniture Indus., Inc.*, 187 F.3d at 375 (noting that a feature does not have to be purely source designating or aesthetic, but rather can serve both functions). *Contra Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213 (2000) (finding product design to be “utilitarian and esthetic” rather source-designating).

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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.¹⁰¹ 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.”¹⁰² 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.¹⁰³

In *Ashley Furniture*, the court examined the potential protectability of one of Ashley’s furniture suite designs (the “Somerset Suite”).¹⁰⁴ 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.¹⁰⁵

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.¹⁰⁶ Using the *Abercrombie* continuum as

¹⁰¹ *Ashley Furniture Indus., Inc.*, 187 F.3d at 371.

¹⁰² *Id.*; see MCCARTHY ON TRADEMARKS, *supra* note 4, § 8:5 (regarding product shapes as protectable trade dress in general).

¹⁰³ *Ashley Furniture Indus., Inc.*, 187 F.3d at 375 (“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, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 775 (1992)). For more discussion regarding functionality see *infra* Part II.

¹⁰⁴ *Ashley Furniture Indus., Inc.*, 187 F.3d at 367–68.

¹⁰⁵ *Id.* at 369.

¹⁰⁶ *Id.* at 368.

its basis for analysis, the court held that it was possible for a jury to conclude that the design in question was either arbitrary or fanciful.¹⁰⁷ 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.¹⁰⁸

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 configuration may be protectable as valid trade dress.¹⁰⁹ 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.¹¹⁰ Arguably, such trite symbols are either generic

¹⁰⁷ *Id.* at 374.

[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.

Id.

¹⁰⁸ *Id.* at 375–76.

¹⁰⁹ *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1344 (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*. Compare *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225, 243 (5th Cir. 2010), with *Ashley Furniture Indus., Inc.*, 187 F.3d at 371 (finding *Seabrook* to be an “elaboration of *Abercrombie*”).

¹¹⁰ *Ashley Furniture Industries, Inc.*, 187 F.3d at 371.

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.

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or aesthetically functional.¹¹¹ Judge Motz cited *Seabrook* for the proposition that many such ordinary symbols would be excluded from trademark protection as generic.¹¹² To be sure, the functionality doctrine will preclude many such putative marks.¹¹³ 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 features.”¹¹⁴ And, although Judge Motz acknowledged that applying the *Abercrombie* analysis poses challenges for non-verbal marks, she explained that the analysis is, nevertheless, both workable and appropriate.¹¹⁵

Of course it is possible that a fact-finder could conclude that the eye-appeal of the Sommerset Suite design was the principal

Id. (quoting *Seabrook*, 568 F.2d at 1344); see also MCCARTHY ON TRADEMARKS, *supra* note 4, § 7:33 (“Ordinary geometric shapes such as circles, ovals, squares, etc., even when not used as a background for other marks, are regarded as nondistinctive and protectable only upon proof of secondary meaning.”).

¹¹¹ See *infra* Part II. E., regarding the close relationship between genericity and functionality.

¹¹² *Ashley Furniture Indus., Inc.*, 187 F.3d at 371.

¹¹³ *Id.* (“[W]e 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.”).

¹¹⁴ *Id.* at 376.

¹¹⁵ *Id.* at 370.

This is not to say that the *Abercrombie* analysis may not be difficult to apply in some product configuration cases. But the contention that we should therefore refuse to apply it at all in such cases is, as the Supreme Court remarked with respect to another thorny Lanham Act issue, “unpersuasive . . . because it relies on an occasional problem to justify a blanket prohibition.”

Id. (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 168 (1995)). To a certain degree, Judge Motz’s opinion evinces a preference for applying a general theory of trademark law rather than subdividing the analysis on the basis of classifications of trademark subject matter (i.e., product packaging versus product configuration). In this regard, the opinion may be characterized as “Landellian.” See GILMORE, *supra* note 15, at 43 (“The Langdellians sought, with considerable success, to formulate theories which would cover broad areas of the common law and reduce an unruly diversity to a manageable unity.”). For a case that takes a completely opposite view, see *Amazing Spaces, Inc. v. Metro Mini Storage*, 608 F.3d 225 (5th Cir. 2010). In *Amazing Spaces*, the Fifth Circuit rejected using the *Abercrombie* rubric for non-word marks, and wholeheartedly embraced the *Wal-Mart* tripartite analysis. *Id.* at 240. Although the ultimate conclusions are not at odds with the analysis suggested in this Article, the reasoning employed is 180 degrees in the opposite direction.

consumer motivation. If so, like the Baroque design discussed below in *Wallace International Silversmiths, Inc. v. Godinger Silver Art Co.* and the children's clothing designs in *Wal-Mart*, the aesthetic functionality doctrine might, indeed, serve as a gatekeeper to prevent the suite design from receiving trade dress protection.¹¹⁶ But Judge Motz's recognition that there is no need to establish a rule isolating product designs for special treatment deserves serious consideration.¹¹⁷ The approach of Judge Motz and the Fourth Circuit in *Ashley Furniture* 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 of this Article explained that, by the time that the *Wal-Mart* dust had settled, trademark law was changed. Justice Scalia's opinion created new doctrine.¹¹⁸ 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.¹¹⁹ 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

¹¹⁶ See *Wallace Int'l Silversmiths, Inc., v. Godinger Silver Art Co.*, 916 F. 2d. 76, 81 (2d Cir. 1990); see also *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213 (2000); *infra* Part II. C. for further discussion.

¹¹⁷ *Ashley Furniture Indus., Inc.*, 187 F.3d at 371.

¹¹⁸ Clegg, *supra* note 11, at 287 ("[The Court] scaled back the protection of trade dress . . . [and] ruled that the unqualified protection of inherently distinctive trade dress applied only to product *packagingtrade* dress features, namely, the physical characteristics of the vehicle in which the product is sold."). But see Dinwoodie, *supra* note 4, at 702 ("The last thing that trademark law needs is more doctrine.") (footnote omitted); GILMORE, *supra* note 15, at 111 ("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.").

¹¹⁹ *Wal-Mart Stores, Inc.*, 529 U.S. at 212.

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acquired a secondary meaning.¹²⁰ 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.¹²¹ Professor Dinwoodie has also argued that applying a functionality analysis 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.”¹²² Relying on functionality provides an easier method of decision-making, and will strengthen the public domain better than the *Wal-Mart* tripartite analysis.¹²³

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.¹²⁴ The Restatement (Third) of Unfair Competition articulates the doctrine:

¹²⁰ *Id.*

¹²¹ Others have recognized the importance of functionality in modern trademark law. See, e.g., Dinwoodie, *supra* note 4, at 617–18 (“[T]rademark protection should depend upon whether the particular symbolic matter identifies the source of a product (i.e., whether the matter is ‘distinctive’), and upon whether protection of the 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.

¹²² *Id.* at 702.

¹²³ *Id.* at 703.

¹²⁴ See *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 169 (1995) (“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.’”) (quoting

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.¹²⁵

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

Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 850 n.10 (1982); W.T. Rogers Co. v. Keene, 778 F.2d 334, 339 (7th Cir. 1985) (“[A] functional feature is one which competitors would have to spend money not to copy but to design around.”); Fiji Water Co., LLC v. Fiji Mineral Water USA, LLC, 741 F. Supp. 2d 1165, 1172–73 (C.D. Cal. 2010) (defining functionality); *In re Morton-Norwich Products, Inc.* 671 F.2d 1332 (C.C.P.A. 1982) (finding the design of a bottle with a spray top to be an “arbitrary decoration—no more de jure functional than is the grille of an automobile with respect to its under-the-hood power plant”); *see also* Clegg, *supra* note 11, at 277 (explaining that functionality typically looks at whether a feature is utilitarian or affects the purpose, use, cost, or quality of the product); Samuel Oddi, *The Functions of “Functionality” in Trademark Law*, 22 HOUS. L.REV. 925 (1985) (“Judge Rich equated ‘functional’ (de jure) with ‘utilitarian’” and explained that “[u]tilitarian’ means ‘superior in function (de facto) or economy of manufacture,’ which ‘superiority’ is determined in the light of competitive necessity to copy.”); Pierce, *supra* note 55, at 181 (“[T]he 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) (footnote omitted) (“A functional product feature cannot be protected as a trademark.”); *Id.* at 282–83 (discussing Judge Rich’s opinion in *In re Morton-Norwich Products*); Wong, *supra* note 62, at 1117 (“[T]he courts have held that the ‘functional’ features on a product can never be protected under trade-dress law.”); *Id.* at 1119–20 (footnote omitted) (reviewing definitions of functionality); *Id.* at 1131 (footnote omitted) (“[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.’”). *See generally* MCCARTHY ON TRADEMARKS, *supra* note 4, §§ 7:67–7:78.

¹²⁵ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 (1995).

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perpetual monopoly inconsistent with the utility patent laws.”¹²⁶ In our intellectual property scheme, United States law recognizes that new, useful, and nonobvious inventions and discoveries must be protected by patent law.¹²⁷ Patent protection grants to a patentee a monopoly that lasts for twenty years from the date of filing a patent application.¹²⁸ That twenty-year period is a fixed duration unlike trademark or trade dress protection which may be renewed

¹²⁶ Kohler Co. v. Moen Inc., 12 F.3d 632, 648 (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, *supra* note 4, § 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*, *supra* note 62, at 1118 (“[T]he functionality bar prevents trade-dress law from permanently securing designs that are more properly guarded by transitory species of intellectual property [sic] law, such as patents or copyrights.”) (footnote omitted); *id.* at 1154 (“There are two apparent purposes for the functionality doctrine: (1) to prevent the perpetual monopolization of valuable product features, and (2) to partition the law of intellectual property between trademark and other forms of protection (e.g., copyright and patent).”) (footnote omitted); *Dinwoodie*, *supra* note 4, at 712 (“For fifty years, both the avoidance of anti-competitive effect and mediating any dispute with patent law have been invoked by courts and scholars as the reason for the doctrine.”) (footnote omitted); *id.* at 713–14 (“Preserving the integrity of the patent system is thus logically a pivotal part of a competition-based functionality concept, and recognition also that the doctrine seeks to protect the climate of competition, not the interests of particular competitors.”) (footnotes omitted); *Thurmon*, *supra* note 124, at 253–82 (chronicling the historical origins and pre-modern history of the functionality doctrine in United States trademark law).

¹²⁷ 35 U.S.C. §§ 101–03 (2006); *Sabnis*, *supra* note 96, at 189.

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.

Id. (footnotes omitted).

¹²⁸ 35 U.S.C. § 154(a)(2) (2006).

ad infinitum for successive ten-year periods.¹²⁹ 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 is the functional equivalent of it.¹³⁰ 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.¹³¹ 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.¹³²

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.¹³³ 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

¹²⁹ Compare *id.*, with 15 U.S.C. §§ 1058–59 (2006).

¹³⁰ 35 U.S.C. § 154(a)(1); *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950) (articulating and explaining the doctrine of equivalents).

¹³¹ 15 U.S.C. §§ 1114(1), 1125(c) (2006).

¹³² 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.

Id.; see MCCARTHY ON TRADEMARKS, *supra* note 4, § 2.05[1].

¹³³ See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995) (“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.”).

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use of the feature would put competitors at a significant non-reputation-related disadvantage.¹³⁴

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.¹³⁵ Two foundational cases that illustrate the doctrine of aesthetic functionality are *Pagliero v. Wallace China Co.*¹³⁶ and *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co.*¹³⁷ In *Pagliero*, the defendant had copied several of Wallace's china patterns and sold the copied designs on hotel dinnerware.¹³⁸ 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

¹³⁴ *Id.* at 165 (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982)).

¹³⁵ See *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76, 81 (2d Cir. 1990) (“[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.”); see also MCCARTHY ON TRADEMARKS, *supra* note 4, §§ 7:79–7:83 (describing the aesthetic functionality doctrine sections); Sabnis, *supra* note 96, at 189 (“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); Oddi, *supra* note 124, at 930 (citing RESTATEMENT OF TORTS § 741 (1938)); Thurmon, *supra* note 124, at 303–08 (discussing aesthetic functionality).

¹³⁶ 198 F.2d 339 (9th Cir. 1952). See discussions of this case in MCCARTHY ON TRADEMARKS, *supra* note 4, § 7:79; Wong, *supra* note 62, at 1132–33; Dinwoodie, *supra* note 4, at 690–94.

¹³⁷ 916 F.2d 76 (2d Cir. 1990). See discussion of this case in MCCARTHY ON TRADEMARKS, *supra* note 4, § 7:80.

¹³⁸ *Pagliero*, 198 F.2d at 340.

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.¹³⁹

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 [sic] 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.¹⁴⁰

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”).¹⁴¹ Thus, the court ruled that the design was “a

¹³⁹ *Id.* at 343–44 (footnote omitted).

¹⁴⁰ *Id.* at 343 (footnote omitted).

¹⁴¹ *Id.* at 344 (“It seems clear that these designs are not merely indicia of source, os [sic] 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.”); *see also* Wong, *supra* note 62, at 1139 (“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.”).

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functional feature of the china”¹⁴² One commentator has broadly interpreted 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).”¹⁴³

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, however, was much less expensive.¹⁴⁴ In the lower court, Judge Haight 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.¹⁴⁵ To be sure, in order for a twentieth 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 lower court explained: “The ‘Baroque’ curls, roots and flowers are not ‘mere indicia of source.’ Instead, they are requirements to compete in the silverware market.”¹⁴⁶ Indeed, 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.”¹⁴⁷ 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

¹⁴² *Pagliero*, 198 F.2d at 344; see *Aurora World, Inc. v. Ty Inc.*, 719 F. Supp. 2d 1115, 1148 (C.D. Cal. 2009) (citing and quoting *Pagliero*); Harold R. Weinberg, *Trademark Law, Functional Design Features, and the Trouble with Traffix*, 9 J. INTELL. PROP. L. 1, 16 (2001).

¹⁴³ Wong, *supra* note 62, at 1133.

¹⁴⁴ 916 F.2d. 76, 78–79 (2d Cir. 1990).

¹⁴⁵ *Id.* at 78 (citing *Pagliero*, 198 F.2d at 344).

¹⁴⁶ *Id.*

¹⁴⁷ *Id.* at 80.

functionality doctrine denies such protection.”¹⁴⁸ 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.¹⁴⁹

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 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.¹⁵⁰

¹⁴⁸ *Id.* at 81 (citing THIRD RESTATEMENT OF THE LAW, UNFAIR COMPETITION (Preliminary Draft No. 3), Ch. 3, § 17(c) at 213–14.).

¹⁴⁹ Oddi, *supra* note 124, at 961.

¹⁵⁰ *Aurora World, Inc. v. Ty Inc.*, 719 F. Supp. 2d 1115, 1149 (C.D. Cal. 2009).

D. *Traffix Issues*

In *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 somewhat alter the technical definitions of those concepts.¹⁵¹ 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 *Traffix*. The *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.¹⁵² In explaining the applicable law regarding functionality, the Court noted that "a functional feature is one the 'exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.'"¹⁵³ Referencing the decisions in both *Qualitex* and *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*,¹⁵⁴ 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-

¹⁵¹ See *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 24 (2001) (holding 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); Thurmon, *supra* note 124, at 250; Weinberg, *supra* note 142, at 3 (criticizing the *Traffix* Court's treatment of "functionality").

¹⁵² *Traffix Devices Inc.*, 532 U.S. at 29 ("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 also MCCARTHY ON TRADEMARKS, *supra* note 4, § 7:89.

¹⁵³ *Traffix Devices Inc.*, 532 U.S. at 32.

¹⁵⁴ *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844 (1982).

reputation-related disadvantage' in cases of esthetic functionality, the question involved in *Qualitex*.¹⁵⁵

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.¹⁵⁶ However, whether courts will embrace, or already have embraced, this distinction remains open to question.¹⁵⁷ Some recent cases suggest that courts have not adopted *Traffix* as a total departure from prior definitions of "functionality," and that the initial worries of a rewriting of the law of functionality have not been realized. For example, the Court of Appeals of Texas recently stated:

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

¹⁵⁵ *Traffix Devices Inc.*, 532 U.S. at 33.

¹⁵⁶ Thurmon, *supra* note 124, at 326 ("The Supreme Court granted certiorari in *Traffix* to resolve a relatively minor question concerning the relevance of an expired utility patent and ended up rewriting the entire law of functionality. Gone is the uniform use of competitive need functionality standard. Gone is the consistent treatment of all functionality questions, whether aesthetic or utilitarian. In their place are inconsistent and largely incomprehensible standards and distinctions.").

¹⁵⁷ See MCCARTHY ON TRADEMARKS, *supra* note 4, § 7:80 (commenting on *Traffix*, Professor McCarthy remarks: "Justice Kennedy further muddied the waters of the aesthetic functionality theory" and that "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.") (footnotes omitted); see also Thurmon, *supra* note 124, at 360 (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, *supra* note 11, at 295–302 (discussing the potential changes to the definition of "functionality" that *Traffix* may have brought about); Weinberg, *supra* note 142, at 6 ("*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.").

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competitors at a significant non-reputation-related disadvantage.¹⁵⁸

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.’”¹⁵⁹ 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.¹⁶⁰ The Ninth Circuit has also interpreted *Traffix* as permitting an inquiry into competition in cases involving aesthetic functionality.¹⁶¹

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

¹⁵⁸ *Astoria Indus. of Iowa, Inc. v. Brand FX Body Co.*, 2010 WL 1433404, at *3 (Tex. App. 2010) (footnotes omitted).

¹⁵⁹ *Astoria Indus. of Iowa, Inc.*, 2010 WL 1433404, at n.16 (“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.”).

¹⁶⁰ *Atlas Equip. Co., LLC v. Weir Supply Grp., Inc.*, C07-1358Z, 2009 WL 4670154, at n.11 (W.D. Wash. 2009).

¹⁶¹ *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1071–72 (9th Cir. 2006). A California District Court followed this reasoning in *Aurora World, Inc. v. Ty Inc.*, 719 F. Supp. 2d 1115, 1148 (C.D. Cal. 2009)).

mark becomes the generic term to describe an article, for example, trademark protection ceases.¹⁶²

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.”¹⁶³ 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.”¹⁶⁴

As trademark law concepts, functionality and genericity 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.¹⁶⁵ 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 must have the freedom to use the functional elements of a product.¹⁶⁶ In one sense, these concepts blur into one as trademark laws typically attempt to keep “functional product characteristics” free for the public to use.¹⁶⁷ For example, the word “apple,” if used in association with the fruit, would certainly be seen as a generic term and be ineligible for trademark protection.¹⁶⁸ Additionally, the word “apple,” due to its generic meaning, serves a descriptive purpose in identifying the characteristics of a specific

¹⁶² *Wallace Int’l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76, 81 (2d Cir. 1990) (citations omitted); see *Pierce*, *supra* note 55, at 183–87 (explaining the strong similarity between the concept of genericity and functionality, citing illustrative cases and scholarship).

¹⁶³ *Wallace Int’l Silversmiths, Inc.*, 916 F.2d at 81.

¹⁶⁴ *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 647 (7th Cir. 1993) (Cudahy, J., Dissenting).

¹⁶⁵ Carol A. Melton, *Generic Term or Trademark? Confusing Legal Standards and Inadequate Protection*, 29 Am. U. L. Rev. 109, 110 (1979).

¹⁶⁶ *Traffix Devices Inc.*, 532 U.S. at 29.

¹⁶⁷ Martin Senftleben, *Study on Misappropriation of Signs*, COMMITTEE ON DEVELOPMENT AND INTELLECTUAL PROPERTY (Mar. 14, 2012), available at http://www.wipo.int/edocs/mdocs/mdocs/en/cdip_9/cdip_9_inf_5.pdf.

¹⁶⁸ Uche U. Ewelukwa, *Comparative Trademark Law: Fair Use Defense in the United States and Europe—The Changing Landscape of Trademark Law*, 13 WIDENER L. REV. 97, 103 (2007).

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type of fruit.¹⁶⁹ But when removed from that context and used in conjunction with computer products, the word “apple” becomes arbitrary.¹⁷⁰ Arbitrary marks are protected, as they do not preclude competitors from being able to use the generic or functional terms to describe the product.¹⁷¹ Potential trademark protection also extends to symbols.¹⁷² However, like words, these symbols can be deemed generic.¹⁷³ A graphic representation of an apple could be considered generic when used in conjunction with fruit sales.¹⁷⁴ The same apple shape could be considered descriptive if used in association with apple-flavored yogurt.¹⁷⁵ And, again, as was the case with the word “apple,” the shape of an apple would be arbitrary when used in conjunction with computer products and

¹⁶⁹ *Id.* at 103.

¹⁷⁰ *Id.* at 104–05.

¹⁷¹ *Id.* at 105.

¹⁷² MCCARTHY ON TRADEMARKS, *supra* note 4, § 11:16.50

¹⁷³ *Id.* §§ 7:36–7:37 (Professor McCarthy explains that a picture of a product may be considered “generic.”)

¹⁷⁴ *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, *supra* note 4, § 11:16.50 (“In the same way that pictorial nonword [sic] 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); MCCARTHY ON TRADEMARKS, *supra* note 4, § 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 . . . 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* Oddi, *supra* note 124, at 935. (this understanding comports with the historical origins of language and writing. Ancient Egyptian hieroglyphs included what Egyptologists refer to as “ideograms.” Simply stated, ideograms are one type of Egyptian hieroglyph that meant what the object represented); *see also* Paul Douglas Callister, *Law’s Box: Law, Jurisprudence and the Information Ecosphere*, 74 UMKC L. REV. 263, 296 (2005) (explaining that ancient Egyptians used hieroglyphics as ideograms to represent specific ideas); *see infra* note 284 and accompanying text.

¹⁷⁵ Ewelukwa, *supra* note 131, at 103.

thus eligible for protection within that industry.¹⁷⁶ The functions of the term “apple” and an apple shape differ between industries.¹⁷⁷ While the functions are generic and ineligible for protection within fruit sales, they can be protected within computer sales as they distinguish a source of origin.¹⁷⁸

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.¹⁷⁹ 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.¹⁸⁰ 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.¹⁸¹ Similarly, in *Wal-Mart*, the children’s clothing motifs that Justice Scalia characterized as “product design” were aesthetically functional, because a principal factor motivating

¹⁷⁶ *Id.*

¹⁷⁷ David W. Barnes, *One Trademark Per Source*, 18 TEX. INTELL. PROP. L.J. 1, 15 (2009) (“An apple orchard may put the word “apple” on its products despite Apple Inc.’s trademark rights for use of APPLE as a source-indicator for computers and computer programs.”).

¹⁷⁸ *Id.* at 15; see also *Apple Trademark List*, APPLE (Mar. 7, 2013), <http://www.apple.com/legal/trademark/appendmlist.html>.

¹⁷⁹ See *supra* Part I.E. (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).

¹⁸⁰ See Bartow, *supra* note 60, at 272.

¹⁸¹ See *id.* at 268 (“And there can be no trademark protection when a color has a function, which it always will when it is a product feature.”); *Id.* at 272–74 (explaining the high likelihood that colors will be functional in nearly all contexts); MCCARTHY ON TRADEMARKS, *supra* note 4, § 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).

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consumer purchases was the desire to buy clothing that bore attractive, playful artwork.¹⁸² 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 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.¹⁸³

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 International, 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

¹⁸² See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213 (2000) (“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.”).

¹⁸³ *Aurora World, Inc. v. Ty Inc.*, 719 F. Supp. 2d 1115, 1149 (C.D. Cal. 2009) (citation omitted).

which competitors, in the absence of secondary meaning, are free to copy.¹⁸⁴

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.’”¹⁸⁵

In a similar manner, rather than needing to characterize the clothing motifs at issue in *Wal-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 protectable at all.¹⁸⁶ 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.¹⁸⁷ Secondary meaning is irrelevant *vis-à-vis* functionality.¹⁸⁸ Thus, recognizing the Samara Brothers’ designs

¹⁸⁴ *Predator Int’l, Inc. v. Gamo Outdoor USA, Inc.*, 669 F. Supp. 2d 1235, 1249 (D. Colo. 2009).

¹⁸⁵ *E & J Gallo v. Proximo Spirits, Inc.*, 2012 WL 273076, at 12 (E.D. Cal. 2012) (citation omitted).

¹⁸⁶ *See Wallace Int’l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76, 81 (2d Cir. 1990) (holding “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”).

¹⁸⁷ *See id.* at 80 (“the commercial success of an aesthetic feature automatically destroys all of the originator’s trademark interest in it, notwithstanding the feature’s secondary meaning”).

¹⁸⁸ *See* 15 U.S.C. § 1125(a)(3) (2006) (“In a civil action for trade dress infringement . . . the person who asserts trade dress protection has the burden of proving that the matter

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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.¹⁸⁹ 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.¹⁹⁰ Consequently, in the absence of a design patent,¹⁹¹ 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.¹⁹² As 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.”¹⁹³ This is the same principle that allowed Godinger to manufacture Baroque tableware.¹⁹⁴ 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.¹⁹⁵

sought to be protected is not functional.”); MCCARTHY ON TRADEMARKS, *supra* note 4, § 7:63 (“For functional items, no amount of evidence of secondary meaning . . . will create a right to exclude.”) (footnote omitted).

¹⁸⁹ *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 213 (2000).

¹⁹⁰ *See Wallace Int'l Silversmiths, Inc.*, 916 F.2d at 80–81.

¹⁹¹ *See* 35 U.S.C. § 171 (2006) (“Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor”); MCCARTHY ON TRADEMARKS, *supra* note 4, § 7:90 (“Nature of a design patent”).

¹⁹² *See infra* Part III. C.

¹⁹³ 719 F. Supp. 2d 1115, 1149 (C.D. Cal. 2009).

¹⁹⁴ *See supra* text accompanying notes 107–12.

¹⁹⁵ *See* Dinwoodie, *supra* note 4, at 704.

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.¹⁹⁶ The Court emphasized that the appellate court had reached the same conclusion.¹⁹⁷ When considered in light of the doctrine of aesthetic functionality, it is entirely possible that that factual determination was ill-advised or, perhaps, just plain wrong.¹⁹⁸ 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

The conceptual role for the functionality doctrine is not to cut a broad swathe through trade dress protection but rather to facilitate the 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.

Id. (footnote omitted).

¹⁹⁶ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 766 (1992) ("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 . . ."). 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, *supra* note 4, § 7:71 (footnote omitted).

¹⁹⁷ *Two Pesos, Inc.*, 505 U.S. at 770 ("Both courts thus ruled that Taco Cabana's trade dress was not descriptive but rather inherently distinctive, and that it was not functional.").

¹⁹⁸ See Thurmon, *supra* note 124, at 293–94 (discussing *Two Pesos* and *Qualitex*, emphasizing their affect on the doctrine of functionality); Sabnis, *supra* note 96, at 190–92 (discussing *Two Pesos* and *Qualitex*).

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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.”¹⁹⁹

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”²⁰⁰ 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.²⁰¹ Congress forged that requirement as part of the Lanham Act.²⁰² 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.²⁰³ Without empirical data as support, the *Wal-Mart* Court unilaterally assumed that colors and product designs do not automatically communicate source to potential consumers.²⁰⁴ In truth, word marks and product packaging do not necessarily communicate source to potential buyers either. The *Abercrombie* analysis

¹⁹⁹ *Two Pesos, Inc.*, 505 U.S. at 765 (citation omitted).

²⁰⁰ *Id.*

²⁰¹ See *In re Oppendahl & Larson LLP*, 373 F.3d 1171, 1173 (2004) (“Descriptive marks can qualify for registration on the Principal Register if they acquire secondary meaning.”).

²⁰² 15 U.S.C. § 1052 (2006).

²⁰³ *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 212, 214–15 (2000).

²⁰⁴ *Id.* at 212.

teaches that we can only determine whether word marks and product packaging may operate as valid trademarks or trade dress *after we have first analyzed them contextually*.²⁰⁵ In order to analyze them contextually, a fact-finder 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 fact-finder 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 dress under any circumstances.²⁰⁶ 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 *Abercrombie* analysis, coupled with utilitarian functionality and aesthetic functionality—rather than applying *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.²⁰⁷ The core of the functionality doctrine has been described in many ways such as

²⁰⁵ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 22 (2d Cir. 1976) (finding the “defendant’s use of ‘Safari’ with respect to boots was made in the context of hunting and traveling expeditions and not as an attempt to garner A&F’s good will”).

²⁰⁶ See Bartow, *supra* note 60, at 264 (“Colors always add aesthetic value, and often communicate messages unrelated to commercial source.”).

²⁰⁷ See e.g., Clegg, *supra* note 11; Dinwoodie, *supra* note 4; Oddi, *supra* note 124; Pierce, *supra* note 55; Thurmon, *supra* note 124; Weinberg, *supra* note 142; Wong, *supra* note 62; see also Dinwoodie, *supra* note 4, at 685 n.278 (citing numerous articles).

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“whether the feature is ‘superior or optimal,’ ‘essential to the use or purpose of the article,’ or ‘an important ingredient in the product’s success’”²⁰⁸ 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 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.²⁰⁹ 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 (e.g., the Baroque-style in *Wallace v. Godinger*) or elements that communicate a general idea or concept (e.g., the children’s clothing motifs and even Justice Scalia’s hypothetical penguin-shaped cocktail shaker in *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.²¹⁰

Fortunately, lawyers and judges schooled in intellectual property are familiar with 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.²¹¹ 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.²¹² In simple terms, this is the functionality doctrine at

²⁰⁸ Dinwoodie, *supra* note 4, at 686.

²⁰⁹ See *supra* text accompanying notes 87–88.

²¹⁰ See *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 213 (2000); *Wallace Int’l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76, 81 (2d Cir. 1990).

²¹¹ Wong, *supra* note 62, at 1160–61.

²¹² 17 U.S.C. § 101 (2006) (definition of “[p]ictorial, graphic, and sculptural works”).

work in copyright law. One commentator has explained this obvious connection clearly:

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.²¹³

The Copyright Act expressly states this principle of conceptual separability,²¹⁴ and the judiciary, in several famous cases such as *Mazer v. Stein*,²¹⁵ *Carol Barnhart Inc. v. Economy Cover Corp.*,²¹⁶ and *Brandir International, Inc. v. Cascade Pacific Lumber Co.*,²¹⁷ 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,²¹⁸ and well-known cases, such as *Baker v. Selden*,²¹⁹ Judge Learned Hand’s classic opinion in *Nichols v. Universal Pictures Corp.*²²⁰ and *Herbert Rosenthal Jewelry Corp. v. Kalpakian*²²¹ have explained the doctrine and its application.

²¹³ Wong, *supra* note 62, at 1160–61 (footnotes omitted).

²¹⁴ 17 U.S.C. § 101 (2006) (provides a definition of “[p]ictorial, graphic, and sculptural works”).

²¹⁵ 347 U.S. 201, 218 (1954).

²¹⁶ 773 F.2d 411, 419 (2d Cir. 1985).

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

²¹⁸ 17 U.S.C. § 102 (b) (2006).

²¹⁹ 101 U.S. 99, 105–06 (1880).

²²⁰ 45 F.2d 119, 121 (2d Cir. 1930).

²²¹ 446 F.2d 738, 742 (9th Cir. 1971).

B. Conceptual Separability Analysis

The Copyright Act expressly protects “[p]ictorial, graphic, and sculptural works” as a distinct category of “works of authorship,” and, therefore, protectable, copyrightable subject matter.²²² The Act defines “[p]ictorial, 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.*²²³

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*.²²⁴ *Mazer* involved statuettes of dancers that were being used as a lamp bases.²²⁵ The principal issue in the case was

²²² 17 U.S.C. § 102 (a)(5).

²²³ 17 U.S.C. § 101 (2006) (emphasis added).

²²⁴ 347 U.S. 201, 218 (1954).

²²⁵ *Id.* at 203.

whether the product's design—its human-dancer-shape—was protected by copyright law.²²⁶ 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.²²⁷

The defendant argued that, because the statuettes served as a lamp bases, they were functional.²²⁸ The United States Supreme Court recognized the need to separate the artistic elements of the shape from the functional elements.²²⁹ 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 lampshade were not protectable by copyright because they were utilitarian.²³⁰ Citing the Copyright Office Regulations in force at the time,²³¹ the Court remarked that "artistic articles are protected in 'form but not their mechanical or utilitarian aspects.'"²³²

Carol Barnhart Inc. v. Econ. Cover Corp. involved mannequins.²³³ This case is especially interesting and potentially instructive in terms of trademark analysis because the issues actually relate to both utilitarian and aesthetic functionality.²³⁴ 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 buttoned

²²⁶ *Id.* at 205.

²²⁷ *Id.* at 202.

²²⁸ *Id.* at 215–16.

²²⁹ *Id.* at 218.

²³⁰ *Id.*

²³¹ Copyright Office Registration of Claims to Copyright, 37 C.F.R. § 202.10 (1959), the language of which now appears in the current definition of "pictorial, graphic, and sculptural works" at 17 U.S.C. § 101 (2006).

²³² *Mazer*, 347 U.S. at 218.

²³³ *Carol Bernhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 412 (2d Cir. 1985).

²³⁴ *Id.* at 414.

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women's blouse).²³⁵ The Second Circuit addressed the question of whether these mannequin shapes were copyrightable.²³⁶ The district judge 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."²³⁷ The Second Circuit affirmed.²³⁸ 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."²³⁹ 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 *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

²³⁵ *Id.* at 412.

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.

Id.

²³⁶ *Id.*

²³⁷ *Id.*; see also *id.* at 414 ("[Th]e 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.").

²³⁸ *Id.* at 419.

²³⁹ *Id.* at 414.

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, 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.²⁴⁰

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.'"²⁴¹ The court, thus, concluded: "[a]pplying 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."²⁴²

²⁴⁰ *Id.* at 417 n.3 (quoting H.R. REP. No. 1476, at 55 (1976)).

²⁴¹ *Id.* at 418 (citing H.R. REP. No. 1476, at 55 (1976)).

²⁴² *Id.*

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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 form . . . the features claimed to be aesthetic or artistic, *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 the chest and some width of shoulders.²⁴³

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 *Brandir International, 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."²⁴⁴

Brandir International, Inc. involved the copyrightability of a ribbon-shaped bicycle rack, specifically, "a bicycle rack made of bent tubing that is said to have originated from a wire

²⁴³ *Id.* at 419.

²⁴⁴ *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987).

sculpture.”²⁴⁵ 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.²⁴⁶ Judge Oakes quoted with approval Professor Robert Denicola’s now-famous article: “Professor Denicola points out that although the Copyright Act of 1976 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.’”²⁴⁷ 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.²⁴⁸

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.”²⁴⁹ Interestingly, the Second Circuit recently cited both *Traffix* and *Brandir* in virtually the same breath in analyzing the issues of trade dress protection and functionality for a watch design.²⁵⁰

²⁴⁵ *Id.* at 1143, 1147–48.

²⁴⁶ *Id.* at 1147–48.

²⁴⁷ *Id.* at 1145 (quoting Robert Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 741 (1983)).

²⁴⁸ *Id.*

²⁴⁹ *Id.* at 1146–47. See Weinberg, *supra* note 142, at 49–51 (discussing *Brandir Int’l, Inc.*, 834 F.2d 1142).

²⁵⁰ *Cartier, Inc. v. Sardell Jewelry, Inc.*, 294 Fed.Appx. 615, 620 (2d Cir. 2008).

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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 Newman, dissenting in *Carol Barnhart*, noted a slight distinction,²⁵¹ and Judge Oakes in *Brandir* mentioned this distinction as well.²⁵² 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, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”²⁵³ The classic, chestnut case that established this principle is *Baker v. Selden*.²⁵⁴ 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.”²⁵⁵ 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

²⁵¹ *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 420 n.1 (2d Cir. 1985)

²⁵² *Brandir International, Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1148 (2d Cir. 1987).

²⁵³ 17 U.S.C.S. § 102 (2006).

²⁵⁴ *Baker v. Selden*, 101 U.S. 99 (1880).

²⁵⁵ *Id.* at 100.

explained?”²⁵⁶ 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.”²⁵⁷ 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 Pictures Corporation*.²⁵⁸ 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.”²⁵⁹ 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

²⁵⁶ *Id.* at 101.

²⁵⁷ *Id.* at 104.

²⁵⁸ 45 F.2d 119 (2d Cir. 1930).

²⁵⁹ *Id.* at 120.

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never extended. Nobody has ever been able to fix that boundary, and nobody ever can.²⁶⁰

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.²⁶¹

²⁶⁰ *Id.* at 121 (citation omitted). This has come to be known as Judge Hand's "abstractions test." See, e.g., CCC Info. Servs. v. MacLean Hunter Mkt. Reports, 44 F.3d 61 (2d Cir. 1994).

²⁶¹ 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.

Id. (citations omitted).

*Herbert Rosenthal Jewelry Corp. v. Kalpakian*²⁶² 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.²⁶³ 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.'"²⁶⁴ In sum, the court reasoned that "[a] jeweled bee pin is therefore an 'idea' that defendants were free to copy."²⁶⁵ What is especially significant, is that the court recognized that the artistic elements that were necessary to communicate "bee-ness" (i.e., the *idea* of a bee) were not protectable within the scope of copyright law.²⁶⁶ 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.²⁶⁷ 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.²⁶⁸ 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.²⁶⁹ According to the court, "[t]here is no greater similarity between the pins of

²⁶² *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971).

²⁶³ *See id.* at 739.

²⁶⁴ *Id.* at 741.

²⁶⁵ *Id.* at 742.

²⁶⁶ *See id.* at 741.

²⁶⁷ *See Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76, 80–81 (2d Cir. 1990).

²⁶⁸ *See Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741 (9th Cir. 1971).

²⁶⁹ *Id.*

plaintiff and defendants than is inevitable from the use of jewel-encrusted bee forms in both.”²⁷⁰

CONCLUSION

Justice Scalia’s opinion in *Wal-Mart* fashioned new law.²⁷¹ In order for a product design to serve as protectable trade dress or as a trademark, that design must first acquire a secondary meaning.²⁷² 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.²⁷³ 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.”²⁷⁴ Features that “render the product itself more useful and appealing”²⁷⁵ are, by definition, either functional in a utilitarian sense or aesthetically functional.²⁷⁶ 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 seeks protection) communicate source-identification or whether they perform a utilitarian objective or communicate a style, genre, or idea. If those elements perform a

²⁷⁰ *Id.* at 742; see Oddi, *supra* note 124, at 955–56 (discussing several cases denying trademark protection for jewelry designs based on aesthetic functionality).

²⁷¹ See generally *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000).

²⁷² See *id.* at 214.

²⁷³ See *id.* at 213.

²⁷⁴ *Id.*

²⁷⁵ *Id.*

²⁷⁶ See *id.*

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.²⁷⁷ Secondary meaning is irrelevant when a putative mark is generic or functional.²⁷⁸ It is only relevant when a putative mark is descriptive.²⁷⁹ 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.

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

²⁷⁷ 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, *supra* note 4, at 652–53 (noting that "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.")

²⁷⁸ See *supra* note 136 and accompanying text.

²⁷⁹ See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212 (2000).

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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.²⁸⁰

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).”²⁸¹ 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 § 43(a) but not for other distinctive words, *symbols*,

²⁸⁰ Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960).

²⁸¹ Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 770 (1992).

*or devices capable of identifying a producer's product.*²⁸²

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.”²⁸³ 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.²⁸⁴ 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.

²⁸² *Id.* at 774 (emphasis added).

²⁸³ JEROME HALL, *Foundations of Jurisprudence* 135 (1973).

²⁸⁴ See SIR ALAN GARDINER, *EGYPT OF THE PHARAOHS* 19–26 (1961); *supra* note 128 regarding the Ancient Egyptian use of “ideograms.”