

No. 20-1817

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IN THE  
**Supreme Court of the United States**

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EZAKI GLICO KABUSHIKI KAISHA, D/B/A/ EZAKI GLICO Co., LTD.  
& EZAKI GLICO USA CORP.,

*Petitioners,*

v.

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

*Respondents.*

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**On Petition for a Writ of Certiorari  
to the United States Court of Appeals  
for the Third Circuit**

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**BRIEF OF INTELLECTUAL PROPERTY OWNERS  
ASSOCIATION AS *AMICUS CURIAE*  
IN SUPPORT OF PETITIONERS**

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DANIEL J. STAUDT  
*President*  
KEVIN H. RHODES  
SAMANTHA AGUAYO  
INTELLECTUAL PROPERTY  
OWNERS ASSOCIATION  
1501 M Street, NW  
Suite 1150  
Washington, DC 20005

GREGORY A. CASTANIAS  
*Counsel of Record*  
JOHN G. FROEMMING  
AMELIA A. DEGORY  
JONES DAY  
51 Louisiana Ave., NW  
Washington, DC 20001  
(202) 879-3939  
gcastanias@jonesday.com

*Counsel for Amicus Curiae*

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**INTEREST OF THE *AMICUS CURIAE***

*Amicus curiae* Intellectual Property Owners Association (IPO) is an international trade association representing a “big tent” of diverse companies, law firms, service providers, and individuals in all industries and fields of technology that own, or are interested in, intellectual property rights.<sup>1</sup> IPO advocates for effective, affordable, and balanced IP rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; and disseminating information to the public on the importance of intellectual property. IPO’s mission is to promote high quality and enforceable IP rights and predictable legal systems for all industries and technologies.

IPO regularly represents the interests of its members before Congress and the United States Patent and Trademark Office (“USPTO”); and has filed *amicus curiae* briefs in this Court and other courts on significant issues of intellectual property law. The members of IPO’s Board of Directors approved the filing of this brief and are listed in the Appendix.<sup>2</sup>

Many of IPO’s members—individual manufacturers as well as corporations large and small—frequently participate on both sides of Lanham Act actions. They have

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<sup>1</sup> No party’s counsel authored this brief in whole or part; no party or party’s counsel contributed money intended to fund the preparation or submissions of the brief; and no person other than *amicus*, its members, or counsel contributed money intended to fund the preparation or submission of the brief. Counsel for all parties were provided timely notice of *amicus*’s intent to file and have consented to the filing of this brief.

<sup>2</sup> IPO procedures require approval of positions in briefs by a two-thirds majority of directors present and voting.

relied on this Court's well-settled functionality test to appropriately protect their trademarks and trade dress rights. Allowing the Third Circuit's holding on functionality that is contrary to well-settled precedent from this Court to stand would undermine and jeopardize the settled expectations and investments in the creation and protection of trade dress rights of IPO members and others. The Third Circuit's new test for functionality also risks opening the floodgates to consumer confusion as IPO members and other manufacturers will be unable to use unique and distinctive trade dress to differentiate their products from those made and sold by others.

#### **INTRODUCTION AND SUMMARY OF THE ARGUMENT**

Manufacturers have long enjoyed robust protection for trade dress, such as product design, that identifies their products' source. This Court has held for decades that such trade dress is protectable so long as it is not "functional," that is, "essential to the use or purpose of the article" or "affect[ing] the cost or quality of the article." *Inwood Lab'ys, Inc. v. Ives Lab'ys, Inc.*, 456 U.S. 844, 850 n.10 (1982); see 15 U.S.C. § 1125(a)(3), (c)(4)(A).

As a result, such distinctive designs have flourished as important visual indicators of the source and quality of products. A consumer on a Sunday drive can immediately tell from the grille of a car zipping by that it is a Jeep, a BMW, a Kia, or a Lexus. She could walk into a dealership the next day and inquire about buying one of her own. If she wanted a refreshment while she waited, she could look at a bottle of Coca-Cola and know what it was without even needing to see the label. And she might also reach in her bag and be able to quickly find her eos lip balm based on the balm's unique ovoid shape. The automotive grilles, the Coca-Cola bottle, and the eos lip balm all have protectable trade dress. Trade dress allows consumers to identify



these products and associate their appearance with the single source of those products.

In this regard, this Court's test for functionality has served the public well, allowing source-identifying designs like these and others to flourish, and aiding consumers in identifying brands of quality and distinction. Yet the Third Circuit in this case decided to take a new path that veered away from this Court's well-established test for functionality—as well as from all of the other Circuits—by holding, in essence, that trade dress cannot be protected unless the product configuration is completely without any function—*i.e.*, useless.

The Third Circuit's decision is deeply flawed. It abandons this Court's test in favor of an acontextual picking-and-choosing of a dictionary definition of functionality that turns this Court's test on its head. By settling on “useful” and “nothing more” as its definition of “functionality,” Pet. App. 9a, the Third Circuit also contravenes Congress's indication—by passing and amending the Lanham Act while not disturbing functionality's settled meaning—that it intended “functional” to be defined according to this Court's *Inwood* test.

The Third Circuit reasoned that its new rule was justified by the need to keep patent and trademark law in separate “realms.” Pet. App. 10a. But its concerns about trademark law “invas[ing]” patent law's “domain,” *id.*, were misplaced. This Court's long-standing test already ensures that “essential” features—like the dual-spring design in traffic warning signs—are ineligible for trademark protection. See *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001).

Many iconic and valuable—not to mention informative to consumers—trade dresses are thus in peril in the Third Circuit. Automobile grilles, which are undoubtedly “useful”

for ventilating the heat and fumes of combustion engines, would lose protection under the Third Circuit's rule. So, too, the easily recognized ovoid shape of the lip balm in the consumer's purse would not be protectable because it is "useful"—it contains the balm, and helps her easily find the balm among the other tube-shaped items in her bag. And the Coke bottle, which is "useful" for containing liquid and drinking the cola from the bottle, would meet the same fate. Those inconsistent and flawed results demonstrate how the Third Circuit's decision will eviscerate protections on which manufacturers have long relied to develop and market their products and avoid consumer confusion. Amicus therefore urges the Court to grant review on both questions presented in the petition and reverse the decision below.

#### **ARGUMENT**

##### **I. THE THIRD CIRCUIT'S DEFINITION OF "FUNCTIONAL" UNDER THE LANHAM ACT CONFLICTS WITH THIS COURT'S AND EVERY OTHER CIRCUIT'S DECISIONS, AND IS WRONG**

The Court should grant review on the first question presented. As Petitioners have explained, the Third Circuit wrongly disregarded this Court's settled precedents by holding that in trade-dress law, "functional" means only "useful" and "nothing more." Pet. 19–21. The Third Circuit also stands alone among the Circuits in adopting a dictionary definition for functionality rather than following this Court's longstanding test. Pet. 14–20. And its reasoning is wrong as a matter of hornbook statutory construction.

**A. The Third Circuit’s Decision Conflicts With This Court’s Decisions In *Inwood*, *Qualitex*, And *TrafFix*, As Well As Every Other Circuit’s Decisions**

1. This Court has long held that to be “functional” under the Lanham Act, a product feature must be “essential to the use or purpose of the article” or “affect[] the cost or quality of the article.” *Inwood*, 456 U.S. at 850 n.10; *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995); *TrafFix*, 532 U.S. at 32; see Pet. 21. The Court’s well-established test accords with trade-dress law’s general concern with protecting consumers from a likelihood of confusion over a product’s source. See *TrafFix*, 532 U.S. at 28; 1 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:64 (5th ed. June 2021 update). The Third Circuit disregarded all precedent and learned treatises. See Pet. 22.

The Third Circuit should have decided this case simply by relying on this Court’s opinion in *TrafFix*. The dual-spring design for road signs in *TrafFix* helped keep the signs upright on windy days, and worked better that way, so it would be beneficial for competitors to copy the design, and the manufacturer should not be able to protect it indefinitely. See *TrafFix*, 532 U.S. at 31–32; McCarthy § 7:63 (“To boil it down to a phrase: something is ‘functional’ if it works better in this shape.”); *Textron, Inc. v. U.S.I.T.C.*, 753 F.2d 1019, 1024–25 (Fed. Cir. 1985). The Third Circuit only paid lip service to *TrafFix* in analyzing whether Pocky’s cookie “works better” due to its shape, Pet. App. 13a. In the end the *TrafFix* analysis made no difference, because the Third Circuit ignored it and returned again and again to the notion that “functional” means only “useful”—nothing more. *E.g.*, Pet. App. 13a, 15a–17a. That is plainly incorrect under this Court’s precedents.

2. Given the clarity of this Court's case law, it is unsurprising that every Circuit to have addressed the issue has embraced this Court's holdings in *Inwood*, *Qualitex*, and *TrafFix*. See Pet. 13–19. Many companies have also relied on this Court's settled definition of “functional” to protect trade dress. See *infra* Part II. The Third Circuit, however, departed from its sister Circuits and upended that reliance by adopting a new test for functionality. The Court should grant review to resolve this split.

**B. The Third Circuit's Decision Is Wrong As A Matter Of Statutory Construction**

The Third Circuit's approach, which was based on an acontextual use of a single dictionary, is not only at odds with this Court's prior decisions and the other federal courts of appeals but is also wrong as a matter of statutory construction. The court observed that “the Lanham Act does not define functionality,” yet it paradoxically set aside this Court's longstanding test for functionality in favor of its own dictionary definition and paraphrasing thereof in order to arrive at “useful.” Pet. App. 9a. That approach was contrary to precedent and prior statutory interpretation.

As Petitioners point out, “the Third Circuit was not writing on a blank slate when it defined ‘functional.’” Pet. 22. In addition to failing to explain why it chose one dictionary over all others in rejecting this Court's authoritative interpretation of “functional,” see *id.*, the Third Circuit did not explain why it cherry-picked certain definitions (*e.g.*, dictionary definitions 2a and 2d) over others. See Pet. App. 9a; *cf. Taniguchi v. Kan Pac. Saipan, Ltd.*, 566 U.S. 560, 566–67 (2012) (noting where a dictionary had “divided [a] definition into two senses” and critiquing respondent's “almost exclusive[]” reliance on a single dictionary “[a]gainst” the authority of “[m]any dictionaries in use” at the relevant time).

The Third Circuit's approach also contravenes Congressional expectations. Congress is aware of this Court's definition and has indicated that it expects "functionality" to be assessed by the *Inwood* test. Congress is presumed to be aware of this Court's precedents, *Merck & Co. v. Reynolds*, 559 U.S. 633, 648 (2010), and to adopt the Court's construction of a statute "when it re-enacts a statute without change," *Forest Grove Sch. Dist. v. T.A.*, 557 U.S. 230, 239–40 (2009) (quoting *Lorillard v. Pons*, 434 U.S. 575, 580 (1978)).

According to these principles, the Lanham Act carries forward this Court's definition of functionality. As Petitioners explain, Congress's 1998 and 1999 amendments to the Lanham Act adopted this Court's interpretation of "functional" in *Inwood* and *Qualitex*. Pet. 22; see *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1274 (Fed. Cir. 2002) ("Congress explicitly recognized the functionality doctrine in a 1998 amendment to the Lanham Act by making 'functionality' a ground for *ex parte* rejection of a mark."). Moreover, Congress has amended the Lanham Act several times since *Inwood*, and even *TrafFix*, and did not disturb sections 1052(e)(5), 1125(a)(3), or 1115(a)(8). The statute therefore preserves this Court's interpretation of "functional." See, e.g., *Shapiro v. United States*, 335 U.S. 1, 16 (1948); A. Scalia & B. Garner, *READING LAW: THE INTERPRETATION OF LEGAL TEXTS* 322 (2012). The Third Circuit erred in holding otherwise.

## **II. THE THIRD CIRCUIT'S DECISION WOULD EVISCERATE THE ACT'S PROTECTIONS FOR EVERY PRODUCT CONFIGURATION THAT ALSO POSSESSES UTILITY**

The importance of resolving this circuit split and returning functionality under the Lanham Act to a uniform national standard is obvious. The Third Circuit's decision wrongly jeopardizes well-known trade-dress

configurations based on a misguided account of the relationship between the Lanham Act and the Patent Act. If allowed to stand, the decision below would place many iconic trade dresses in limbo in the Third Circuit. The result would be to hand trade-dress copyists free rein to clothe phony products in their competitors' hard-earned and well-established trade dress.

**A. The Third Circuit's Decision Threatens To Eliminate Lanham Act Protection For All Trade Dress Unless It Is Completely Useless**

The Third Circuit's decision is not merely wrong; it would carve a giant hole into the Lanham Act's guarantees by protecting only those product configurations that are entirely bereft of utility—in effect, only completely useless product configurations could gain the benefits of the statute. As one commentator has observed, “it seems as though the Third Circuit is rolling back protection for trade dress.” 1A Michael Landau, *LINDEY ON ENT., PUBL'G & THE ARTS* § 2:46.10 (3d ed. Apr. 2021 update). Another warns that the Third Circuit's decision “drastically changes the functionality standard without transparency into its analysis or guidance on a new test.” Julia Anne Matheson, *A Sticky Mess: Pocky Ruling Further Divides The Circuits*, *WORLD INTELL. PROP. REV.* (Oct. 15, 2020), <https://www.worldipreview.com/article/a-sticky-mess-pocky-ruling-further-splits-the-circuits>. This Court should intervene to resolve the split created by this misguided account of the law.

The Third Circuit's decision was driven principally by the view that patent law and trademark law should be conceptualized as entirely distinct “domain[s],” such that only patent law is available to provide intellectual-property protection for any product possessing any measure of utility. *See* Pet. App. 10a; Pet. 20. To justify disregarding this Court's long settled definition of

“functional,” the Third Circuit expressed concern over “invad[ing] the Patent Act’s domain.” Pet. App. 10a.

That concern was misplaced. To be sure, “[i]t is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new . . . functions for a limited time.” *Qualitex*, 514 U.S. at 164. Meanwhile, trademark law protects distinctive product design and configuration. *Traffix*, 532 U.S. at 32–33.

The Third Circuit incorrectly found conflict where there was none. A court “must read [two allegedly conflicting] statutes to give effect to each if [it] can do so while preserving their sense and purpose.” *Watt v. Alaska*, 451 U.S. 259, 267 (1981). The Third Circuit apparently thought that it needed to lower the functionality bar to protect “the Patent Act’s domain.” Pet. App. 10a. But “[a]ny perceived conflict” between this Court’s functionality test (as expressed in the Lanham Act) and the Patent Act is “more apparent than real.” *Morton v. Mancari*, 417 U.S. 535, 550 (1974).

That is because the Third Circuit’s apprehension about “overextend[ing]” trademark law “to protect all of a product’s features,” Pet. App. 8a, is not one that would have been implicated by applying this Court’s longstanding definition of “functionality.” This Court’s test for functionality does not “protect all of a product’s features,” *id.* Rather, it protects only features that are not “essential to the use or purpose of the article or . . . affect[] the cost or quality of the article.” *Traffix*, 532 U.S. at 32. The Third Circuit’s concerns were therefore misplaced.

It is already true that a party may not receive a “back-door patent[]” via trademark for a feature that is “driven by practical, engineering-type considerations such as making the product work more efficiently.” McCarthy § 7:67. Indeed, as Judge Posner observed: “Functional features are by definition those likely to be shared by different

producers of the same product and therefore are unlikely to identify a particular producer.” *Publ’ns Int’l, Ltd. v. Landoll, Inc.*, 164 F.3d 337, 340–43 (7th Cir. 1998) (“Unabridged dictionaries, board-page books for infants, travel books, encyclopedias, atlases, law books, and comic books are other examples of book genres that contain innumerable look-alikes published by different publishers, look-alikes that do not, however, confuse consumers about the identity of the publisher of any particular book.”).

This Court in *TrafFix* rejected the notion that “functionality” is a complete prohibition on overlap between trademark protection and patent protection when it ruled that the dual-spring design feature of traffic warning signs, “claimed in . . . expired utility patents,” creates only a “strong evidentiary inference of functionality,” and not a conclusive exclusion from trademark protection, of the identical aspect of the signs. 532 U.S. at 30. *See also id.* at 31 (“the disclosure of a feature in the claims of a utility patent constitutes strong evidence of functionality”).

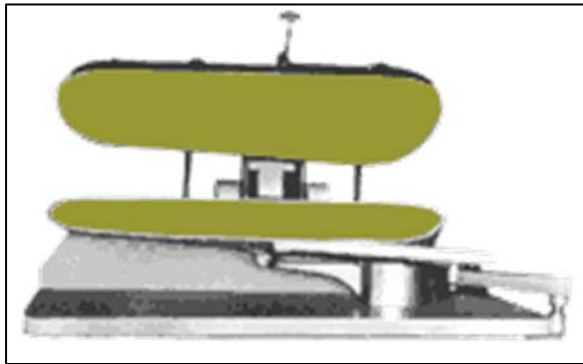
That accords with this Court’s observations in other contexts that different intellectual-property protections may coexist and even overlap without requiring judicial intervention to police their bounds. *See, e.g., Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 155 (1989) (“[T]rade secret protection d[oes] not conflict with either the encouragement or disclosure policies of the federal patent law.”).

And the Federal Circuit—the only federal court of appeals that hears both trademark and patent cases—has had no difficulty applying this Court’s “traditional rule” on functionality notwithstanding potential overlap with patent protection. *See, e.g., Valu Eng’g.*, 278 F.3d at 1275 (quoting *TrafFix*, 532 U.S. at 33); *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1375 (Fed. Cir. 2012) (evaluating



patent claim as potential evidence of a feature's functionality under *TrafFix's* "teach[ing]").

The *Inwood* test both acknowledges and protects the differences between the Lanham Act and the Patent Act. Subject to patent or other intellectual-property protections, competitors are free to copy purely functional design aspects (such as the dual-spring design in *TrafFix*) but not distinctive, source-identifying aspects (such as the green-gold color of the laundry press pad in *Qualitex*).



There is no indication that Congress, in passing and amending the Lanham Act over the years, meant for trademark law to protect *only* product configurations that lack any of the utility that might support the issuance of a patent. And, of course, an invention must also be shown to have more than mere utility to gain a patent; it must also be novel and nonobvious. 35 U.S.C. §§ 102, 103.

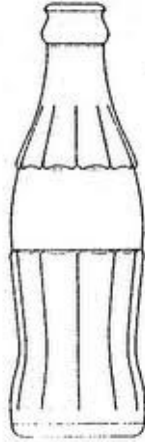
This Court's *Inwood* test therefore appropriately protects distinctive trade dress while allowing competitors to copy features that make a product work better. The Third Circuit's "useful" test would protect little to no trade dress, because a party would be hard-pressed to identify a product configuration that "does not serve any function." See *Bodum USA, Inc. v. A Top New Casting, Inc.*, 927 F.3d 486, 492 (7th Cir. 2019), *cert. denied*, 140 S. Ct. 675 (2019). Yet

the Third Circuit appears to demand that there be “no functional reason to design” a product configuration for it to merit trade dress protection. *See* Pet. App. 12a. That demand was misguided. It conflicts with this Court’s precedents, with the imperatives of the federal trademark and patent systems, and with common sense. It should not be allowed to stand unreviewed.

**B. The Third Circuit’s Decision Undermines Settled Expectations Regarding Lanham Act Protection On Which Companies’ Branded-Products Businesses Have Been Built**

The Third Circuit’s rejection of this Court’s settled functionality standard has real-world consequences. It endangers many well-recognized trade dresses and risks consumer confusion. It also permits judges to substitute their own observations about a product for record evidence to reach a conclusion on functionality as a matter of law. Those results are untenable.

1. Take the Coca-Cola bottle shape, “the indisputable paradigm of a strong trademark and trade dress in a container shape.” McCarthy § 7:94. “[N]o symbol in the world is so readily recognized.” *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 756–57 (6th Cir. 1998) (Martin, C.J., dissenting). Yet the “famous form” not only “allows the consumer to identify immediately what’s inside the bottle”—Coca-Cola—“it also serves a utilitarian function by containing the Coca-Cola Company’s primary product.” *Id.* The bottle’s grooves are also a useful feature; they make the bottle easier to hold. Under the Third Circuit’s test, because these features are not completely useless, they would not be protectable.



Other well-known packaging trade dresses would be under threat too, because any amount of utility would qualify as “functionality” and thus trump inherent distinctiveness of packaging trade dress under the Third Circuit’s rule. McCarthy § 7.63.

Additional quintessential trade dresses beyond packaging are also now put at risk in the Third Circuit. Consider Jeep’s readily recognizable front-end grille design, which includes a “bread loaf” outline and seven vertical slots tightly spaced between “eyeball” headlights. *See* U.S. Registration No. 2,794,553.



The seven-slotted grille is certainly “useful”—it allows air to flow through to and cool the engine. But, other, alternative designs have proliferated, and “nearly every

other motor vehicle manufacturer has managed to find a way to cool the engine without using vertical slots.” *AM Gen. Corp. v. DaimlerChrysler Corp.*, 311 F.3d 796, 805 (7th Cir. 2002).

Moreover, it bears noting, other automotive manufacturers have been able to design, market, and themselves trademark competing automobiles with *their own* distinctive grille designs—the BMW “kidney” grilles, the Kia “tiger nose” grilles, the Chevrolet “dual-port” grille, the Lexus “spindle” grille, and the Jaguar “mesh” grille, among many others. See Angelo Young, *Does Your Car Look Happy To You? Designers Talk About The Evolution Of Lights, Grilles and Bumpers*, INT’L BUS. TIMES (Dec. 3, 2013), <https://www.ibtimes.com/does-your-car-look-happy-you-designers-talk-about-evolution-lights-grilles-bumpers-1491974>. These designs are also threatened by the Third Circuit’s decision, because they are at least as “useful” as Jeep’s.



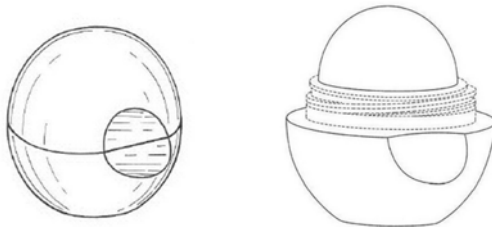
In the same way, Herman Miller’s iconic Eames office chairs’ ribbed backrests, one-piece construction of the seat and back, and distinctive trapezoidal armrests “serve[] . . . utilitarian function[s.] . . . But that does not mean that every chair’s overall appearance is functional as a matter of law.” *Blumenthal Distrib., Inc. v. Herman Miller, Inc.*, 963 F.3d 859, 867 (9th Cir. 2020). Rather, other designs can and do offer different features that serve those functions. *See also infra* Part III.



For another example, the shape of Weber’s kettle grill, which “includes a bottom of generally semi-spherical shape having a top of generally semi-ellipsoid shape,” U.S. Registration No. 1,478,530, also serves a utilitarian function. The semi-spherical shape promotes even heat circulation within the grill. Yet the shape immediately tells the consumer “this is a Weber grill.” And, as with automotive grilles, trade-dress protection has not hampered innovation in charcoal grill design, including barrel grills, egg-shaped grills, and rectangular grills.



The packaging of eos's lip balm, too, immediately identifies the source as eos. See U.S. Registration Nos. 4,824,682 and 5,398,970. But the "ovoid" configuration with an indented portion on one side midway down the container, *see id.*, is also useful. It is not only a container, like the Coke bottle; it also helps consumers to locate the lip balm by touch in a dark bag or purse, because the ovoid shape differs from pens, pencils, or other makeup tubes, and the mounded lip balm—with greater, more rounded surface area than a traditional tube—can be easily applied to the lips.



Examples of similarly paradigmatic trade dresses that are nonetheless “useful” abound. See Pet. 34–36. Yet the Third Circuit offered no real limiting principle for its “useful” test. Instead, when revising its opinion on rehearing, it attempted to dispense with protections for well-known articles like the Bodum French press or the Eames chairs’ trapezoidal armrests by claiming that they “offered no edge in usefulness.” Pet. App. 12a.

2. In addition to providing no limit on what is “useful” as a matter of law, the Third Circuit’s new test invites mischief in another way. Rather than evaluate the evidence of record, the court substituted its own observations about the product—*e.g.*, that the Pocky sticks’ shape “lets people eat the cookie without having to open their mouths wide” or that it allows for “enough” sticks to be packaged together “to share with friends”—to conclude that the design was functional as a matter of law. Pet. App. 16a.

That line of reasoning would endanger other iconic trade dresses. For instance, adidas’s famous three-stripe mark was “born from function and practicality”; when the Dassler brothers began manufacturing running spikes in the 1920s, the stripes provided “a way of binding the shoe together and providing structure to the shoe.” Gregk Foley, *Here’s How Adidas’s Three Stripes Became World Famous*, Highsnobiety (2017), <https://www.highsnobiety.com/p/adidas-three-stripes-history/>. In the Third Circuit, nothing would prevent a judge from observing that the stripes may be “useful” to support the shoe, and therefore conclude that the feature is functional as a matter of law.





Permitting judges' own opinions of a product's "usefulness" to dictate functionality—and therefore trade-dress protection—endangers intellectual-property rights, and would put even the most non-functional registered trade dress at risk for *ex post* nullification by a court. See Matheson, *Sticky Mess*, *supra*. Such an outcome is incompatible with the need for reliable and predictable intellectual-property rights that can reasonably be determined *ex ante*.

\* \* \*

The distinctive elements of goods like Jeep's grille shape, the Coca-Cola bottle's shape, and eos lip balm's shape and indentation, do not provide a monopoly on the underlying good. Rather, they are brand signals, immediately communicating to the consumer, for instance: "This is a bottle of Coca-Cola." None of these products exists in a single-product market. Pepsi competes with different bottles, ChapStick competes with a tubular lip-balm container. Yet the Third Circuit's rule would eliminate the brand owner's ability to (as this Court observed in another context) "secure" "the goodwill of his business" and "protect the ability of consumers to distinguish among competing producers." See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992). That is wrong, and would threaten brand owners' intellectual-property rights immeasurably. The Court should grant review.

### III. THE COURT SHOULD GRANT REVIEW ON BOTH QUESTIONS PRESENTED IN THE PETITION

The second question presented by the petition asks the Court to address the role of alternative designs in addressing the question of functionality. The Court should also grant review on this question because it is inextricably intertwined with the proper standard for functionality. The Circuits—even those that faithfully apply this Court’s test for functionality—are split on this issue. *See* Pet. 26–32.

Consideration of alternative designs—for example, the various ways that an automotive grille can be configured while still performing the function of air intake and cooling—will allow judges and juries to better ascertain whether a particular product configuration is “functional,” or whether it represents a design choice that allows different designs with identical functions to compete in the marketplace. *See, e.g.*, RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 (1995) (defining a functional 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.*” (emphasis added)).

#### CONCLUSION

The Court should grant the petition and should reverse the decision below.

July 29, 2021

DANIEL J. STAUDT  
KEVIN H. RHODES  
SAMANTHA AGUAYO  
INTELLECTUAL PROPERTY  
OWNERS ASSOCIATION  
1501 M Street, NW  
Suite 1150  
Washington, DC 20005

Respectfully submitted,

GREGORY A. CASTANIAS  
*Counsel of Record*  
JOHN G. FROEMMING  
AMELIA A. DEGORY  
JONES DAY  
51 Louisiana Ave., NW  
Washington, DC 20001  
(202) 879-3939  
gcastanias@jonesday.com

*Counsel for Amicus Curiae*

## **APPENDIX**

**APPENDIX — MEMBERS OF THE BOARD OF  
DIRECTORS INTELLECTUAL PROPERTY  
OWNERS ASSOCIATION**

Eric Aaronson Pfizer Inc.	Karen Cochran Shell Oil Company
Brett Alten Hewlett Packard Enterprise	Johanna Corbin AbbVie
Ronald Antush Nokia of Americas Corp.	Buckmaster de Wolf General Electric Co.
Estelle Bakun Exxon Mobil Corp.	Robert DeBerardine Johnson & Johnson
Scott Barker Micron Technology, Inc.	Anthony DiBartolomeo SAP SE
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Brian Bolam Procter & Gamble Co.	Daniel Enebo Cargill, Inc.
Steve Caltrider Eli Lilly and Co.	Yen Florczak 3M Innovative Properties Co.
John J. Cheek Tenneco Inc.	Louis Foreman Enventys
Cara Coburn Roche Inc.	Scott M. Frank AT&T

*Appendix*

Darryl P. Frickey Dow Chemical Co.	William Krovatin Merck & Co., Inc.
Isabella Fu Microsoft Corp.	Michael C. Lee Google Inc.
Gary C. Ganzi Evoqua Water Technologies, LLC	Elizabeth Lester Equifax Inc.
Tanuja Garde Raytheon Co.	Michelle Macartney Intellectual Ventures Management Corp.
Krish Gupta Dell Technologies	William Miller General Mills, Inc.
Henry Hadad Bristol-Myers Squibb Co.	Kelsey L. Milman Caterpillar Inc.
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Heath Hogle Dolby Laboratories	Ross Oehler Johnson Matthey Inc.
Thomas R. Kingsbury Bridgestone Americas, Inc.	KaRan Reed BP America, Inc.
Laurie Kowalsky Koninklijke Philips N.V.	Cindy Rosser DocuSign, Inc.

*Appendix*

Paik Saber  
Medtronic, Inc.

Matthew Sarboraria  
Oracle USA Inc.

Manny Schecter  
IBM Corp.

Jessica Sinnott  
DuPont

Thomas Smith  
GlaxoSmithKline

Daniel Staudt  
Siemens Corp.

Gillian Thackray  
Thermo Fisher Scientific  
Inc.

Joerg Thomaier  
Bayer Intellectual  
Property GmbH

Mark Wadrzyk  
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Amgen, Inc.