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**In the Supreme Court of the United States**

LANARD TOYS, INC., and LANARD TOYS, LTD.,

*Petitioners,*

v.

GENERAL MOTORS CORP. and AM GENERAL, LLC,

*Respondents.*

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

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**PETITION FOR A WRIT OF CERTIORARI**

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## QUESTION PRESENTED

In *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001), this Court ruled (i) that a product design feature is functional, and cannot be protected under trade dress law, if it is “essential to the use or purpose of the article or if it affects the cost or quality of the article,” and (ii) that, in making the functionality determination, “there is no need \* \* \* to engage \* \* \* in speculation about other design possibilities.” *Id.* at 32. The United States Court of Appeals for the Fifth Circuit has since held that the “availability of alternative designs is irrelevant” to whether a design feature is functional, whereas the United States Court of Appeals for the Federal Circuit has since held that the availability of alternative designs is a “legitimate source of evidence to determine whether a feature is functional.”

The question presented is whether the Sixth Circuit panel, in holding that there is no genuine dispute of material fact that certain design elements of respondents’ military vehicle are nonfunctional, erred in considering the availability of alternative product designs.

**PARTIES TO THE PROCEEDING**

Petitioners are Lanard Toys, Inc., and Lanard Toys Limited, defendants-appellants in the courts below. Respondents are General Motors Corporation and AM General, LLC, plaintiffs-appellees in the courts below.

**RULE 29.6 STATEMENT**

Neither Lanard Toys, Inc., nor Lanard Toys Limited is a subsidiary or affiliate of a publicly owned corporation.

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## PETITION FOR A WRIT OF CERTIORARI

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### OPINIONS BELOW

The majority and concurring opinions of the Sixth Circuit (App., *infra*, 1a-22a) are reported at 468 F.3d 405. The district court's order granting summary judgment for General Motors and AM General on trademark and trade dress infringement (App., *infra*, 23a-44a) is unreported.

### JURISDICTION

The judgment of the court of appeals was entered October 25, 2006. The order of the court of appeals denying rehearing was entered January 31, 2007. App., *infra*, 45a-46a. On March 29, 2007, Justice Stevens extended the time within which to petition for a writ of certiorari to and including May 31, 2007. This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

### STATUTORY PROVISIONS INVOLVED

Relevant statutory provisions are set forth at App., *infra*, 58a-76a.

### STATEMENT

This case highlights the stark division among the courts of appeals as to whether the existence of alternative product designs is relevant to determining whether a product design feature is "functional," and therefore ineligible for trade dress protection. By holding there is no genuine dispute of material fact that a set of design features was nonfunctional – based solely on evidence that different, similarly functional design options were available – the Sixth Circuit joined the Federal Circuit in misconstruing this Court's ruling that "speculation about other design possibilities" has no bearing on the functionality question. *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 33-34 (2001). In so doing, it deepened the split among the courts of appeals, with the Fifth Circuit reaching the opposite conclusion that, under *TrafFix*, "[t]he availability of alternative designs is irrelevant." *Eppendorf-Netheler-Hinz GmbH v. Ritter GmbH*, 289 F.3d 351, 357 (5th Cir. 2002).

District courts and commentators have lamented the increasingly unsettled state of the law governing functionality. See, e.g., *Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co.*, 292 F. Supp. 2d 535, 546 (S.D.N.Y. 2003) (“*TrafFix* bears strongly on the import of alternative designs to the question of functionality, but the exact holding of *TrafFix* on this point is highly elusive.”); Mark Alan Thurmon, *The Rise and Fall of Trademark Law’s Functionality Doctrine*, 56 FLA. L. REV. 243, 244, 326 (2004) (“Trademark law’s functionality doctrine is a mess, and the responsibility for this mess rests squarely with the United States Supreme Court.”).

The confusion surrounding this critically important issue led the Sixth Circuit panel to conclude that the structural design elements of respondents’ “Humvee” military vehicle were nonfunctional, simply because other manufacturers had succeeded in building similar military vehicles with somewhat different designs. In addition to placing the Sixth Circuit in direct conflict with the Fifth, that holding runs counter to this Court’s trade dress jurisprudence. This case provides an excellent opportunity for the Court to resolve the disagreement among the circuits and to clarify the extent to which product designs can be protected under trade dress law.

#### **A. Trade Dress and the Functionality Doctrine**

1. Though monopolies are disfavored under the law, trademark rights are exceptions. See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 1:32 (4th ed. 2007). Granting monopoly rights in a trademark is not anticompetitive because only the brand is protected, while the right to copy the underlying product is unaffected. Thus, consumers benefit in two ways: they can identify the products made by the sellers they prefer (because the brand cannot be copied), and they have access to competitively priced alternatives (because the trademark does not grant monopoly rights in the goods themselves).

“Trade dress” traditionally referred to the overall appearance of a product’s packaging. See 1 J. THOMAS

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MCCARTHY, *supra*, § 7:75. It is protectible under trademark law for the same reason word marks and logos are protectible: to “prevent consumer confusion and protect the value of identifying symbols.” *Id.* § 6:3. Over the years, the definition of trade dress has expanded to include the shape and design of the product itself. *Id.* § 8:5. Extending the trademark monopoly to product design, however, creates a significant risk of inhibiting competition by granting monopoly rights in the underlying goods themselves. For this reason, although the law does recognize the ability of product design to function as a source indicator, it also takes pains to guard against improper protection of product design that would confer patent-like rights without the limited term and rigorous review such rights require. It does this through the functionality doctrine, which permits the copying of functional features regardless of secondary meaning or likelihood of confusion. See *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 164-165 (1995). Because a functional design element is not protectible under the Lanham Act, it may be copied by anyone – not just direct competitors. See 15 U.S.C. § 1052(e)(5). This means that, if the design elements of the military Humvee are functional, they could be copied not only by the manufacturer’s direct competitors, but also by Lanard and other toy and hobby manufacturers.

This Court has cautioned against “misuse or overextension of trade dress [protection].” *TrafFix*, 532 U.S. at 29 (citing *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 213 (2000)). First, the Court has noted that “[t]rade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products,” because “[a]llowing competitors to copy will have salutary effects in many instances.” *TrafFix*, 532 U.S. at 29. When multiple competitors are able to offer products that feature the same functional design elements, the resulting price competition inures to consumers’ benefit.

Second, “[i]t is the province of patent law, not trademark law, to encourage innovation by granting inventors a monopoly

over new product designs or functions for a limited time \* \* \*, after which competitors are free to use the innovation.” *Qualitex*, 514 U.S. at 164 (1995). Because the law generally disfavors monopolies, patent applications are subject to rigorous scrutiny, and the period of exclusive rights is limited. After that period, competitors are free to appropriate the innovation however they wish.

The functionality doctrine polices the boundary between the domains of trade dress and patent law. “If a product’s functional features could be used as trademarks \* \* \* a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever.” *Qualitex*, 514 U.S. at 164-165. And, because producers have every incentive to characterize their designs as nonfunctional (and thereby obtain exclusive rights in perpetuity), the party seeking trade dress protection bears the burden of proving that the matter sought to be protected is not functional. 15 U.S.C. § 1125(a)(3). The functionality doctrine thus prevents manufacturers from using trade dress law to circumvent the strictures of the patent process.

The doctrinal division of labor therefore may be stated as follows: If a product feature is functional, a producer seeking exclusive use of it must obtain a patent, which will eventually expire. In contrast, trade dress protection extends indefinitely, but cannot cover a functional product attribute.

2. The *TrafFix* opinion, issued in 2001, provides the Court’s most recent analysis of the functionality doctrine. In that case, plaintiff Marketing Displays, Inc. (“MDI”) had obtained a patent for a type of wind-resistant roadside sign that used a dual-spring design. After the patent expired, defendant TrafFix Devices began manufacturing dual-spring signs that looked like MDI’s, and MDI sued for trade dress infringement.

The district court granted summary judgment for defendant TrafFix, holding that the dual-spring design was functional and thus ineligible for trade dress protection. *TrafFix*, 532 U.S. at 26. The Sixth Circuit reversed, citing the “competitive need”

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test, under which a feature was deemed functional only if its exclusive use would “put competitors at a significant non-reputation-related disadvantage.” *Qualitex*, 514 U.S. at 165. The court of appeals reasoned that it took “little imagination to conceive of a hidden dual-spring mechanism or a tri or quad-spring mechanism that might avoid infringing [MDI’s] trade dress.” *TrafFix*, 532 U.S. at 27 (internal quotation marks omitted). Because there were possible configurations other than MDI’s dual-spring design, the court of appeals concluded that the dual spring was not competitively necessary, so it was nonfunctional in the relevant sense.

This Court reversed, holding that MDI’s dual-spring design was functional despite the availability of alternatives. It explained that although the “competitive need” test is proper in cases of “aesthetic functionality” – in which mere appearance actually serves a function – competitive need is “incorrect as a comprehensive definition.” *TrafFix*, 532 U.S. at 32-33. The Court did not intend for that test to displace the so-called traditional test, in which a design feature is considered functional “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Id.* at 32 (quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850 n.10 (1982)).

In reaffirming the *Inwood* test as the definitive standard for determining whether a product design feature may be protected as trade dress, the Court underlined its longstanding commitment to the principles that trademark protection cannot be granted in derogation of the constitutional scheme, and that the purpose of trade dress protection is to promote – not stifle – competition. See *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938) (plaintiff’s patent in the pillow-shaped form of shredded wheat having expired, competitors were not prevented from selling the cereal in the same functional shape). See also *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964); *Inwood*, 456 U.S. at 857; and *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 160 (1989).

Importantly, the Court in *TrafFix* made a special point of clarifying that, under the traditional test, “[t]here is no need \* \* \* to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose.” *TrafFix*, 532 U.S. at 33. MDI’s dual-spring design was functional, because it “is not an arbitrary flourish in the configuration of MDI’s product; it is the reason the device works. Other designs need not be attempted.” *Id.* at 34.

3. Unfortunately, the Court’s instruction in *TrafFix* that “[t]here is no need \* \* \* to engage \* \* \* in speculation about other design possibilities” has spawned more confusion among the lower courts than it dispelled. The Fifth Circuit understands the statement to mean that, under the traditional test, “[t]he availability of alternative designs is irrelevant.” *Eppendorf*, 289 F.3d at 355. In contrast, the Federal Circuit “do[es] not read the Court’s observations in *TrafFix* as rendering the availability of alternative designs irrelevant”; rather, the availability of alternative designs is “a legitimate source of evidence to determine whether a feature is functional.” *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276 (Fed. Cir. 2002); accord 1 J. THOMAS MCCARTHY, *supra*, § 7:75 (“In the author’s view, the observations by the Supreme Court in *TrafFix* do not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine in the first instance if a particular feature is in fact ‘functional.’”).

In the words of one commentator, “[t]he current division and confusion in the lower federal courts is much more significant than the minor split \* \* \* that led the Supreme Court to intervene in *TrafFix*.” Mark Alan Thurmon, *The Rise and Fall of Trademark Law’s Functionality Doctrine*, 56 FLA. L. REV. 243, 334 (2004).

## **B. Factual Background of the Present Case**

1. In the early 1980s, the United States government solicited proposals for a new High Mobility Multipurpose Wheeled Vehicle, which the government called an “HMMWV”

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(or a “Humvee,” in military slang) to be used by the Armed Forces. AM General was one of three companies awarded “Phase I” contracts, under which the government paid them to develop Humvee prototypes to be tested by the military. *AM General Corp. v. DaimlerChrysler Corp.*, 311 F.3d 796, 808 (7th Cir. 2002).

Pursuant to the contract, AM General designed its prototype to detailed and precise military performance specifications supplied by the government. During the testing phase, the military raised various performance issues with respect to AM General’s prototype. In response, AM General’s engineers made numerous design modifications, including significant changes to the design of the vehicle’s nose grille. *Ibid.* The government awarded the Humvee contract to AM General in 1983. *Ibid.*

Although AM General did not initially identify the design elements in which it claims exclusive rights, AM General’s prototype embodied each of the five design elements that the Sixth Circuit would eventually decide constituted respondents’ protectible trade dress: the grille, the slanted and raised hood, the split windshield, the rectangular doors, and the squared edges. MICHAEL GREEN & GREG STEWART, *HUMVEE AT WAR* 28 (2005). It is unlikely that a contractor bidding on a military project would spend money to add mere ornamental flourishes to its design, but in any event it is clear that these five design elements were critically functional to an effective military combat vehicle:

- *Grille.* A vehicle’s grille must protect the radiator behind it while simultaneously allowing air to pass freely through it. The grille at issue here consists of a series of vertical openings sized to allow maximum airflow while protecting the radiator from damage. The grille’s initial appearance was quite different from the one ultimately put into production. The early prototype had narrow, horizontal openings; the

vertical opening design came later. *Id.* at 26, 28.<sup>1</sup> Shorter vertical slats are stronger than longer horizontal ones, which is important for a combat vehicle that might be overturned or have debris land on it. The grille is set high on the Humvee, allowing for maximum ground clearance and superior mobility. The lights are set wide for broader illumination than the Humvee's predecessors, and high so as not to be obstructed by brush or high water.

- *Slanted and raised hood.* The Humvee's hood is sloped to enhance visibility. The opening on the front part of its hood is a continuation of the grille, allowing air to circulate even when the nose is against a solid object (such as a wall) or under water. As with the grille, the hood is raised to maximize underbody clearance. See [http://www.amgeneral.com/vehicles\\_hmmwv\\_features.php](http://www.amgeneral.com/vehicles_hmmwv_features.php).
- *Split windshield.* The split windshield design incorporates two separate panels of glass. If one panel is shattered, visibility remains through the other panel. The supporting divider may strengthen the windshield frame, including enhancing its ability to support the weight of the Humvee if it flips over in combat. Weapons, cameras, sensors, and other equipment can be attached to the divider. See [http://www.emx-inc.com/EMX\\_Accessories.html](http://www.emx-inc.com/EMX_Accessories.html).
- *Rectangular doors.* The rectangular shape of the Humvee doors maximizes the opening area for rapid ingress and egress of soldiers wearing body armor, helmets, and packs, and carrying rifles. The shape also allows the military's armored version of the

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<sup>1</sup> It is unlikely that this change was made for ornamental rather than functional reasons, because the accelerated time frame for testing the prototype left barely enough time to test for reliability and durability. *Id.* at 23-26.

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doors to be interchangeable (left to right side of vehicle and vice versa) and adds strength to the Humvee. [Http://www.amc.army.mil/amc/pa/releases04/tardec.html](http://www.amc.army.mil/amc/pa/releases04/tardec.html). Adding armor panels to rectangular doors is also easier and cheaper than adding them to irregularly shaped ones.

- *Squared edges.* The squared edges obviously maximize the interior space within the overall size parameters of the Humvee. As with the rectangular doors, the squared edges facilitate the addition of armor plates or panels.

2. In 1993, AM General applied for a federal trademark registration for the grille design. Registration was twice refused on the ground that the grille did not serve as a source identifier and was likely to be confused with existing registrations for the grille configuration for the JEEP Wrangler. *AM General*, 311 F.3d at 809. AM General was finally granted a trademark registration for the grille design in 1996. *Ibid.*

Shortly after the first Gulf War, in an effort to capitalize on the popularity of the Humvee, AM General introduced a commercial vehicle, which it called the Hummer. *Id.* at 808. The Hummer is a modified version of the military vehicle. In 1999, AM General transferred to GM all rights in the civilian Hummer vehicle, and licensed back from GM the right to continue using the grille on the military Humvee, as required by the military specifications. *Id.* at 810. Soon after acquiring rights to the civilian Hummer vehicle (now known as the “H1”), GM unveiled the new H2, a less expensive and smaller vehicle. The H2 differed in many respects from its predecessor, incorporating luxury features not available on the H1 or, of course, on its military counterpart. *Ibid.* The H2 – and, later, the H3 – did not, for example, incorporate the split windshield designed for the military vehicle. At the time this action commenced, AM General claimed ownership of the military vehicle trade dress by virtue of a “Confirmatory Trademark Agreement” executed after this litigation began. GM claimed ownership of the civilian

vehicle trade dress, and both parties asserted rights in an unspecified, shared trade dress common to both.

3. In 1992, petitioner Lanard, a company that manufactures and sells an assortment of military-themed toys, began selling a toy vehicle called the Mudslinger, modeled after the military Humvee. App., *infra*, 2a-3a. The toy's packaging included the phrase "Hyper Humvee." *Ibid.* AM General's licensing agent protested Lanard's use of the word "Humvee" and also suggested that replicas might infringe its trade dress. Though Lanard believed "Humvee" was a generic military designation, it agreed to remove the term from packaging for the toy modeled after that military vehicle and to refrain from challenging AM General's ownership of the mark HUMVEE. Lanard has never produced or sold replicas of the civilian Hummer.

In 1997, Lanard sought a license to use the Humvee and Hummer names on its toy vehicles, but AM General refused. *Ibid.* Lanard then contacted AM General's new licensing agent, enclosing photos of the toy vehicles and again seeking a license to use the names. AM General responded a year and a half later, demanding that Lanard stop selling certain of its military vehicles because of an infringing "nose design." *Ibid.* Subsequent efforts to resolve the matter through negotiation were unsuccessful.

### **C. Procedural History**

1. In March 2001, nine years after Lanard began selling toy military vehicles modeled after the Humvee and at least eight years after AM General first had notice of such sales, GM filed suit against Lanard in the United States District Court for the Eastern District of Michigan, claiming infringement of the Hummer's trade dress. In June 2003, Lanard filed a complaint against AM General in the same court, seeking a declaratory judgment as to AM General's rights in the Humvee vehicle and grille design. App., *infra*, 3a. After AM General asserted counterclaims for infringement, the cases were treated as consolidated for purposes of discovery, summary judgment, and trial.

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During discovery, Lanard deposed Robert J. Gula, then-Senior Vice President of Engineering and Product Development for AM General, and formerly the Deputy Project Manager for the Humvee operation. Gula testified that the shape of the Humvee “was basically a byproduct of a vehicle that was designed to meet a performance specification,” and that “the shape of the vehicle was a result of what it took to meet those requirements.” App., *infra*, 52a, 54a.

Apparently recognizing that Gula’s testimony amounted to a concession that the claimed trade dress elements of the Humvee were functional, GM and AM General prepared a declaration for Gula’s signature (App., *infra*, 55a-57a) later that same day, asserting that the same performance standards could be achieved (and had been achieved by other manufacturers) through one or more alternative design options:

The Government’s requirements could have been met with any number of different vehicle appearances. \* \* \* AM General’s prototype could have had a different appearance and still functioned in the same way. That is because the exterior appearance and styling of the vehicle is not essential to the use or purpose of the vehicle. Indeed, not using the same appearance and styling as AM General’s prototype did not impede Chrysler or Teledyne from meeting the Government’s technical specification or from competing for the Government contract.

App., *infra*, 57a.

In April 2004, GM and AM General (jointly) and Lanard each moved for summary judgment. To carry their statutory burden of proving the nonfunctionality of their unregistered product design,<sup>2</sup> GM and AM General relied exclusively on Gula’s rehabilitative declaration emphasizing the availability of alternative designs. Respondents submitted no additional evi-

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<sup>2</sup> Respondent GM owns a federal registration for the grille design only. When a design is registered, the burden of proof regarding functionality shifts to the party challenging the validity of the trade dress rights.

dence of any kind, and the record therefore contains no evidence whatever that the claimed features are incidental, arbitrary, or ornamental, or that they are not “the reason the device works.” *TrafFix*, 532 U.S. at 33.

The district court mistakenly believed that functionality is a defense to infringement of an unregistered trade dress and that Lanard had the burden of proof on that issue. See 15 U.S.C. § 1125(a)(3) (“the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional”). App., *infra*, 28a. The court granted GM’s and AM General’s motion with respect to the Mudslinger vehicle. *Ibid.* After a jury trial on Lanard’s laches defense and on damages, the jury awarded GM an 8% royalty on sales of the toy vehicle, as well as Lanard’s profits.

2. On appeal, although acknowledging that the district court had erred in treating functionality as a defense rather than requiring plaintiffs to prove nonfunctionality as an element of the infringement claim, the Sixth Circuit affirmed the summary judgment ruling. With respect to the validity of the asserted trade dress elements, the only question at issue here, the panel first determined that the trade dress consisted of the vehicle’s grille, slanted and raised hood, split windshield, rectangular doors, and squared edges. Then, after stating that the availability of other potential designs was “insufficient evidence” of nonfunctionality, the panel nonetheless concluded that respondents’ design is nonfunctional, basing its decision on Gula’s declaration as to the availability of alternatives, which was the *only* evidence in the record on that point. App., *infra*, 13a-14a.

Further underscoring the absence of any evidence of nonfunctionality in the record, and its confusion regarding the functionality doctrine, the panel went on to say that GM and AM General had met their burden of proving the nonfunctionality of the unregistered product design because “the plain appearance of the vehicle shows that the elements which comprise its trade dress are *inherently non-functional*.” App., *infra*, 14a (emphasis added). For, although “[t]he military un-

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doubtedly had function in mind while designing the Humvee,” the exterior appearance and styling of the vehicle were “more likely an unrelated afterthought.” App., *infra*, 14a.

### **REASONS FOR GRANTING THE WRIT**

The Court should grant review of the Sixth Circuit’s decision for at least three reasons. *First*, the lower courts are sharply divided over the question whether the availability of design alternatives is relevant to assessing a design feature’s functionality. Commentators agree that this Court’s pronouncement in *TrafFix* is the source of that confusion. *Second*, the Sixth Circuit’s opinion conflicts with this Court’s precedents. In relying on the availability of alternative design choices as the basis for its determination of nonfunctionality, the Sixth Circuit departed from the principle that, if a design feature is “the reason the device works,” then “other designs need not be attempted.” *TrafFix*, 532 U.S. at 34. The panel also invoked as a basis for its holding the novel concept of “inherent[] nonfunctional[ity],” which, if not set straight, could drastically erode the functionality limitation on trade dress protection. *Third*, a clear and uniform test for functionality is critically important; not only does it demarcate the bounds of trademark law, but a split involving the Federal Circuit (which controls the Patent and Trademark Office’s standards for registering a mark) has particularly troubling consequences for the consistent application of trade dress doctrine across the country.

#### **I. THE CIRCUITS ARE DEEPLY SPLIT ON THE APPLICATION OF THE FUNCTIONALITY TEST AS SET FORTH IN *TRAFFIX***

The basic reason why lower courts are at odds in their understanding of the *TrafFix* standard for functionality is that they disagree over the extent to which that decision effected a change in the law. To understand their confusion, one must first appreciate the legal landscape before *TrafFix* was decided.

**A. Before *TrafFix*, Lower Courts Were Confused About Whether A Competitive-Need Analysis Was Appropriate For Traditional Design Features**

The evolution of the functionality doctrine over the last several decades reflects a pattern of lower courts moving toward a functionality test based on “competitive need” – a standard that considers the availability of alternative designs – and straining to fit this Court’s guidance into that model. The Court, however, has never embraced a competitive-need test for functionality with respect to traditional products, although it has applied it in cases of aesthetic functionality. As the brief history recounted below makes clear, *TrafFix* corrected the Sixth Circuit and other lower courts that had mistakenly applied the aesthetic functionality test in cases of traditional functionality, where analysis of competitive need has no place – and where the availability of alternative designs is therefore irrelevant.

1. In 1938, the Restatement of Torts outlined a claim for “Imitation of Appearance.” To prove that a defendant’s imitation was unprivileged, the plaintiff was required to show that a product’s features were nonfunctional, and a “functional feature” was defined to be one that “affects [the product’s] purpose, action or performance, or the facility or economy of processing, handling or using [it].” RESTATEMENT (FIRST) OF TORTS § 742 (1938). That definition of functionality was very broad, essentially equating to usefulness, and many lower courts – most notably the Court of Customs and Patent Appeals (“CCPA”) – added glosses to the formulation, eventually reducing it to the question “whether the law permits \* \* \* a monopoly” like the one a plaintiff seeks to gain through its infringement claim. *Application of Deister Concentrator Co.*, 289 F.2d 496, 499 (CCPA 1961).

In 1982, the CCPA pushed its functionality reasoning to its natural conclusion: if “the effect upon competition is really the crux of the matter,” then the test for functionality is whether other producers have a competitive need for the design feature in question. *In re Morton-Norwich Products, Inc.*, 671 F.2d

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1332, 1341 (CCPA 1982). In *Morton-Norwich*, the court held that a spray bottle design was not legally functional, reasoning that the basis of the functionality doctrine is “not 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.” *Id.* at 1339. It noted that “[t]he evidence, consisting of competitor’s molded plastic bottles for similar products, demonstrates that the same functions can be performed by a variety of other shapes with no sacrifice of any functional advantage. There is no necessity to copy appellant’s trade dress to enjoy any of the functions of a spray-top container.” *Id.* at 1342. Thus, the *Morton-Norwich* “competitive need” test for functionality explicitly examined the availability to competitors of functionally equivalent designs. *Id.* at 1341-1342.

2. Later that year, this Court decided *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844 (1982). Although *Inwood* was not a case about functionality, the Court observed in a footnote that, “[i]n general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Id.* at 850 n.10. In the years following *Inwood*, many courts of appeals read *Inwood* not to preclude a competitive-need analysis. The Second Circuit took the lead, characterizing the *Inwood* “cost or quality” language as dictum, and applying *Morton-Norwich*. See *LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 76-77 (2d Cir. 1985); see also *Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 429 (5th Cir. 1984) (“The ultimate inquiry concerning functionality \* \* \* is whether characterizing a feature or configuration as protected ‘will hinder competition or impinge upon the rights of others to compete effectively in the sale of goods.’” (quoting *Morton-Norwich*, 671 F.2d at 1342)).

3. In 1995, this Court’s *Qualitex* decision lent some support to the lower courts’ belief that *Inwood* did not foreclose the competitive-need analysis set forth in *Morton-Norwich*. In *Qualitex*, the issue was whether plaintiff could enjoy trade dress

protection of the particular green-gold color it used on its dry cleaning press pads. The Court held that a mere color can, if it has taken on secondary meaning, meet the basic legal requirements for a trademark. 514 U.S. at 166. In so doing, it used language that could be interpreted to equate the *Inwood* “essential to the use or purpose” or “affect[ing] the cost or quality of the article” standard with competitive need:

This Court \* \* \* has explained that, “in general terms, a product feature is functional,” and cannot serve as a trademark, “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,” that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.

*Id.* at 165 (quoting *Inwood*, 456 U.S. at 850 n.10). The “significant non-reputation-related disadvantage” test of competitive need was one that had long been used in cases of aesthetic functionality, because the traditional “essential to the use or purpose \* \* \* or \* \* \* affect[ing] the cost or quality” test does not work well in that setting. For example, if farmers prefer to match the color of their loaders to the color of their tractors, a competitor entering the market might have a competitive need to copy “John Deere green” even though that color would not render the equipment more useful. See *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85, 97-98 (S.D. Iowa 1982). For that reason, aesthetic functionality has always been evaluated in terms of competitive need. See RESTATEMENT (FIRST) OF TORTS § 742 cmt. a (1938) (“The determination of whether or not [aesthetic] features are functional depends upon \* \* \* whether prohibition of imitation by others will deprive the others of something which will substantially hinder them in competition.”). The language in *Qualitex*, however, could be read as the Court’s endorsement of the competitive-need standard in cases of *both* aesthetic and traditional functionality.

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**B. The *TrafFix* Decision Makes Clear That Different Tests Apply In Cases Of Traditional And Aesthetic Functionality**

As explained above, the question in *TrafFix* was whether plaintiff, a manufacturer of temporary roadside signs capable of withstanding gusts of wind, could invoke trade dress rights to prevent a competitor from imitating its dual-spring design. The Sixth Circuit held that the dual-spring design was not functional, reasoning that, because various other spring configurations might accomplish the same end as plaintiff's design, the dual-spring design was not one whose exclusive use would "put competitors at a *significant* non-reputation-related disadvantage." *Marketing Displays, Inc. v. TrafFix Devices, Inc.*, 200 F.3d 929, 940 (6th Cir. 1999) (quoting *Qualitex*, 514 U.S. at 165). In other words, the Sixth Circuit read *Qualitex* to endorse a competitive-need analysis in cases of traditional functionality.

This Court reversed, holding that the competitive-need standard is "incorrect as a comprehensive definition" of functionality. *TrafFix*, 532 U.S. at 33. It explained that, although "[i]t is proper to inquire into a 'significant non-reputation-related disadvantage' in cases of esthetic functionality, the question involved in *Qualitex*," that test "did not purport to displace the th[e] traditional rule" set forth in *Inwood*. *Ibid*. Instead, "[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." *Ibid*.

The Court had little trouble concluding that MDI's dual-spring design was functional, because it "provides a unique and useful mechanism to resist the force of the wind." *Ibid*. The Court made clear that "[t]here is no need \* \* \* to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. \* \* \* The dual-spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. Other designs need not be attempted." *Ibid*.

### C. The Ensuing Chaos

Unfortunately, the explanation of functionality in *TrafFix* has, if anything, spawned more confusion than it dispelled. Within a year after that decision, the courts of appeals had once again split on one of the questions *TrafFix* sought to answer: what evidentiary role, if any, the availability of alternative product designs should play in assessing functionality.

1. In *Eppendorf-Netheler-Hinz GmbH v. Ritter GmbH*, 289 F.3d 351 (5th Cir. 2002), plaintiff Eppendorf was a manufacturer of pipette tips that accurately dispensed small volumes of liquid for medical purposes. Eppendorf sued Ritter for infringement of certain asserted trade dress elements, such as the plastic fins on the pipette tips. *Id.* at 354. At trial, which took place before this Court decided *TrafFix*, Eppendorf's expert argued that the design features were nonfunctional because "the appearance and number of fins could be changed without affecting the function of the fins." *Id.* at 357. The jury found the features to be nonfunctional, and on appeal Eppendorf defended the verdict on the ground that "the evidence clearly established that there were alternative designs to each of the eight non-functional features." *Ibid.*

The Fifth Circuit reversed the finding of nonfunctionality. It explained that, although Eppendorf's argument involving alternative designs was "consistent with this court's [previous] utilitarian definition of functionality," it is "unpersuasive in light of the Court's discussion of functionality in *TrafFix*." *Ibid.*<sup>3</sup> It read *TrafFix* as establishing two tests for functionality: one for traditional products, and one for aesthetically functional products. Under the traditional test for functionality, "a product feature is functional, and cannot serve as a trademark, if it is

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<sup>3</sup> In this context, a "utilitarian" feature is one for which copying is a competitive necessity. See *Morton-Norwich*, 671 F.2d at 1339 ("'Utilitarian' means 'superior in function (de facto) or economy of manufacture,' which 'superiority' is determined in light of competitive necessity to copy.").

essential to the use or purpose of the article or if it affects the cost or quality of an article.” *Id.* at 355 (quoting *TrafFix*, 532 U.S. at 32). “Under this traditional definition,” it reasoned, “if a product feature is ‘the reason the device works,’ then the feature is functional. *The availability of alternative designs is irrelevant.*” *Ibid.* (emphasis added). Because Eppendorf’s expert conceded that “fins of some shape, size, or number are necessary to provide support for the flange and to prevent deformation of the product,” the Fifth Circuit held that they are “essential to the operation of the Combitips,” and therefore “functional as a matter of law.” *Id.* at 358. Thus, in its view of the law, “[a]lthough alternative designs are relevant to the utilitarian [*i.e.*, competitive-need] test of functionality, alternative designs are not germane to the traditional test for functionality.” *Id.* at 358.

2. The Federal Circuit sees things quite differently. In *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268 (Fed. Cir. 2002), the Trademark Trial and Appeal Board had sustained Rexnord’s challenge to Valu’s registration of trade dress relating to its designs of conveyor guide rails, holding that the shapes were functional under the four *Morton-Norwich* “competitive need” factors, one of which explores the availability of alternative designs. *Id.* at 1272. The Federal Circuit affirmed the Board’s finding of functionality and, in particular, its examination of alternative design possibilities under the *Morton-Norwich* analysis.

Unlike the Fifth Circuit, which read *TrafFix* as foreclosing the competitive-need approach to functionality that considered alternative design possibilities, the Federal Circuit “d[id] not understand the Supreme Court’s decision in *TrafFix* to have altered the *Morton-Norwich* analysis.” *Id.* at 1276. The Federal Circuit opined that

the *Morton-Norwich* factors aid in the determination of whether a particular feature is functional, and the third factor focuses on the availability of “other alternatives.”  
\* \* \* Nothing in *TrafFix* suggests that consideration of alternative designs is not properly part of the overall mix,

and we do not read the Court's observations in *TrafFix* as rendering the availability of alternative designs irrelevant. Rather, we conclude that the Court merely noted that once a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available. But that does not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine whether a feature is functional in the first place.

*Ibid.* The Federal Circuit noted that its view was in accord with that of a leading treatise. See 1 J. THOMAS MCCARTHY, *supra*, § 7:75 (“In the author’s view, the observations of the Supreme Court in *TrafFix* do not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine in the first instance if a particular feature is in fact ‘functional.’”).

3. In the years since the Federal Circuit decided *Valu Engineering*, numerous courts have noted the division of authority on the evidentiary role, if any, that alternative designs play in assessing functionality. See *Antioch Co. v. Western Trimming Corp.*, 347 F.3d 150, 156 (6th Cir. 2003) (noting the split among the Fifth and Federal Circuits and holding that, “at the very least, a court is not *required* to examine alternative designs when applying the traditional test for functionality”); *Straumann Co. v. Lifecore Biomedical Inc.*, 278 F. Supp. 2d 130, 135 n.4 (D. Mass. 2003) (characterizing the relevance of the availability of design alternatives as a “hotly contested question” in the Fifth, Sixth, and Federal Circuits); *Invisible Fence, Inc. v. Technologies, Inc.*, 2007 WL 273129, \*4-5 (N.D. Ind. Jan. 26, 2007) (noting the split among the Fifth, Sixth, and Federal Circuits); *New Colt Holding Corp. v. RJG Holdings of Florida, Inc.*, 312 F. Supp. 2d 195, 213-214 (D. Conn. 2004) (same).

The secondary literature likewise has chronicled the increasingly diverse functionality landscape, and called for this

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Court to issue further guidance. See Vincent N. Palladino, *Trade Dress Functionality after Traffix: the Lower Courts Divide Again*, 93 TRADEMARK REP. 1219, 1219-1220 (2003) (there is a “new split of authority” over whether “evidence concerning the availability of alternative designs [is] relevant”); Justin Pats, *Conditioning Functionality: Untangling the Divergent Strands of Argument Evidenced by Recent Case Law and Commentary*, 10 MARQ. INTELL. PROP. L. REV. 515, 520 (2006) (a “great deal of variance has surfaced” in the courts of appeals since *Traffix*, with some courts considering alternative designs as part of a competitive-need analysis, and others eschewing them under the *Inwood* test); Margreth Barrett, *Consolidating the Diffuse Paths to Trade Dress Functionality: Encountering Traffix on the Way to Sears*, 61 WASH. & LEE L. REV. 79, 83, 129-135 (2004) (noting the “considerable disagreement \* \* \* among \* \* \* scholars and the courts of appeals over precisely how the Supreme Court intended its functionality standard to be interpreted and applied,” including whether “to exclude evidence of alternatives from the initial functionality determination”); Siegrun D. Kane, *Trademarks Just Ain't What They Used to Be*, 842 PLI/PAT 261, 272 (2005) (“There is an ongoing debate about whether *Traffix* changed the longstanding principle that the availability of alternative designs constitutes evidence of nonfunctionality.”).

4. In the present case, the Sixth Circuit adopted reasoning indistinguishable from the Federal Circuit’s. The court purported to adopt a position between the Fifth Circuit’s position and the Federal Circuit’s – it took note of the existence of alternative designs, but called them “*insufficient* evidence for nonfunctionality” because the “mere existence of other potential designs is no defense to a design’s functionality.” App., *infra*, 13a (emphasis added). Having said that, however, the panel went on to assign the presence of alternatives precisely the dispositive role it professed to disclaim. The *only* evidence of nonfunctionality in the record was the Gula declaration, which asserted that the Humvee’s grille, slanted and raised hood, split windshield, rectangular doors, and squared edges were “not

essential to the use or purpose of the vehicle,” insofar as the government’s performance requirements “could have been met with any number of different vehicle appearances.” App., *infra*, 57a.<sup>4</sup> If this case had been heard in the Fifth Circuit, it would have come out the other way. Because the Fifth Circuit would have found no evidence of nonfunctionality whatever in the Gula declaration, it would have held that GM could not meet its burden. The Court should step in to resolve the circuit split to ensure uniform outcomes in the courts below.

It is particularly bizarre that the Sixth Circuit affirmed a grant of summary judgment to respondents based on the Gula declaration alone. That document (App., *infra*, 55a-57a) – a four-page, litigation-driven testimonial from AM General’s Senior Vice President – *at most* showed the availability of alternative designs. Not a word of it remotely supported the proposition that the design features at issue are nonfunctional. Even if true that the Humvee “could have had a different appearance and still functioned in the same way” (App., *infra*, 57a), the record was utterly devoid of evidence that any of the elements identified by the court was “an arbitrary flourish in the configuration of” the Humvee. *TrafFix*, 532 U.S. at 34. To the contrary, as AM General’s own website makes abundantly clear, these features are “the reason the [vehicle] works.” *Ibid.* Only by adhering to the same preconceptions it followed in *TrafFix*, which led to a reversal in this Court, could the Sixth

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<sup>4</sup> Evidence supporting the nonfunctionality of the grille, which is the subject of a federal registration, must be analyzed differently from evidence supporting the other four elements of the product design. Because a federal registration for a design feature is presumably granted only upon a showing of nonfunctionality, the registration itself may be considered evidence. However, there are two problems with looking to the registration as evidence of nonfunctionality in this case. First, the registration was issued upon a lesser showing than the one established in *TrafFix*. See *infra* at 27-28. Second, even an incontestably registered mark remains subject to the functionality defense (see 15 U.S.C. § 1115(b)(8)), but Lanard has been deprived of its statutory right to defend itself on these grounds. See *infra* at 26.

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Circuit have believed that a declaration suggesting the availability of alternative designs sufficed to meet plaintiffs' burden of establishing nonfunctionality. This Court should once again review the Sixth Circuit's excessive enthusiasm for granting trade dress protection to functional design elements.

## II. THE SIXTH CIRCUIT'S OPINION MISCONSTRUES *TRAFFIX* AND DANGEROUSLY WEAKENS THE FUNCTIONALITY REQUIREMENT

In two distinct ways, the Sixth Circuit's opinion in this case threatens to erode the high evidentiary requirement this Court has imposed for parties attempting to prove that their product designs are nonfunctional. *First*, allowing plaintiffs to use evidence of alternative design possibilities in support of their nonfunctionality arguments makes it considerably easier for them to gain exclusive use of design features without resort to the rigorous patent review process. *Second*, by describing the Humvee's design elements as "*inherently* non-functional" (Pet. App., *infra*, 14a (emphasis added)) – a novel and nonsensical classification – the opinion below risks setting a precedent that relieves plaintiffs of their burden of adducing factual support for their nonfunctionality arguments.

1. A return to first principles makes clear that the Sixth and Federal Circuits broke with this Court's precedents in concluding that evidence of alternative designs is relevant to an assessment of functionality. As this Court has explained, the purpose of trade dress protection, like trademark protection, is "to 'secure to the owner of the [trade dress] the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.'" *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992) (citation omitted). It accomplishes this by granting producers the exclusive right to use product designs whose *only* purpose is to identify the producer of the good, *i.e.*, ones that have no function. If a design is functional, exclusive use of it must come, if at all, through the patent process. See *Qualitex*, 514 U.S. 159 at 164 ("It is the province of patent law, not trademark law, to

encourage innovation by granting investors 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, \* \* \* a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever.” *Qualitex*, 514 U.S. at 164. That is why the Court has regularly cautioned against “misuse or over-extension of trade dress [protection].” *TrafFix*, 532 U.S. at 29 (citing *Wal-Mart*, 529 U.S. at 213). Thus, if trade dress law is to serve its purpose of enabling reputation-based competition without also risking an end run around the strictures of patent law for useful features, it is critical to have a meaningfully broad, fact-based definition of functionality.

The need to limit the scope of trade dress protection explains the breadth of the traditional functionality test set forth in *Inwood* and reaffirmed in *TrafFix*: “a product feature is functional if it 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. Under that formulation, if a product design is “the reason the device works” (*id.* at 34), it is not eligible for trade dress protection, which extends only to features that are “arbitrary flourish[es].” *Ibid.* It is true that the proponent of trade dress protection faces a high bar, because “product design almost invariably serves purposes other than source identification.” *Id.* at 29. But that is as it should be – whether a feature’s asserted usefulness qualifies it for protection is the province of patent, not trade dress law.

Because design features can be functional without being competitively necessary, the existence of alternative product designs – which gives insight only into competitive need – is irrelevant to assessing a product’s functionality. Reliance on the availability of alternatives would be akin to allowing trademark protection for the word “car” as long as the alternative “auto” is available. But that deviates sharply from the longstanding imperative that trademark law does not protect what must by its nature and purpose be available to all competitors. It does not

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matter how many synonyms exist for a particular generic designation; all are in the public domain. By the same token, no matter how many alternatives exist for a particular useful design, all must remain in the public domain and available to competitors.

Only evidence that a design feature is a mere arbitrary flourish is evidence of nonfunctionality. The Sixth Circuit erred in concluding otherwise, as did the Federal Circuit before it. By allowing plaintiffs to point to alternative designs as evidence of nonfunctionality, those courts impermissibly lower the bar to obtaining trade dress protection.

2. The Sixth Circuit's opinion also threatens to weaken the functionality requirement with its remarkable statement that "the plain appearance of the vehicle shows that the elements which comprise its trade dress are *inherently non-functional*." App., *infra*, 14a (emphasis added). The classification of the design features at issue here as falling within that novel doctrinal category implies that, in the panel's view, the features are by their very nature *incapable* of serving any function. See WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY (UNABRIDGED), at 1163 (1986) (defining "inherent" to mean "structural or involved in the constitution or essential character of something").

As applied to the grille, split windshield, rectangular doors, squared edges, and raised hood of a military vehicle, the "inherently non-functional" label is simply a way to substitute the court's preferred conclusion for any analysis whatever of the inconvenient facts.<sup>5</sup> The Sixth Circuit effectively ruled that

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<sup>5</sup> This is especially grievous with respect to the grille, as the Sixth Circuit's substitute for establishing nonfunctionality robs competitors of their statutory right to rebut the presumption of validity of a registered mark on functionality grounds. The Lanham Act provides that the functionality of a design feature is a defense that can be asserted at any time, even after a registration has become incontestable. See 15 U.S.C. § 1115(b)(8). If, however, a feature is "inherently nonfunctional," i.e., *incapable* of serving a function, then challenging the validity of the mark

the grille design is *incapable* of protecting the vehicle's radiator while allowing air to pass freely through it; the split windshield is *incapable* of adding strength to the windshield and frame, enhancing the vehicle's ability to support its own weight if flipped upside down; the rectangular doors are *incapable* of maximizing the opening area for fast ingress and egress of soldiers wearing gear and carrying rifles; the squared edges are *incapable* of maximizing space within the overall size limitations of the vehicle; and the slanted and raised hood is *incapable* of providing greater visibility and wheel clearance.

On a doctrinal level, the notion of "inherently non-functional" product design has no place in trade dress law. "[P]roduct design almost invariably serves purposes other than source identification," which is why "consumer predisposition to equate the feature with the source does not exist." *Wal-Mart*, 529 U.S. at 213. Just as product "design \* \* \* is not inherently distinctive" (*id.* at 212), it cannot be inherently nonfunctional. Instead, much as a party attempting to register a mark must prove that it has acquired secondary meaning (*ibid.*), a plaintiff claiming trade dress infringement bears the burden of proving nonfunctionality. See 15 U.S.C. § 1125(a)(3). The Sixth Circuit's language to the contrary is doctrinally untethered.

Most significant for present purposes, however, is the fact that the "inherently non-functional" description of the Humvee's trade dress elements threatens to give other federal courts license to relieve plaintiffs of the burden of factually proving nonfunctionality. It similarly threatens to deprive defendants of their ability to show that the features are indeed functional; after all, there is no contrary evidence that could ever overcome an "inherent" characteristic. Each potential development would make it easier for plaintiffs to show nonfunctionality, which risks allowing trademark law to "make

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on functionality grounds is literally impossible. Therefore, the present split in the circuits not only precludes uniformity of case law, it effectively negates even that uniformity meant to be effected by federal statute.

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an ‘end run’ around the strict requirements of utility patent law by giving equivalent rights to exclude.” 1 J. THOMAS MCCARTHY, *supra*, § 7:64.

### III. THE CIRCUIT CONFLICT CONCERNS A MATTER OF OVERRIDING IMPORTANCE AS TO WHICH NATIONAL UNIFORMITY IS REQUIRED

This Court has underscored the importance of a uniform national rule in the realm of intellectual property. See *Bonito Boats*, 489 U.S. at 162 (“one of the fundamental purposes behind the Patent and Copyright Clauses of the Constitution was to promote national uniformity in the realm of intellectual property”). The circuit split following *TrafFix* shows that there is in fact no national uniformity with respect to the critical issue of when an unpatented design feature may be protected under trade dress law; to the contrary, it has troubling implications for the registrability and enforcement of product design trade dress.

Once a trademark registration is registered in the Patent and Trademark Office, it is presumptively valid, and the burden shifts to any challenger to prove (for example) that the registered design is functional. See 15 U.S.C. § 1057(b). However, because the Patent and Trademark Office is bound by the decisions of the Federal Circuit (TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 101.03), federal trademark registration for a product design will necessarily be issued or refused based on the Federal Circuit’s interpretation of the *TrafFix* test. As explained above, that court permits plaintiffs to point to the availability of alternative designs as evidence of nonfunctionality, which makes it easier for plaintiffs to prove nonfunctionality in the Federal and Sixth Circuits than in the Fifth Circuit. If a product design registration is granted due in part to the existence of alternatives, but the owner seeks to enforce that registration in the Fifth Circuit, that court will have to choose between giving effect to the statutory presumptions and applying its own understanding of this Court’s *TrafFix* test. Hence, at least in some jurisdictions, the circuit split creates an unacceptable disconnect between the standard for establishing that a product

design is nonfunctional for registration purposes, and the standard for establishing that it is nonfunctional for enforcement purposes.

Clear instructions from this Court with respect to interpretation of the “essential to the use or purpose” prong of the functionality test are therefore necessary to ensure a uniform national rule in the realm of intellectual property.

**CONCLUSION**

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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MAY 2007

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