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## DEFENSIVE AESTHETIC FUNCTIONALITY: DECONSTRUCTING THE ZOMBIE

*By Anthony L. Fletcher\**

### I. INTRODUCTION

Dictionary.com<sup>1</sup> defined “zombie” as “the body of a dead person given the semblance of life, but mute and will-less, by a supernatural force, usually for some evil purpose.” The word is a decent metaphor for the doctrine of defensive aesthetic functionality; believed buried and nearly forgotten, it unexpectedly arose and stalked the marketplace earlier this year, claiming as its victim an eternal “flapper” named Betty Boop. Whether that is “evil” is a matter of opinion, but as of this writing, it is believed to be moot—until it arises again, which seems likely, sooner or later.

Functionality itself is a conundrum. The U.S. Trademark (Lanham) Act of 1946 lists it as a ground for refusing registration,<sup>2</sup> as a basis for cancellation of a registration at any time,<sup>3</sup> as a reason for denying “incontestable” status to registrations,<sup>4</sup> and as a challenge that may be asserted against the conclusiveness of an incontestable registration as evidence of exclusive right to use the mark that is the subject of the registration.<sup>5</sup> But the Act nowhere defines “functional” or “functionality.”

The only authority that seems to offer anything resembling a concise definition is *Black’s Law Dictionary*, which defines “functional feature” as follows: “*Trademarks*. A design element that is either physically necessary to construct an article or commercially necessary to manufacture and sell it; a product’s attribute that is essential to its use, necessary for its proper and successful operation, and utilitarian rather than ornamental in every detail.”<sup>6</sup> The definition also explains that “[a] functional feature is not eligible for trademark protection.”<sup>7</sup> Further, the

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1. As of Nov. 2011.
2. 15 U.S.C. § 1052(e)(5).
3. 15 U.S.C. § 1064(3).
4. 15 U.S.C. § 1065 by incorporation by reference to 15 U.S.C. § 1064(3).
5. 15 U.S.C. § 1115(b)(8).
6. *Black’s Law Dictionary* (8th ed. 2005).
7. *Id.*

entry contains definitions of “functionality”<sup>8</sup> and “*aesthetic functionality*.”<sup>9</sup> Taken as a whole, these fall only somewhat short of the apocryphal characterization of “legal advice” as that which is “unquestionably correct and absolutely useless.” One can conclude from the analysis thus far that the condition of being “functional” disqualifies whatever it is that is “functional” from being a trademark.<sup>10</sup> The rest offers some tantalizing clues, but the dénouement is yet to come.<sup>11</sup>

## II. BETTY BOOPED

“Defensive aesthetic functionality” is a term adopted from a heading in *McCarthy on Trademarks*, Section 7:82.<sup>12</sup> The section begins:

A handful of cases take the position that the unauthorized use of what is unquestionably someone else’s valid and nonfunctional trademark is not an infringement because the *defendant* is making an aesthetically functional use of the mark.

The doctrine has a checkered history, some of the high (or, perhaps, low) points of which this article will explore. It most recently arose on appeal of a case involving copyright and trademark rights to the name and image of a cartoon character named “Betty Boop,” created *circa* 1930.<sup>13</sup> In the first decision,

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8. “*Trademarks*. The quality of having a shape, configuration, design, or color that is so superior to available alternatives that giving the first user exclusive trademark rights would hinder competition.” *Id.*

9. “A doctrine that denies protection to the design of a product or its container when the design is necessary to enable the product to function as intended.” *Id.*

10. As we will see, the doctrine of defensive aesthetic functionality posits that what is unquestionably (and sometimes registered as) a trademark can be aesthetically functional. Read on, or see the author’s previous foray into these muddy waters, *The Defense of ‘Functional’ Trademark Use: If What Is Functional Cannot Be A Trademark, How Can A Trademark Be Functional?*, 75 TMR 249-68 (1985). See also Anthony L. Fletcher, Douglas W. Kenyon & Mary Jo Leugers, *Functionality, Current Developments in Trademark Law* 121-156, Practising Law Institute—Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series Number 229 (1986) (“PLI Handbook Outline”).

11. Restatement (Third) of Unfair Competition § 17 cmt. a (1995) is more authoritative, but even less enlightening: “A design is ‘functional’ . . . if the design affords benefits in the manufacturing, marketing, or use of the goods or services with which the design is used, apart from any benefits attributable to the design’s significance as an indication of source, that are important to effective competition by others and that are not practically available through the use of alternative designs.” Note also cmt. c: “‘*Aesthetic’ functionality*. When aesthetic considerations play an important role in the purchasing decisions of prospective consumers, a design feature that substantially contributes to the aesthetic appeal of a product may qualify as ‘functional.’ . . . A design is functional because of its aesthetic value only if it confers a significant benefit that cannot practically be duplicated by the use of alternative designs.”

12. 1 J. Thomas McCarthy, *McCarthy on Trademarks*, § 7:82 (4th ed. 2011).

13. *Fleischer Studios, Inc. v. A.V.E.L.A. Inc.*, 636 F.3d 1115 (2011), withdrawn and superseded, 654 F.3d 958 (9th Cir. 2011).

after concluding that the plaintiffs did not own the copyrights in issue, the court exercised its “clear [prerogative] to affirm the district Court’s determination on an alternate basis,” even though “the parties did not cite or argue the application of *Job’s Daughters*[<sup>14</sup>] to the facts of this case and . . . the district court did not base its decision on that case.”<sup>15</sup> The alternative basis was, essentially, the reasoning of *Job’s Daughters*, which led it to the conclusion that the defendant was “not using Betty Boop as a trademark, but instead as a functional product.”<sup>16</sup>

The bases for that conclusion were, as they had been in *Job’s Daughters*: (i) that both the name “Betty Boop” and her image were prominent features of the challenged merchandise, “so as to be visible to others when worn”; (ii) the defendant’s merchandise was “never designated . . . as ‘official’”; and (iii) there was no showing of “a single instance in which a customer was misled about the origin, sponsorship, or endorsement of” the Betty Boop product. We will return to *Job’s Daughters* later in this article.

After hearing argument for rehearing of the case—with INTA,<sup>17</sup> some sports leagues, and some entertainment interests vigorously urging reconsideration as *amici curiae*—the court of appeals withdrew its earlier opinion, entered a superseding opinion, and denied rehearing as moot. The superseding opinion remands the trademark issues to the district court but makes no mention whatever of “functionality” of any sort. This has led two authors to conclude:

The now-withdrawn opinion’s focus on the aesthetic functionality doctrine and whether a trademark was desirable, and therefore unprotected by trademark law, posed a real threat to modern licensing programs for clothing, caps and other merchandise. Before the withdrawal of the previous opinion with its misapplication of the aesthetic functionality doctrine, trademark owners were potentially left powerless to prevent the sale, advertising and distribution of unauthorized merchandise bearing such trademarks as team names, team logos, college logos, college names, cartoon characters or commercial logos.

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14. Int’l Order of *Job’s Daughters v. Lindeberg & Co.*, 633 F.2d 912 (9th Cir. 1980).

15. *Fleischer Studios*, 636 F.3d at 1122.

16. *Id.*

17. Amicus Brief of the International Trademark Association in *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, reproduced at 101 TMR 1390-1417 (2011); the views of the United States Patent and Trademark Office (USPTO)’s Commissioner of Trademarks on the possible consequences of the first appellate decision may be found in Deborah S. Cohn, *Mere Ornamentation and Aesthetic Functionality: Causing Confusion in the Betty Boop Case?*, 101 TMR 1218-1222 (2011), viz.: “In short, aesthetic functionality as a defense is ‘too blunt a weapon,’ and application of the doctrine should be reserved for its original purpose of determining whether a valid trademark exists.” *Id.* at 1222, emphasis added.

Under the substituted opinion, even if Fleischer fails on remand to prove secondary meaning and loses the case, that result would not threaten licensing programs in general. *Trademark owners can therefore rest assured that they may continue to maximize licensing revenue by using trademark law to stop sales of unauthorized merchandise bearing the protected name or design or a counterfeit or colorable imitation of the protected name or design.*<sup>18</sup>

That is an optimistic assessment. A more pessimistic one is that the doctrine of defensive aesthetic functionality had lain dormant for years until Betty Boop resurrected it temporarily. If those who forget history are doomed to repeat it, the Ninth Circuit's recent washing its hands of the issue seems likely to do no more than delay its next resurrection, and, possibly, may hasten it. The first decision, obviously, created a brouhaha in the trademark community, and no doubt introduced many otherwise innocent practitioners to the idea of defensive aesthetic functionality. Because the doctrine, such as it is, offers the only defense to counterfeiting and to certain kinds of trademark infringement that can muster any intellectual support whatever, it seems likely to rise again. Bad ideas can be both contagious and chronic. Therefore, the doctrine seems worthy of consideration of likely grounds for disposition if it arises again.

### III. A SHORT HISTORY OF FUNCTIONALITY

Defensive aesthetic functionality either evolved or devolved, depending on one's point of view, from the doctrines of functionality and aesthetic functionality.

Functionality is a common law doctrine. The first Restatement of Torts defined functionality as “[a] feature of goods [that] affects [a product’s] purpose, action or performance, or the facility or economy of processing, handling or using the product.”<sup>19</sup> The case law was largely developed by the United States Court of Customs and Patent Appeals, a predecessor to the Federal Circuit Court of Appeals.<sup>20</sup> At this point in history, it is more helpful to look to U.S. Supreme Court precedent, which supersedes what the U.S. Court of Customs and Patent Appeals has said and binds all U.S. courts.

In the year that the Restatement of Torts was published, the Supreme Court said that a form was “functional” when “the cost of the [item] would be increased and its high quality lessened if some

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18. Thomas L. Casagrande & Paul C. Van Slyke, *Trademark Licensing Safe Under Betty Boop*, IP Law 360, articles 267290, Aug. 30, 2011 (emphasis added).

19. Restatement (First) of Torts § 742 (ALI 1938).

20. The U.S. Court of Appeals for the Federal Circuit (CAFC) absorbed the jurisdiction of the U.S. Court of Customs and Patent Appeals (CCPA), of the other circuit courts of appeals with respect to patent cases, and of some other entities as well.

other form were substituted for the [original].”<sup>21</sup> By 1982, the Court stated that “In 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.”<sup>22</sup> In 1995, the Supreme Court noted: “This Court consequently has explained that, ‘[i]n general terms, a product feature is functional,’ and cannot serve as a trademark, ‘if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,’ that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.”<sup>23</sup> While the statement is attributed to *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, the “non-reputation-related disadvantage” language is not to be found in the source cited. It is either a gloss added in 1995, or it came from a source other than that cited.

A few illustrations of features of articles found to be functional are: the black color of fruit juice bottles (screens out sunlight and conceals unsightly separation of pulp from liquid),<sup>24</sup> medicine tablet scoring (facilitates division), beveled edges (reduces breakage), concave bottom (aids dividing), and round shape (facilitates manufacture),<sup>25</sup> and the soothing pink color of PEPTO-BISMOL stomach relief syrup (“a disordered stomach will accept that which is pleasing and reject that which is repulsive”).<sup>26</sup> By contrast, one example of nonfunctionality is the color pink of fibrous glass residential insulation (no utilitarian purpose).<sup>27</sup>

The original Restatement of Torts also identified another variety of functionality:

When goods are bought largely for their aesthetic value, their features may be functional because they definitely contribute to that value and thus aid the performance of an object for which the goods are intended. . . . A candy box in the shape of a heart may be functional, because of its significance as a gift to a beloved one, while a box of a different shape or the form in which the ribbon is tied around the box may not be functional.<sup>28</sup>

The principal difficulty with this passage is that everything “may” (or, presumably, “may not”) be functional. Even in 1938, one suspects that the candy box in the shape of a heart had become

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21. *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 121 (1938).

22. *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.10 (1982).

23. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995).

24. *Cal. Crushed Fruit Corp. v. Taylor Beverage & Candy Co.*, 38 F.2d 885 (W.D. Wis. 1930).

25. *Smith, Kline & French Labs. v. Clark & Clark*, 157 F.2d 725, 730 (3d Cir. 1946).

26. *Norwich Pharmacal Co. v. Sterling Drug Co.*, 271 F.2d 569, 572 (2d Cir. 1959).

27. *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 1122 (Fed. Cir. 1985).

28. Restatement (First) of Torts § 742, cmt. a (1938).

trite, particularly in February, so there were obstacles greater (and more immediately apparent) than functionality to asserting a claim of trademark protection. The Restatement then spreads more fog: “The determination of whether or not such features are functional depends upon the question of fact whether prohibition of imitation by others will deprive the others of something which will substantially hinder them in competition.” The question that immediately springs to mind is why those “others” would object to being deprived of “something that will substantially hinder them in competition.” And, for that matter, is it “whether” or “not” that triggers the conclusion of functionality. But assuming the sentence is intended to refer to situations in which the deprivation of the right to use the feature in question will substantially hinder them in competition, the test still begs the question of what is aesthetically functional. The inability of Kellogg to use WHEATIES for its wheat flakes cereal (it used PEP, when it tried to compete) certainly was a competitive disadvantage, yet it was permissible, because WHEATIES is a trademark. However, if its exclusive use by General Mills substantially hindered Kellogg in competing with it, as apparently it did, WHEATIES would be functional and not a trademark, except, of course, it was, and remains, a trademark.

Restatement Third of Unfair Competition § 17, comment c, is a bit more coherent:

When aesthetic considerations play an important role in the purchasing decisions of prospective consumers, a design feature that substantially contributes to the aesthetic appeal of a product may qualify as “functional.” As with utilitarian design features, however, the fact that the design performs a function by contributing to the aesthetic value of the product does not in itself render the design ineligible for protection as a trademark. . . . A design is functional because of its aesthetic value only if it confers a significant benefit that cannot practically be duplicated by the use of alternative designs. . . . The ultimate test of aesthetic functionality . . . is whether the recognition of trademark rights would significantly hinder competition.

The problem with this formulation is that the inquiry into whether a particular aesthetic feature can “practically be duplicated by the use of alternative designs” is unanswerable. It is relatively easy, on the utilitarian side, to determine whether there exist adequate alternatives to, for example, a wheel (usually not). When the question becomes, on the aesthetic side, whether there are equally attractive alternatives to, for example, a fleur de lys, the rather obvious answer for some people is yes, and for others the answer is no.

Perhaps the Supreme Court resolved the mystery in 2001 when it retreated from its “non-reputation-related disadvantage” litmus for functionality set forth in *Qualitex v. Jacobson Products Co.*<sup>29</sup>:

Discussing trademarks, 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.’” Expanding upon the meaning of this phrase, we have observed that a functional feature is one the “exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.” The Court of Appeals in the instant case seemed to interpret this language to mean that a necessary test for functionality is “whether the particular product configuration is a competitive necessity. This was incorrect as a comprehensive definition. As explained in *Qualitex* and *Inwood*, a feature is also functional when it is essential to the use or purpose of the device or when it affects the cost or quality of the device. The *Qualitex* decision did not purport to displace this traditional rule. Instead, it quoted the rule as *Inwood* had set it forth. It is proper to inquire into a “significant non-reputation-related disadvantage” in cases of esthetic functionality, the question involved in *Qualitex*. 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.<sup>30</sup>

For all its inaccuracy (*Qualitex* is not a case of aesthetic functionality<sup>31</sup>) and self-absorption, the passage (after some judicious editing out of clutter) does explicitly state that the “significant non-reputation-related disadvantage” test is appropriate for aesthetic functionality cases. Of course, nobody yet seems to have proffered a definition for “non-reputation-related disadvantage.”

An extensive review of aesthetic functionality cases is beyond the scope of this article, but it seems fair to characterize the law on

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29. *Qualitex*, 514 U.S. at 159.

30. *Traffix Devices v. Mktg. Displays, Inc.*, 532 U.S. 26, 32-33 (2001) (citations omitted without indication, textual underline emphasis added).

31. *Qualitex* (514 U.S. 159) is best thought of as a case not involving functionality at all. The trade dress at issue was the green-gold color of commercial laundry press pads (the commercial laundry equivalent of home ironing board covers). The record was clear that the market was composed mainly of immigrants, the vast majority of whom did not read English. For these consumers, the color was the only indicia of manufacture the purchasing public could rely upon to distinguish the plaintiff's superior pads from those of others. Clearly, it functioned as a trademark.

the subject as “uncertain,” except in one respect; it does always bear on the plaintiff’s entitlement to trademark protection.<sup>32</sup>

#### IV. A SHORT, QUALITATIVE HISTORY OF DEFENSIVE AESTHETIC FUNCTIONALITY AND A CONSIDERATION OF THE CASE FOR IT

*Pagliero v. Wallace China Co. Ltd.*<sup>33</sup> is generally acknowledged to be the genesis of defensive aesthetic functionality. Wallace sold china dinnerware to hotels. It came in four uncopyrighted (or design patented) patterns: Tweed, Hibiscus, Shadowleaf, and Magnolia. Pagliero sold replacement china to hotels, and offered four knockoffs under the same four names. The court considered the pattern claims under Section 44(h) of the Lanham Act, which in general terms afforded protection against “unfair competition.” The legal framework was explained as follows:

Imitation of the physical details and designs of a competitor’s product may be actionable, if the particular features imitated are ‘non-functional’ and have acquired a secondary meaning. But, where the features are ‘functional’ there is normally no right to relief. ‘Functional’ in this sense might be said to connote other than a trade-mark purpose. If the particular feature is an important ingredient in the commercial success of the product, the interest in free competition permits its imitation in the absence of a patent or copyright. On the other hand, where the feature or, more aptly, design, is a mere arbitrary embellishment, a form of dress for the goods primarily adopted for purposes of identification and individuality and, hence, unrelated to basic consumer demands in connection with the product, imitation may be forbidden where the requisite showing of secondary meaning is made.<sup>34</sup>

The application of these principles produced the following result:

These criteria require the classification of the designs in question here as functional. Affidavits introduced by Wallace repeat over and over again that one of the essential selling features of hotel china, if, indeed, not the primary, is the design. The attractiveness and eye-appeal of the design sells the china. Moreover, from the standpoint of the purchaser china satisfies a demand for the aesthetic as well as for the utilitarian, and the design on china is, at least in part, the response to such demand. The granting of relief in this type of situation would render Wallace immune from the most direct

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32. The PLI Handbook Outline, *supra* note 10, contains a number of illustrative cases.

33. 198 F.2d 339 (9th Cir. 1952).

34. *Id.* at 343 (citation and footnote omitted).

and effective competition with regard to these lines of china. It seems clear that these designs are not merely indicia of source, so that one who copies them can have no real purpose other than to trade on his competitor's reputation. On the contrary, to imitate is to compete in this type of situation.<sup>35</sup>

The first thing to note is that this is *not* a case of *defensive* aesthetic functionality. The claim failed because the designs sought to be protected were adjudged to be aesthetically functional, not because their copies were aesthetically functional. Whatever else *Pagliari* may be, it is a case of aesthetic functionality of the trademark or trade dress sought to be protected, not defensive aesthetic functionality. As the opinion states, the designs could not be protected "in the absence of patent or copyright."<sup>36</sup> That, of course, suggests that the designs *could* have been protected if they had been copyrighted (aesthetic functionality is not a defense to copyright infringement).

The case can be explained on the basis that the way the law permits the designs to be protected is copyright, and that where copyright is not obtained, there will be no protection. But to do so ignores some thoughts the court chose to verbalize to explain, although its reach exceeded its grasp. That is because the stated criteria for functionality are more conclusions than a litmus to detect the condition. The two stated criteria are: (a) the design serves "other than a trademark purpose," which says in effect that one criterion for denying trademark protection is non-trademark use of the purported trademark, which seems acceptable here, because varying plate patterns on a line of plates usually do not serve a trademark purpose; the other indicia of functionality appears to be (b) that the feature is "an important ingredient in the commercial success of the product," which overlooks the fact that many trademarks have become very important ingredients in the commercial success of a product—for example, PEPSI.<sup>37</sup>

One of the two tests for nonfunctionality is unremarkable, because it is basically a statement of what a trademark is: (a) "a mere arbitrary design for the goods principally adopted for the purpose of identification and individuality" pretty well identifies what a strong trademark should be; (b) "hence unrelated to basic consumer demand for the product" presumes that trademarks are unrelated to basic consumer demand for a product; to the extent the meaning of a trademark incorporates the characteristics or reputation of a product, that seems to be incorrect. So, *Pagliari's* contribution to the jurisprudence of aesthetic functionality is a few

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35. *Id.* at 343-44.

36. *Id.* at 343.

37. See *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942), *infra* note 62.

talismanic phrases of uncertain meaning and application—phrases that would be invoked in the future to justify more questionable results.

About two and a half decades after *Pagliero*, the publisher of PENTHOUSE magazine attempted to register the magazine's "key logo" as a trademark for jewelry—charms for charm bracelets; the use of the trademark was the configuration of the charm itself. The Trademark Trial and Appeal Board refused registration on the ground that jewelry designs are considered functional by nature because jewelry is purchased on the basis of design. The U.S. Court of Customs and Patent Appeals reversed. "Penthouse is not merely attempting to register a jewelry design as a trademark; it seeks to register its established mark used as a jewelry design."<sup>38</sup> The opinion also noted that registration of the mark for other products was "prima facie evidence that it is capable of recognition as a trademark," and therefore sales could be triggered by recognition of the mark, as well as its attractiveness.<sup>39</sup> *Pagliero* is not cited or mentioned in the case, but the Board's overruled thinking was eerily similar to that of the *Pagliero* case.

The first significant case to stand on *Pagliero*'s shoulders and reach for defensive aesthetic functionality came twenty-one years after *Pagliero* in *Boston Professional Hockey Ass'n, Inc. v. Dallas Cap & Emblem Manufacturing, Inc.*,<sup>40</sup> a suit by a number of National Hockey League member teams and the League against an embroidered emblem manufacturer who was selling embroidered emblems of the teams' official insignias (logos), most of which were registered marks for ice hockey entertainment services. Relief was denied by the trial court, in part in reliance upon *Pagliero*:

The test is not whether the products in question are duplications of their marks, but whether the defendant's use of the mark would mislead the public as to the source of the goods. . . . The designs of the plaintiffs' symbol can be characterized as functional because these have become "an important ingredient in the commercial success of the product." [Citing *Pagliero*] When an artistic rendition creates a demand in the market which is unrelated to its feature as an indicia of source, the law will not afford that design protection under the trademark laws. In the instant case, the registered trademark is, in effect, the product itself. The marks have achieved intrinsic value to a segment of the consuming public which may be attracted to their aesthetic features and to their

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38. *In re Penthouse Int'l Ltd.*, 565 F.2d 679, 682 (C.C.P.A. 1977).

39. *Id.* at 683.

40. 360 F. Supp. 459 (N.D. Tex. 1973). In the interests of full disclosure, the author was the lead counsel for the plaintiffs in the case and its subsequent appeal.

characteristics as a patch to be used on apparel or for collecting.<sup>41</sup>

The case was appealed, and, in the above respects, reversed.<sup>42</sup>

The likelihood of confusion requirement was held to be met on appeal as follows:

The confusion or deceit requirement is met by the fact that the defendant duplicated the protected trademarks and sold them to the public knowing that the public would identify them as being the teams' trademarks. The certain knowledge of the buyer that the source and origin of the trademark symbols were in plaintiffs satisfies the requirement of the act. The argument that confusion must be as to the source of the manufacture of the emblem itself is unpersuasive, where the trademark, originated by the team, is the triggering mechanism for the sale of the emblem.<sup>43</sup>

The answer to the functionality holding was as follows:

The short answer to defendant's arguments is that the emblems sold because they bore the identifiable trademarks of plaintiffs. This fact clearly distinguishes the case from *Pagliero* . . ., relied upon by the district court. *Pagliero* involved designs on chinaware which were neither trademarked, patented nor copyrighted. The court found no unfair competition on the ground that the designs were functional, that is, they connoted other than a trademark purpose. "The attractiveness and eye-appeal of the design sells the china," not the trademark character of the designs. In the case at bar, the embroidered symbols are sold not because of any such aesthetic characteristic but because they are the trademarks of the hockey teams. Those cases which involved utilitarian articles such as pole lamps, . . . fluorescent lighting fixtures . . . and toggle clamps, all involved products which had a consumer demand regardless of their source or origin. The principles involved in those cases are not applicable to a trademark symbol case where the design or symbol has no demonstrated value other than its significance as the trademark of a hockey team.<sup>44</sup>

Approximately five years later, the Ninth Circuit Court took issue with *Boston Professional Hockey*,<sup>45</sup> stating that "[i]nterpreted expansively, Boston Hockey holds that a trademark's owner has a

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41. *Id.* at 462-63, 464.

42. *Boston Prof'l Hockey Ass'n, Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004 (5th Cir. 1975).

43. *Id.* at 1012.

44. *Id.* at 1013.

45. *Int'l Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir. 1980).

complete monopoly over its use, including its functional use, in commercial merchandising.”<sup>46</sup> The Ninth Circuit case involved the symbol of Job’s Daughters, characterized as “a young women’s fraternal organization,”<sup>47</sup> which had a collective membership mark and authorized some manufacturers to make “official” replicas of the mark to be sold to the members. Lindeburg had been such a designee for a year, but was not renewed; he nevertheless continued selling. Job’s Daughters’ enforcement of whatever rights it had in its emblem was haphazard at best, but it chose to sue anyway. The argument of the case is interesting. It begins by positing a dichotomy based on two different contexts of use.

[T]he name “Job’s Daughters” and the Job’s Daughters insignia are indisputably used to identify the organization, and members of Job’s Daughters wear the jewelry to identify themselves as members. In that context, the insignia are trademarks of Job’s Daughters. But in the context of this case, the name and emblem are functional aesthetic components of the jewelry, in that they are being merchandised on the basis of their intrinsic value, not as a designation of origin or sponsorship.<sup>48</sup>

The discussion proceeds to an obvious observation, and then segues into a more debatable one:

It is not uncommon for a name or emblem that serves in one context as a collective mark or trademark also to be merchandised for its own intrinsic utility to consumers. We commonly identify ourselves by displaying emblems expressing allegiances. . . . [I]t would be naive to conclude that the name or emblem is desired because consumers believe that the product somehow originated with or was sponsored by the organization the name or emblem signifies.<sup>49</sup>

In the first place, the two different “contexts” that the court identifies are not so different. When *Job’s Daughters* members “wear the jewelry to identify themselves as members,” the court recognizes that “the insignia are trademarks of Job’s Daughters.” The court acknowledges that “[w]e commonly identify ourselves by expressing allegiances . . . ,” but when we purchase jewelry to do so, “the name and emblem are functional aesthetic components of the jewelry, in that they are being merchandised on the basis of their intrinsic value.” Stripped of the confusion the conjunction of “aesthetically” and “functional” seems often to bring to analysis (“intrinsic value” isn’t far behind), this seems to say that when

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46. *Id.* at 918.

47. *Id.* at 914.

48. *Id.* at 918.

49. *Id.*

members buy insignia jewelry to show their allegiance to their organization, the insignia is aesthetically functional, but when they use the jewelry for its intended purpose, the insignia is a trademark. That is a terribly fine distinction to fathom, much less apply in practice.

As for the naïveté of one who believes that jewelry (or presumably clothing and trinkets) bearing recognized trademarks is perceived to originate with or be sponsored by the trademark owner, there is at least one case, decided two years later, that indicates at least half of sports fans share that “naïve” belief.<sup>50</sup> One is tempted to say that it was naïve of the court to express that opinion without “intrinsic” evidence.<sup>51</sup> Today, that “naïve” belief is probably correct more often than not. The major sports leagues and their members (among others) have devoted fortunes to acquiring trademark rights in their team names and insignia for a broad variety of collateral products bearing those names and insignia, and to vigorously enforcing such rights under trademark counterfeiting (among other) laws. And they have been richly rewarded by doing so.

The court further concluded:

Job’s Daughters did not show a single instance in which a customer was misled about the origin, sponsorship, or endorsement of Lindeburg’s jewelry, nor that it received any complaints about Lindeburg’s wares. Finally, there was evidence that many other jewelers sold unlicensed Job’s Daughters jewelry, implying that consumers did not ordinarily purchase their fraternal jewelry from only “official” sources.<sup>52</sup>

Evidence of actual consumer confusion is notoriously difficult to find, which is one reason some litigants in such cases periodically undertake confusion surveys. But it is one thing to dismiss a trademark infringement case for lack of proof of likelihood of confusion; it is quite another to dismiss the same case

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50. In *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, W.D. Wash., 1982, the defendant was manufacturing jerseys and shirts with the names of National Football League teams on them; the court found that there was actual confusion. “The evidence of actual confusion concerns the testimony of a retail purchaser of defendant’s products and the survey itself. The purchaser assumed defendant’s product (shirts bearing the word ‘Chargers’ on them) were licensed. In the survey, interviewees confronted with identical copies of defendant’s jersey were asked if they felt authorization was required in order to manufacture the jersey. Depending on the descriptive term employed on the jersey, 41.8% of the general public who saw shirts with the city name/regional designation, 53.6% of the interviewees who were shown jerseys with a player’s name on the front and 47.8% of those shown shirts with the team nickname felt that authorization from the NFL or the member club was required. The results were higher for people in the potential purchaser category.” *Id.* at 661.

51. That said, the author notes that he has some misgivings about aspects of that particular survey, although he has no doubt that a significant percentage of the public at that time shared the “naïve” belief found by the survey.

52. *Job’s Daughters*, 633 F.2d at 920.

because the accused infringing use is an “aesthetically functional” use.

Finally, regarding *Job’s Daughters*, Lindeburg’s conduct falls squarely within one of the classic pronouncements of unfair competition:

In doing this defendant, by its very act, admits that it is taking material that has been acquired by complainant as the result of organization and the expenditure of labor, skill, and money, and which is salable by complainant for money, and that defendant in appropriating it and selling it as its own is endeavoring to reap where it has not sown, and by disposing of it to newspapers that are competitors of complainant’s members is appropriating to itself the harvest of those who have sown.<sup>53</sup>

Lindeburg unarguably was reaping (or harvesting) where *Job’s Daughters* had sown, and spouting jargon like “aesthetic functionality” and “intrinsic” cannot alter that fact; it can, however, and apparently did, obscure it.

Two other cases—decided by two district courts in 1983—make arguments that should be considered in support of defensive aesthetic functionality, one very insightful, the other more prosaic. They will be examined in chronological order.

First, in *Bi-Rite Enterprises, Inc. v. Button Master*,<sup>54</sup> a manufacturer of authorized pin-on buttons or badges (and other paraphernalia) displaying names, logos, and pictures of popular musical artists, and sold largely at and outside venues in which those artists were performing, sued a competitor who sold similar merchandise, but had not gone to the trouble or expense of obtaining authorization from the performers. On cross-motions for summary judgment, the court dismissed claims for false designation of origin, trademark dilution, and right of privacy, but allowed claims for violation of the right of publicity of those groups that had granted Bi-Rite exclusive licenses of their right of publicity. The dismissal of the false designation of origin claim was ordered because

. . . marks that are exploited only for their functional value and not to confuse the public receive no protection under unfair competition laws. Functionality in this context means that consumers desire the mark for its intrinsic value and not as a designation of origin.<sup>55</sup>

Because it is a fair statement of what had come before in earlier decisions, this merits analysis.

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53. *Int’l News Serv. v. Associated Press*, 248 U.S. 215, 239-40 (1918).

54. 555 F. Supp. 1188 (S.D.N.Y. 1983).

55. *Id.* at 1195.

Because it is correct that what is not likely to confuse the public receives no protection under unfair completion (or trademark) laws, the verbiage “exploited only for their functional value” is unnecessary. That is fortuitous, because the phrase reads and sounds fine, but is bereft of clear meaning. If “functional” is given its legal meaning “marks that are exploited only for their functional value” faces the problems that (i) marks cannot be functional, and (ii) what is functional cannot be a mark. The phrase is more paradox than description of an identifiable occurrence.

Implicit in “and not to confuse the public” is the notion that, somehow, purpose or intent is determinative. It is not. One who has never heard of TIDE laundry detergent cannot intend to confuse the public by selling his own TIDE laundry detergent, but he will infringe nevertheless, because there is a likelihood of confusion.

“Intrinsic value” presents a significant problem in the formulation as well. The legal definition of “intrinsic value” is: “The inherent value of a thing, without any special features that might alter its market value. The intrinsic value of a silver coin, for example, is simply the value of the silver within it.”<sup>56</sup> To take the context of this case, the intrinsic value of THE BEATLES is the value of those two words without any associations that might alter their market value. That is zilch, plus or minus some infinitesimal amount. So, if words mean what they mean, and consumers do desire the mark THE BEATLES, it is *not* for its intrinsic value; it is, rather, for some other associative value, such as, perhaps, its value as a designation of origin.

“When *I* use a word,” Humpty Dumpty said in rather a scornful tone, “it means just what I choose it to mean—neither more nor less.”

“The question is,” said Alice, “whether you *can* make words mean so many different things.”

“The question is,” said Humpty Dumpty, “which is to be master—that’s all.”<sup>57</sup>

*Bi-Rite* has other interesting observations. One is:

This push to extend trademark protection to the use of established marks on collateral products is only the most recent manifestation of the effort (as old as the trademark law itself) to protect the full economic value of distinctive marks. . . . The cause is rooted in fairness and commercial good sense. People establish marks through effort and

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56. Black’s Law Dictionary, *supra* note 6.

57. Lewis Carroll [Charles Lutwidge Dodgson], *Through the Looking Glass*, chap. 6 (1871).

investment, and the value embodied in these marks should be protected against those who would steal or dilute it. The zeal to protect the full value of marks, and the feelings and economic interests that fuel it, however, cannot negate the fact that unfair competition law clearly requires confusion as to the source of goods before it will protect against the unauthorized use of a mark.<sup>58</sup>

Protection of “the full economic value of distinctive marks,” the court seems to say, is a perfectly reasonable goal and desire, “rooted in fairness and commercial good sense,” but that pesky law of unfair competition thwarts fairness and commercial good sense by protecting only against “confusion as to the source of goods.” Indeed, the cases that accept defensive aesthetic functionality often refer to trademarks as indicia of “source.” That concept is dated. The statutory definition of “trademark” is “any word, name, symbol, or device, or any combination thereof” used or intended to be used by a juristic person “to identify *and distinguish* his or her goods . . . from those manufactured by others and to indicate the source of the goods, even if the source is unknown.”<sup>59</sup> The first object of a trademark, in order, anyway, is to distinguish the goods of its owner from the goods of others. Indication of “source” is secondary, and is either necessary or optional, depending on whether the “and” is conjunctive or disjunctive. In either event, the actual source may be anonymous. Section 43(a), which makes certain types of common law unfair completion actionable, requires only likelihood of “confusion, . . . mistake, or . . . [deceit] as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person. . . .”<sup>60</sup> The rigid focus on source of the product has been obsolete for years.<sup>61</sup> And the types of likely confusion that manifest themselves in *Job’s Daughters* and *Bi-Rite* situations certainly include post-purchase confusion, initial interest confusion, and confusion as to affiliation, connection, or sponsorship. A single-minded focus on confusion of source simply ignores the reality of how trademarks function in the marketplace.

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58. *Bi-Rite*, 555 F. Supp. 1188 at 1194.

59. 15 U.S.C. § 1127 (emphasis added).

60. 15 U.S.C. § 1125(a)(1)(A).

61. “The vast majority of courts recognize post-sale confusion, which may occur among those who see an infringing mark in use by an owner who were not confused at the time they bought the product. Similarly, initial interest confusion which is dispelled by the time of purchase can also be actionable. Reverse confusion is a type of infringement and occurs when the junior user’s advertising swamps the market and customers are likely to be confused into thinking that the senior user’s goods or services are those of the junior user.

Source confusion is not the boundary, for actionable confusion includes confusion as to affiliation, connection or sponsorship. . . .” 4 McCarthy, *supra* note 12, § 23:5 (footnotes omitted).

The protection of trade-marks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trade-mark is a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trade-mark owner has something of value. If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress.<sup>62</sup>

When considered in this light, the holding in *Boston Professional Hockey* that “[t]he confusion or deceit requirement is met by the fact that the defendant duplicated the protected trademarks and sold them to the public knowing that the public would identify them as being the teams’ trademarks. . . .”<sup>63</sup> is not unreasonable at all.

There is one further passage in *Bi-Rite* that merits attention:

Although industry and investment are encouraged by protecting distinctive marks, they are also encouraged by a system that allows entrepreneurs to copy and exploit such marks in nonconfusing ways. Indeed, a system that permits nonconfusing copying may achieve greater social utility and wealth than a system that protects marks without a showing of confusion. The originator of a mark may in some circumstances lose far less in economic value because of copying by others than is gained by the copiers and the public. Copying enables one to sell the mark for a lower price than the originator is able or inclined to sell, thereby making the goods involved accessible to more consumers as the price is reduced. Indeed, the freedom to copy tends to create competition among copiers, and will drive down prices to the point where the marginal return on investment is merely adequate, thus creating the broadest practicable public access to goods, and tending to prevent monopoly profits and prices.<sup>64</sup>

The court goes on to assert that these policies “explain” Congress’s limitation of trademark protection to likelihood of confusion (as opposed to copyright and patent law that simply

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62. *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942).

63. *Boston Prof'l Hockey Ass'n*, 510 F.2d at 1012.

64. *Bi-Rite*, 555 F. Supp. at 1194-95.

prohibits copying). The court cites no source for this observation, congressional or secondary.

This is also an economic argument, one would suppose, for counterfeiting aircraft parts and pharmaceutical products, both of which, if widely practiced, would sooner or later come at the cost of increasing death and grief. Indeed, permitting confusing as well as nonconfusing copying would promote even more “economies.” Such policies can have consequences that probably should be weighed before endorsed. And when last heard from, Congress had not endorsed any such rationale.

*University of Pittsburgh v. Champion Products, Inc.*,<sup>65</sup> is reminiscent of *Boston Professional Hockey*. The University sued a vendor of sweaters and garments bearing the University insignia and name. It lost. The crux of the decision is the following factual findings:

33. The Pitt insignia, as used by Champion prominently emblazoned on soft goods, are functional.

34. These insignia perform the function of allowing the wearer to express identity, affiliation, or allegiance to Pitt.

35. This functional feature is an essential feature of the product.

36. The product could not perform this function unless it bore the Pitt insignia.

37. The Pitt insignia prominently emblazoned on the Champion Pitt-insignia soft goods is therefore essential to the use or purpose of the articles.<sup>66</sup>

There were numerous factual problems with Pitt’s case. The defendant was a major merchant of such college-identified goods, and had been selling similar garments for forty-seven years before the decision, some even through the University book store. There was no evidence of likelihood of confusion, or even of a single instance or confusion, and the garments were all sold under the well-recognized CHAMPION brand. The court concluded that the use of the Pitt name on soft goods had not “acquired any special significance beyond allowing the garment’s wearer to display his or her support for the school and its athletic teams.” The insignia on the garments “serve a real, albeit aesthetic, function for the wearer.” As such, the garments were not in competition with unadorned goods, so the “relevant product market” was “soft goods which allow the consumer to show his or her allegiance to Pitt.” Pointing out that granting Pitt the relief it sought would give it a perpetual monopoly over the market, thus precluding any

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65. 566 F. Supp. 711 (W.D. Pa. 1983).

66. *Id.* at 716.

competition within that market, the court concluded that it knew “of no legal theory which would countenance such a result.”<sup>67</sup>

The problems with the *Job’s Daughters*–fueled view of functionality already have been discussed. In part they are attributable to imbuing old words, such as “intrinsic,” with new, incompatible meanings. As for branding the Pitt trademarks, in effect, as a “monopoly,” a court of appeals had three years earlier recognized the flaw in the argument:

Wrangler’s pejorative use of “monopoly” implies that Strauss’s trademark right is harmful and anti-competitive. On the contrary, the pocket tab trademark gives the public a reliable indication of source and thus facilitates responsible marketplace competition.<sup>68</sup>

Long before that, the Supreme Court had written:

. . . The owner of a trade-mark may not, like the proprietor of a patented invention, make a negative and merely prohibitive use of it as a monopoly.

. . . In truth, a trade-mark confers no monopoly whatever in a proper sense, but is merely a convenient means for facilitating the protection of one’s good-will in trade by placing a distinguishing mark or symbol—a commercial signature—upon the merchandise or the package in which it is sold.<sup>69</sup>

Somewhat later, Judge Learned Hand observed: “A trademark is indeed often spoken of as a monopoly; but in fact it is only part of the protection of the owner’s business from diversion to others by means of deceit.”<sup>70</sup> This is fairly formidable judicial firepower for a district court judge to ignore by offhand characterization of a trademark as a “monopoly” without any citation of authority.<sup>71</sup>

Here, the problem appears to be the definition of the submarket within which the purported “monopoly” exists—“soft goods which allow the consumer to show his or her allegiance to Pitt.”<sup>72</sup> Effectively, the PITT trademarks, and confusingly similar counterfeits, copies, and colorable imitations of them, appear to define the outer limit of the market within which the “monopoly”

67. All quotes from *id.* at 721. Actually, the court did know of a legal theory that would justify such a result, because it cited, and evidenced familiarity with, *Boston Prof’l Hockey*, in order to express its preference for the wisdom of *Job’s Daughters*.

68. *Levi Strauss & Co. v. Blue Bell, Inc.*, 632 F.2d 817, 822, 5 (9th Cir. 1980).

69. *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97-98 (1918).

70. *Artype, Inc. v. Zappullah*, 228 F.2d 695, 696-97 (2d Cir. 1956).

71. For more, similar authority, see 1 McCarthy, *supra* note 12, § 2:11.

72. Actually, the “sub-market” is somewhat narrower still. A better description would be “pre-manufactured and marked “soft goods with trademarks of PITT prominently displayed so as to allow the consumer to show his or her allegiance to Pitt.” Self-embellished, or simply school-colored garments do not appear to have been in issue.

exists. By this reasoning, General Motors has a “monopoly” over the market for new CHEVROLET automobiles, and PepsiCo has a “monopoly” over the market for PEPSI cola. If these examples are to be characterized as “monopolies,” there should at least be appended the characterization of them as “legal” monopolies.

### V. A SHORTER CONSIDERATION OF THE CASE AGAINST DEFENSIVE AESTHETIC FUNCTIONALITY

The simplest legal argument against the doctrine of defensive aesthetic functionality of trademarks is that the Supreme Court in *Traffix* has established that whether or not forbidding use of a trademark by others will place those others at “a significant, non-reputation-related disadvantage” is an appropriate test in cases of aesthetic functionality.<sup>73</sup> Because what is forbidden to be utilized by others is a trademark, it is apparent that the disadvantage of being unable to use the trademark is “reputation-related,” not “non-reputation-related.” As such, it cannot qualify as “aesthetically functional.” The dictionary definition of “trademark” is:

1. A word, phrase, logo, or other graphic symbol used by a manufacturer or seller to distinguish its product or products from those of others. The main purpose of a trademark is to designate the source of goods or services. In effect, the trademark is the commercial substitute for one’s signature. . . .<sup>74</sup>

There can hardly be something more reputation-related than “the commercial substitute for one’s signature,” which was recognized more than eight decades ago by Learned Hand, whose articulation of the principle has resonated through the years:

. . . [A merchant’s] mark is his authentic seal; by it he vouches for the goods which bear it; it carries his name for good or ill. If another uses it, he borrows the owner’s reputation, whose quality no longer lies within his own control. This is an injury, even though the borrower does not tarnish it, or divert any sales by its use; for a reputation, like a face, is the symbol of its possessor and creator, and another can use it only as a mask. And so it has come to be recognized that, unless the borrower’s use is so foreign to the owner’s as to insure against any identification of the two, it is unlawful.<sup>75</sup>

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73. *Qualitex v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995).

74. Black’s Law Dictionary, *supra* note 6. The Lanham Act defines “trademark” as “any word, name, symbol or device, or any combination thereof, [used, or intended to be used and for which application to register has been made] to identify and/or distinguish his or her goods . . . from those manufactured or sold by others, and to indicate the source of the goods, even if the source is unknown.” 15 U.S.C. § 1127.

75. *Yale Elec. Corp. v. Robertson*, 26 F.2d 972, 974 (2d Cir. 1928).

In less elegant, but nevertheless “functional” language:

[A] trademark is . . . the objective symbol of the good will that a business has built up. Without the identification function performed by trademarks, buyers would have no way of returning to buy products that they have used and liked. If this consumer satisfaction and preference is labeled “good will,” then a trademark is the symbol by which the world can identify that good will.<sup>76</sup>

Restatement (Third) of Unfair Competition, the trademark authority with the greatest collection of brainpower behind it, is unequivocal in its repudiation of defensive aesthetic functionality:

. . . A few cases, however, invoke the doctrine of functionality to permit the use of another’s trademark as ornamentation on goods such as jewelry and clothing, arguing that in such contexts the mark is an important functional component of the goods. [*Job’s Daughters* and *University of Pittsburgh* are among the three cited, illustrative cases.] The issue in such cases, however, is not the eligibility of the design for protection as a trademark, but rather the scope of permissible use of a trademark by another. Thus, the rule stated in this Section is inapplicable, and liability is determined under the rules governing trademark infringement.<sup>77</sup>

Professor McCarthy put it this way:

A handful of cases take the position that the unauthorized use of what is unquestionably someone else’s valid and nonfunctional trademark is not an infringement because the *defendant* is making an aesthetically functional use of the mark. These cases take the aesthetic functionality theory of a challenge to the validity of a mark and turn it on its head into a defense to a valid mark.

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The author agrees with [a commentator] and the Restatement that the notion of a defensive type of aesthetic functionality is bad law, poor policy and provides no coherent rules. The language in *Job’s Daughters* about “functionality” was merely an attempt at articulating a particular application of the familiar rule that there is no trademark infringement unless it is proven that there is a likelihood of confusion as to source, sponsorship, approval or affiliation caused by defendant’s use of plaintiff’s mark. . . .

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76. 1 McCarthy, *supra* note 12, § 3.2.

77. Restatement (Third) of Unfair Competition § 17, Reporter’s Note cmt. b, p.180 (1995).

The theory of defensive aesthetic functionality is much too blunt a weapon to serve as a device to solve problems that arise when a trademark is used by defendant in an arguably “decorative” sense, such as on T-shirts, baseball caps and other paraphernalia. In such cases the question is the familiar but difficult one of whether there is a likelihood of confusion as to source, sponsorship, affiliation or connection. No notions of “defensive aesthetic functionality” are proper to serve as an escape from facing head-on the question of likelihood of confusion.<sup>78</sup>

Finally, as the INTA *amicus* brief points out, until the first decision in *Fleischer*, the Ninth Circuit never embraced *Job’s Daughters* unequivocally.<sup>79</sup>

## VI. CONCLUSION

Functionality, historically, affects only eligibility of the purported trademark for protection. What is functional is ineligible for trademark protection. No respectable legal authority recognizes defensive “aesthetic functionality” as having anything to do with eligibility for trademark protection, because all of the supposedly “aesthetically functional” objects, or elements of the object, are already, independently, trademarks.

The case for defensive aesthetic functionality ignores: (i) the fact that the purportedly “aesthetically functional” element of whatever is at issue, is already, independently, a trademark; (ii) that it is the reputation and goodwill of the original trademark that invariably is a significant, and often the primary, motivating force for purchase of the merchandise incorporating that “aesthetically functional” element; (iii) that the defendant is undoubtedly profiting from the goodwill and reputation of the “aesthetically functional” element; and (iv) the defendant is at least diminishing, at most preempting, the plaintiff’s opportunity to exploit its own reputation and goodwill in the market the defendant has invaded.

There is no good explanation for, or justification of, the doctrine of defensive aesthetic functionality. “Functionality” has to be redefined to lend any support to the doctrine, and it hasn’t been. “Aesthetic” is a misnomer too. A defendant’s products do not sell because of the aesthetic embedded in them; they sell because of the reputation of the borrowed trademark. The doctrine hasn’t yet been justified, and the attempts to square defensive aesthetic functionality with conventional trademark law misuse language and ignore the accepted meaning of words.

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78. 1 McCarthy, *supra* note 12, § 7.8.2.

79. See Amicus Brief of the International Trademark Association in *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, reproduced at 101 TMR 1390, 1401-1044 (2011).

The better trademark legal authorities not only fail to endorse the validity of doctrine, they repudiate it.

The courts that have embraced defensive aesthetic functionality have turned a blind eye to the fact that the sale of the articles with the supposed aesthetically functional character is at least in large part the sale of the goodwill and reputation of the plaintiff. *Job's Daughters* candidly admits that the accused infringements were bought and worn to express the wearer's allegiance to the organization represented by the trademark. The mystery is how there can be such a disconnect between the purchase motivated by allegiance to an organization, sports team or musical group, and the use of the purchased item for its intended purpose. The seller of the merchandise incorporating the "aesthetically functional" trademark is profiting from the goodwill and reputation of the entity identified by the "aesthetically functional" trademark, which is a significant, and perhaps the only, reason for the sale in the first place; thus the trademark owner is deprived of the value of the trademark incorporated in the purchase price of the article with the "aesthetically functional" feature.

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