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Toward a More Coherent Doctrine of Trademark Genericism and Functionality: Focusing on Fair Competition

Sandra L. Rierson

Thomas Jefferson School of Law, srierson@tjssl.edu

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Cover Page Footnote

Associate Professor of Law, Thomas Jefferson School of Law. This Article has benefited from the helpful feedback and critique of Michael Handler, Laura Heymann, Mark Lemley, Shaun Martin, Lisa Ramsey, Brenda Simon, and Harold R. Weinberg, for which I am very grateful. I also received helpful comments and insights from the participants in the 2016 ABA-IPL Scholarship Symposium. I am also indebted to Farhana Akhther and Warren McCann for their invaluable research assistance, and to Thomas Jefferson School of Law for its generous support.

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Sandra L. Rierson*

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INTRODUCTION

The doctrines of trademark genericism and functionality serve similar functions under the Lanham Act and the common law of unfair competition. Genericism, in the context of word marks, and functionality, for trade dress, bar trademark registration under the Lanham Act and, both under the Act and at common law, render a trademark unprotectable and invalid. In the word mark context, genericism stands for the proposition that certain parts of vocabulary cannot be cordoned off as trademarks; all competitors must be able to use words that consumers understand to identify the goods or services that they are selling.¹ Functionality likewise demands that certain aspects of product design cannot be legally protected as trade dress, as to do so would potentially limit competitors' ability to make products that work as well at the same price. The core concern, for both doctrines, is or should be the preservation of free and fair market competition.

Part I of this Article explains the theoretical parallels between the doctrines of genericism and functionality, and examines the history and purpose of these doctrines. A finding that a word is or has become generic, or that a form of trade dress is functional, negates a mark's registration and protection under the Lanham Act, as well as under state and common law. Even incontestable marks can be declared invalid, regardless of the passage of time, under either doctrine. The types of trademarks typically at issue when making genericism and functionality determinations—word marks that are, at best, descriptive, or product design functioning as trade dress—are correctly described as weak. The genericism and functionality doctrines therefore play a critical role in marking the boundaries of trademark law. To properly draw those lines, deci-

¹ The focus of this definition is on the availability of the words to competitors, not the public at large, because a different trademark doctrine aims to insulate all public, non-commercial uses of words (even those that are arbitrary or fanciful marks) from trademark protection: fair use. *See, e.g.*, *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 121–23 (2004) (holding that, while descriptive fair use is not defeated by a showing of likelihood of confusion, the degree of confusion may be pertinent to whether defendant's use of the plaintiff's mark is fair); *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt. Inc.*, 618 F.3d 1025, 1041–43 (9th Cir. 2010) (defining and applying descriptive fair use doctrine); *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1175–83 (9th Cir. 2010) (applying test for nominative fair use).

sion makers need to correctly define and understand the theory underlying both doctrines.

In Part II, this Article argues that both genericism and functionality, in their practical interpretation and purpose, should more clearly reflect the core principle of protecting fair competition. In particular, the concept of viable, competitive alternatives—either in the form of words or alternative designs—should play an enhanced role in determining whether an erstwhile trademark is generic or functional. The various tests for genericism and functionality currently employed by the courts often attempt to draw formalistic distinctions among categories of words or product features that may confound business owners (and their lawyers) and divert the focus of the courts' inquiry in such cases away from the core value at the heart of both doctrines: preserving fair competition.

I. THE ORIGIN AND EVOLUTION OF THE GENERICISM AND FUNCTIONALITY DOCTRINES

As noted above, both trademark genericism and functionality originated as doctrines under the common law and now act as bars to registration and trademark protection under the Lanham Act.² They share similar roots: As the common law of unfair competition expanded to protect source identifiers outside the scope of a technical trademark (i.e., an inherently distinctive word mark), courts developed concomitant limitations to curb the potential for overly expansive protections that would hinder competition.³ Courts were also concerned that protecting certain types of word marks and trade dress under the auspices of trademark law could effectively evade constitutionally mandated limits on the patent monopoly.⁴ The genericism and functionality doctrines reflect these developments and concerns. When Congress passed the Lanham Act in 1946, the doctrines took on additional significance, as the benefits of federal registration expanded exponentially.⁵ Flexible common

² See *infra* Sections I.A–I.B.

³ See *infra* notes 26–31, 69 and accompanying text.

⁴ See *infra* notes 27–28, 70 and accompanying text.

⁵ Lanham Act, Pub. L. No. 79-489, 60 Stat. 427 (1946) (amended 1988).

law rules have been supplanted by more rigid tests for genericism and functionality that have created uncertainty and confusion for courts and litigants alike.

A. The Common-Law Roots and Modern Evolution of the Genericism Doctrine

The trademark law prohibition on the protection of generic words or phrases originated, like most aspects of trademark law, in the common law of unfair competition.⁶ However, the judicial need to draw a bright line between descriptive words or phrases and generic ones did not. Two main aspects of the Lanham Act of 1946 changed the scope and significance of genericism analysis: (1) the Lanham Act allowed trademark registration and protection of descriptive, but not generic, words or terms that had acquired secondary meaning; and (2) it increased the value of federal trademark registration by extending nationwide priority in a mark to the registrant.⁷ Both changes significantly increased the potential impact of a finding that a putative trademark was, or had become, generic. Even as the genericism doctrine has evolved to become a critical aspect of trademark law, courts have struggled to formulate a workable definition of the doctrine.

1. Common-Law Treatment of Generic and Descriptive Words

Under the common law, particularly prior to the enactment of the Lanham Act in 1946, most courts treated descriptive and generic terms in a similar fashion: neither was protectable as a technical trademark,⁸ but both were entitled to protection against passing off, if they had acquired distinctiveness (i.e., they had evolved in the

⁶ See Deven R. Desai & Sandra L. Rierson, *Confronting the Genericism Conundrum*, 28 CARDOZO L. REV. 1789, 1811–20 (2007) (examining and explaining the common-law roots of the genericism and genericide doctrines).

⁷ See *infra* notes 32–34 and accompanying text.

⁸ RESTATEMENT (FIRST) OF TORTS § 721 (AM. LAW INST. 1938) (“A designation cannot be a trade-mark for goods if it is likely to be regarded by prospective purchasers as a common name or generic name for such goods or as descriptive of them or of their ingredients, quality, properties, functions or uses.”); see also *id.* § 715(c) (noting that a trademark cannot be “a common or generic name for the goods or a picture of them . . . or a designation descriptive of the goods or of their quality, ingredients, properties or functions”).

minds of consumers into source-identifying marks).⁹ Therefore, a court's determination that a word or term was generic versus descriptive, or descriptive versus generic, was not highly consequential. In fact, some early common-law sources classified descriptive words as a subset of generic terms.¹⁰ If a business owner could prove that either a descriptive or generic term had acquired distinctiveness, and therefore was acting as a source identifier, it would be considered a "trade name" and hence protected against passing off.¹¹ If the word or term was inherently distinctive, it would be en-

⁹ Several courts have held that generic or descriptive names may be protected against unfair competition if they have acquired secondary meaning. *See, e.g.*, *Bell v. Davidson*, 597 P.2d 753, 755 (Okla. 1979); *Staple Cotton Coop. Ass'n v. Fed. Staple Cotton Co-Op Ass'n*, 162 So.2d 867, 869-70 (Miss. 1964); *Storm v. Canyon Amusement Corp.*, 79 N.W.2d 698, 700 (S.D. 1956); *Golden Slipper Square Club v. Golden Slipper Rest. & Catering*, 88 A.2d 734, 736 (Pa. 1952); *Farrell v. Mennen Co.*, 235 P.2d 128, 130 (Utah 1951); *Bernstein v. Friedman*, 160 P.2d 227, 229 (Wyo. 1945); *Jenney Mfg. Co. v. Leader Filling Stations Corp.*, 196 N.E. 852, 854 (Mass. 1935).

For examples of cases discussing secondary meaning, see *Electric Supply Co. v. Hess*, 245 P. 27, 28 (Wash. 1926), which notes that secondary meaning doctrine applies to "common, descriptive [and] generic words," and *Saunders System Atlanta Co. v. Drive It Yourself Co. of Georgia*, 123 S.E. 132, 136 (Ga. 1924).

Other courts have held that neither generic nor descriptive terms are entitled to trademark protection without a showing of secondary meaning. *See, e.g.*, *MacPhail v. Stevens*, 586 P.2d 1339, 1341 (Colo. App. 1978); *Williamson v. Answer Phone of Jacksonville, Inc.*, 118 So.2d 248, 251 (Fla. Dist. Ct. App. 1960); *Better Bus. Bureau of Kan. City Advert. Club, Inc. v. Chappell*, 307 S.W.2d 510, 515 (Mo. Ct. App. 1957); *Hartzler v. Goshen Churn & Ladder Co.*, 104 N.E. 34, 38 (Ind. Ct. App. 1914).

For an example of a case finding that either generic or descriptive trade names may be entitled to protection upon a showing of secondary meaning, see *Anti-Defamation League of B'nai B'rith v. Arab Anti-Defamation League*, 340 N.Y.S.2d 532, 534-44 (N.Y. Sup. Ct. 1972).

¹⁰ *See* *Speaker v. Shaler Co.*, 87 F.2d 985, 987 (7th Cir. 1937) (noting that "descriptive words" are "included within the broader category of generic terms"); JAMES LOVE HOPKINS, *THE LAW OF TRADEMARKS, TRADENAMES AND UNFAIR COMPETITION* § 46 (4th ed. 1924) (defining a "generic term" as any term that is "too general . . . in its meaning to become the monopoly of an individual in application to merchandise," including geographical names, proper names, and descriptive words); *see also* Milton Handler & Charles Pickett, *Trade-Marks and Trade Names—An Analysis and Synthesis: I*, 30 COLUM. L. REV. 168, 168-70 (1930) (explaining the technical differences between trademarks and trade names).

¹¹ *See, e.g.*, *Houston v. Berde*, 2 N.W.2d 9, 10 (Minn. 1942) (noting when "generic words are used in a trade-name," their use will be restrained when such use causes confusion or deception); *Acad. of Motion Picture Arts & Scis. v. Benson*, 104 P.2d 650, 652 (Cal. 1940) (noting deceptive use of "generic, descriptive, personal, and geographic names" that have acquired secondary meaning constitutes unfair competition).

titled to protection as a technical trademark, regardless of whether it had acquired distinctiveness. A mark is considered inherently distinctive when its “intrinsic nature serves to identify a particular source of a product.”¹² To be considered inherently distinctive, and thus qualify as a technical trademark, a mark had to be non-descriptive (i.e., fanciful or arbitrary).¹³

In the late nineteenth and early twentieth centuries, the rights invested in a technical trademark (as opposed to a trade name) were broader and more absolute than typically thought.¹⁴ To prove infringement, the trademark owner did not have to show “fraud,” or a deliberate intent to deceive consumers, on the part of the defendant.¹⁵ Courts generally required evidence of fraud to prove the tort of “passing off” based on the misuse of a trade name (a source identifier that did not qualify as a technical trademark).¹⁶ Although

¹² *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

¹³ *Handler & Pickett*, *supra* note 10, at 169.

¹⁴ *See, e.g., In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879) (characterizing trademarks as “a property right”); *see also Kidd v. Johnson*, 100 U.S. 617, 619 (1879) (“The right to use the trade-mark is not limited to any place, city, or State, and, therefore, must be deemed to extend everywhere.”); *Apollo Bros. v. Perkins*, 207 F. 530, 533 (3d Cir. 1913) (observing that the law “only permits a monopoly in the use of a trade-mark when it has become the absolute and exclusive property of the first user—good against the world”); *HOPKINS*, *supra* note 10, § 4 (opining that trademark rights are “broader and by far . . . more valuable” than rights to a trade name); Grafton Dulany Cushing, *On Certain Cases Analogous to Trade-Marks*, 4 HARV. L. REV. 321, 322 (1891) (noting that “[a] trademark has become an absolute right”); Daniel M. McClure, *Trademarks and Unfair Competition: A Critical History of Legal Thought*, 69 TRADEMARK REP. 305, 317–19 (1979) (characterizing early treatment of technical trademarks as conferring monopolistic property rights); Kenneth J. Vandavelde, *The New Property of the Nineteenth Century: The Development of the Modern Concept of Property*, 29 BUFF. L. REV. 325, 343–44 (1980) (describing early treatment of trademarks as “absolute property”).

¹⁵ *See Apollo Bros.*, 207 F. at 533 (“A technical trade-mark . . . is treated as property, and an infringement thereof carries with it the presumption of fraud; but where no such exclusive right to the use of such trade-mark exists, a technical trade-mark right is not established, and fraud—unfair competition—in the use of the mark must be proved.”); *HOPKINS*, *supra* note 10, § 22 (noting that “fraud is presumed from the wrongful use of a trademark”); McClure, *supra* note 14, at 317 (observing that, in this era, a plaintiff in a trademark infringement case “was not required to show actual confusion of purchasers or a fraudulent intent by the defendant”).

¹⁶ *See HOPKINS*, *supra* note 10, § 22 (“While fraud is presumed from the wrongful use of a trademark it must be proven, directly or by inference, in all cases of unfair competition which do not involve a technical trademark.”); Cushing, *supra* note 14, at 332 (noting that in “cases analogous to trade-marks,” i.e., cases involving common law trade names, “fraud is the gist of the action”); *see also HOPKINS*, *supra* note 10, § 61 (stating

early cases required a showing of intentional passing off by the defendant to prove fraud, and thus liability for misuse of another's trade name, the law evolved to eliminate the intent requirement and focus instead on likelihood of confusion on the part of consumers.¹⁷

The legal advantage of an inherently distinctive technical trademark over a trade name (protectable only with a showing of acquired distinctiveness) dissipated relatively quickly under the common law.¹⁸ In an article considered groundbreaking at the time, Columbia law professors Milton Handler and Charles Pickett argued in 1930 that legal protection of trademarks and trade names had merged, although the courts did not always recognize that they had done so, with less absolute protection being granted to trademarks and greater protection being extended to trade names: both were protected against uses that led to a likelihood of consumer confusion.¹⁹ Handler and Pickett were at the forefront of the Legal Realism movement, as they argued that courts should discard formalistic labels in favor of a pragmatic approach to trademark law that focused on the manner in which marks actually functioned in the commercial marketplace.²⁰ Handler and Pickett's theory was confirmed in the First Restatement of Torts, published in 1938, which observed that "there are no important differences between

that use of "merely descriptive word" will not be restrained unless circumstances show "fraud on the part of the user"); McClure, *supra* note 14, at 317 (observing that, during this era, a plaintiff in an action for unfair competition or passing off would be required to prove both "actual deception of purchasers and fraudulent intent by the defendant").

¹⁷ See Desai & Rierison, *supra* note 6, at 1813-14 (discussing this trend and citing cases); see also RESTATEMENT (FIRST) OF TORTS § 717 cmt. a (AM. LAW INST. 1938) (noting that fraud "is not essential to infringement of either a trade-mark or a trade name").

¹⁸ See Church & Dwight Co. v. Russ, 99 F. 276, 278 (C.C.D. Ind. 1900) ("The tendency of the courts at the present time seems to be to restrict the scope of the law applicable to technical trade-marks, and to extend its scope in cases of unfair competition." (citations omitted)); RESTATEMENT (FIRST) OF TORTS § 717 cmt. a (observing that "there are no important differences between the protection given to the interest in trade-marks and that given to the interest in trade names").

¹⁹ Handler & Pickett, *supra* note 10, at 200 (concluding that "the supposedly sharp line of demarcation [between trademarks and trade names] is being obliterated").

²⁰ See Brian Leiter, *Rethinking Legal Realism: Toward A Naturalized Jurisprudence*, 76 TEX. L. REV. 267, 272 n.24 (1997) (characterizing Professor Milton Handler as a legal realist); see also Karl N. Llewellyn, *Some Realism About Realism—Responding to Dean Pound*, 44 HARV. L. REV. 1222, 1237 (1931) (characterizing Handler as a realist in the field of "trade-marks and advertising").

the protection given to the interest in trade-marks and that given to the interest in trade names.”²¹

One difference remained, however, between trade names and technical trademarks: only trademarks could be registered under federal law.²² Under the Trade-Mark Act of 1905, descriptive terms could not be registered.²³ The only exception was the so-called “ten-year clause,” which provided that any name that had been “in actual and exclusive use as a trademark” for ten or more years prior to the enactment of the statute could be registered, regardless of whether it qualified as a technical trademark.²⁴ This distinction, however, was not of great practical importance, as the benefits of registration under the 1905 Act were limited.²⁵

Although the common law did treat generic and descriptive terms similarly, the courts also recognized the potentially negative competitive implications of restricting competitors’ use of generic terms.²⁶ The cases in which these issues arose typically involved disputes regarding intellectual property rights in trademarks or trade names attached to patents, after the patent’s expiration. In this context, the genericism doctrine reflected the courts’ concern that trademark law would effectively and illegitimately extend the life of the patent monopoly. For example, in discussing the status

²¹ RESTATEMENT (FIRST) OF TORTS § 717 cmt. a.

²² Trademark Act of 1905, Pub. L. No. 58-84, § 5, 33 Stat. 724, 728 (repealed 1946) (prohibiting registration of a trademark “which consists . . . merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term”).

²³ *See id.*

²⁴ *Id.*; Thaddeus Davids Co. v. Davids, 233 U.S. 461, 465–67 (1914) (interpreting the ten-year clause); Barber-Colman Co. v. Overhead Door Corp., 65 F.2d 147, 150 (C.C.P.A. 1933) (holding that mark which has acquired secondary meaning, but is not a technical trademark, cannot be registered under Trade-Mark Act of 1905 unless the ten-year clause applies).

²⁵ Registration of a mark under the 1905 Act served as prima facie evidence of mark validity and ownership of the mark. *See* Sylvester J. Liddy, *The Lanham Act—An Analysis*, 86 TRADEMARK REP. 421, 422 (1996) (originally published in 37 TRADEMARK REP. 87 (1947)). However, mark registration did not confer nationwide priority in the mark; the benefits of registration extended no farther than the geographical reach of the goodwill of the mark. *See infra* note 34 and accompanying text. Moreover, the concept of mark incontestability did not exist under the 1905 Act.

²⁶ Kellogg Co. v. Nat’l Biscuit Co., 305 U.S. 111, 118 (1938); Singer Mfg. Co. v. June Mfg. Co., 163 U.S. 169, 185 (1896).

of the word “Singer” denoting a particular brand of sewing machine, the U.S. Supreme Court observed that “along with the public ownership of the [formerly patented] device there must also necessarily pass to the public the generic designation of the thing which has arisen during the monopoly”²⁷ To do otherwise, the Court wrote, would “disregard the public dedication [of the formerly patented invention] and practically perpetuate indefinitely an exclusive right.”²⁸

However, these early cases did not divorce the concept of genericism from the secondary meaning doctrine, or acquired distinctiveness. In discussing the trademark status of “Shredded Wheat” breakfast cereal, the Court applied the primary significance test to determine whether the mark at issue was protectable:

[T]o establish a trade name in the term ‘shredded wheat’ the plaintiff must show more than a subordinate meaning which applies to it. It must show that the *primary significance* of the term in the minds of the consuming public is not the product but the producer. This it has not done.²⁹

The Court found that, to the extent “shredded wheat” retained any source-identifying significance, it was as a “subordinate meaning” of the term.³⁰ Moreover, even as to terms classified as “generic” under this definition, the Court recognized a duty on the part of competitors to avoid passing off by using the generic term “fairly”—i.e., in a way that “reasonably distinguishes its product from that of the plaintiff.”³¹

²⁷ *Singer*, 163 U.S. at 185; *see also Kellogg*, 305 U.S. at 118 (“Since during the life of the patents ‘Shredded Wheat’ was the general designation of the patented product, there passed to the public upon the expiration of the patent, not only the right to make the article as it was made during the patent period, but also the right to apply thereto the name by which it had become known.”).

²⁸ *Singer*, 163 U.S. at 185–86.

²⁹ *Kellogg*, 305 U.S. at 118 (emphasis added).

³⁰ *Id.*

³¹ *Id.* at 120; *see also Singer*, 163 U.S. at 187 (reasoning that the “right to use the name because of its generic signification” did not “imply a power to destroy any good will [sic] which belonged to the original maker” or to “deceive and defraud the public by so using the name as to delude them into believing that the machine made by one person was made by another”).

2. Changes Wrought by the Lanham Act

The repeal of the Trade-Mark Act of 1905 and subsequent passage of the Lanham Act in 1946 changed two aspects of trademark law with respect to the treatment of generic words or phrases. Both changes heightened the significance of a judicial determination that a word or term was generic. First, it created a distinction between “merely descriptive” terms and “common descriptive” (i.e., generic) ones: the former became registrable, with a showing of acquired distinctiveness; the latter did not.³² Second, it greatly enhanced the significance of federal trademark registration by giving the registrant nationwide priority in the mark;³³ the extent of a registrant’s priority was no longer limited by the geographic reach of his goodwill.³⁴ Therefore, the judicial construction of a dividing line between generic and descriptive terms became much more critical and significant.

The current version of the Lanham Act extends no protection to words or terms considered generic, even if the word or term was, at one point, a registered, inherently distinctive trademark.³⁵ The Act codifies the doctrine of genericide by stating that, if a mark *becomes* “the generic name for the goods or services on or in connection with which it is used,” for any reason, it is considered abandoned and is no longer a valid trademark.³⁶ A mark that is deemed generic can never achieve “incontestable” status.³⁷ If a valid mark becomes generic, it can be canceled at any time, even if it would

³² Lanham Act, Pub. L. No. 79-489, §§ 2(e), (f), 15(4), 60 Stat. 427, 429, 434 (1946) (amended 1988).

³³ Trade-Mark Act of 1905, Pub. L. No. 58-84, § 5, 33 Stat. 724, 726 (1905) (repealed 1946).

³⁴ See *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 100 (1918); cf. *Dawn Donut Co. v. Hart’s Food Stores, Inc.*, 267 F.2d 358, 364, 365 (2d Cir. 1959) (noting that if the plaintiff’s expansion of business into the defendant’s trading area is probable, and concurrent use of the marks would give rise to a likelihood of confusion, then the plaintiff may enjoin the defendant from using its mark in that retail area).

³⁵ See generally Lanham Act, 15 U.S.C §§ 1051-1141n (2012).

³⁶ § 1127. The Act ties abandonment via genericide to the “course of conduct” of the mark’s owner, “including acts of omission as well as commission,” implying that the mark’s owner has a duty to police unauthorized uses of the mark to prevent it from becoming generic. *Id.*

³⁷ See § 1065(4) (providing that “no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered”).

otherwise be considered incontestable.³⁸ If a defendant to an infringement lawsuit claims the plaintiff's unregistered mark is generic, the plaintiff bears the burden of proving that it is not.³⁹

As noted above, descriptive terms are treated differently under the Lanham Act. Descriptive terms may be registered with a showing of acquired distinctiveness.⁴⁰ Moreover, an "incontestable" mark is not subject to challenge on the grounds that it is descriptive and lacks such acquired distinctiveness (and perhaps never had it in the first place).⁴¹ Therefore, the dividing line between generic and descriptive terms constitutes the de facto boundary of protectable word marks: words or terms found to lie on the generic side of the fence cannot function as trademarks.

3. Judicial Attempts to Define Genericism as Codified in the Lanham Act

The Lanham Act provides only one definition of the word "generic" in the context of the statutory section regarding mark cancellation: "The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has

³⁸ § 1064(3) (providing that a mark may be cancelled "[a]t any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered"); *see also* § 1115(b)(2) (providing that an incontestable mark may be subject to the defense that it has been abandoned by the registrant).

³⁹ *Filipino Yellow Pages, Inc. v. Asian Journal Publ'ns, Inc.*, 198 F.3d 1143, 1146 (9th Cir. 1999) ("If a supposedly valid mark is not federally registered . . . the plaintiff has the burden of proving nongenericness once the defendant asserts genericness as a defense."); *see also* *Blinded Veterans Ass'n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1041 (D.C. Cir. 1989); *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 297 (3d Cir. 1986).

⁴⁰ *See* § 1052. Although § 1052(e)(1) bars registration of marks that are "merely descriptive" of the goods of the applicant, § 1052(f) nonetheless allows registration of such marks if they have "become distinctive of the applicant's goods in commerce." Other marks that are registrable only with a showing of acquired distinctiveness, under § 1052(f), include "deceptively misdescriptive" marks (§ 1052(e)(1)), "primarily geographically descriptive" marks (§ 1052(e)(2)), and marks that are "primarily merely a surname" (§ 1052(e)(4)).

⁴¹ *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 196 (1985) (holding that "[m]ere descriptiveness is not recognized by either [section] 15 or [section] 33(b) as a basis for challenging an incontestable mark").

been used.”⁴² In doing so, the Act appears to have codified the common-law “primary significance” test articulated by the Supreme Court in *Kellogg Co. v. National Biscuit Co.*,⁴³ albeit at least facially only in cases involving the genericide of formerly registered, presumably valid marks.⁴⁴ Courts have expanded beyond this definition of “generic,” however, in attempting to delineate a boundary between words or terms that are potentially subject to trademark protections and those that are not.

Perhaps the most common judicial definition of a generic word or term is borrowed from the world of science: “A ‘generic’ term is one that refers, or has come to be understood as referring, to the genus of which the particular product or service is a species. It cannot become a trademark under any circumstances.”⁴⁵ A corollary of the genus/species terminology is the “who are you/what are you?” test.⁴⁶ Under this analysis: “A mark answers the buyer’s questions ‘Who are you?’ ‘Where do you come from?’ ‘Who vouches for you?’ But the [generic] name of the product answers the question ‘What are you?’”⁴⁷ In practice, these tests have proven difficult to apply.⁴⁸

⁴² 15 U.S.C. § 1064(3) (2012).

⁴³ 305 U.S. 111, 118 (1938).

⁴⁴ This section of the Act was adopted specifically to reject the Ninth Circuit’s “purchaser motivation test” for genericism, as articulated in *Anti-Monopoly, Inc. v. General Mills Fun Group*, 611 F.2d 296, 305–06 (9th Cir. 1979). See Wayne F. Osoba, Note, *The Legislative Response to Anti-Monopoly: A Missed Opportunity to Clarify the Genericness Doctrine*, 1985 U. ILL. L. REV. 197, 209–11 (1985) (discussing legislative response to the *Anti-Monopoly* decision and resulting amendment of the Lanham Act).

⁴⁵ *Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999); see also *Park ‘N Fly*, 469 U.S. at 194; *Surgicenters of Am., Inc. v. Med. Dental Surgeries, Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

⁴⁶ See *Filipino Yellow Pages*, 198 F.3d at 1147.

⁴⁷ *Id.* (quoting *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1391 (9th Cir. 1993)); see also *Soc’y of Fin. Exam’rs v. Nat’l Ass’n of Certified Fraud Exam’rs*, 41 F.3d 223, 227 (5th Cir. 1995); *CES Publ’g Corp. v. St. Regis Publ’ns*, 531 F.2d 11, 13 (2d Cir. 1975).

⁴⁸ See, e.g., *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 296–97 (3d Cir. 1986) (noting the recognized difficulties of distinguishing among suggestive, descriptive, and generic terms); Desai & Rierson, *supra* note 6, at 1826–30 (discussing difficulties arising from courts’ attempts to distinguish between genus and species, or generic and descriptive terms); Arthur J. Greenbaum, Jane C. Ginsburg & Steven M. Weinberg, *A Proposal for Evaluating Genericism After “Anti-Monopoly,”* 73 TRADEMARK REP. 101, 109–

The resultant uncertainty—particularly in terms of drawing distinctions between generic and descriptive names—imposes costs on consumers and competitors alike.⁴⁹ As discussed above, a descriptive name that has acquired secondary meaning is entitled to the full protection of the Lanham Act, just like an inherently distinctive mark.⁵⁰ However, it may take years of use and advertising to create that secondary meaning—in other words, it is expensive to *teach* consumers that a descriptive mark identifies a specific source. If the mark owner succeeds in doing so, her money and effort may nonetheless be wasted if a court (or the U.S. Patent and Trademark Office) later determines that the mark is generic. If the mark is deemed generic, despite its acquisition of secondary meaning, and no restrictions are placed on its use by competitors, then consumers may be harmed because they may be deceived.

B. Functionality's Grounding in the Common Law and the Traffix Pileup

Like descriptive and generic word marks, trade dress was initially ineligible for protection as a trademark under the common law.⁵¹ However, just like weaker word marks (formerly known as trade names), trade dress was entitled to more limited forms of protection against unfair competition, particularly in cases involving deliberate deception.⁵² Even in these very early cases, however, functional trade dress was exempt from prohibitions on copying by competitors.⁵³ As the common law has evolved, the functionality doctrine has waxed and waned in terms of its expansiveness, but two themes have consistently illuminated the doctrine: (1) the need to limit protection of trade dress when a prohibition on copying it would put competitors at an unfair disadvantage; and (2) the need to preserve the boundary between patent and trademark law by eliminating trade dress protections that conflict with the policy and

10 (1983) (noting the “long-standing, widely-embraced fallacy that genericism may be determined by dividing the relevant world of goods into genres and species”).

⁴⁹ Desai & Rierison, *supra* note 6, at 1829 (discussing costs imposed on consumers and trademark holders by ambiguous distinction between generic and descriptive terms).

⁵⁰ *See supra* note 40 and accompanying text.

⁵¹ *See infra* note 58 and accompanying text.

⁵² *See infra* notes 60–61 and accompanying text.

⁵³ *See infra* note 69 and accompanying text.

purpose of federal patent law.⁵⁴ Although the federal courts appeared to have settled on a flexible, factors-based functionality test that emphasized fair competition, the Supreme Court in *TrafFix Devices, Inc. v. Marketing Displays, Inc.* supplanted that rule with a two-part test.⁵⁵ *TrafFix* held that a product feature is functional if (1) it is “essential to the use or purpose of the article,” or (2) it “affects the cost or quality of the article.”⁵⁶ Although *TrafFix* appeared to create a bright-line rule, it did not engender consistency or predictability in the functionality doctrine. The circuits are split in their interpretations of *TrafFix*, particularly as to relevance (or lack thereof) of alternative designs.⁵⁷

1. The Common-Law Expansion of Trade Dress Protection and the Consequent Rise of the Functionality Doctrine

Like descriptive or generic words or phrases, a product’s trade dress was not eligible for protection as a trademark under the common law.⁵⁸ Not surprisingly, even distinctive forms of trade dress were not registrable as trademarks under the Trade-Mark Act of 1905.⁵⁹ However, not unlike the common-law trade name, if a form of trade dress had acquired distinctiveness—that is, it was acting as a source identifier in the minds of consumers—courts of equity were reluctant to allow competitors to copy the trade dress and thereby pass off their goods as those of the plaintiff (particularly if they did so deliberately).⁶⁰ Claims for unfair competition or

⁵⁴ See discussion *infra* Section I.B.1.

⁵⁵ 532 U.S. 23, 31 (2001).

⁵⁶ *Id.*

⁵⁷ See *infra* notes 129–35 and accompanying text.

⁵⁸ See Mark Alan Thurmon, *The Rise and Fall of Trademark Law’s Functionality Doctrine*, 56 FLA. L. REV. 243, 256–57 (2004) (noting that early common-law courts “summarily rejected” efforts to obtain trademark protection in various forms of trade dress).

⁵⁹ Trade-Mark Act of 1905, Pub. L. No. 58-84, § 5, 33 Stat. 724, 724 (1905) (repealed 1946). The ten-year clause applied only to word marks, and therefore did not enable the registration of any distinctive forms of trade dress.

⁶⁰ See RESTATEMENT (FIRST) OF TORTS § 741 cmt. h (AM. LAW INST. 1938) (noting that unprivileged imitation of a product feature was prohibited when “the feature in fact identifies source and the imitation is likely to deceive prospective purchasers who care about source”); Thurmon, *supra* note 58, at 257–58 (noting that although “early courts refused to give full trademark status to nontraditional product identifiers, they did recognize the need to provide some protection” to them); see also Cook & Bernheimer

passing off based on defendant's copying of plaintiff's trade dress, like claims based on defendant's imitation of plaintiff's trade name, turned on two questions: (1) whether plaintiff's trade dress had acquired distinctiveness; and (2) whether defendant's copying of that trade dress led to a likelihood of consumer confusion.⁶¹

As the distinctions between legal protection of common-law trademarks and trade names faded, so too did restrictions on the protection of trade dress as a nontraditional form of source identifier. Courts began to recognize that various forms of trade dress, just like word marks or logos, could function as trademarks.⁶² Modern courts have broadly defined trade dress to include "the total image of a product" and recognize that it "may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques."⁶³

The Lanham Act currently reflects this more expansive interpretation of trade dress and its ability to function as a source identifier. The Act now broadly defines a "trademark" to include any "word, name, symbol, or device, or any combination thereof" used in commerce to "identify and distinguish" the goods of the regi-

Co. v. Ross, 73 F. 203, 205-06 (C.C.S.D.N.Y. 1896) (finding unfair competition by defendant based on copying of plaintiff's square-shaped whiskey bottle, such that the "consumer, deceived by the shape, will mistake the bottle for one of [the plaintiff's]").

⁶¹ RESTATEMENT (FIRST) OF TORTS § 741(b) (prohibiting unprivileged imitation of the physical appearance of goods when (1) "the copied or imitated feature has acquired generally in the market a special significance identifying the other's goods"; and (2) "the copy or imitation is likely to cause prospective purchasers to regard his goods as those of the other"). As explained further below, non-functionality was also a requirement for protection of trade dress. § 741(b)(ii).

⁶² See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 161-62 (1995) (holding that color alone could be registered as a trademark under the Lanham Act); Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach*, 84 IOWA L. REV. 611, 621-22 (1999) (observing that, over time, "the categories of subject matter protected as trademarks grew to encompass the packaging or receptacles in which products were contained").

⁶³ *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1578 (Fed. Cir. 1995) (quoting *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983)). However, as Professor J. Thomas McCarthy aptly noted: "To state that something is *capable* of trade dress protection is hardly the same as concluding that it [is] likely to or has become valid and legally protectable trade dress." 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8:4 (4th ed. 2016). Trade dress is protectable only if it is both (1) distinctive, either through inherent or acquired distinctiveness, and (2) nonfunctional. *Id.* § 8:1.

strant and to indicate their source.⁶⁴ The Act protects both registered and unregistered trade dress from infringement.⁶⁵ The Supreme Court has held that some forms of trade dress, primarily product packaging and logos, may be considered “inherently distinctive,” and therefore are protectable under the Lanham Act even if they lack evidence of acquired distinctiveness.⁶⁶ In this aspect, the Lanham Act treats these types of trade dress more favorably than descriptive or other types of word marks that were previously classified as “trade names” under the common law. The Court has held that two other types of trade dress, product design and color, can never be considered inherently distinctive.⁶⁷ These forms of trade dress are protectable only with a showing of acquired distinctiveness,⁶⁸ similar to descriptive word marks.

With regard to trade dress in the form of product design, the courts have consistently recognized the potentially negative competitive effects of extending trademark protection to useful product features—what is now known as the doctrine of functionality. Early common-law decisions that recognized product design as a form of protectable trade dress (although not as a technical trademark) emphasized that, even though unfair competition may exist when “the defendant, a competitor, has unnecessarily and knowingly imitated his rival’s devices to such an extent that purchasers are likely to be deceived by the resemblance of the devices,” such copying was

⁶⁴ 15 U.S.C. § 1127 (2012). Service marks likewise include any “word, name, symbol, or device, or any combination thereof” that is used in commerce to “identify and distinguish” the services of the registrant and to indicate their source. *Id.*

⁶⁵ See 15 U.S.C. § 1125(a) (2012) (prohibiting use of any “word, term, name, symbol, or device, or any combination thereof” that is “likely to cause confusion”); *id.* § 1114(1)(a) (prohibiting infringement of registered trademarks).

⁶⁶ See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992) (finding “no basis for requiring secondary meaning for inherently distinctive trade dress protection under [section] 43(a) but not for other distinctive words, symbols, or devices capable of identifying a producer’s product”).

⁶⁷ *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 212 (2000) (holding that “[d]esign, like color, is not inherently distinctive”); see also MCCARTHY, *supra* note 63, § 8:12.50 (characterizing the Court’s holding in *Samara Brothers* as a “bright line rule”).

⁶⁸ See MCCARTHY, *supra* note 63, § 8:12.50 (noting that the Supreme Court has “created two categories of symbols that always required proof of secondary meaning to achieve the status of a protectable mark or trade dress: (1) a single color of a product; and (2) the design of a product”).

permissible if “the points of resemblance are the necessary result of functional requirements.”⁶⁹

Even more so than in the genericism context, the common-law doctrine of functionality reflected the courts’ concern that trademark protection could be used to illegitimately extend the life of an expired patent. In the *Shredded Wheat* case, which was also instrumental in defining the parameters of genericide, the Supreme Court discussed the potential conflict between trade dress protection and the constitutional limits on patent rights:

The plaintiff has not the exclusive right to sell shredded wheat in the form of a pillow-shaped biscuit—the form in which the article became known to the public. That is the form in which shredded wheat was made under the basic patent. The patented machines used were designed to produce only the pillow-shaped biscuits Hence, upon expiration of the patents the form, as well as the name, was dedicated to the public.⁷⁰

The Court also recognized that the defendant/competitor Kellogg had a right to copy the pillow shape of the biscuit because it was “functional.”⁷¹ Thus, “the cost of the biscuit would be increased and its high quality lessened if some other form were substituted for the pillow-shape.”⁷² Therefore, even in a case not involving an expired patent, the Court recognized that, to preserve fair competition, trade dress protection could not prevent competitors from replicating “functional” product features.⁷³ In doing so,

⁶⁹ *McGill Mfg. Co. v. Leviton Mfg. Co.*, 43 F.2d 607, 608 (E.D.N.Y. 1930); *see also Lovell-McConnell Mfg. Co. v. Am. Ever-Ready Co.*, 195 F. 931, 932 (2d Cir. 1912) (holding that courts should prevent “imitation in details of construction, with the consequent likelihood of confusion . . . unless the points of resemblance are the necessary result of an effort to comply with the physical requirements essential to commercial success”).

⁷⁰ *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 119–20 (1938); *see also Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896) (“[A]long with the public ownership of the [previously patented] device there must also necessarily pass to the public the generic designation of the thing which has arisen during the monopoly in consequence of the designation having been acquiesced in by the owner, either tacitly . . . or expressly . . .”).

⁷¹ *Kellogg*, 305 U.S. at 122.

⁷² *Id.*

⁷³ *Id.*

the Court recognized that, at least in part, the doctrine of functionality was necessary to prevent trademark law from hindering rather than enhancing fair competition.⁷⁴ However, just as in the genericism context, the Court in *Kellogg* held that the defendant still had an obligation to refrain from “passing off or deception,” even regarding formerly patented and/or functional product features.⁷⁵ The Court found that the defendant, Kellogg, had acted fairly because it had taken “reasonable precaution to prevent confusion or the practice of deception in the sale of its product.”⁷⁶

The First Restatement of Torts was published the same year as the Supreme Court’s decision in *Kellogg*.⁷⁷ Like the Supreme Court’s decision in *Kellogg*, the Restatement acknowledged the protection of trade dress, tempered by the doctrine of functionality.⁷⁸ First, the Restatement recognized the “unprivileged imitation” of the “physical appearance of goods” as a potential basis for tort liability, at least as to goods of the same class.⁷⁹ Such imitation would provide a basis for liability only when (1) the relevant product features had acquired distinctiveness,⁸⁰ and (2) defendant’s use of those features were “likely to cause prospective purchasers to regard his goods as those of the other,” or, in more modern terms, likely to cause consumer confusion.⁸¹

Second, the Restatement recognized and defined a doctrine of functionality in the context of trade dress protection. According to the Restatement, a feature of goods is considered “functional” if it “affects their purpose, action or performance, or the facility or

⁷⁴ *See id.*

⁷⁵ *Id.*

⁷⁶ *Id.* at 121–22 (noting that defendant’s “obligation . . . is not to insure that every purchaser will know it to be the maker [of the product] but to use every reasonable means to prevent confusion”).

⁷⁷ *See* RESTATEMENT (FIRST) OF TORTS (AM. LAW INST. 1938).

⁷⁸ *See id.* § 741.

⁷⁹ *Id.* The Restatement noted that “[t]here is a paucity of authority on the question whether the interest in the physical appearance of one’s goods is protected against the imitation or copy of that appearance on goods of a different class,” and therefore took no position on that issue. *Id.*

⁸⁰ The Restatement specifically required “that the copied or imitated feature has acquired generally in the market a special significance identifying the other’s goods.” § 741(b).

⁸¹ § 741.

economy of processing, handling or using them”⁸² This definition of functionality equates a functional product feature with a utilitarian one, without the emphasis on preserving fair competition reflected in the Court’s opinion in *Kellogg*.⁸³ Under this functionality test, the existence of a “competitive need” for the relevant product feature (or lack thereof) has little effect, regardless of whether the feature at issue is or was subject to patent protection. The Restatement explained that “the shape of a bottle or other container may be functional though a different bottle or container may hold the goods equally well.”⁸⁴ However, the impact of the exclusion of competitive need from the functionality analysis was tempered by the Restatement’s restriction on the use of such functional features. Reflecting existing case law, the Restatement specified that if a functional product feature had acquired distinctiveness, competitors who copied it had a duty to “take reasonable steps to inform prospective purchasers that the goods which he markets are not those of the other.”⁸⁵

Professor Mark Thurmon has characterized this Restatement definition of functionality as a “clear break with the prior case law,” which had evolved to embrace a more flexible, competitive-need based analysis of functionality.⁸⁶ For many years, common law courts created and implemented various definitions of functionality that fluctuated between more absolute bars to protection of any utilitarian aspect of a device, primarily driven by the courts’ desire to avoid conflicts with patent law, to a more flexible “com-

⁸² *Id.* § 742. The comment further explains that “[a] feature of goods, or of their wrappers or containers, may be functional because it contributes to efficiency or economy in manufacturing them or in handling them through the marketing process,” or because it “contributes to their utility, to their durability or to the effectiveness or ease with which they serve their function or are handled by users.” § 742 cmt. a.

⁸³ *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 122 (1938).

⁸⁴ § 742 cmt. a.

⁸⁵ *Id.* § 741(b)(2); *see also Kellogg*, 305 U.S. at 122.

⁸⁶ Thurmon, *supra* note 58, at 275; *see also* Harold R. Weinberg, *Trademark Law, Functional Design Features, and the Trouble with Traffix*, 9 J. INTELL. PROP. L. 1, 10–14 (2001) (characterizing the pre-Restatement period of the functionality doctrine as one which emphasized the “economic nature” of the doctrine and considered competitive need for the relevant product feature, unlike the view articulated in the Restatement). It is unclear why the authors of the Restatement chose to adopt this broader definition of functionality. *See* Weinberg, *supra*, at 15.

petitive need” rationale, focused more on the need to avoid unfair competition.⁸⁷ However, as noted above, because these courts consistently imposed a duty on defendants to refrain from “passing off” their goods as those of the plaintiff, plaintiffs in trade dress infringement cases were typically entitled to some form of relief in such cases, so long as they could prove that their trade dress had acquired distinctiveness, and defendant’s copying had led to a likelihood of consumer confusion.⁸⁸

The United States Court of Customs and Patent Appeals (“CCPA”), created in 1929, and its 1982 successor, the U.S. Court of Appeals for the Federal Circuit,⁸⁹ have played a key role in defining the doctrine of functionality. The Federal Circuit has jurisdiction over appeals from decisions of the Trademark Trial and Appeal Board (“TTAB”), the administrative court that reviews trademark registration decisions from the U.S. Patent and Trademark Office (“USPTO”).⁹⁰ Given that this federal appellate court has the final say in the vast majority of trademark registration disputes, its functionality decisions have been extremely influential over the rest of the federal circuits, and remain so today. For example, in 1982, the CCPA articulated a decision, *In re Morton-Norwich Products, Inc.*, which became the cornerstone of the functionality doctrine in federal courts.⁹¹

In *Morton-Norwich* the CCPA embraced a flexible, competitive-need-based approach to functionality.⁹² Under the test adopted by the CCPA in this case, courts consider the following factors in determining whether a product feature is functional, and hence un-

⁸⁷ Thurmon, *supra* note 58, at 253–82 (examining and describing the common law evolution of the functionality doctrine, up to the Supreme Court’s decision in *Traffix*); *see also* Weinberg, *supra* note 86, at 9–23.

⁸⁸ *See supra* note 85 and accompanying text.

⁸⁹ The Federal Courts Improvement Act merged the CCPA and the Court of Claims to form the Federal Circuit in 1982. Pub. L. No. 97–164, 96 Stat. 25 (1982).

⁹⁰ 28 U.S.C. § 1295(a)(4) (2012).

⁹¹ 671 F.2d 1332, 1334 (1982); *see also* Amy B. Cohen, *Following the Direction of Traffix: Trade Dress Law and Functionality Revisited*, 50 IDEA 593, 625–27 (2010) (analyzing the *Morton-Norwich* decision).

⁹² *Morton-Norwich Prods.*, 671 F.2d at 1339 (noting that public policy underlying the doctrine does not focus on “the right to slavishly copy articles which are not protected by patent or copyright, but the *need* to copy those articles, which is more properly termed the right to compete effectively” (emphasis added)).

protectable as a trademark: (1) the existence of an expired utility patent disclosing the utilitarian advantage of the applicable design;⁹³ (2) the existence of advertising by the originator of the design that “touts its utilitarian advantages”;⁹⁴ (3) whether a “particular design results from a comparatively simple or cheap method of manufacturing the article”;⁹⁵ and (4) the availability and appeal of alternative designs available to competitors.⁹⁶ Two of these factors focus the courts’ attention on the usefulness of the relevant product feature by asking whether the party claiming trade dress protection has publicized the “utilitarian advantages” of the design, either in advertising or in the context of an expired utility patent. The final two factors focus more specifically on the potential competitive impact of extending trade dress protection to the design, considering the design’s impact on cost and quality of manufacture and the availability of competitively equivalent alternatives.

Taken as a whole, the *Morton-Norwich* factors clearly reflect the philosophy that the “right to compete effectively”⁹⁷ lies at the heart of the functionality doctrine. Although two of the factors focus on the utilitarian nature of the design, they do so in the context of identifying the need to copy the design in order to compete effectively in the market for the relevant product. Utilitarianism, in and of itself, does not render a product feature functional under the *Morton-Norwich* factors-based analysis. In fact, the court explicitly rejected a definition of functionality that would allow for the protection of “the design of a particular article . . . as a trademark only where the design was useless, that is, wholly unrelated to the function of the article.”⁹⁸ The court distinguished between the concepts of de facto functionality, the “lay” definition of functionality that is synonymous with utilitarianism, and de jure functionality, a

⁹³ *Id.* at 1340–41.

⁹⁴ *Id.* at 1341.

⁹⁵ *Id.*; see also *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 122 (1938) (noting that the cost of defendant’s product “would be increased and its high quality lessened if some other form were substituted for the pillow-shape”).

⁹⁶ *Morton-Norwich Prods.*, 671 F.2d at 1341 (noting that “[s]ince the effect upon competition ‘is really the crux of the matter,’ it is, of course, significant that there are other alternatives available” (citation omitted)).

⁹⁷ *Id.* at 1339.

⁹⁸ *Id.* at 1338.

legal conclusion rendering a design unprotectable as a mark.⁹⁹ In *Morton-Norwich*, the Federal Circuit sought to create a functionality doctrine that balanced the need to prevent trade dress infringement with the right to copy in an effort to preserve fair competition.¹⁰⁰

Numerous federal courts adopted the *Morton-Norwich* approach to functionality, with its focus on competitive necessity and the availability of alternative designs.¹⁰¹ The Third Restatement of Unfair Competition, published in 1995, reflected this view, defining a “functional” product feature as one that “affords benefits in the manufacturing, marketing, or use of the goods or services with which the design is used . . . that are important to effective competition by others and that are not practically available through the use of alternative designs.”¹⁰²

2. The Supreme Court’s Modification of the Functionality Doctrine

The Supreme Court first dipped its toe into the functionality waters in 1982, the same year the CCPA decided the *Morton-Norwich* case. The Court’s decision in *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.* primarily addressed the doctrine of contributory trademark infringement.¹⁰³ However, in a footnote regarding a functionality defense that was not addressed in the majority opinion, the Court noted that “[i]n general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.”¹⁰⁴ This footnote did not embrace the competitive necessity rationale articulated by the CCPA/Federal Circuit and the Third Restatement of Unfair Com-

⁹⁹ *Id.* at 1337.

¹⁰⁰ *Id.* at 1340 (noting the need to “strike a balance between the ‘right to copy’ and the right to protect one’s method of trade identification” in the context of the functionality doctrine (citation omitted)).

¹⁰¹ See Thurmon, *supra* note 58, at 282–96 (describing the evolution of the case law during this period).

¹⁰² RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 (AM. LAW INST. 1995). The Second Restatement of Torts, which was published in the interim between the First Restatement of Torts and the Third Restatement of Unfair Competition, did not address this topic. See Thurmon, *supra* note 58, at 292.

¹⁰³ See 456 U.S. 844, 862–63 (1982).

¹⁰⁴ *Id.* at 850 n.10.

petition, because it set up a two-part test that did not mention or apparently consider the existence of competitively equivalent alternative designs as part of the functionality analysis.¹⁰⁵ However, it was properly characterized as dicta by most of the courts that considered it and did not have a significant impact on the functionality doctrine.¹⁰⁶

The Supreme Court appeared to clarify its functionality jurisprudence, in line with the Federal Circuit's competitive necessity test, in a subsequent opinion, *Qualitex Co. v. Jacobson Products Co.*¹⁰⁷ In this case, the Court initially adopted the two-part test originally stated in *Inwood*: “[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.”¹⁰⁸ However, the Court went on to characterize this statement in a way that reflected the competitive necessity rationale, by defining a product feature as functional, if the exclusive use of that feature “would put competitors at a significant non-reputation-related disadvantage.”¹⁰⁹ Although *Qualitex* did not mention the alternative design factor, it implied that the factor was relevant by emphasizing competitive disadvantage as central to the functionality doctrine.¹¹⁰ If an alternative, competitively equivalent design exists, a business will not suffer a “significant non-reputation-related disadvantage,” if forced to choose the alternative design over the design that acts as a source identifier for its competitor.¹¹¹ By emphasizing the competitive necessity rationale, the Court appeared to bring its limited functionality jurisprudence in line with the extensive development of the doctrine in the lower federal courts, particularly the Federal Circuit.

¹⁰⁵ Compare *id.*, with RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17.

¹⁰⁶ See, e.g., *LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 76 (2d Cir. 1985) (characterizing the Supreme Court's functionality definition in *Inwood* as dictum); Cohen, *supra* note 91, at 627-35 (discussing the lower courts' treatment of the functionality definition stated in *Inwood*).

¹⁰⁷ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 166 (1995).

¹⁰⁸ *Id.* at 165 (internal quotations omitted) (quoting *Inwood*, 456 U.S. at 850 n.10).

¹⁰⁹ *Id.*

¹¹⁰ See *id.*

¹¹¹ *Id.*

The relative stability of the federal courts' functionality jurisprudence at this point rendered the impact of the Court's 2001 decision in *TrafFix* all the more surprising. In *TrafFix*, the Court repeated the *Inwood* two-part test for functionality: A product feature is functional if (1) it is "essential to the use or purpose of the article," or (2) it "affects the cost or quality of the article."¹¹² However, rather than embrace competitive necessity as a fundamental underpinning of the doctrine, with its concomitant reliance on the availability of alternative designs, the Court rejected it.¹¹³ The Court pronounced that "[w]here the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature."¹¹⁴ The Court went on to reverse the underlying Sixth Circuit decision, finding the product feature at issue to be nonfunctional on the grounds that the circuit court had given undue weight to the availability of alternative designs.¹¹⁵

Many courts and commentators were caught off guard by the Court's decision, given that the Court granted certiorari in *TrafFix* to resolve a circuit split regarding a different issue: whether the existence of an expired utility patent rendered a product feature functional, a question it declined to answer.¹¹⁶ The question regarding the existence of an expired utility patent arose in the lower courts because of the concern that the *Morton-Norwich* analysis did not adequately police the boundaries of patent and trademark law,¹¹⁷ which had long been viewed as a free-standing justification for the functionality doctrine itself. The Court, however, explicitly de-

¹¹² *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 24 (2001) (quoting *Qualitex*, 514 U.S. at 165).

¹¹³ *Id.* at 33.

¹¹⁴ *Id.*

¹¹⁵ *Id.* at 33–34.

¹¹⁶ *Id.* at 28 (noting that certiorari was granted to resolve a circuit split over the issue of "whether the existence of an expired utility patent forecloses the possibility of the patentee's claiming trade dress protection in the product's design"); *id.* at 35 (declining to resolve the question of whether the "Patent Clause of the Constitution of its own force, prohibits the holder of an expired utility patent from claiming trade dress protection" (citation omitted)).

¹¹⁷ *See, e.g., Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1507 (10th Cir. 1995) (rejecting the idea that "no patent law purpose is served by allowing copying of product configurations that are not necessary to competition").

clined to limit its articulation of the functionality doctrine to cases in which the competitive need rationale provoked a conflict with the Patent Clause of the Constitution.¹¹⁸ Unlike the *Morton-Norwich* four-factor analysis, the *TrafFix* two-part test makes no mention of utility patents.¹¹⁹ The Court reasoned that “[w]hether a utility patent has expired *or there has been no utility patent at all*, a product design . . . may be functional because it is ‘essential to the use or purpose of the article’ or ‘affects the cost or quality of the article.’”¹²⁰ *TrafFix* did hold that the existence of an expired utility patent created a strong presumption of functionality, but it did so because the patent offers proof that the two-part test has been satisfied.¹²¹ The Court’s consideration of utility patents in the context of functionality is therefore primarily grounded in utilitarianism, not the constitutional right to copy.

Although the Supreme Court in *TrafFix* seemed to reject the relevance of alternative designs in the context of utilitarian functionality doctrine, it did suggest that competitive necessity still could determine whether a design or product feature was *aesthetically* functional. The Court explained that its previous statement—providing that “a functional feature is one the ‘exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage’”—applied only in cases of aesthetic functionality (the “question involved in *Qualitex*”).¹²² The Court in *Qualitex* held that color alone, specifically the green-gold color of dry cleaning pads, could (and in that case did) become a source identifier, and hence a legally protectable trademark.¹²³ *Qualitex* further held that the functionality doctrine did not prohibit the protection of color as a form of trade dress under the Lanham Act.¹²⁴

¹¹⁸ *TrafFix*, 532 U.S. at 35.

¹¹⁹ Compare *id.*, with *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340–41 (C.C.P.A. 1982).

¹²⁰ *TrafFix*, 532 U.S. at 35 (emphasis added) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982)).

¹²¹ *Id.* at 29–30 (“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.”).

¹²² *Id.* at 33 (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)).

¹²³ *Qualitex*, 514 U.S. at 162–64.

¹²⁴ *Id.* at 166.

The Court in *TrafFix* therefore created two functionality tests: one for cases of utilitarian functionality (in which competitive necessity and alternative designs would be considered irrelevant), and another for cases implicating the aesthetic functionality doctrine (where competitive necessity remained central to the doctrine).¹²⁵ However, even the facts of *Qualitex* itself do not neatly fit into the aesthetic functionality box created by the Court. The *TrafFix* Court observed that in *Qualitex* there was “no indication that the green-gold color of the laundry press pad had any bearing on the use or purpose of the product or its cost or quality.”¹²⁶ In so observing, the Court appears not to have carefully considered its own prior reasoning. In fact, the *Qualitex* Court did find that the green-gold color was utilitarian in the context of a dry cleaning pad: it served to avoid “noticeable stains.”¹²⁷ The color was nonetheless determined to be nonfunctional, as the Court found that there was “no competitive need in the press pad industry for the green-gold color, since other colors [were] equally usable.”¹²⁸ In other words, competitors did not need to copy the green-gold color to hide stains on their dry cleaning pads, because other colors would hide stains just as well.

The confusion wrought by the *TrafFix* decision in the context of the functionality doctrine has been well documented.¹²⁹ The federal circuits have split in their interpretations of the rules created by *TrafFix*, especially regarding the relevance, or lack thereof, of alternative designs in the context of utilitarian functionality.¹³⁰ The Federal Circuit has interpreted the *TrafFix* opinion narrowly, concluding that the Court’s decision in *TrafFix* did not fundamentally alter the *Morton-Norwich* four-factor approach to functionality, and, therefore, consideration of alternative designs re-

¹²⁵ See discussion *supra* notes 112–15, 122–24.

¹²⁶ *TrafFix*, 532 U.S. at 33.

¹²⁷ *Qualitex*, 514 U.S. at 166.

¹²⁸ *Id.* (quoting *Qualitex Co. v. Jacobson Prods. Co.*, No. CV 90 1183 HLH(JRX), 1991 WL 318798, *4 (C.D. Cal. Sept. 3, 1991)).

¹²⁹ See, e.g., Cohen, *supra* note 91, at 667; Brett Ira Johnson, *Trade Dress Functionality: A Doctrine in Need of Clarification*, 34 CAMPBELL L. REV. 125, 130 (2011).

¹³⁰ See, e.g., Cohen, *supra* note 91, at 667 (concluding that “the varied approaches to the treatment of alternative designs, reflected both in the split in the circuit court as well as the decisions of the various district courts [in the wake of *TrafFix*], is troubling and confusing”).

mains “properly part of the overall mix” in determining whether a product feature should be considered functional in the first instance.¹³¹ Other circuits have read the *TrafFix* decision more broadly and consequently determined that, if a product feature is utilitarian—that is, it is “essential to the use or purpose of the article or if it affects the cost or quality of the article”—it is functional and cannot be protected.¹³² Thus, “[t]he availability of alternative designs is irrelevant.”¹³³ In applying this test, the Fifth Circuit concluded that the party claiming trade dress protection failed to prove non-functionality, because it did not show that the relevant product feature was an “arbitrary flourish” that served no purpose in the underlying product.¹³⁴ While most courts agree that the availability of alternative designs should still be considered in the context of aesthetic functionality cases, distinguishing between aesthetic and utilitarian functionality cases poses its own problems.¹³⁵

The existence of a circuit split on any legal issue creates confusion and uncertainty, and the potential for forum shopping, among litigants. In the trademark context, it is particularly disruptive to have a difference of opinion between the Federal Circuit, which hears all appeals from TTAB registration decisions,¹³⁶ and its sister circuits, which also decide questions of trademark registrability or mark validity in the context of infringement lawsuits.¹³⁷ All parties would benefit if the courts could adopt a unified functionality definition in the wake of *TrafFix*, or, alternately, if the Court clarified its jurisprudence on this issue.

¹³¹ *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1274 (Fed. Cir. 2002); *see also* *McAirlaids, Inc. v. Kimberly-Clark Corp.*, 756 F.3d 307, 311 (4th Cir. 2014).

¹³² *Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH*, 289 F.3d 351, 355 (5th Cir. 2002) (quoting *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001)).

¹³³ *Id.* (citing *TrafFix*, 532 U.S. at 33–34); *see also* *Groeneveld Transport Efficiency, Inc. v. Lubecore Int'l, Inc.*, 730 F.3d 494, 506–07 (6th Cir. 2013) (rejecting consideration of alternative designs).

¹³⁴ *Eppendorf*, 289 F.3d at 357–58.

¹³⁵ *See* *Dippin' Dots, Inc. v. Frosty Bites Distrib.*, 369 F.3d 1197, 1203–04 & n.7 (11th Cir. 2004) (holding ice cream color to be functional under both utilitarian and aesthetic analyses); *Baughman Tile Co. v. Plastic Tubing, Inc.*, 211 F. Supp. 2d 720, 722 n.2 (E.D.N.C. 2002) (applying utilitarian functionality doctrine analysis to determine whether the color of plastic tubing should be considered functional).

¹³⁶ 28 U.S.C. § 1295(a)(4)(B) (2012).

¹³⁷ 15 U.S.C. § 1121 (2012).

3. The Current Status of Functionality Under the Lanham Act

The doctrine of functionality, like the genericism doctrine, has increased in importance due to the elevated significance of trademark registration and the expansion of trademark protection generally under the Lanham Act. However, unlike genericism, which appeared as a bar to registration in the original version of the Lanham Act passed in 1948, Congress did not codify the functionality doctrine until fifty years later in 1998.¹³⁸ Like generic words or phrases, the current version of the Lanham Act excludes functional aspects of product design from protection.¹³⁹ A functional design may not be registered as a trademark, even if it has acquired distinctiveness.¹⁴⁰ If registered, it may be canceled at any time, even if it is encompassed within a mark that would otherwise be considered incontestable.¹⁴¹ To state a claim for infringement of unregistered trade dress under the Lanham Act, the plaintiff has the burden of proving “that the matter sought to be protected is not functional.”¹⁴² However, the Lanham Act does not define the word “functional.” Instead, the courts have attempted to do so, as described above.¹⁴³ Moreover, the Lanham Act—unlike the common law—does not provide “functional” product features with a limited degree of protection, even if they have acquired secondary meaning.¹⁴⁴ As both the Lanham Act and common law have embraced product design as a form of trademark, and the significance of the protections extended to trademarks has increased, it has become even more important to have a clear, workable functionality doctrine designed to preserve and protect fair competition.

¹³⁸ Technical Corrections to Trademark Act of 1946, Pub. L. No. 105-330, 112 Stat. 3069 (1998); *see also* MCCARTHY, *supra* note 63, § 7:63.

¹³⁹ *See* 15 U.S.C. § 1052(e)(5) (2012).

¹⁴⁰ *See id.* (barring registration of any putative mark that “comprises any matter that, as a whole, is functional”). Functional product features may not be registered with a showing of acquired distinctiveness. *See* § 1052(f).

¹⁴¹ *See* 15 U.S.C. § 1115(b)(8) (2012). (providing that an incontestable mark may be subject to the defense that it is functional); *id.* § 1064(3) (providing that a mark may be cancelled “[a]t any time if the registered mark . . . is functional”).

¹⁴² 15 U.S.C. § 1125(a)(3) (2012).

¹⁴³ *See supra* notes 103–35 and accompanying text.

¹⁴⁴ *See supra* notes 139–42 and accompanying text.

II. GENERICISM AND FUNCTIONALITY: COMMON THEMES FOR REFORM

Over the years, the genericism and functionality doctrines have evolved, both in their significance and in their obtuseness. Flexible, common-law principles of unfair competition have given way to more formalistic, bright-line rules, especially as these rules have been codified and federalized. Rather than enhance predictability, however, these rules have had the opposite effect. Moreover, in adopting an all-or-nothing approach to trademarks deemed generic or functional, the courts have, in various respects, tolerated or even enabled some degree of consumer confusion, which injures both competitors and the public. By reorienting the doctrines towards their common-law roots, courts can improve outcomes and, perhaps more importantly, enhance consistency and predictability as courts attempt to mark the boundaries of trademark law.

A. Redefining and Simplifying Genericism and Functionality

The tests developed by the courts to address the issues of genericism and functionality have proven difficult to apply and have drawn the doctrines away from their original purpose: to ensure free and fair competition.¹⁴⁵ In doing so, these doctrines have unintentionally imposed costs on consumers as well. By refocusing the doctrines on the core ideal of free and fair competition, courts can simplify the doctrines and achieve more consistent and predictable results, to the benefit of competitors and consumers alike.

1. Refocusing Genericism on the Primary Significance Test

In the genericism context, the court's analysis of whether a putative mark is functioning as a source identifier when consumers are using it in a commercial setting should answer the question of whether the putative mark is deemed generic in the vast majority of cases. The Supreme Court's reasoning in *Kellogg* emphasized that a valid trademark exists when "the *primary significance* of the term in the minds of the consuming public is not the product but the producer."¹⁴⁶ The Court recognized that words or terms can have dual

¹⁴⁵ See *supra* notes 42–49, 129–35 and accompanying text.

¹⁴⁶ *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118 (1938) (emphasis added).

meanings—one generic and one not—at the same time; the question is which definition predominates in the minds of consumers.¹⁴⁷ The Court found that, under the facts of that case, any source-identifying significance retained by the Shredded Wheat mark had become a “subordinate meaning” of the term.¹⁴⁸ Therefore, the term was no longer protectable as a trademark.

As the author and Deven Desai have previously argued, courts have both over-simplified and unnecessarily complicated this analysis.¹⁴⁹ The various tests developed by the courts to ferret out generic words—e.g., genus/species, who-are-you, what-are-you—attempt to put words into neat categorical boxes, without sufficiently taking into account the context in which they are being used and perceived by consumers. Many, if not most, words in the English language have multiple meanings. Outside the confines of trademark law, such linguistic flexibility is rarely considered problematic, because meaning is determined from context. For example, if the word “snow” were to be used in casual conversation, the listener would be able to tell whether the speaker intended to reference (1) frozen precipitation, (2) a dessert, (3) cocaine, or (4) to deceive, all of which are dictionary definitions of the word “snow.”¹⁵⁰ However, if an erstwhile trademark co-exists with an alternative, generic meaning of the same word, courts and the Patent and Trademark Office are quick to point to that alternative meaning as evidence that the word (or words) cannot be a trademark.

Courts therefore over-rely on evidence derived from dictionaries, newspapers, and the like to prove the death or nonexistence of a trademark:

Dictionary entries and media uses certainly may reflect some of the ways in which a term is used. These noncommercial uses of a trademark are, however, poor barometers of the consumer’s perception of the mark in commercial contexts and—unlike competitive misuse of the mark—they do not

¹⁴⁷ *See id.*

¹⁴⁸ *Id.*

¹⁴⁹ *See* Desai & Rierson, *supra* note 6, at 1836.

¹⁵⁰ *See id.* at 1838–39.

necessarily affect consumer perceptions in commercial settings.¹⁵¹

In truth, this type of evidence proves little other than the fact that the putative trademark also has a non-trademark meaning associated with it. The court's primary task, in such cases, is to determine whether the "generic" meaning of the term is primary or subordinate, when viewed by consumers in a commercial setting.

Over-relying on noncommercial uses of a mark as evidence of genericism also has the pernicious effect of undermining the fair use doctrine. Particularly as applied to words or terms that may otherwise be considered descriptive, it should be obvious that such terms would appear in the lexicon in their non-trademark sense. Indeed, the descriptive fair use doctrine presumes that such uses will occur and shields them from a claim of trademark infringement.¹⁵² However, by pointing to such uses as indicative of the term's invalidity as a mark, the genericism doctrine indirectly incentivizes trademark holders to "police" uses of their marks that should be considered fair. This type of over-enforcement of trademark rights may lead to trademark bullying or at least the perception of it, which imposes its own set of costs on society.¹⁵³

2. Rationalizing Functionality

As discussed above, the Supreme Court's rewriting of the functionality doctrine has been widely criticized.¹⁵⁴ In *TrafFix*, the Court expanded the definition of a functional product feature, unmooring the doctrine from its underpinnings in the law of unfair competition. *TrafFix* arguably reoriented functionality by redirecting courts' attention away from the competitive impact of extending trade dress protection to a product feature, and instead focus-

¹⁵¹ *Id.* at 1836.

¹⁵² *See, e.g.*, *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 123 (2004) (holding that, while descriptive fair use is not defeated by a showing of likelihood of confusion, the degree of confusion may be pertinent to whether defendant's use of the plaintiff's mark is fair); *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1031 (9th Cir. 2010) (defining and applying descriptive fair use doctrine).

¹⁵³ *See generally* Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 WIS. L. REV. 625 (2011).

¹⁵⁴ *See supra* note 129.

ing their attention on the question of whether the trade dress at issue should be considered utilitarian. It also created an illusory distinction between aesthetic functionality cases, in which the Court still permits application of competitive necessity rationale, and utilitarian ones, which, as explained above, now appear to exclude this type of analysis.¹⁵⁵ The doctrine should be redirected toward its pro-competitive roots.

In considering whether a product feature or design should be considered functional, a court's primary focus should be a relatively simple one: Will limiting the ability of competitors to use this product feature negatively impact their ability to fairly compete in the market for this product? The *Morton-Norwich* factors, slightly reconfigured, are relevant in answering this basic question: (1) does this design feature make this product work, or make it work better?¹⁵⁶ (2) would the producer incur additional cost if forced to eliminate or alter this design feature? and (3) does this design feature make the product appeal to consumers in a way that is not related to its source-identifying function? A positive response to any of these questions should create a presumption of functionality, because restricting the right to copy any such product feature could unfairly hinder free and fair competition. However, that presumption should be rebuttable: If the design feature does confer some benefit in terms of the product's function or appeal to consumers, are there equally attractive means that can be used to achieve the same result, without imposing additional costs? If so, the competitor should choose one of those alternatives, to avoid creating a likelihood of consumer confusion, assuming that the plaintiff has proven both acquired distinctiveness of the product design and likelihood of confusion. In applying this test, a court should be able to determine whether a product feature is functional in the vast majority of cases.

However, as discussed more thoroughly below, the need to avoid conflict with patent law requires consideration of a final

¹⁵⁵ See discussion *supra* notes 112–15 and 122–24.

¹⁵⁶ One factor emphasized by the *Morton-Norwich* court was whether the party claiming trade dress protection of a product design had advertised the utilitarian benefits of that design. See *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1338–41 (C.C.P.A. 1982). Such advertising would constitute proof and/or an admission that such benefits existed.

question in some functionality cases.¹⁵⁷ Many, if not most, product designs that function as trade dress are not the subject of an expired utility patent;¹⁵⁸ as to these types of designs, there is no direct conflict with patent law. Moreover, if a design feature was formerly covered by a utility patent, it will, in most cases, make the product work, or work better in some respect, thereby conferring a competitive advantage on the patent holder. In these types of cases, the analysis described above will render the product feature functional, thereby again avoiding a direct conflict with patent law. However, it is possible that a patented design feature (or one claim within a patent) may have no utilitarian impact on the underlying product or otherwise impact competition in the manner described above. In such cases, the court should directly examine whether extending trade dress protection would effectively extend the patent monopoly: Would it prevent competitors from copying the previously patented device? If so, the product feature may be deemed functional for this reason as well, *without* consideration of alternative designs.¹⁵⁹

One benefit of this unified definition is that it eliminates the need for courts to attempt to distinguish between instances of utilitarian and aesthetic functionality. Aesthetic aspects of product design—as in the case of the color of the dry-cleaning pads in *Qualitex*, discussed above¹⁶⁰—often serve a utilitarian purpose as well as a source-identifying function. Courts should not discount or ignore the source-identifying capacity of a product feature merely because it is simultaneously utilitarian. By doing so, they potentially impose costs on consumers and business owners by enabling a defendant to pass off his goods as those of the plaintiff.

¹⁵⁷ See *infra* notes 191–253 and accompanying text.

¹⁵⁸ See *infra* notes 194–99 and accompanying text.

¹⁵⁹ This recommendation for reform essentially follows the reasoning of the Tenth Circuit in *Vornado Air Circulation Systems, Inc. v. Duracraft Corp.*, 58 F.3d 1498 (10th Cir. 1995), a case that preceded the Supreme Court’s decision in *Traffix*. In *Vornado*, the Tenth Circuit held that “where a disputed product configuration is part of a claim in a utility patent, and the configuration is a described, significant inventive aspect of the invention . . . so that without it the invention could not fairly be said to be the same invention, patent law prevents its protection as trade dress, even if the configuration is nonfunctional.” *Id.* at 1510.

¹⁶⁰ See *supra* notes 126–28 and accompanying text.

Moreover, by restricting trade dress protection to those product features that exist only as an “arbitrary flourish,”¹⁶¹ the functionality doctrine intrudes upon and merges with the doctrine of inherent distinctiveness. Some forms of trade dress may be considered inherently distinctive, and the test for determining whether they satisfy that standard sounds remarkably similar to the definition of functionality adopted by many federal courts post-*TrafFix*.¹⁶² This merger of standards is doubly confusing, given that the Supreme Court has held that the forms of trade dress most typically associated with the functionality doctrine—color and product design—can never be considered inherently distinctive, even if they are, in fact, arbitrary and serve no utilitarian purpose.¹⁶³

Like word marks, features of trade dress may serve a dual function in practice and in the mind of the consumer. To the consumer, they may simultaneously have a utilitarian purpose and act as a source identifier. In determining which function predominates (or, to borrow word mark terminology, the primary significance of the mark), a court must necessarily consider whether alternatives to the relevant product feature are available to the competitor and are truly equal to their source-identifying counterpart. However, as

¹⁶¹ *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34 (2001); *Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH*, 289 F.3d 351, 357 (5th Cir. 2002).

¹⁶² The term “arbitrary” is frequently used by courts when attempting to define inherently distinctive trade dress. The case most frequently cited and relied upon by other courts in making this determination, *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, uses the term “arbitrary” as though it were synonymous with “distinctive” in this context. *See* 568 F.2d 1342, 1344 (C.C.P.A. 1977) (“In determining whether a design is arbitrary or distinctive this court has looked to . . . [various factors.]”); *see also* *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 584 (2d Cir. 1993) (finding that, because product packaging was “undeniably arbitrary,” it was inherently distinctive and did not require proof of secondary meaning to be protectable); *Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 702 (5th Cir. 1981) (reasoning that “[i]f the features of the trade dress sought to be protected are arbitrary and serve no function either to describe the product or assist in its effective packaging,” the trade dress should be considered inherently distinctive).

¹⁶³ *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 212 (2000) (holding that “[d]esign, like color, is not inherently distinctive”); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162–63 (1995) (analogizing color to a descriptive word mark, which is protectable only if it develops secondary meaning over time); *see also* MCCARTHY, *supra* note 63, § 8:12.50 (noting that the Supreme Court has “created two categories of symbols that always required proof of secondary meaning to achieve the status of a protectable mark or trade dress: (1) a single color of a product; and (2) the design of a product”).

discussed below, when trademark protection of such product features collides directly with the policies underlying the Patent and Copyright Clause of the Constitution, trademark law must yield.¹⁶⁴ Therefore, if trade dress protection is sought for a product feature that is a “described, significant inventive aspect”¹⁶⁵ of an expired utility patent, competitors should not be required to adopt alternative designs.

B. The Patent Dilemma and the Importance of Alternatives

One policy justification for both the genericism and functionality doctrines lies within the constitutional authorization for a different form of intellectual property: patents. The Constitution enables Congress to grant an inventor an “exclusive [r]ight” to her discoveries for “limited [t]imes,” for the purpose of promoting “the useful [a]rts.”¹⁶⁶ Trademarks are not subject to the time limitation that is constitutionally imposed on a patent, and therefore they may last in perpetuity, so long as the mark at issue continues to be used.¹⁶⁷ The heart of the potential conflict between patent and trademark law lies in this temporal disparity. The Supreme Court has held that a patent owner cannot evade the statutory and constitutional time limit on a patent by recasting his invention as a form of trade dress protected under the auspices of trademark law.¹⁶⁸ Both the genericism and functionality doctrines exist, in part, to police this boundary between patents and trademarks. This Article argues, however, that this policing function is implicated in only a minority of cases raising issues of genericism and functionality. Even in that context, if the functionality and genericism doctrines focus on preserving fair competition, they will simultaneously ad-

¹⁶⁴ See *infra* notes 219–26 and accompanying text.

¹⁶⁵ *Vornado Air Circulation Sys, Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1510 (10th Cir. 1995).

¹⁶⁶ U.S. CONST. art. I, § 8, cl. 8.

¹⁶⁷ Under the Lanham Act, a federal trademark registration does not expire after a set period of time. The Act requires the owner of a federally registered mark to file a renewal application with the USPTO attesting to the continued use of the mark in commerce and to pay a specified fee every ten years. 15 U.S.C. §§ 1058–1059 (2012). If the mark owner fulfills these obligations, the mark may theoretically last in perpetuity.

¹⁶⁸ See *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 120 (1938); *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896).

here to the limitations of patent monopolies—at least in the vast majority of cases.

1. The Link Between Expired Patents and Genericide

The genericism doctrine, which almost exclusively applies to word marks, is not often considered critical or even relevant to the patent/trademark boundary discussed above. However, some of the earliest examples of genericide—the process by which a valid trademark loses its source-identifying significance and becomes a generic word—arose from cases involving expired utility patents. When the patent expires on an invention, the ability to exploit that patent may be thwarted if the trademark used to identify it has evolved to signify the generic product rather than the brand. In such cases, the trademark is rendered invalid via genericide, thus enabling competitors to copy it, much like the expired patent itself. Competitive necessity compels this result as well. The existence and promotion of an alternative, generic name for the goods produced under the patent may resolve both the conflict with patent law and the anticompetitive effects of trademark protection in this scenario, thus avoiding the genericide of the mark.¹⁶⁹

A classic genericide case, *Bayer Co. v. United Drug Co.* exemplifies the link between genericide of a trademark and expiration of an underlying patent.¹⁷⁰ In *Bayer*, the manufacturer of a drug sold under the trademark Aspirin proffered the alternative term “acetyl salicylic acid” as an alternative to the trademark.¹⁷¹ Perhaps not surprisingly, this “extraordinary collocation of letters,”¹⁷² in the words of Judge Learned Hand, did not catch on. Judge Hand found that consumers did not understand the word “aspirin” to mean “anything more than a kind of drug,” despite the manufacturer’s

¹⁶⁹ Trademark attorney Jerre Swann argued in 1999 (pre-*TrafFix*) that genericism should take a page from the functionality playbook and similarly put the availability of alternatives at the center of the doctrine rather than on the periphery. See Jerre B. Swann, *Genericism Rationalized*, 89 TRADEMARK REP. 639, 650 (1999).

¹⁷⁰ 272 F. 505 (S.D.N.Y. 1921).

¹⁷¹ *Id.* at 510.

¹⁷² *Id.* Judge Learned Hand’s colorful description actually referred to an alternative name for the drug, “monoaceticacidester of salicylic acid,” but it captured the essence of both generic names for the drug. *Id.*

belated efforts to infuse it with source-identifying significance.¹⁷³ The court further found that consumers did not understand “aspirin” and “acetyl salicylic acid” to be the same drug.¹⁷⁴ Because the word “aspirin” did not retain any source-identifying significance, it was not entitled to protection as a trademark.¹⁷⁵

The problem faced by the drug manufacturer in *Bayer* is not unique. The inventor who creates and patents a unique product may effectively “fall victim to [his] own success” when he attempts to obtain or maintain trademark protection for the name of his product, after the patent has expired.¹⁷⁶ If there is only one source for a particular good or service, then the mark that identifies the source may also become the word that identifies the thing itself.¹⁷⁷ Under these circumstances, competitors who wish to copy and exploit the formerly patented invention may need to label their copies with the same trademark used by the inventor, because the public understands nothing else.¹⁷⁸

¹⁷³ *Id.*

¹⁷⁴ *Id.*

¹⁷⁵ *Id.*

¹⁷⁶ Desai & Rierson, *supra* note 6, at 1820 (alteration in original).

¹⁷⁷ *Id.* at 1820–21 (“Because the trademark/patent holder enjoys a monopoly over the production of the good during the patent period, the trademark label placed on the good typically serves a dual function: to identify the sole source of the good (i.e., the trademark holder) and to identify the good itself. When the patent period ends, consumers continue to identify the good by using the trademark.”).

¹⁷⁸ *But see* Gideon Parchomovsky & Peter Siegelman, *Towards an Integrated Theory of Intellectual Property*, 88 VA. L. REV. 1455, 1502–04 (2002). Parchomovsky and Siegelman wrote that *Singer Manufacutring Co. v. June Manufacturing Co.*, 163 U.S. 169 (1896), and *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938), held that “the generic name by which a patented invention has become known falls into the public domain at the expiration of the patent.” Parchomovsky & Siegelman, *supra*, at 1502. They critiqued this holding, based on an economic theory of leveraged patents, as failing to recognize and maximize the benefits of allowing an inventor to enjoy trademark protection after the expiration of a patent. *Id.* at 1503–04.

Parchomovsky and Siegelman’s economic analysis arguably does not accurately distinguish between generic names and non-generic marks in terms of the economic value of post-patent trademark protections. Genericide, as explained above, is not an unavoidable consequence of patent protection. However, when it does occur, competitors’ ability to exploit the expired patent may be severely compromised if the generic name is protected as a trademark, negatively impacting the market for the formerly patented product and, consequently, the consumers who buy it. Trademark law, therefore, should distinguish between marks that have become generic names and those that have not, particularly in cases involving expired patents.

The genericide of trademarks associated with expired utility patents is not, however, inevitable. So long as a viable alternative to the trademarked name exists, neither patent law nor the law of unfair competition requires the invalidation of the trademark. A viable alternative exists when consumers can and do use alternative words to identify the good or service at issue, other than the trademark. As a result, patent holders should strive to develop and adapt workable, alternative names for their patented inventions (assuming they do not already exist), in addition to selecting a viable trademark for the purpose of identifying and marketing their inventions. If they fail to do so, they may fall victim to their own success, as described above. Admittedly, even if an alternative name exists, the trademark owner may not be able to convince the public to use it. The trademark owner can, however, increase the chances of success in this regard by (1) using the name itself, in conjunction with the trademark, in identifying its own goods or services, and (2) choosing an alternative generic name that is not lengthy or difficult to pronounce, spell, or remember.¹⁷⁹

Trademarks can fall victim to genericide, of course, in cases that do not involve expired patents. Similarly, consumers' access to viable alternatives (or lack thereof) should play a critical role in any genericism determination; the significance of alternative monikers, from a competitive standpoint, is or should not be limited to cases involving expired patents. A patent imparts a legal monopoly that creates a finite period of market dominance. For the reasons stated above, that monopoly can erode the source-identifying significance of a trademark. The same phenomenon may occur outside the patent context, when market dominance occurs for other reasons, such as superior quality of product or effective marketing. Unlike the case involving a utility patent, in this context the trademark holder enjoys market dominance solely due to her own commercial success. Here as well, the genericide doctrine prevents trademark law from artificially suppressing competition. Just as in the case of a formerly patented product, if the public equates the trademark with the thing itself, competitors should be allowed to

¹⁷⁹ Bayer's proffered alternatives to the trademark Aspirin—"acetyl salicylic acid" or "monoaceticacidester of salicylicacid"—would not satisfy this standard. *Bayer*, 272 F. at 510.

use the name that the public understands. Again, alternatives are key: If no alternative name exists as a viable substitute for the putative trademark, then competitive necessity may require the denial of trademark protection, as consumers may recognize no other name as referring to the good or service in question.

There are numerous examples of trademark/generic combinations that are concurrently recognized by consumers, allowing the trademark holder to retain the source-identifying significance of its mark, despite enjoying a period of market dominance. For example, consumers recognize the word “Google” as the name of one of the most successful companies in the world.¹⁸⁰ Google is, of course, a federally registered trademark.¹⁸¹ In 2016, Forbes estimated the value of Google brand at over \$82.5 billion.¹⁸² However, the Google trademark was recently challenged, and its cancellation sought, on the grounds that it was generic.¹⁸³ In so doing, the plaintiff argued that “a majority of the public understands the word google, when used as a verb, to mean the indiscriminate act of searching the Internet without regard to the search engine used.”¹⁸⁴ The court correctly found that, even though some portion of the public does use the word “google” in this manner, this usage of the mark does not demonstrate that it has become generic.¹⁸⁵ To determine the primary significance of the word “google,” the court correctly focused on the “use and understanding of the mark in the context of purchasing decisions.”¹⁸⁶

Even if a majority of the public used the word “google” in the manner described by the plaintiff, the result would not necessarily be genericide, so long as the majority of the public also recognizes that Google is a specific, highly effective search engine.¹⁸⁷ Con-

¹⁸⁰ See *The World’s Most Valuable Brands*, FORBES, <http://www.forbes.com/powerful-brands/list/> [<https://perma.cc/2T7K-WT3Y>] (last visited Mar. 31, 2017).

¹⁸¹ GOOGLE, Registration No. 4,525,914.

¹⁸² See *The World’s Most Valuable Brands*, *supra* note 180.

¹⁸³ *Elliot v. Google Inc.*, 45 F. Supp. 3d 1156, 1161 (D. Ariz. 2014), *appeal docketed*, No. 15-15809 (9th Cir. Apr. 22, 2015).

¹⁸⁴ *Id.*

¹⁸⁵ *Id.* at 1173–75.

¹⁸⁶ *Id.* at 1162 (quoting 2 MCCARTHY, *supra* note 63, § 12:8); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 15 cmt. c (AM. LAW INST. 1995).

¹⁸⁷ *Elliot*, 45 F. Supp. 3d at 1173 (discussing survey evidence and expert opinions).

sumers' concurrent generic use of the term signifies Google's dominance of the search engine market, not the collapse of its trademark validity.¹⁸⁸ Unlike the term "acetyl salicylic acid" in *Bayer*, which was meaningless to the average consumer,¹⁸⁹ the term "search engine" is used and understood by consumers who also identify Google as a particular search engine.¹⁹⁰ Consumers would be confused and misled if Yahoo and Bing labeled themselves "Google" or invited consumers to "Google" on their search engines. Neither the competitive market for search engines nor the integrity of the patent system would be improved by allowing Google's competitors to use its name in this manner.

Therefore, although genericide does play a role in policing the boundary between trademark and patent law, that function is subsidiary to the doctrine's broader competitive focus. Any trademark may need to be invalidated on grounds of genericism if the public recognizes no other name as identifying the good or service to which it is attached. Otherwise competitors are unfairly tongue-tied in marketing their wares. The patent monopoly creates the perfect conditions for this type of market impact, but the genericide phenomenon is not limited to cases involving expired utility patents. Whenever a trademark holder enjoys a period of market dominance—engendered by either a federally-enforced patent monopoly or the fruits of her own commercial success—she needs to ensure that consumers can understand and use some name other than her trademark to refer to the good or service at issue. Without a viable alternative, the trademark will cease to function as such.

2. Patents and Functionality

Much more so than the genericism doctrine, the functionality principle has traditionally been viewed by courts and commentators alike as a bulwark between trade dress protection, under both the Lanham Act and the common law, and the bounds of federal patent law. This Section argues that, to some degree, this aspect of

¹⁸⁸ See Laura A. Heymann, *The Grammar of Trademarks*, 14 LEWIS & CLARK L. REV. 1313, 1348 (2010) (noting that use of a trademark as a verb may be an indication of brand strength and "enduring fame" rather than genericism).

¹⁸⁹ See *Bayer Co. v. United Drug Co.*, 272 F. 505, 511 (S.D.N.Y. 1921).

¹⁹⁰ See *Elliot*, 45 F. Supp. 3d at 1173–75.

the functionality doctrine has been overstated. Moreover, a functionality doctrine primarily aimed at preserving a level competitive playing field will almost always protect the legal space that has been carved out, both legislatively and constitutionally, for patents.

The Supreme Court described the patent/trademark conflict, and functionality's role in resolving it, in *Qualitex*:

It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).¹⁹¹

Qualitex identified two problems associated with extending trade dress protection to functional product features, vis-à-vis patent law: (1) functional product features that satisfy the requirements of patentability should not be accorded protection for an unlimited period of time, because the Constitution specifies that patent monopolies may be extended only for "limited times"; and (2) functional product features that do not satisfy the requirements of patentability should not be accorded monopolistic protections that are constitutionally reserved for patents.¹⁹²

If trade dress protection effectively results in extending the life of a utility patent, the Patent and Copyright Clause of the Constitution¹⁹³ requires that trade dress law step aside to allow the patent to fully fall into the public domain, regardless of whether alternative designs would achieve the same result from a competitive standpoint. However, outside this relatively narrow circumstance, the need to avoid a conflict with patent law should not require the abandonment of a pro-competitive approach to the doctrine of functionality, including the consideration of alternative designs. If non-

¹⁹¹ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164–65 (1995) (citation omitted).

¹⁹² *Id.*

¹⁹³ U.S. CONST. art. I, § 8, cl. 8.

patented forms of trade dress are ineligible for trademark protection due to their functionality, the justification for the application of the doctrine lies in the preservation of fair competition, rather than a tenuous or, in some cases, non-existent conflict with patent law.

The overriding principle that trademark law *does not*—or at least should not—extend a patent-like monopoly to the holder of the trademark should inform all aspects of the functionality doctrine. Precisely because its roots are lodged in the common law of unfair competition, outside the constitutional grounding of both patent and copyright laws, trademark law provides a more limited form of protection that serves to enable free competition and protect consumers, rather than inspire invention and creativity. The limits of trademark law are key to maintaining the constitutional balance between trademarks and patents.

a) The Constitutional Limits of Patent Preemption

The *Qualitex* Court correctly observed that many product features considered “functional” would not satisfy the statutory conditions for patentability.¹⁹⁴ In fact, the vast majority of product features that may be considered “functional” trade dress would not clear the patentability hurdle. As noted above, *TrafFix* defined a functional product feature as one that is “essential to the use or purpose of the article” or “affects the cost or quality of the article.”¹⁹⁵ A patented device similarly must be “useful,”¹⁹⁶ but it must satisfy other requirements as well. It must also be “novel”—that is, the claimed invention must not be “patented, described in a printed publication, or in public use, on sale, or otherwise available to the public” before the patent application is filed.¹⁹⁷ The claimed

¹⁹⁴ *Qualitex*, 514 U.S. at 164–65.

¹⁹⁵ *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 24 (2001) (quoting *Qualitex*, 514 U.S. at 165).

¹⁹⁶ 35 U.S.C. § 101 (2012) (providing that patents may be obtained for a “new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof,” provided other statutory requirements are met); *see also In re ‘318 Patent Infringement Litig.*, 583 F.3d 1317, 1324–27 (Fed. Cir. 2009) (analyzing statutory utility requirement and concluding that it was not met).

¹⁹⁷ 35 U.S.C. § 102(a)(1) (2012); *see also In re Gleave*, 560 F.3d 1331, 1334–35 (Fed. Cir. 2009) (defining novelty requirement for patentability).

invention also must not have been “obvious” to one of “ordinary skill in the art” to which the invention pertains, prior to the patent filing date.¹⁹⁸ Finally, the invention must be described in the patent application, such that one of ordinary skill in the art could make and use it.¹⁹⁹ None of these requirements apply to useful forms of trade dress that may be deemed functional. Therefore, the range of product features that may be considered functional trade dress extends far beyond the limits of federal patent protection.

Qualitex identified this difference in scope as a policy consideration justifying the functionality doctrine itself: utilitarian product features should not be protected under trademark law, because to do so would confer upon them monopolistic protection that is constitutionally reserved for patents.²⁰⁰ In *Compco Corp. v. Day-Brite Lighting, Inc.*, the Supreme Court embraced an even broader concept of patent preemption, articulating a bright-line rule that would place all forms of product design outside the reach of trademark law:

[W]hen an article is unprotected by a patent or a copyright, state law may not forbid others to copy that article. To forbid copying would interfere with the federal policy, found in Art. I, § 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain.²⁰¹

¹⁹⁸ 35 U.S.C. § 103 (2012). Obviousness is determined based on “(1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the art; and (4) objective considerations of nonobviousness.” *OSRAM Sylvania, Inc. v. Am. Induction Techs., Inc.*, 701 F.3d 698, 706 (Fed. Cir. 2012) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966)).

¹⁹⁹ 35 U.S.C. § 112 (2012); *see also* *SRI Int’l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (discussing this requirement).

²⁰⁰ *Qualitex*, 514 U.S. at 164–65.

²⁰¹ 376 U.S. 234, 237 (1964); *see also* *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231 (1964) (“An unpatentable article, like an article on which the patent has expired, is in the public domain and may be made and sold by whoever chooses to do so.”). Professor Mark McKenna summarized this position as follows:

[F]eatures that are within the subject matter of patent law . . . fall outside of trademark law’s reach not because of the consequences of trademark protection for particular competitors, but to preserve the

The Court specified that, even if a product design was nonfunctional and had acquired secondary meaning, state law could not forbid copying it, even if consumer confusion was likely to result.²⁰²

Twenty-five years later, the Court took a more nuanced view of the interrelationship between federal patent law and state unfair competition law in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*²⁰³ Although the Court in *Bonito Boats* recognized that its opinions in *Compco* and its companion case, *Sears, Roebuck & Co. v. Stiffel Co.*, spoke “in absolutist terms” regarding a constitutional right to copy, it rejected the idea that federal patent law ipso facto preempted “all state regulation of potentially patentable but unpatented subject matter.”²⁰⁴ Instead the Court favored a “pragmatic approach” to the preemption issue, noting that “[s]tate law is not displaced merely because the contract relates to intellectual property which may or may not be patentable; the states are free to regulate the use of such intellectual property in any manner not inconsistent with federal law.”²⁰⁵

In procedural terms, the Court’s reasoning shifted from a broad notion of field preemption to conflict preemption. Field preemption exists when “the federal interest [in the field] is so dominant that the federal system will be assumed to preclude enforcement of state laws on the same subject.”²⁰⁶ Conflict preemption exists when compliance with both state and federal law is impossible, or where the state law precludes the “accomplishment and execution

broader structure of the intellectual property system. [F]reedom to copy [is] the background legal rule to which patent law operates as a carefully circumscribed exception.

Mark P. McKenna, (*Dys*)*functionality*, 48 HOUS. L. REV. 823, 834 (2011).

²⁰² *Compco*, 376 U.S. at 238. The Court noted that, in such cases, state law could require precautions such as labeling to prevent confusion, but could not prohibit copying itself. *Id.* For a discussion of intermediate remedies provided to prevent confusion in the copying of functional product features, see *infra* text accompanying notes 302–09.

²⁰³ 489 U.S. 141 (1989).

²⁰⁴ *Id.* at 154 (citing *Sears, Roebuck*, 376 U.S. at 232).

²⁰⁵ *Id.* at 156 (quoting *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979)).

²⁰⁶ *Farina v. Nokia Inc.*, 625 F.3d 97, 115 (3d Cir. 2010). A federal law may also expressly preempt a state one when Congress says that it intends to displace state law on a given issue, in the text of the federal statute itself. See *Hillsborough Cty. v. Automated Med. Labs., Inc.*, 471 U.S. 707, 713 (1985); *Farina*, 625 F.3d at 115. The Patent Act does not include language indicating such an intent.

of the full purposes and objectives of Congress,” as expressed in the federal statute.²⁰⁷ In *Bonito Boats*, the court invalidated a Florida state law that prohibited the duplication of boat hull designs on the grounds that the statute granted rights “similar in scope and operation to the rights accorded [under federal patent law],” while exceeding many of its limitations.²⁰⁸ The Florida law undermined the purpose and objectives of the federal patent scheme. The Court distinguished the Florida statute from state laws prohibiting unfair competition and theft of trade secrets, both of which the Court characterized as peacefully co-existing with federal patent law.²⁰⁹

In each of these decisions—*Compco*, *Sears Roebuck*, and *Bonito Boats*—the Supreme Court interpreted the scope of federal patent law preemption, vis-à-vis a conflicting state statute. None of these cases interpreted the Lanham Act, the federal statute that dominates trademark law today. Moreover, none of these cases directly

²⁰⁷ *Farina*, 625 F.3d at 115 (citing *Hillsborough Cty.*, 471 U.S. at 713).

²⁰⁸ *Bonito Boats*, 489 U.S. at 158. The Court noted that the Florida law offered boat hull manufacturers monopolistic protection for their designs for an unlimited number of years, “without regard to their ornamental or technological merit.” *Id.* at 158–59; *see also id.* at 144–45 (quoting FLA. STAT. § 559.94 (1987)).

²⁰⁹ *See id.* at 155–56 (discussing state trade secret laws); *id.* at 157–58 (discussing unfair competition law). The Court had previously upheld state laws prohibiting theft of trade secrets, rejecting the claim that these laws were preempted by federal patent law. *See Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 474 (1974). State right of publicity laws have also raised preemption issues in the context of federal copyright law. Although the Supreme Court has not addressed this issue, most of the federal courts that have considered it have similarly found that right of publicity laws are not preempted by the federal Copyright Act. *See, e.g., Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1003–05 (9th Cir. 2001) (holding that plaintiff’s right of publicity claim was not preempted by federal copyright law, on the grounds that the subject matter protected by the respective statutes (persona versus work of authorship) were dissimilar); *Brown v. Ames*, 201 F.3d 654, 658 (5th Cir. 2000) (noting that a “*persona* does not fall within the subject matter of copyright—it does not consist of a ‘writing’ of an ‘author’ within the meaning of the Copyright Clause of the Constitution” (citation omitted)). *But see Maloney v. T3Media, Inc.*, 853 F.3d 1004 (9th Cir. 2017) (holding that plaintiff’s right-of-publicity claim was preempted by the Copyright Act). However, commentators have raised concerns about the intrusion of right of publicity and other state statutes into the realm of copyright law. *See generally* Joseph P. Bauer, *Addressing the Incoherency of the Preemption Provision of the Copyright Act of 1976*, 10 *VAND. J. ENT. & TECH. L.* 1 (2007) (arguing for expanded preemption of state law claims under the Copyright Act); Jennifer E. Rothman, *The Other Side of Garcia: The Right of Publicity and Copyright Preemption*, 39 *COLUM. J. L. & ARTS* 441 (2016); Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 *U.C. DAVIS L. REV.* 199 (2002).

confronted the scope or interpretation of the functionality doctrine in trademark law. The significance of the Lanham Act lies in its source: Both the Patent Act and the Lanham Act are creatures of Congress. As one commentator has observed: “Although it may be true that ‘[i]t is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time,’ it is equally true that, *as a matter of statutory law*, there is nothing to prevent Congress from altering this balance.”²¹⁰ None of these cases answers the question of whether and to what extent the Constitution—specifically the Patent and Copyright Clause²¹¹—creates a “right to copy” that overrides congressional attempts to regulate trade dress via the Lanham Act.

Although *Compco* and *Sears Roebuck* cited the Patent and Copyright Clause in finding a broad “right to copy” anything outside the scope of federal patent and copyright law,²¹² as discussed above, the Supreme Court quickly retreated from this bright-line rule. The Court has noted that, in drafting the Patent Act, Congress defined patentable subject matter to “include anything under the sun that is made by man.”²¹³ A broad constitutional right to copy such subject matter—whether or not it is patentable or functional—would render all forms of product design ineligible for protection as trade dress, in direct conflict with the plain language of the Lanham Act. The Lanham Act broadly defines trademarks to include any “symbol” or “device” that is used to “identify and distinguish” the goods of the producer from the goods of others, and “to indicate the source of the goods.”²¹⁴ The Supreme Court

²¹⁰ Theodore H. Davis, Jr., *Copying in the Shadow of the Constitution: The Rational Limits of Trade Dress Protection*, 80 MINN. L. REV. 595, 622 (1996) (emphasis added) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995)).

²¹¹ U.S. CONST. art. I, § 8, cl. 8.

²¹² *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 228 (1964).

²¹³ *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) (citing legislative history of the Patent Act); *see also Bonito Boats*, 489 U.S. at 154 (noting that “the broadest reading of [*Sears, Roebuck*] would prohibit the States from regulating the deceptive simulation of trade dress or the tortious appropriation of private information” and rejecting that interpretation).

²¹⁴ 15 U.S.C. § 1127 (2012) (defining the term “trademark”); *see also id.* § 1125(a) (creating a cause of action for infringement of unregistered marks, including trade dress).

has held that trade dress, including trade dress in the form of product design, falls within this definition.²¹⁵ No court has held that the Lanham Act's inclusion of trade dress within the definition of a trademark is unconstitutional.

The question therefore becomes whether and to what extent the functionality rule embedded in the Lanham Act is constitutionally compelled. The Supreme Court expressly declined to answer this question in *TrafFix*, a case that examined the significance of an expired utility patent in the context of a trade dress infringement claim filed under the Lanham Act.²¹⁶ The Court noted that, if a case arose in which the functionality rule failed to prevent the protection of trade dress that was “the practical equivalent of an expired utility patent,” then “that will be time enough to consider the matter.”²¹⁷ Arguably, *TrafFix* was such a case,²¹⁸ but the Court still declined to rule on the issue. Rather, the Court broadly construed the functionality doctrine, rejecting the concept of alternative designs, without elaborating upon the theoretical underpinnings of the rule. However, *TrafFix* at least implied that if trade dress protection under the Lanham Act had the practical effect of extending the life of a utility patent, it would undermine the purpose of the Patent and Copyright Clause.

The Constitution specifies that the lifetime of a patent must be “limited.”²¹⁹ Congress has determined that the limit is twenty years from the date of filing the patent application.²²⁰ Trademarks, on the other hand, have no expiration date. They are valid and enforceable so long as the trademark holder continues to use the mark

²¹⁵ *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209 (2000); *see also Qualitex*, 514 U.S. at 162 (“Since human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, this [statutory] language, read literally, is not restrictive.”).

²¹⁶ *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 35 (2001) (declining to decide whether the Patent Clause of the Constitution “prohibits the holder of an expired utility patent from claiming trade dress protection”).

²¹⁷ *Id.*

²¹⁸ *Id.* at 30 (“In the case before us, the central advance claimed in the expired utility patents . . . is the dual-spring design; and the dual-spring design is the essential feature of the trade dress MDI now seeks to establish and to protect.”).

²¹⁹ U.S. CONST. art. I, § 8, cl. 8.

²²⁰ 35 U.S.C. § 154(a)(2) (2012).

and does not abandon it.²²¹ Therefore, it is not surprising that the Supreme Court has historically been reluctant to allow trade dress protection to “tack on” to an expired utility patent.²²² Doing so may alter the terms of the “patent bargain” struck by an inventor who secures a temporary monopoly under the auspices of federal patent law.²²³ As the Court explained in *Kellogg* and *Singer*:

[O]n the expiration of a patent the monopoly granted by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property. It is upon this condition that the patent is granted. It follows . . . that on the termination of the patent there passes to the public the right to make the machine in the form in which it was constructed during the patent. We may therefore dismiss without further comment the [unfair competition] complaint as to the form in which the defendant made his machines.²²⁴

These cases preceded the federalization of trademark law, and, therefore, they did not need to (and did not) ground their reasoning in the Constitution. However, a strong case can be made that the Patent and Copyright Clause of the Constitution compels this result.²²⁵ Once an inventor has accepted the benefit offered under the

²²¹ Under the Lanham Act, the holder of a federally registered trademark may maintain that registration by filing a renewal application (attesting to continued use) and paying a specified fee every ten years. A trademark holder may renew the mark indefinitely so long as the mark has not been abandoned. 15 U.S.C. §§ 1058–1059 (2012). A mark is considered “abandoned” when its “use has been discontinued with intent not to resume such use” or when the mark becomes generic or “otherwise lose[s] its significance as a mark.” *Id.* § 1127.

²²² See *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 120 (1938); *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896).

²²³ *Kellogg*, 305 U.S. at 120 (quoting *Singer*, 163 U.S. at 185).

²²⁴ *Id.*

²²⁵ Courts have been more willing to allow the extension of Lanham Act protection to material that is or was previously the subject of a federal design patent, as compared to utility patents. Design patents may be awarded to protect any “new, original and ornamental design for an article of manufacture.” 35 U.S.C. § 171 (2012). As the Federal Circuit has noted: “[A] design patent, unlike a utility patent, limits protection to the ornamental design of the article.” *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293 (Fed. Cir. 2010). Not unlike trade dress law, design patent protection does not extend to functional designs. See *Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1460 (Fed. Cir. 1997)

Constitution and federal patent laws—the grant of a monopoly that will be protected and enforced for a finite period of time by the federal courts—he must consent to the cessation of that monopoly at the patent’s expiration. The cost of accepting a monopoly protected by the state is the public dedication of the underlying invention at the end of the monopoly. The expiration of the patent monopoly therefore should obviate the need for competitors to consider alternative designs. In other words, competitors should not need to “design around” a product configuration that is the subject of an expired utility patent, even if it has acquired secondary meaning and acts as a source identifier. When a product design feature is functional for this reason, then alternative designs need not be part of the equation. However, as discussed later, competitors should still have a duty to refrain from public deception in the marketing of these products and may need to take affirmative steps to prevent consumer confusion, even if the product design is functional.²²⁶ Moreover, most functionality cases do not involve a claim of trade dress protection asserted after the expiration of a utility patent. In these cases, fair competition, not patent law, should drive the doctrine.

(“A design or shape that is entirely functional, without ornamental or decorative aspect, does not meet the statutory criteria of a design patent.”). The scope of the functionality doctrine in the trade dress context, particularly in the post-*Traffix* era, is broader than the functionality doctrine in the context of design patent law. See Peter Lee & Madhavi Sunder, *Design Patents: Law Without Design*, 17 *STAN. TECH. L. REV.* 277, 282–83 (2013). However, the potential for conflict between the two federal statutes, the Lanham Act and the Patent Act, is significantly reduced in the context of design patents, as compared to utility patents, because the protections they afford are not at cross-purposes; if anything, they are duplicative of each other. More importantly, the constitutional concerns raised by extending trade dress protections to product features that were previously the subject of a design patent are simply not as significant as those created by extending trade dress protection to product features contained within an expired utility patent. Unlike federal laws protecting utility patents, design patent laws do not go to the heart of the constitutional admonition to “promote the [p]rogress of . . . useful [a]rts” by protecting, for limited times, the “[d]iscoveries” of inventors. U.S. CONST. art. I, § 8, cl. 8. Therefore, the two forms of patent protection are not (and should not be) entitled to the same level of deference, in terms of trademark protection.

²²⁶ See *infra* text accompanying notes 302–09.

b) Patent Law's Impact on Functionality with Regard to Product Features Outside the Scope of Patent Law

Although the *TrafFix* Court appeared to rule out consideration of alternative designs from the functionality equation generally, and not just in cases involving expired utility patents, the Court did not hold that the Constitution compelled this result.²²⁷ For the reasons discussed below, this Section argues that the broad conception of functionality articulated in *TrafFix*, one which focuses on utilitarianism rather than preservation of fair competition, is neither necessary nor effective to police the boundary between patent and trademark law. The key distinction between the two visions of functionality is the relevance (or lack thereof) of alternative designs, when the party claiming trade dress protection has not previously sought and obtained patent protection for the relevant product design or feature.

As discussed above, the Supreme Court articulated but quickly abandoned the notion that the Patent and Copyright Clause precludes any form of intellectual property protection for subject matter that is not entitled to a patent or a copyright.²²⁸ In retreating from this position, the Court cited trade secret law as an example of concurrent state and federal protection for subject matter that may or may not be patentable.²²⁹ Trade secret law has been a longstanding alternative to federal patent protection. Congress has tolerated the existence of state trade secret laws for more than one hundred years and has never indicated that they threaten or are inconsistent with federal patent law.²³⁰ Rather, Congress has recently

²²⁷ See discussion *supra* notes 116–21.

²²⁸ See *supra* notes 201–09 and accompanying text.

²²⁹ *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 155–56 (1989) (citing *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 484–90 (1974)). In describing its decision in *Kewanee*, the Court noted that even though “state law protection was available for ideas which clearly fell within the subject matter of patent,” the “nature and degree of state protection did not conflict with the federal policies of encouragement of patentable invention and the prompt disclosure of such innovations.” *Id.* at 155.

²³⁰ *Kewanee Oil*, 416 U.S. at 493 (“Trade secret law and patent law have co-existed in this country for over one hundred years.”); see also *id.* at 494 (Marshall, J., concurring) (observing that “[s]tate trade secret laws and the federal patent laws have co-existed for many, many years,” during which “Congress has repeatedly demonstrated its full awareness of the existence of the trade secret system, without any indication of disapproval”).

chosen to expand trade secret protections by federalizing trade secret law.²³¹

Many product features or designs that qualify for trade secret protection would also be considered functional under trademark law, even if they do not meet the requirements for patentability. In other words, a product feature that is functional in a utilitarian sense—one that is “essential to the use or purpose of the article” or affects its cost or quality²³² may also be a trade secret. Rarely would an “arbitrary flourish”²³³ be the subject of trade secret protection. If the Constitution precluded all other forms of intellectual property protection of “functional” subject matter that was not patentable, trade secret law would surely have to go. Instead, the Supreme Court has explicitly held that state laws prohibiting theft of trade secrets do not conflict with, and are not preempted by, federal patent law.²³⁴

²³¹ Defend Trade Secrets Act of 2016, Pub. L. 114–153, 130 Stat. 376 (codified in scattered sections of 18 U.S.C.). The Defend Trade Secrets Act was passed by a unanimous vote in the U.S. Senate and was ratified in the U.S. House of Representatives by a vote of 410 to 2. *S.1890 - Defend Trade Secrets Act of 2016*, CONGRESS.GOV, <https://www.congress.gov/bill/114th-congress/senate-bill/1890/all-actions?overview=closed&q=%7B%22roll-call-vote%22%3A%22all%22%7D> [<https://perma.cc/B3QK-53SX>] (last visited Mar. 31, 2017). The federal act essentially codified the Uniform Trade Secrets Act, a model rule that has been adopted by forty-eight states. David Enzminger, *President Obama Signs Federal Defend Trade Secrets Act*, IPWATCHDOG (May 13, 2016), <http://www.ipwatchdog.com/2016/05/13/obama-signs-defend-trade-secrets-act/id=69102/> [<https://perma.cc/ZU7Q-GFYX>]. Like the Lanham Act, federal jurisdiction for claims brought under the Defend Trade Secrets Act is based on the Commerce Clause. *See* 18 U.S.C. § 1836(b)(1) (2012).

²³² *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001).

²³³ *Id.* at 34 (noting that the relevant design feature was not an “arbitrary flourish” but instead the “reason the device worked,” therefore rendering it functional).

²³⁴ *See generally Kewanee Oil*, 416 U.S. 470. Numerous federal circuits have also held that the Copyright Act does not preempt claims for misappropriation of a trade secret. *See, e.g.,* *Globeranger Corp. v. Software AG, Inc.*, 836 F.3d 477, 488 (5th Cir. 2016); *Seng-Tiong Ho v. Taflove*, 648 F.3d 489, 503–04 (7th Cir. 2011); *Stromback v. New Line Cinema*, 384 F.3d 283, 302–05 (6th Cir. 2004); *Dunn & Bradstreet Software Servs, Inc. v. Grace Consulting, Inc.*, 307 F.3d 197, 217–18 (3d Cir. 2002); *DSC Commc’ns Corp. v. Pulse Commc’ns Corp.*, 170 F.3d 1354, 1365 (Fed. Cir. 1999); *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1549–50 (11th Cir. 1996); *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 846–48 (10th Cir. 1993); *Trandes Corp. v. Guy F. Atkinson Co.*, 996 F.2d 655, 658–60 (4th Cir. 1993); *Comput. Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 716–21 (2d Cir. 1992); *S.O.S., Inc. v. Payday, Inc.*, 886 F.2d 1081, 1090 n.13 (9th Cir. 1989).

Moreover, although not all trade secrets meet the requirements of patentability, many do. Therefore, inventors may choose between these intellectual property regimes (trade secret or patent law) when seeking to protect their inventions, even if the requirements of patentability are met.²³⁵ Whereas patent law offers a guaranteed monopoly for a finite period of time,²³⁶ trade secret law, somewhat like trademark law, offers more limited protection with no expiration date.²³⁷ The majority opinion in *Kewanee Oil* surmised that inventors would rarely choose trade secret protection over patent law, because of the superior protections afforded under the federal patent regime.²³⁸ However, as Justice Marshall noted at the time,²³⁹ and as various commentators have argued,²⁴⁰ the choice of patent law over trade secret law is not a foregone conclu-

²³⁵ *Kewanee Oil*, 416 U.S. at 491–92 (holding that federal patent law does not preempt state trade secret laws, even if the underlying subject matter is patentable).

²³⁶ The Supreme Court observed:

In consideration of [an invention's] disclosure and the consequent benefit to the community, the patent is granted. An exclusive enjoyment is guaranteed [the inventor] for seventeen years, but upon expiration of that period, the knowledge of the invention inures to the people, who are thus enabled without restriction to practice it and profit by its use.

Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 151 (1989) (quoting *United States v. Dubilier Condenser Corp.*, 289 U.S. 178, 186–87 (1933)).

²³⁷ See *Kewanee Oil*, 416 U.S. at 489–90 (noting that in many respects trade secret law provides weaker protections than patent law); 3 LOUIS ALTMAN & MALLA POLLACK, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 14:15 (4th ed. 2016) (describing key differences between protections afforded under patent and trade secret law).

²³⁸ *Kewanee Oil*, 416 U.S. at 490 (“The possibility that an inventor who believes his invention meets the standards of patentability will sit back, rely on trade secret law, and after one year of use forfeit any right to patent protection [due to disclosure] is remote indeed.” (citation omitted)).

²³⁹ *Id.* at 493–94 (Marshall, J., concurring) (noting that, under some circumstances, trade secret protections may be “clearly superior to the [seventeen]-year monopoly afforded by the patent laws”).

²⁴⁰ See, e.g., Andrew Beckerman-Rodau, *The Choice Between Patent Protection and Trade Secret Protection: A Legal and Business Decision*, 84 J. PAT. & TRADEMARK OFF. SOC'Y 371, 377 (2002); Andrew A. Schwartz, *The Corporate Preference for Trade Secret*, 74 OHIO ST. L.J. 623, 624 (2013) (arguing that corporations should prefer trade secret over patent protection of intellectual property); Mimi C. Goller, *Is A Padlock Better Than A Patent?: Trade Secrets vs. Patents*, 71 WIS. LAW., May 1998, at 20; R. Mark Halligan, *Trade Secrets vs. Patents: The New Calculus*, 2 LANDSLIDE, no. 7, July–Aug. 2010, at 10 (discussing relative merits of trade secret vs. patent protection).

sion, nor is it a rarity for an inventor to choose trade secret over patent law (or copyright law) when both are viable options.²⁴¹ Due to the emphasis on secrecy in trade secret law (as the name implies), proffering trade secret protection as an alternative to the patent bargain arguably does more to undermine the patent law incentive to invent and disclose²⁴² than trade dress protection does, especially given that trade dress protection is limited by the functionality doctrine.

In upholding the viability of trade secret law in the face of the federal patent regime, as noted above, the Supreme Court emphasized the limitations of trade secret protection, in comparison to the temporary monopoly granted under federal patent law.²⁴³ By contrast, in striking down the Florida law protecting boat hull designs in *Bonito Boats*, the Court emphasized that the state statute offered protections that were more, not less, monopolistic than those available under federal patent law.²⁴⁴ The limitations of trademark law, which does not simply prohibit the copying of trade dress, are key to its peaceful coexistence with the Patent and Copyright Clause.

The protection afforded to trade dress under the Lanham Act is (or should be) more akin to trade secret law than the Florida statute in *Bonito Boats*, for two basic reasons. First, trade dress is protectable under trademark law only if it is distinctive—that is, it is acting as a source identifier for the underlying product.²⁴⁵ Moreover, the types of trade dress most commonly subjected to a functionality bar—color and product design—are protectable only with a show-

²⁴¹ See also *GlobeRanger Corp. v. Software AG U.S., Inc.*, 836 F.3d 477, 483–84 (5th Cir. 2016) (noting that a creator may choose between the protections of trade secret law or federal copyright law, depending on whether she more highly values the lack of disclosure requirements under the trade secret regime or the guaranteed yet limited monopoly extended under copyright law).

²⁴² See *Kewanee Oil*, 416 U.S. at 494 (Marshall, J., concurring) (“I have no doubt that the existence of trade secret protection provides in some instances a substantial disincentive to entrance into the patent system, and thus deprives society of the benefits of public disclosure of the invention which it is the policy of the patent laws to encourage.”).

²⁴³ *Id.* 489–90 (majority opinion).

²⁴⁴ *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151 (1989).

²⁴⁵ See *supra* note 68 and accompanying text.

ing of *acquired* distinctiveness.²⁴⁶ The requirements of patentability, as described above, do not include a finding of distinctiveness, either inherent or acquired. Second, and more importantly, trademark protections are not monopolistic in the same manner as patents (and copyrights): trademark rights are not held “in gross.”²⁴⁷ Because proof of trademark infringement requires proof of a likelihood of consumer confusion, not just copying, it does not confer the same type of monopoly accorded to inventors under patent law. Nevertheless, many useful (but not patentable) product features that might otherwise be considered distinctive trade dress are not protectable under trademark law, as a result of the functionality doctrine. In this context, however, the driving policy consideration behind the doctrine is or should be the preservation of fair competition, not a perceived conflict with patent law.

Some recent developments in trademark law have threatened to undermine its limitations, blurring the distinctions between traditional trademark protection and the monopolies conferred by patents and copyrights.²⁴⁸ The federal trademark dilution statute, in particular, comes dangerously close to conferring monopolies on trademark holders, with little to no justification or benefit.²⁴⁹ How-

²⁴⁶ See *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 206 (2000) (holding that “[d]esign, like color, is not inherently distinctive”).

²⁴⁷ See *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918) (concluding that a trademark right is not “a right in gross or at large, like a statutory copyright or a patent for an invention, to either of which, in truth, it has little or no analogy”); see also *Desai & Rierson*, *supra* note 6, at 1800–01 (observing that “a fundamental tenet of trademark law has always been that, unlike copyrights and patents, trademarks are not held ‘in gross,’ and therefore the trademark holder’s right to prohibit others’ use of the mark is limited to circumstances in which that use harms consumers, as determined via the ‘likelihood of confusion’ standard”).

²⁴⁸ See, e.g., *Playboy Enters., Inc. v. Netscape Commc’ns Corp.*, 354 F.3d 1020, 1024–29 (9th Cir. 2004) (reversing district court grant of summary judgment on trademark infringement claim due to existence of disputed issues of fact regarding initial interest confusion); *Brookfield Commc’ns, Inc. v. West Coast Ent’t Corp.*, 174 F.3d 1036, 1057–58 (9th Cir. 1999) (finding likelihood of success on the merits of trademark infringement claim based on a theory of initial interest confusion); *Ferrari S.P.A. Esercizio v. Roberts*, 944 F.2d 1235, 1245 (6th Cir. 1991) (finding trademark infringement, despite the absence of consumer confusion at the point of sale, based on a theory of post-sale confusion).

²⁴⁹ See Sandra L. Rierson, *The Myth and Reality of Dilution*, 11 DUKE L. & TECH. REV. 212, 291 (2012) (observing that “[d]ilution laws come close to granting trademark rights ‘in gross’”). The article argued that the benefits of dilution law are outweighed by the costs that it imposes on consumers and competitors. *Id.* at 212–304.

ever, federal trademark dilution law applies only to “famous” marks.²⁵⁰ Trade dress in the form of product design is considered a weak form of trademark,²⁵¹ and therefore rarely if ever should be entitled to protection under federal trademark dilution law.²⁵² Therefore, in practice, trademark dilution law should have a minimal impact on the doctrine of functionality, given its general inapplicability to forms of trade dress that could be deemed functional.

The final reason for relying on competition policy, rather than patent law incentives, to define the boundaries of functionality is a practical one. If the core purpose of the trademark functionality doctrine is to police the boundary between patent and trademark law (even in cases involving non-patentable subject matter), then it should be more clearly linked to the contours of the patentability determination rather than vague notions of utility. Many types of trade dress deemed functional under *Inwood*’s two-part test appear to have little if any connection to the concept of patentability. The color blue, for example, was deemed functional when applied to a surgical probe because of its visibility during surgical procedures.²⁵³ It is difficult to see how the constitutional purpose of spurring innovation and disclosure of invention is aided by denying trade dress protection to the maker of a distinctive blue surgical probe, when the benefits conferred by the color blue could just as easily have been achieved through the use of alternative colors.

²⁵⁰ 15 U.S.C. § 1125(c)(2)(A) (2012).

²⁵¹ See *Wal-Mart Stores*, 529 U.S. at 213 (2000) (noting that “[c]onsumers are aware . . . that, almost invariably, even the most unusual of product designs . . . is intended not to identify the source, but to render the product itself more useful or more appealing”).

²⁵² See Rierson, *supra* note 249, at 298–300, 307–08 (arguing that dilution law is particularly inappropriate as applied to trade dress infringement claims, and that the federal dilution statute should be amended to eliminate trade dress dilution claims); see also Robert G. Bone, *A Skeptical View of the Trademark Dilution Revision Act*, 11 *INTELL. PROP. L. BULL.* 187, 196–98 (2007) (criticizing the Trademark Dilution Revision Act for extending dilution protection to trade dress); Paul Heald, *Sunbeam Products, Inc. v. The West Bend Co.: Exposing the Malign Application of the Federal Dilution Statute to Protect Product Configuration*, 5 *J. INTELL. PROP. L.* 415, 423–24 (1998) (arguing that the Federal Trademark Dilution Act should not be construed to apply to trade dress).

²⁵³ See *ERBE Elektromedizin GmbH v. Canady Tech. LLC*, 629 F.3d 1278, 1289 (Fed. Cir. 2010).

3. Functionality and Alternative Designs

As described above, a competitor's access to alternative designs, enabling it to effectively compete without creating a likelihood of confusion with the plaintiff's trade dress, was for many years a central focus in functionality analysis.²⁵⁴ However, the Supreme Court's decision in *TrafFix* has, at a minimum, called into question the relevance of alternative designs in the functionality doctrine. According to most circuits, *TrafFix* held that alternative designs are irrelevant to the functionality equation, except in cases of aesthetic functionality.²⁵⁵ By removing this piece of the functionality equation in all cases—not just those that implicate a direct conflict with patent law—the Court has unnecessarily broadened the doctrine and hindered its ability to enhance free and fair competition.

In comparing word marks and trade dress, Professor Graeme Dinwoodie argued that the exclusionary effect of trademark protection in words, measured in competitive terms, is slight compared to the potential exclusionary effect of extending trademark protection to aspects of product design.²⁵⁶ Professor Dinwoodie explained: “[I]t is easy to adopt an alternative label for a competing product; the part of the lexical commons that is appropriated by the first producer is very small.”²⁵⁷ By comparison, “the supply of shapes by which to design a particular product is more confined.”²⁵⁸ However, the relative availability of competitively acceptable alternatives—be they words or forms of trade dress—is a fact-intensive inquiry that should be examined in each individual case.

Whether a host of competitive alternatives (or none) exists varies from case to case, regardless of whether the source identifier at issue is in the form of a word or trade dress. As described above, the genericism doctrine comes into play, particularly in cases of genericide, because there is no competitively acceptable alternative to the trademarked word.²⁵⁹ Of course there would be, in theory, a

²⁵⁴ See *supra* notes 91–102 and accompanying text.

²⁵⁵ See *supra* notes 132–34 and accompanying text.

²⁵⁶ Dinwoodie, *supra* note 62, at 632–37.

²⁵⁷ *Id.* at 634.

²⁵⁸ *Id.* at 637.

²⁵⁹ See *supra* notes 176–90 and accompanying text.

host of words that the competitor could adopt as his own trademark, but they would not have any significance in the mind of the consumer. For example, if Bayer's competitor had called its drug the fanciful name Zinga, it would not have been sued for infringing the Aspirin trademark. However, it also would have been at a distinct competitive disadvantage, because consumers would not have known what "Zinga" was. In the *Qualitex* case, by contrast, the court noted that competitors could choose among a host of alternative colors for their dry-cleaning pads, all of which would serve the utilitarian purpose of hiding stains.²⁶⁰ Even though the plaintiff's specific color (green-gold) was in some sense utilitarian, it was not functional because there were several competitively equivalent substitutes.²⁶¹

In the functionality context, when the extension of trade dress protection would not effectively extend the life of an expired utility patent, the court should examine (1) whether any alternatives to the plaintiff's trade dress exist that would not negatively impact the cost or the quality of the product, and (2) whether forcing the defendant to choose one of those alternatives would have a negative competitive effect. In some contexts, as Professor Dinwoodie observed, the range of alternatives will be limited or perhaps nonexistent.²⁶² In others, however, they may be plentiful.

Eliminating the courts' ability to perform this analysis yields limited benefits and may impose significant costs. Restricting the functionality doctrine to the narrow question of whether a product feature is utilitarian is not necessary to avoid a conflict with patent law because, as explained above, the rule is over-inclusive.²⁶³ Nor is such a rule warranted by the policy of preserving free competition. Sometimes choosing a substitute for plaintiff's distinctive trade dress is competitively costly to the defendant; sometimes it is not. Allowing a defendant to copy the plaintiff's distinctive trade dress with no consideration as to whether it is competitively necessary to do so, when a likelihood of confusion may result, may undermine rather than foster fair competition.

²⁶⁰ *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159, 166 (1995).

²⁶¹ *Id.*

²⁶² Dinwoodie, *supra* note 62, at 637.

²⁶³ See *supra* notes 228-53 and accompanying text.

C. *The Genericism and Functionality Doctrines Should Not Enable Free Riding and Consumer Confusion*

As noted above, the doctrines of genericism and functionality both derive from the common-law tort of unfair competition.²⁶⁴ The doctrines seek to limit the scope of trademark protection so that it does not unfairly limit the ability to compete. Logically, when the doctrines have the opposite effect—when the generic or functional label *enables* rather than *prevents* unfair competition—courts should be able and willing to take steps designed to prevent that result. Consumer confusion imposes costs on consumers and trademark holders alike, and therefore all aspects of trademark law should seek to prevent it.²⁶⁵

Aspects of both the genericism and functionality doctrines, particularly in more recent cases, tolerate consumer confusion (or the potential for it) to varying degrees. For example, modern decisions interpreting the doctrine of functionality have largely abandoned unfair competition protections for designs or product features deemed functional. As to generic words or phrases, the “once generic always generic” mantra also results in the failure to protect words that have acquired (or reacquired) secondary meaning. As a result of both policies, consumers may be confused and trademark holders may be harmed.

1. *Genericism and the Problem of Trademark Incapacity or De Facto Secondary Meaning*

The doctrine of trademark incapacity,²⁶⁶ or “de facto secondary meaning,”²⁶⁷ presents itself in two aspects of the genericism

²⁶⁴ See *supra* Sections I.A–I.B.

²⁶⁵ See Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2124 (2004) (noting that, when consumer confusion results, the cost of a “false negative error”—failure to extend trademark protection when it is due—is more costly than a “false positive error,” i.e., extending trademark protection when it is not warranted); Desai & Rierson, *supra* note 6, at 1798–99 (explaining search cost rationale for trademark protection); Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L. J. 461, 482 (2005) (explaining how trademark infringement increases consumer search costs).

²⁶⁶ Altman & Pollock, *supra* note 237, § 20:33; Jake Linford, *A Linguistic Justification for Protecting ‘Generic’ Trademarks*, 17 YALE J. L. & TECH. 110, 113–14 (2015) (defining trademark incapacity as a doctrine under which “courts dismiss evidence that consumers

doctrine. First, numerous courts have held that, once a name or term has been deemed generic (either formally, by a court, or informally, in a dictionary), it can never function as a trademark, even if it subsequently acquires distinctiveness in the minds of consumers.²⁶⁸ Second, in determining the trademark significance of a word in the first instance, courts that have placed a word or term in the generic category will often ignore or refuse to consider evidence suggesting that its primary significance is that of a source identifier (the traditional definition of a trademark).²⁶⁹ Such cases beg the question of how a word or term can truly be generic if evidence suggests that the primary significance of the term is that of a source identifier in the commercial marketplace. Some degree of consumer confusion is bound to result when courts decline to pro-

perceive a [generic] term as source-identifying” on grounds that such secondary meaning is “legally insignificant”).

²⁶⁷ Desai & Rierson, *supra* note 6, at 1831 (noting that “‘de facto’ secondary meaning . . . is the legal equivalent of no secondary meaning”).

²⁶⁸ See, e.g., *Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 810–12 (2d Cir. 1999) (“No manufacturer can take out of the language a word . . . that has generic meaning as to a category of products and appropriate it for its own trademark use . . .” (citations omitted)); *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 375–76 (1st Cir. 1980) (“No amount of purported proof that a generic term has acquired a secondary meaning associating it with a particular producer can transform that term into a registrable trademark.” (citations omitted)). In his treatise, McCarthy wrote that “[o]nly in an extraordinarily rare case could a name once recognized in the past as a generic name be raised from the public domain to become a trademark by a change in consumer usage over a significant period of time.” 2 MCCARTHY, *supra* note 63, § 12:11. Under McCarthy’s reasoning, only old terms that are “generally unknown in current usage” would be subject to reappropriation as a trademark. *Id.*

²⁶⁹ See, e.g., *Blinded Veterans Ass’n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1045 n.22 (D.C. Cir. 1989) (“A generic term that acquires de facto secondary meaning is still not afforded trademark protection.” (citing 2 MCCARTHY, *supra* note 63, at § 12:15)); *Beer Nuts, Inc. v. Clover Club Foods Co.*, 805 F.2d 920, 924 n.4 (10th Cir. 1986) (“Trademarks that have become generic are subject to cancellation even if they have acquired a secondary meaning.”); *Surgicenters of Am., Inc. v. Med. Dental Surgeries, Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979) (noting that a generic term “cannot become a trademark under any circumstances”); *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 79 (7th Cir. 1977) (“[E]ven proof of secondary meaning . . . cannot transform a generic term into a subject for trademark.”); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (holding that secondary meaning cannot save a generic term); *CES Publ’g Corp. v. St. Regis Publ’ns, Inc.*, 531 F.2d 11, 15 (2d Cir. 1975) (stating that “merely descriptive” terms can be “rescued as trademarks” via proof of secondary meaning, but generic terms cannot).

tect words or phrases as trademarks when, as a practical matter, they are functioning in that capacity.²⁷⁰

a) The Pitfalls of “[L]inguistic [G]rave-[D]igging”²⁷¹

The “once generic, always generic” doctrine holds that, if a word has functioned in the lexicon as a generic term at any point in time, the word can never be protected as a trademark, even if its meaning has evolved such that few people are even aware of its generic meaning. In linguistic terms, the law ignores the reality of “semantic shift,” the process by which words change in meaning.²⁷² More accurately stated, the law recognizes semantic shift in only one direction: the shift that occurs when a trademark loses its source-identifying significance and becomes a generic term, commonly known as genericide.²⁷³ However, when a word evolves in the opposite direction—a semantic shift known as “restriction”²⁷⁴—the law typically provides no protection for the relevant word or term, even when consumers perceive it as a source identifier.

For example, the Second Circuit declined to extend protection to the term “Hog” as applied to a motorcycle manufactured by Harley Davidson, despite evidence that it was functioning as a

²⁷⁰ Desai & Rierison, *supra* note 6, at 1833 (noting that “[i]f the ‘primary significance’ of a term in the commercial context is that of a source identifier, consumers generally do not benefit when competitors are allowed to use the word generically”).

²⁷¹ Professor Jake Linford referred to the process by which courts rely on outdated meanings of terms in dictionaries and similar sources as “linguistic grave-digging.” Linford, *supra* note 266, at 146. Similarly, trademark attorney Jerre Swann referred to this phenomenon as “generic bones in . . . the closet.” Swann, *supra* note 169, at 654.

²⁷² Linford, *supra* note 266, at 113 (defining semantic shift); *see also* Desai & Rierison, *supra* note 6, at 1839 (discussing the phenomenon of “hybrid” trademarks and noting that “[d]espite trademark holders’ best efforts to the contrary, a trademark is much like any other word, and therefore its meaning and use—depending on the context—will evolve over time”).

²⁷³ *See* Desai & Rierison, *supra* note 6, at 1821–22 (describing the process of genericide); *see also* Linford, *supra* note 266, at 149–50 (describing and redefining the doctrine as “generislide”).

²⁷⁴ Linford, *supra* note 266, at 115 (explaining that “restriction” occurs when a word “undergoes a shift in meaning from a broad designator for all members within a category to a prototypical member of the category”).

mark.²⁷⁵ In doing so, the court relied on evidence of “generic” use of the term in dictionaries and in the media for decades preceding the word’s evolution as a mark.²⁷⁶ The Second Circuit reasoned that “[t]he public has no more right than a manufacturer to withdraw from the language a generic term, already applicable to the relevant category of products, and accord it trademark significance, at least as long as the term retains some generic meaning.”²⁷⁷

The courts’ refusal to recognize the evolution of the lexicon (or “semantic shift”) elevates form over substance. If the public can divest a word of its trademark significance by transforming it into a generic word (via the process of genericide), then it should also be able to invest a term previously considered generic with acquired distinctiveness.²⁷⁸ Like the tides, the meaning of language both ebbs and flows. However, as noted above, courts have been reluctant or unwilling to recognize that “[l]iving languages are not static,”²⁷⁹ at least when assessing the trademark significance of previously generic words.

Although courts in a limited number of cases have allowed words previously considered generic to function as trademarks, the courts have done so only under a narrow set of circumstances,²⁸⁰ typically when the generic meaning of the words has been all but obliterated.²⁸¹ As some commentators have argued, courts should

²⁷⁵ *Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 810–12 (2d Cir. 1999); *see also* Linford, *supra* note 266, at 141 (citing use of the term “Hog” in *Harley Davidson* as an example of restriction).

²⁷⁶ *Harley Davidson*, 164 F.3d. at 810–11 & n.8.

²⁷⁷ *Id.* at 812.

²⁷⁸ *See* Swann, *supra* note 169, at 653 (arguing for a genericism doctrine that would give “full reign to the dynamics of language”).

²⁷⁹ Linford, *supra* note 266, at 131.

²⁸⁰ Courts have been slightly more willing to accord protection to generic words that once functioned as trademarks, fell victim to genericide, and then reacquired source-identifying significance. *See, e.g.*, *Singer Mfg. Co. v. Briley*, 207 F.2d 519, 520 & n.3 (5th Cir. 1953) (holding that Singer could function as a trademark for sewing machines, because the company had “recaptured [the name] from the public domain”); *Goodyear Tire & Rubber Co. v. H. Rosenthal Co.*, 246 F. Supp. 724, 729 (D. Minn. 1965) (holding that Goodyear Rubber was a valid trademark, with proof of secondary meaning, despite prior finding of genericness); *see also* Desai & Rierson, *supra* note 6, at 1832 (discussing cases).

²⁸¹ *See, e.g.*, *Miller Brewing Co. v. Falstaff Brewing Corp.*, 655 F.2d 5, 8 n.2 (1st Cir. 1981) (“Where a generic association of a word or term has become obsolete and is

apply the primary significance test to determine whether a word or term is functioning as a trademark in the collective mind of the consuming public, regardless of whether the word, at some previous point in time, would have been considered generic.²⁸² Currently, they do not.²⁸³

The Lanham Act does not bar courts from extending trademark protection to formerly generic words or terms. Arguably, their failure to do so violates the plain language of the Act.²⁸⁴ The Lanham Act provides only one definition of “generic” terms that are not subject to protection: “The primary significance of the registered mark to the relevant public . . . shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.”²⁸⁵ Although this provision specifically relates to mark cancellation, the text does not suggest a different definition of “generic” in the

discoverable only by resort to historical sources or dictionaries compiled on historical principles to preserve from oblivion obsolete words, then, from the viewpoint of trademark and like law, the word or term is no longer a generic word.”). One commentator has characterized this standard as “so high as to be practically insurmountable.” See Peter J. Brody, Comment, *Reprotection for Formerly Generic Words*, 82 U. CHI. L. REV. 475, 491 (2015).

²⁸² See Desai & Rierson, *supra* note 6, at 1832–33 (arguing that competitors should not be allowed to use a word generically if “the ‘primary significance’ of a term in the commercial context is that of a source identifier”); Linford, *supra* note 266, at 162–66 (arguing that courts should apply the primary significance test to determine whether formerly generic words have attained trademark significance); Brody, *supra* note 281, at 508 (concluding that the primary significance test embodied in the Lanham Act should be used as the test to determine whether a word or term should be considered generic “in all instances”); cf. ALTMAN & POLLACK, *supra* note 266, § 20:33 (arguing that previously generic words should be protected as marks if there has been a “complete transformation” of their meaning).

²⁸³ See, e.g., *Microsoft Corp. v. Lindows.com, Inc.*, No. 01-CV 02115-ORD, 2004 WL 329250, at *2 (W.D. Wash., Feb. 10, 2004) (refusing to instruct the jury that, “even if [Microsoft’s Windows trademark] were generic prior to November 1985, the trademark would nonetheless be valid today so long as the primary significance of the term today is not generic”).

²⁸⁴ The Second Circuit observed: “The ‘primary significance test’ is the law of the land; it was adopted by the Supreme Court in *Kellogg Co. v. National Biscuit Co.*, and subsequently codified by Congress in the Trademark Clarification Act of 1984.” *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 144 (2d Cir. 1997) (citations omitted).

²⁸⁵ 15 U.S.C. § 1064(3) (2012). This section of the Lanham Act relates specifically to mark cancellation on the grounds that the mark has become generic. No alternative definition of “generic” appears elsewhere in the Act.

context of mark registration or in terms of protecting unregistered trademarks. For the policy reasons stated above and as a matter of statutory interpretation, the primary significance of a putative mark in the commercial marketplace, not its etymological history, should determine whether it is eligible for trademark protection.

b) Rethinking De Facto Secondary Meaning

Another context in which the genericism doctrine currently declines to extend protection to putative marks, under circumstances that could lead to a likelihood of confusion, relates specifically to the use of marks that fall close to the line demarcating the boundary between generic and descriptive. These marks are perhaps best characterized as “highly descriptive,” because, on their face, they look like descriptive word marks: They “convey [an] immediate idea of the ingredients, qualities or characteristics of the goods.”²⁸⁶ Examples of highly descriptive terms found to be generic include Surgicenters,²⁸⁷ Lite Beer,²⁸⁸ Filipino Yellow Pages,²⁸⁹ and Diet Chocolate Fudge Soda.²⁹⁰ In all of these cases, courts have found that the seemingly descriptive name referred to a product genus/class of goods rather than a species/particular product. As explained by the court in *A.J. Canfield Co. v. Honickman*, “some terms so directly signify the nature of the product that interests of competition demand that other producers be able to use them even if terms have or might become identified with a source”²⁹¹ In other words, “[c]ourts refuse to protect a generic term because competitors need it more to describe their goods than the claimed [mark holder] needs it to distinguish its goods from others.”²⁹² Of course, competitors could choose an inherently distinctive mark to denote their own products, but courts have fo-

²⁸⁶ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976).

²⁸⁷ *Surgicenters of Am., Inc. v. Med. Dental Surgeries, Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979).

²⁸⁸ *See Miller Brewing Co. v. G. Heileman Brewing Co., Inc.*, 561 F.2d 75, 80 (7th Cir. 1977) (finding “Lite Beer” to be generic).

²⁸⁹ *Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999).

²⁹⁰ *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 297 (3d Cir. 1986).

²⁹¹ *Id.* at 304.

²⁹² *Id.*

cused on their need to use the putative mark for its descriptive properties.

As the court recognized in *Canfield*, denying protection to marks that have acquired distinctiveness imposes costs on consumers and on the trademark holder.²⁹³ It is unclear why it is necessary to use the blunt instrument of genericism in this context to preserve competitors' ability to "describe their goods."²⁹⁴ That is, of course, the primary purpose of the fair use doctrine.²⁹⁵ Presumably, a competitor can describe his goods using the same or similar words as a descriptive trademark without committing trademark infringement, even if there are few other words available to describe the relevant goods. The claim of infringement would be viable only if the competitor chose to use the same descriptive/generic name as its own trademark. To the extent the fair use doctrine is not broad enough to allow for robust competition in this regard, a better solution may be to expand the scope of fair use rather than declare the relevant mark generic. At a minimum, as discussed below, marks that fall into this category should receive some degree of protection from unfair competition and passing off, even if deemed generic.²⁹⁶

2. Courts Should Prevent Unfair Competition Even If Trademarks Are Deemed Functional or Generic

As previously discussed, under the common law and under the Lanham Act, generic words or phrases and functional product features or designs are not entitled to protection as trademarks. However, common law courts nonetheless ordered defendants to take steps to ensure that a competitor's use of generic words or phrases and/or functional product features did not result in deliberate passing off or even unintentional consumer confusion. Unfortunately, this common-law tradition has somewhat faded in the context of generic words, and all but disappeared in the functionality context.

²⁹³ *Id.* at 308; see also Desai & Rierson, *supra* note 6, at 1830 ("When secondary meaning is established and the putative mark is functioning as a source-identifier, confusion and inefficiency may result when the mark is deemed 'generic' and free for all to use.").

²⁹⁴ *A.J. Canfield Co.*, 808 F.2d at 304.

²⁹⁵ See *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1041–43 (9th Cir. 2010) (defining and applying descriptive fair use doctrine).

²⁹⁶ See *infra* notes 297–309 and accompanying text.

These cases should not be controversial. A court dispensing equitable remedies (which are typical in trademark infringement cases) should shape such remedies in a manner sufficient to prevent the consumer fraud and unfair competition that may result when words or product features have acquired distinctiveness, but nonetheless cannot be protected from trademark infringement as a result of the genericism or functionality doctrine.

a) Intermediate Protection for Generic Words

Some of the most well-known cases illustrating genericide provided some form of relief to the plaintiff/trademark holder despite deeming the mark at issue generic. For example, in the Supreme Court's analysis of the name "Shredded Wheat" as applied to cereal, the Court held that, although the name did not deserve protection as a trademark because it had become generic, the defendant nevertheless had a duty to use "reasonable care to inform the public of the source of its product."²⁹⁷ In this case, the Court found that defendant Kellogg Company's use of a distinctive label and carton was sufficient to demonstrate that it was "fairly" using the Shredded Wheat name.²⁹⁸ Many courts have shaped injunctive relief in genericide cases to limit a competitor's ability to use a generic word or term when necessary to prevent consumer confusion and thereby ensure fair competition.²⁹⁹ Although many of these

²⁹⁷ *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118–19 (1938). The Court noted that, even though the "Shredded Wheat" brand had been deemed generic, "[t]he question remains whether Kellogg Company in exercising its right to use the name 'Shredded Wheat' and the pillow-shaped biscuit, is doing so fairly. Fairness requires that it be done in a manner which reasonably distinguishes its product from that of plaintiff." *Id.* at 120; *see also* RESTATEMENT (FIRST) OF TORTS § 735(2) (AM. LAW INST. 1938).

²⁹⁸ *Kellogg*, 305 U.S. at 120–21 (noting that the Kellogg cartons "do not resemble those used by the plaintiff either in size, form, or color," and that the "difference in the labels is striking").

²⁹⁹ *See, e.g., Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 203–04 (1896) (holding that, even though the word "Singer" had "become public property, and the defendant had a right to use it," defendant was enjoined from using the word "Singer" on any of its machines or in any of its advertisements "without clearly and unmistakably stating . . . that the machines [were] made by the defendant," and therefore were not the product of the Singer Manufacturing Company); *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 581 (2d Cir. 1963) (affirming district court order that, although the word "thermos" was deemed generic, plaintiff's competitor "must invariably precede the use of the word 'thermos' by the possessive of the name 'Aladdin'; . . . [c]onfine its use of

cases precede the passage of the 1946 Lanham Act and resulting federalization of trademark law, some more recent cases have also imposed such restrictions or recognized the defendant's duty to do so.³⁰⁰

Fewer cases have imposed restrictions on defendants, vis-à-vis the use of generic words that have acquired so-called de facto secondary meaning, if those words did not start their linguistic life cycle as a valid trademark.³⁰¹ In other words, courts have been more willing to extend such protections when the word or term is deemed unprotectable due to genericide, rather than an initial determination that the word is generic. The reason for this distinction is unclear. The potential for likelihood of consumer confusion and its attendant economic costs exists regardless of whether the word or term in question was once recognized as a trademark. The purpose of providing limited forms of relief in these types of cases is not to provide a consolation prize to disappointed trademark holders whose marks were once distinctive and valuable. The point is to avoid consumer confusion and the costs that it imposes on consumers and competitors alike. If that is the goal, then the original status of the relevant mark should be irrelevant in making this determination.

'thermos' to the lower-case 't'; and . . . never use the words 'original' or 'genuine' in describing its product," to "eliminate confusion and the possibility of deceit"); *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 82 (2d Cir. 1936) (noting that defendant should identify its product as "Sylvania cellophane" when filling orders or in advertisements, "in the interest of justice").

³⁰⁰ See, e.g., *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 102 (2d Cir. 1989) (finding the term "murphy bed" to be generic but enjoining defendant's "passing off" of his product as "original" Murphy Beds by the "Murphy Bed Co. of America" under the doctrine of unfair competition).

³⁰¹ Swann, *supra* note 169, at 646 (observing that "the limited protection that may be afforded dual use terms to protect their trademark significance is not available when a mark starts out generic" (internal quotations omitted) (citations omitted)). But see *Blinded Veterans Ass'n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1047 (D.C. Cir. 1989) (finding the term "Blinded American Veteran's Association" generic, but remanding case for further findings regarding consumer confusion and suggesting that, if evidence of "passing off" existed, a disclaimer could be required).

b) Preventing Confusion in the Copying of Functional Designs

Common law applications of the functionality doctrine, like the early decisions in the genericism/genericide context, recognized functionality as part of the broader law of unfair competition and therefore imposed limitations on the use of “functional” product features when necessary to prevent consumer confusion and passing off.³⁰² Under the Lanham Act and the case law interpreting it, however, a court may refuse to consider evidence of secondary meaning, once a product feature is deemed functional.³⁰³ This formalistic approach to functionality effectively precludes more limited forms of protection (such as labels or disclaimers designed to prevent consumer deception), which should otherwise be available under a common law claim for unfair competition, even if a distinctive product feature does not qualify for protection as a trademark. Commentators have criticized this shift by the courts as injurious to both consumers and competitors alike.³⁰⁴

The functionality doctrine’s absolute nature—particularly when combined with its ambiguities and breadth of scope under the Supreme Court’s decision in *TrafFix*—can create unfair competition and harm consumers. For example, in *ERBE Elektromedizin GmbH v. Canady Technology LLC*, the Federal Circuit found that the maker of blue endoscopic surgical probes had failed to carry its burden of proof in establishing the non-functionality of the blue

³⁰² See *supra* notes 75–76, 85 and accompanying text; see also RESTATEMENT (FIRST) OF TORTS § 741(b)(ii) (AM. LAW INST. 1938) (providing that distinctive product features that are functional should not be copied without taking “reasonable steps to inform prospective purchasers that the goods which [defendant] markets are not those of the [plaintiff]”); § 741 cmt. j (“If an imitated feature is functional but has also acquired generally in the market a special significance as an indication of the source of the goods, the imitation is privileged if it is accompanied by reasonable effort to avoid deceiving prospective purchasers as to the source.”).

³⁰³ See, e.g., *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001) (noting that, because the Court had found the relevant product feature to be functional, whether it had acquired secondary meaning “need not be considered”).

³⁰⁴ See Dinwoodie, *supra* note 62, at 746–51 (arguing in favor of awarding limited forms of relief to protect functional designs, when evidence of consumer confusion is present); Thurmon, *supra* note 58, at 344–46 (critiquing application of the functionality doctrine as a complete bar to trademark protection in cases where consumer confusion would likely result).

color of the probes, noting that plaintiff had failed to “present a genuine issue of material fact that the color blue does not make the probe more visible through an endoscopic camera or that such a color mark would not lead to anti-competitive effects.”³⁰⁵ The court rejected plaintiff’s evidence that other colors (anything other than beige or red) would have been clearly visible during endoscopic procedures.³⁰⁶ As a result, the court granted summary judgment to the defendant and allowed it to continue copying the blue color and black markings of plaintiff’s endoscopic probes.³⁰⁷

Concurring in part and dissenting in part, Judge Newman noted that the defendant had admitted to deliberately copying the plaintiff’s trade dress, in the form of the blue color and black markings on the probes.³⁰⁸ Defendant’s deliberate copying, combined with what Judge Newman believed to be “evidence of likelihood of confusion as to the source and identity of the probe,” combined to pose a threat to the public interest, particularly given that the relevant product was used in the surgical field.³⁰⁹ The possibility of consumer deception posed by this case could have been ameliorated by either (1) more narrowly construing the doctrine of functionality to prevent defendant’s copying of plaintiff’s trade dress in the first instance, or (2) imposing equitable limitations on the defendant to restrict its ability to dress up its surgical probes as those of the plaintiff, such as disclaimers in advertising, labeling, or packaging. The court’s refusal to extend any form of protection to the plaintiff’s trade dress increased the likelihood of consumer deception and competitive injury to the original manufacturer.

³⁰⁵ 629 F.3d 1278, 1289 (Fed. Cir. 2010); *see also id.* at 1288 (noting that “[c]olor may not be granted trademark protection if the color performs a utilitarian function in connection with the goods it identifies or there are specific competitive advantages for use”). The Federal Circuit heard this case because the trademark functionality issue was decided concurrently with a patent infringement claim, over which the Federal Circuit had exclusive jurisdiction.

³⁰⁶ *Id.* at 1289.

³⁰⁷ *Id.* at 1291.

³⁰⁸ *Id.* at 1293 (Newman, J., concurring in part, dissenting in part).

³⁰⁹ *Id.* Judge Newman observed that “[t]he public interest in avoidance of deception or confusion looms particularly large in the medical/surgical field, where the surgeon’s experience of quality and performance, on recognition of the surgical device by its unique color, is a matter of public concern.” *Id.*

CONCLUSION

The doctrines of trademark genericism and functionality emerged from the common law of unfair competition, as courts recognized that expanding trademark protections could have the unintentional effect of impairing competition or illegitimately expanding upon a party's patent monopoly. However, in keeping with their overriding goal of suppressing free riding and consumer fraud, the courts consistently maintained a duty on the part of defendants to refrain from using source-identifying words or product features in ways that resulted in consumer deception and loss of goodwill. This flexible common-law approach has been supplanted by more rigid doctrinal rules that attempt to draw brighter lines between generic or functional subject matter and registrable trademarks. Although bright-line rules have the supposed benefit of eliminating ambiguity and its attendant transaction costs, in many ways these more rigid rules have had the opposite effect. The codification of the genericism and functionality doctrines in the Lanham Act, and the heightened importance of trademark registration under the Act, has enhanced the significance of the doctrines and therefore magnified the potential harm imposed by unpredictable rules that may elevate form over substance.

Repurposing the genericism and functionality doctrines toward their original underlying principle would benefit trademark holders and consumers alike. Unlike more controversial areas of trademark law, such as the federal trademark dilution statute, expansion or clarification of trademark rights in this context would not restrict competition at the expense of consumers or endanger free speech. When defining the boundaries of trademark law—which the genericism and functionality doctrines are designed to do—courts should adopt a pragmatic approach that embraces and reflects the common-law roots of trademark law itself: the preservation of free and fair competition.