

15.12 Infringement—Elements—Validity—Trade Dress—Non-Functionality Requirement

For a product’s design to be protected under trademark law, the design must be non-functional.

[A product may be functional in either of two ways. They are referred to as “utilitarian functionality” and “aesthetic functionality.”]

A claimed trade dress has [utilitarian] functionality if it is essential to the use or purpose of a product or affects its cost or quality. To determine whether this definition is satisfied, you should consider the following factors:

- (1) whether the design yields a utilitarian advantage in how well the product works;
- (2) whether alternative designs are available;
- (3) whether advertising touts the utilitarian advantages of the design; and
- (4) whether the particular design results from a comparatively simple or inexpensive method of manufacture.

No one factor is dispositive; all should be weighed together.

[A claimed trade dress has aesthetic functionality if it serves an aesthetic purpose wholly independent of any source identifying function, such that the trade dress’s protection under trademark law would impose a significant non-reputation-related competitive disadvantage on its owner’s competitors. The inquiry is whether, if one seller were given exclusive rights to use the claimed trade dress, other sellers would be forced to use alternative designs that make their products more costly to sell, or for which consumers’ willingness to pay would be lower for reasons having nothing to do with the reputation of any source (*e.g.*, the alternative designs would not have as much intrinsic aesthetic appeal).]

[The plaintiff [name] has the burden of proving non-functionality by a preponderance of the evidence [to show that the trade dress is valid and protected from infringement].]

Comment

In *Blumenthal Distributing, Inc. v. Herman Miller, Inc.*, 963 F.3d 859 (9th Cir. 2020), the Ninth Circuit rejected a portion of an earlier version of this model instruction. Accordingly, this instruction has been completely revised to reflect the holding in that case. Also, the district court should consider modifying this instruction if only utilitarian or aesthetic functionality is at issue, and not both.

It is reversible error to fail to give an instruction defining non-functionality in a trade dress case. *Fuddruckers, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 842-43 (9th Cir. 1987). Functionality is a question of fact. *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 613 (9th Cir. 1989).

“The relationship between trademark protection and functionality is well established: ‘The physical details and design of a product may be protected under the trademark laws only if they are nonfunctional.’” *Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 782 (9th Cir. 2002). For a description of the four-factor test of functionality, see *Disc Gold Ass’n v. Champion Discs, Inc.*, 158 F.3d 1002, 1006-09 (9th Cir. 1998). See also *Int’l Jensen v. Metrosound U.S.A.*, 4 F.3d 819, 822-23 (9th Cir. 1993) (setting forth a three-factor test); *Talking Rain Beverage Co. Inc. v. S. Beach Beverage Co.*, 349 F.3d 601, 603 (9th Cir. 2003) (applying four factor test from *Disc Gold*). The definition of functionality is reflected in *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001) (referring to the “traditional rule” set forth in *Inwood Lab’ys, Inc. v. Ives Lab’ys, Inc.*, 456 U.S. 844, 850 n. 10 (1982)).

The plaintiff asserting infringement of unregistered trade dress has the burden of proving nonfunctionality. 15 U.S.C. § 1125(a)(3) (“In a civil action for trade dress infringement ... for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.”). Because registration is prima facie evidence of validity, the defendant has the burden of proving functionality when the trade dress in question is registered on the principal register. *Vuitton Et Fils S.A. v. J. Young Enterprises, Inc.*, 644 F.2d 769, 775 (9th Cir. 1981) (with functionality at issue, explaining that, “under the Lanham Act, registration and entry of a trademark on the Principal Register ... shifts the burden of proof from the plaintiff, who would have to establish his right to exclusive use in a common law infringement action, to the defendant, who must introduce sufficient evidence to rebut the presumption of plaintiff’s right to such protected use”); 15 U.S.C. § 1115(a) (providing that any registration issued under the Act “shall be prima facie evidence of registrant’s exclusive right to use the registered mark in commerce”). Functionality is an issue of fact. *Vuitton Et Fils S.A.*, 644 F.2d at 775.

In the Ninth Circuit, the plaintiff bears the burden of proving nonfunctionality. See *Sega Enters. Ltd., v. Accolade, Inc.*, 977 F.2d 1510, 1530-31 (9th Cir. 1992) (holding that nonfunctionality is question of fact, which plaintiff bears burden of proving); 15 U.S.C. § 1125(a)(3) (“In a civil action for trade dress infringement . . . for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.”). However, in some circuits, functionality is treated as an affirmative defense. See, e.g., *Vaughan Mfg. Co. v. Brikam Int’l*, 814 F.2d 346, 349 (7th Cir. 1987); *Stormy Clime Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 974 (2d Cir. 1987).

“[I]f exclusive use of a feature would put competitors at a significant non-reputation-related disadvantage, the feature in general terms is functional.” *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 165 (1995). *See also Inwood Lab’ys, Inc.*, 456 U.S. at 850 n.10 (“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.”); *Vuitton et Fils S.A. v. J. Young Enters.*, 644 F.2d 769, 774 (9th Cir. 1981) (“Functional features of a product are features ‘which constitute the actual benefit that the consumer wishes to purchase, as distinguished from an assurance that a particular entity made, sponsored, or endorsed a product.’”) (quoting *Int’l Ord. of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912, 917 (9th Cir. 1980)).

Functionality usually arises in cases of non-word symbols or devices, such as designs or container shapes. In the Ninth Circuit, functionality involves measuring the effect of a design or physical detail in the marketplace. A functional design has aesthetic appeal, or increases the utility or practicality of the product, or saves the consumer or producer time or money. *See Fabrica, Inc. v. El Dorado Corp.*, 697 F.2d 890 (9th Cir. 1983); *TrafFix Devices, Inc.*, 532 U.S. at 29-30 (noting that it is a “well-established rule that trade dress protection may not be claimed for product features that are functional” and that a prior patent for features claimed as trade dress can be “strong evidence” of functionality which adds “great weight to the statutory presumption” that trade dress features “are deemed functional until proved otherwise by the party seeking trade dress protection” and who will carry a “heavy burden” of showing that the feature “is merely an ornamental, incidental, or arbitrary aspect” of the trade dress rather than functional to the trade dress).

If features of claimed trade dress are all functional, plaintiff must show that the features are combined in a nonfunctional way to avoid a finding of functionality. *HWE, Inc. v. JB Rsch., Inc.*, 993 F.2d 694, 696 (9th Cir. 1993).

On the trademark registration of trade dress and its implications for infringement litigation, see *Tie Tech, Inc.*, 296 F.3d at 782-83.

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