

No. 21-417

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

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SULZER MIXPAC AG,

*Petitioner,*

*v.*

A&N TRADING COMPANY, *et al.*,

*Respondent.*

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

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**AMICUS CURIAE BRIEF OF  
THE INTERNATIONAL TRADEMARK  
ASSOCIATION IN SUPPORT OF PETITIONER**

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**AMICUS CURIAE BRIEF OF THE  
INTERNATIONAL TRADEMARK  
ASSOCIATION IN SUPPORT OF PETITIONER**

The undersigned amicus curiae respectfully submits this brief in support of Petitioner.<sup>1</sup>

**INTEREST OF THE AMICUS CURIAE**

Founded in 1878, amicus curiae The International Trademark Association (INTA) is a not-for-profit organization dedicated to serving its members and society as a trusted and influential advocate for the economic and social value of brands by supporting the advancement of trademarks and related intellectual-property concepts as essential elements of trade and commerce. INTA has more than 6,500 member organizations in 185 countries. Its members include intellectual property owners as well as law firms and other professionals who regularly assist brand owners in the creation, registration, protection, and enforcement of their trademarks and related intellectual property. All

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<sup>1</sup> INTA provided Petitioner and Respondent with notice of its intent to file an amicus brief on October 7, 2021. *See* S. Ct. R. 37.2(a). Both Petitioner and Respondent have consented to the filing of this amicus brief. This brief was authored solely by INTA and its counsel. No party or counsel for a party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than *amicus curiae*, its members, and its counsel made such a monetary contribution to its preparation or submission. *See* S. Ct. R. 37.6.

INTA members share the goal of promoting an understanding of the essential role that brands and related intellectual property play in fostering effective commerce, fair competition, and informed decision-making by consumers.

INTA (formerly known as the United States Trademark Association) was founded in part to encourage the enactment of federal trademark legislation after the invalidation on constitutional grounds of the United States' first trademark act. Since then, INTA has been instrumental in making recommendations and assisting legislators in connection with almost all major trademark legislation, and more recently legislation involving other forms of intellectual property. INTA also has participated as amicus curiae in numerous cases involving significant trademark and related intellectual property issues. Of particular note in this case, INTA has submitted amicus briefs in this Court's two most recent decisions addressing the concept of trademark functionality, *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001) and *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995). And, just this term, INTA filed an amicus brief in another trade dress functionality case in this Court, *Ezaki Glico Kabushiki Kaisha v. Lotte International America Corp.*, No. 20-1817 (2021). INTA has also participated as amicus curiae in

numerous other cases in this Court<sup>2</sup> and in other courts across the country. INTA's members are also frequent participants in litigation both in courts and in administrative proceedings before the United States Patent and Trademark Office and the Trademark Trial and Appeal Board with respect to the Lanham Act.

INTA has a particular interest in this case because the question presented – the proper test for determining aesthetic functionality for trade dress – concerns a growing threat to nationwide trade dress protection, and both INTA's members and consumers stand to benefit from a clear, nationwide functionality standard. INTA is vitally interested in

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<sup>2</sup> Cases in which INTA has filed amicus briefs in this Court include: *U.S. Patent & Trademark Office v. Booking.com B.V.*, 140 S. Ct. 2298 (2020); *Romag Fasteners, Inc. v. Fossil, Inc.*, 140 S. Ct. 1492 (2020); *Peter v. NantKwest, Inc.*, 140 S. Ct. 365 (2019); *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019); *Mission Prod. Holdings, Inc. v. Tempnology, LLC*, 139 S. Ct. 1652 (2019); *Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881 (2019); *Matal v. Tam*, 137 S. Ct. 1744 (2017); *Hana Fin., Inc. v. Hana Bank*, 574 U.S. 418 (2015); *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138 (2015); *POM Wonderful LLC v. CocaCola Co.*, 573 U.S. 102 (2014); *Already, LLC v. Nike, Inc.*, 568 U.S. 85 (2013); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000); *Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627 (1999); *Dickinson v. Zurko*, 527 U.S. 150 (1999); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); and *K Mart Corp. v. Cartier, Inc.*, 486 U.S. 281 (1988).

this case because it is an international organization with members in every United States jurisdiction and throughout the world. As an international organization, one of INTA's concerns and central policies has always been to promote the harmonization of intellectual property laws, including among jurisdictions within the United States. To have fundamentally different intellectual property regimes in different jurisdictions unnecessarily complicates and burdens the efforts of intellectual property owners and creators to protect their interests and those of the consuming public. To that end, INTA files this brief seeking to end what it sees as a continuing erosion of trade dress protection and request reaffirmation of a nationwide functionality standard in order to clear up confusion caused by inconsistent approaches applied throughout the country.

## SUMMARY OF ARGUMENT

In addition to brand names and logos, trademark law protects other source-identifying product features, including, among other things, product colors, shapes, and designs. However, the outer limit of trademark protection for such features is functionality. When a product feature is determined to be functional, it is not protectible as a trademark. Although this Court has established clear tests for determining whether product features are functional, lower courts have since then diverged from or failed to follow these tests, sowing confusion and weakening protection for source-identifying trade dress.

In a trio of cases, this Court established standards for assessing both utilitarian and aesthetic functionality. See *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850, n.10 (1982); *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159, 166 (1995); *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001). Under the traditional rule, a product feature is functional in the utilitarian sense if it “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *TrafFix*, 532 U.S. at 32 (citing *Qualitex*, 514 U.S., at 165 (quoting *Inwood Labs.*, 456 U.S. at 850, n. 10)). If an aesthetic product feature is not functional under the traditional test, it may still be functional if the feature confers “a significant benefit that cannot practically be duplicated by the use of alternative designs,” putting competitors at a non-reputation based disadvantage. See *Qualitex*, 514 U.S. at 170 (internal quotations omitted).

The Second Circuit did not find the trade dress at issue—candy-colored mixing tips for dental components—to be functional in either the traditional or aesthetic sense. Instead, the Second Circuit found the coloring scheme to be functional simply because the colors correspond to size, without properly analyzing whether the colors are essential to the use or purpose of the tips, impact the cost or quality, or confer a significant benefit that cannot be replicated. And the evidence suggests that the colors would not be functional under this Court’s tests, or tests applied by several other circuits, because adding colors increases costs and many competitors use different colors or no colors at all.

Unfortunately, the Second Circuit’s opinion is representative of a recent trend among circuit courts to diverge from or refuse to follow this Court’s established tests for assessing functionality. This trend is harmful to brand owners because it reduces available trade dress protection, results in confusion and inconsistent results among the circuits, and may lead to forum shopping. INTA submits this brief to urge the Court to grant Sulzer MixPac AG’s petition for review and reestablish a clear national standard for assessing functionality.

## ARGUMENT

### **A. The Second Circuit’s decision is a departure from this Court’s standard for addressing aesthetic functionality.**

Recognizing that the protection of purely functional devices falls within the purview of patent law, courts long have grappled with whether

distinctive product features denoting source could nonetheless be protectible as “trade dress” under trademark law when the distinctive feature incorporates useful “functional” characteristics.

Although consumer products typically are “useful” in a broad sense and incorporate some “functional” features, in a trilogy of important cases, this Court has clearly articulated standards for determining when a product feature consists of the requisite degree of usefulness to render the feature functional, such that it is not subject to trade dress protection. *See Inwood Labs.*, 456 U.S. at 850, n.10; *Qualitex*, 514 U.S. at 166; *TrafFix*, 532 U.S. at 33.

As set forth in the trilogy, the Court has articulated one standard, referred to as the “traditional rule,” for determining utilitarian functionality, and a second ancillary test to apply to aesthetic features of a product—features that consumers might consider useful, but which in the abstract do not provide utilitarian benefit of any essential significance. For the latter category of product features, this Court established what is referred to as the “aesthetic functionality” standard.

Explaining the traditional rule, the Court has held “we have said ‘[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.’” *TrafFix*, 532 U.S. at 32 (citing *Qualitex*, 514 U.S., at 165 (quoting *Inwood Labs.*, 456 U.S. at 850, n. 10)). That is to say, a useful product feature “is essential to the use or purpose of an article” when the feature is “*necessary* to the operation of the

device,” *TrafFix*, 532 U.S. at 30 (emphasis added), “not an arbitrary flourish in the configuration of [the] product; ***it is the reason the device works.***” *Id.* at 34 (emphasis added).

Under the traditional rule, when the utilitarian functionality of a feature is “essential to the use or purpose of the article,” that is to say “necessary to the operation of the device” or “the reason the device works,” it is functional and “there is no need to proceed further to consider if there is a competitive necessity for the feature.” *TrafFix*, 532 U.S. at 33. In such contexts, it is irrelevant whether the competitor could provide the functional benefits in some other manner.

Conversely, when an aesthetic feature of the product is useful to consumers, *i.e.*, when “a design’s ‘aesthetic value’ lies in its ability to ‘confe[r] a significant benefit that cannot practically be duplicated by the use of alternative designs,’ then the design is ‘functional.’” *Qualitex*, 514 U.S. at 170 (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17, cmt. c (1993)). But when the aesthetic feature is not “essential” to the use or purpose of the article, neither necessary to the “operation” of the device, nor the “reason” the device works, the test is whether there is any “necessity” for competitors to utilize the useful aesthetic feature, or whether competitors nonetheless could produce a competing product without appropriating the useful aesthetic feature adopted by the trade dress proponent.

At issue in *Qualitex* were green-gold colored “press pads” marketed to the dry-cleaning industry.



As noted by the Court, the green-gold color was not functional. “Although it is important to use *some* color on press pads to avoid noticeable stains, the court found ‘no competitive need in the press pad industry for the green-gold color, since other colors are equally usable.’” *Qualitex*, 514 U.S. at 166 (quoting from the trial court decision below, *Qualitex Co. v. Jacobson Prods. Co. Inc.*, 21 U.S.P.Q.2d, 1457, 1460, 1991 WL 318798 (C.D. Cal. Sept. 3, 1991)).

This distinction between utilitarian functionality (governed by the “traditional rule”) and aesthetic functionality is key to the Court’s analysis in *TrafFix*, the latter of the pertinent trilogy of the Court’s cases on trade dress functionality. “Where 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. In *Qualitex*, by contrast, [a]esthetic functionality was the central question, there having been 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.” *TrafFix*, 532 U.S. at 33.

**B. The Second Circuit’s decision misapplies the functionality standard, thereby setting an unreasonably low bar for determining functionality.**

**(1) The decision conflates the doctrines of aesthetic and utilitarian functionality.**

Rather than follow this Court’s clear articulation of the pertinent functionality standards, the ruling for which review is sought, *Sulzer Mixpac AG v. A&N Trading Co.*, 988 F.3d 174 (2d Cir. 2021), conflates the doctrines of utilitarian and aesthetic functionality. The opinion does acknowledge earlier Second Circuit case law quoting the pertinent Supreme Court authority, namely, *Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.*, 696 F.3d 206, 219 (2d Cir. 2012), but fails to properly apply the test. As noted in *Louboutin*, trade dress is “considered to be ‘functional’ in a *utilitarian sense* if it is (1) ‘essential to the use or purpose of the article,’ or if it (2) ‘affects the cost or quality of the article.’” *Id.* (quoting *Inwood Labs.*, 456 U.S. at 850 n.10). A product feature can further be found to be *aesthetically functional* if “the aesthetic design of a product is *itself* the mark for which protection is sought .... [and] giving the markholder the right to use it exclusively ‘would put competitors at a significant, non-reputation-related disadvantage.’” *Louboutin*, 696 F.3d at 219-20 (emphasis in original).

Here the Second Circuit did not find the Sulzer Mixpac color scheme to be “essential to the use or

purpose of the article,” specifically noting, “[t]he district court did not make a factual finding that colors are essential to the use or purpose of mixing tips, *and we decline to do so on this record.*” *Sulzer*, 988 F.3d at 183 (emphasis added). As for whether the color scheme provided any cost or quality advantage, the evidence showed that the use of the color scheme *increased* production costs, and others in the market provided mixing tips bearing different colors, or no color at all, which competing mixing tips worked just as well as the Sulzer Mixpac products. *Id.* at 180. The use of color on the mixing tips thus contributes nothing to the quality of the devices: the devices work just as well with different colors or no color at all. *Id.*

As such, there was no basis for the Second Circuit to hold the design was functional under the traditional test from *Inwood*. The Second Circuit specifically did not find the feature to be “essential to the use or purpose of an article,” nor did it otherwise articulate that the feature is either “*necessary* to the operation of the device,” or “*the reason the device works*,” the requisite criteria articulated by this Court in *TrafFix*, 532 U.S. at 30 & 34 (emphasis added).

And if the color scheme of the mixing tips is not functional in any such “utilitarian sense,” to determine whether the color scheme is “aesthetically functional,” it must be shown the feature is a “competitive necessity,” specifically, a feature for which “giving the markholder the right to use it exclusively ‘would put competitors at a significant, non-reputation-related disadvantage.’” *Louboutin*, 696 F.3d at 219-20. The Second Circuit saw no need

to engage in analyzing “the fact-intensive test where the feature must be ‘shown not to have a significant effect on competition.’” *Sulzer* at 183.

As such, without finding the color scheme essential to the use and purpose of the articles, the Second Circuit nonetheless found the color scheme functional, perhaps in an aesthetic sense, but did so without analyzing the competitive necessity for others to utilize the color scheme, thus precluding any holding the color scheme is aesthetically functional.

**(2) The Second Circuit’s low functionality bar substantially weakens well-established trade dress protection.**

By conflating the doctrines of utilitarian and aesthetic functionality, the Second Circuit set an extremely low bar for finding functionality, essentially holding that a feature that has *some* utility is functional and therefore not subject to protection. As a result, the Second Circuit has made it extremely difficult for trade dress owners to maintain protection under the Lanham Act.

In so doing, the Second Circuit joins the disturbing trend within some Circuits of either misunderstanding, or simply refusing to follow this Court’s clear articulation of the test for assessing functionality. Indeed, in *Ezaki Glico Kabushiki Kaisha v. Lotte International America Corp.*, 986 F.3d 250 (3d Cir. 2021), *petition for cert. filed 2021 WL 2686149* (U.S. June 29, 2021)) (No. 20-1817), the Third Circuit surprisingly held that in the product

configuration trade dress context, the only question is whether the product feature at issue is “useful” in some way.

This matter, as well as *Ezaki Glico*, both provide the Court the opportunity to arrest the troubling trend in which circuits either misconstrue or simply refuse to follow this Court’s clear functionality standard. If this course is not righted, the well-established principles of trade dress law will have evolved in a manner that may render it extremely difficult for trade dress owners to maintain protection on a nationwide scale.

**C. Inconsistent standards applied by various circuits threaten to erode trade dress protection and sow confusion.**

Since this Court’s guidance in *TrafFix* and *Qualitex*, the circuits have diverged markedly in their jurisprudence on functionality of trademarks. In addition to the errors the Second Circuit made in its decision in this case, the distinctions in the precedents in the circuits that have addressed functionality substantively—namely, the Third, Fifth, Seventh, Ninth, and Eleventh Circuits—may well have yielded very different results than did the Second Circuit’s decision in this case. The resulting unpredictability that comes from these divergent approaches clearly indicates that guidance from this Court is needed. We discuss the diverging approaches of each of the referenced circuits below.

### (1) The Third Circuit

Prior to *TrafFix*, the Third Circuit seemed to reject a finding of functionality when colors used served a source-identifying function and had no other utility. *Ideal Toy Corp. v. Plawner Toy Mfg.*, 685 F.2d 78, 81 (3d Cir. 1982) (concluding the colors on the face of a Rubik’s cube toy were nonfunctional because they served no purpose other than identification); *see also Ciba-Geigy Corp. v. Bolar Pharm. Co.*, 747 F.2d 844, 850-51 (3d Cir. 1984) (“[t]he fact that a manufacturer uses different colors to distinguish between its *own* products does not make those particular colors functional as to *other* manufacturers.”) (emphasis added). Post-*TrafFix*, the Third Circuit adopted the Supreme Court’s approach in *Shire US, Inc. v. Barr Laboratories, Inc.*, 329 F.3d 348, 354, 357-59 (3d Cir. 2003), where it held that the colors used for an ADHD medication were functional where customers and medical staff identified the drug by its color, which tended to “enhance efficacy” by promoting “psychological acceptance,” such that the color served a public safety function. *See also, Sweet St. Desserts, Inc. v. Chudleigh’s Ltd.*, 655 Fed. App’x 103, 110 (3d Cir. 2016) (finding that “Blossom Design” for crostata pastry consisting of folds or petals “encapsulates the [pastry’s] filling so that it remains inside the pastry until it is eaten” and was therefore functional).

Under *Ideal Toy*, *Ciba-Geigy*, and *Sweet Street*, it appears the Third Circuit likely would have held the mixing tips at issue here to be nonfunctional. Just

as the colors on a Rubik's cube were only used to match with other colors on the same toy in order to use the toy, so the colors on the mixing tips at issue in *Sulzer* are only used for matching with Mixpac's own products, *not* those of other manufacturers generally. *Sulzer*, 988 F.3d at 183. The Third Circuit's recent decision in *Ezaki Glico* was inconsistent with its prior application of the utilitarian functionality doctrine, and with *TrafFix*, as it merely required any utility at all, setting an inappropriately low bar that is at odds with *TrafFix*. Given the *Ezaki Glico* decision, which is at odds with its own precedent, it is no longer clear how the Third Circuit would approach this case today.<sup>3</sup>

## (2) The Fifth Circuit

While the Fifth Circuit follows the *TrafFix* test for functionality, *Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH*, 289 F.3d 351, 356 (5th Cir. 2002), it has consistently rejected the doctrine of aesthetic functionality altogether. *See, e.g., Bd. of Supervisors for La. State Univ. Agric. & Mech. College v. Smack Apparel Co.*, 550 F.3d 465, 487 (5th Cir. 2008). Therefore, under Fifth Circuit precedent, A&N's aesthetic functionality argument would have been rejected wholesale. In this sense, the Fifth Circuit

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<sup>3</sup> Indeed, it is this ambiguity that prompted INTA to file an amicus brief in that case as well. The fact that both *Ezaki Glico* and this case are potentially before the Supreme Court further highlights that functionality of trademarks is a topic ripe for refinement from this Court, lest the circuits continue their diverging trajectories.

appears not to recognize the aesthetic functionality concept from *Qualitex*.<sup>4</sup>

### (3) The Seventh Circuit

Along with the Ninth Circuit, the Seventh Circuit also features the most robust consideration of functionality. When considering functionality, the Seventh Circuit “consider[s] several factors: ‘(1) the existence of a utility patent, expired or unexpired, that involves or describes the functionality of an item’s design element; (2) the utilitarian properties of the item’s unpatented design elements; (3)

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<sup>4</sup> Note, however, that even after *Board of Supervisors*, some district courts within the Fifth Circuit have appeared to apply aesthetic functionality, or at least failed to clearly distinguish between utilitarian and aesthetic functionality, further contributing to the confusion and lack of predictability confronting both mark owners and alleged infringers. See, e.g., *Sparrow Barns & Events, LLC v. Ruth Farm Inc.*, No. 4:19-CV-00067, 2019 WL 1560442, at \*7 (E.D. Tex. Apr. 10, 2019) (finding that plaintiff was likely to succeed in showing that wedding venue trade dress was non-functional under both “traditional” and “competitive necessity” tests); *Provident Precious Metals, LLC v. Nw. Territorial Mint, LLC*, 117 F. Supp. 3d 879, 895 (N.D. Tex. 2015) (finding that head stamp used to make replica bullet was functional “because it emulates actual ammunition, which would give [appellee] a non-reputation-related advantage over its competitors, particularly in appealing to military service members and gun enthusiasts, who would very likely perceive head stamps that did not resemble actual ammunition as being of lesser quality.”); cf. *Who Dat Yat Chat, LLC v. Who Dat, Inc.*, No. CIV.A. 10-1333, 2012 WL 1118602, at \*14 (E.D. La. Apr. 3, 2012) (noting that *TrafFix* “appeared to have left open the possibility that aesthetic functionality is a viable doctrine”).



advertising of the item that touts the utilitarian advantages of the item's design elements; (4) the dearth of, or difficulty in creating, alternative designs for the item's purpose; (5) the effect of the design feature on an item's quality or cost." *Bodum USA, Inc. v. A Top New Casting Inc.*, 927 F.3d 486, 492 (7th Cir. 2019). The Seventh Circuit has adopted aesthetic functionality as a bar to trademark enforcement and applies the test in *Qualitex. Jay Franco & Sons, Inc. v. Franek*, 615 F.3d 855, 861 (7th Cir. 2010).

The Seventh Circuit, however, has a low bar for considering trade dress functional. For example, the court has said that although "[f]unctionality is a factual question . . . the bar for functionality is so low that it can often be decided as a matter of law . . ." *Arlington Specialties, Inc. v. Urban Aid, Inc.*, 847 F.3d 415, 419-20 (7th Cir. 2017). This low bar is not in keeping with this Court's admonition in *Qualitex* that the "ultimate test of aesthetic functionality . . . is whether the recognition of trademark rights would significantly hinder competition." *Qualitex*, 514 U.S. at 170. Thus, the Seventh Circuit ignores the "significant non-reputation-related disadvantage" required for aesthetic functionality, as specified in *Qualitex* and reiterated in *TrafFix*, instead granting little credit to the availability of alternative designs. *See id.* (not requiring a significant competitive advantage for a finding of aesthetic functionality); *see also Specialized Seating, Inc. v. Greenwich Indus., L.P.*, 616 F.3d 722, 727 (7th Cir. 2010) ("A design such as Clarin's x-frame chair is functional not because it is the only way to do things, but because it represents

one of many solutions to a problem.”). This approach materially differs from this Court’s precedents in *TrafFix* and *Qualitex*.

#### (4) The Ninth Circuit

The Ninth Circuit considers utilitarian functionality under the *Disc Golf* factors articulated in *Disc Golf Association, Inc. v. Champion Discs, Inc.*, 158 F.3d 1002, 1006 (9th Cir. 1998): “(1) whether the design yields a utilitarian advantage, (2) whether alternative designs are available, (3) whether advertising touts the utilitarian advantages of the design, and (4) whether the particular design results from a comparatively simple or inexpensive method of manufacture.” If non-functional under the *Disc Golf* test, a court will then consider aesthetic functionality. Thus, a claimed trade dress has aesthetic functionality if it serves “an aesthetic purpose wholly independent of any source identifying function,’ such that the trade dress’s protection under trademark law ‘would impose a significant non-reputation-related competitive disadvantage’ on its owner’s competitors.” *Blumenthal Distrib., Inc. v. Herman Miller, Inc.*, 963 F.3d 859, 865 (9th Cir. 2020).

It is unclear whether the Ninth Circuit would decide the case as the Second Circuit did here. However, its test for aesthetic functionality differs markedly from that of the Second Circuit, as it focuses on whether there is a design or aesthetic function separate from source identification, whereas the Second Circuit, at least until this case, has focused on competitive disadvantage. These

divergent approaches test wholly different aspects of trade dress and can, will, and likely have, lead to differing results depending on the facts of a particular case.

### (5) The Eleventh Circuit

Unlike the Second Circuit, in considering whether colors are functional the Eleventh Circuit has looked to whether they are used by other competitors or understood by consumers as having a particular meaning. For example, in *Dippin' Dots, Inc. v. Frosty Bites Distribution, LLC*, the Court found that the colors associated with Dippin' Dots ice cream flavors were functional “because [they] indicate[] the flavor of the ice cream, for example, pink signifies strawberry, white signifies vanilla, brown signifies chocolate, etc.” 369 F.3d 1197, 1203-04 (11th Cir. 2004) (discussing examples of colors found to be functional (e.g., red mouthwash connotes cinnamon flavor; blue mouthwash connotes peppermint flavor)). The Eleventh Circuit focused on consumers’ general understanding of the colors at issue there, namely that “the color of ice cream is indicative of its flavor.” *Dippin' Dots*, 369 F.3d at 1205 (agreeing with the district court’s taking of judicial notice of this fact). It therefore appears that the Eleventh Circuit might decide the *Sulzer* case differently.<sup>5</sup>

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<sup>5</sup> Oddly, the Second Circuit in this case cited to *Dippin' Dots* as favorable precedent, concluding that “[t]he colors on the mixing tips serve roughly the same purpose as the colors of the flash-frozen ice cream that the Eleventh Circuit considered,” 988 F.3d at 183, ignoring the fact that the colors in *Dippin' Dots*

**D. Brand owners and consumers would benefit from a uniform functionality standard among the circuits.**

The inconsistent application of functionality standards among the circuits is harmful to both brand owners and the consuming public. As set forth above, each of the circuits' approaches could very well have led to differing outcomes based on no factor other than the forum chosen. With many brands reaching the nationwide market, a uniform approach to addressing functionality would therefore reduce forum shopping and lead to more consistent outcomes.

Although this Court has previously set forth clear standards for addressing functionality, many circuits have either failed to follow or diverged from this Court's guidance in a manner that will continue to sow uncertainty and confusion if not addressed. Because trademark owners cannot rely on the circuits to produce consistent decisions on issues of their trade dress functionality, the issues raised in this case are timely and in need of this Court's guidance.

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coincided with commonly-held perceptions of what flavors are associated with particular colors. In contrast here, the record showed that all mixing tips of the same diameter were *not* all the same color, as evidenced by the fact that "other companies use different or no colors." *Sulzer*, 988 F.3d at 183. It therefore appears that the Second Circuit may have misconstrued the holding in *Dippin' Dots*.

**CONCLUSION**

INTA urges the Court to grant the underlying petition for certiorari in order to correct the error of law made by the Second Circuit and to bring needed clarity to the proper test for addressing aesthetic functionality.

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Respectfully submitted,

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