

---

**OLIFF & BERRIDGE, PLC**

---

ATTORNEYS AT LAW

**FUNCTIONALITY  
AFTER *TRAFFIX***

Presented by William J. Utermohlen

© 2004 OLIFF & BERRIDGE, PLC

**Inwood Labs., Inc. v. Ives Labs.,**  
**456 U.S. 844, 214 USPQ 1 (1982)**

- “a product feature is functional if it is essential to the use or purpose of the article or it affects the cost or quality of an article”

Qualitex Co. v. Jacobson Prods. Co.,  
514 U.S. 159, 34 USPQ2d 1161 (1995)

- “that is, if exclusive use of the features would put competitors at a significant non-reputation- related disadvantage”

## Eppendorf - Netheler - Hinz GmbH v. Ritter GmbH

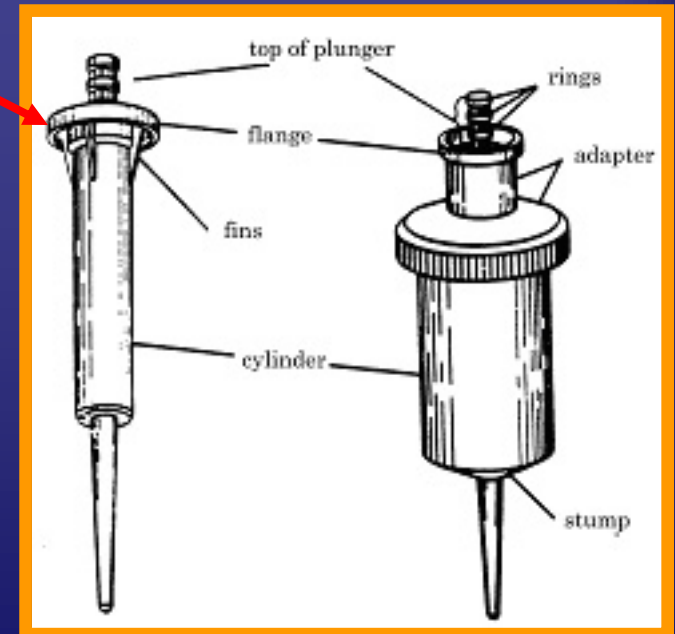
- In early 1980s, Eppendorf introduced into the U.S. a repetitive dispenser that used disposable syringes (or pipette tips), which it called “COMBITIPS”
- In 1990, Polish manufacturer HTL introduced compatible syringes

## Eppendorf - Netheler - Hinz GmbH v. Ritter GmbH (Cont.)

- In 1994, Ritter introduced compatible syringes, called “RITIPS,” and its own dispenser
- In June 1998, Eppendorf separately sued HTL and Ritter on trade dress theories (the HTL case was later dismissed on laches grounds)

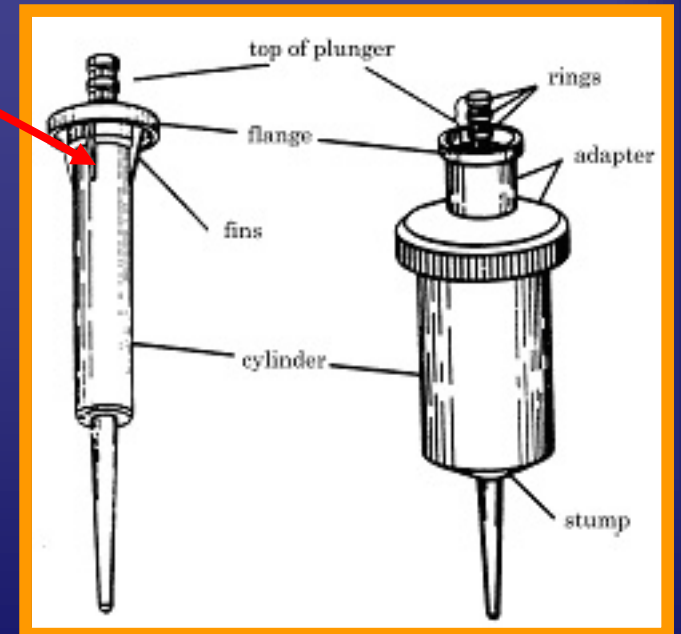
# Eppendorf's Claimed Trade Dress

1. **The flange**
2. The fins supporting the flange
3. The plunger head
4. The plunger ribs
5. The length of the tips
6. The sizes of the syringes
7. The coloring scheme
8. The angle of the stump on the larger sizes



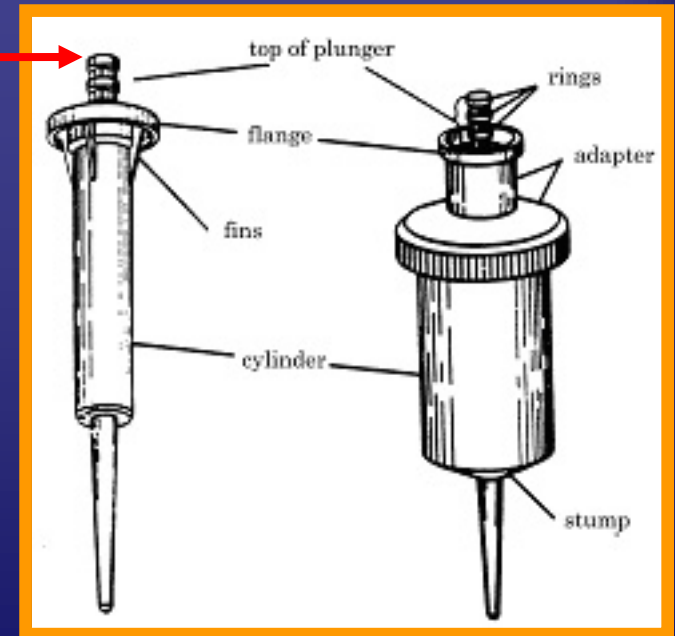
# Eppendorf's Claimed Trade Dress

1. The flange
2. **The fins supporting the flange**
3. The plunger head
4. The plunger ribs
5. The length of the tips
6. The sizes of the syringes
7. The coloring scheme
8. The angle of the stump on the larger sizes



# Eppendorf's Claimed Trade Dress

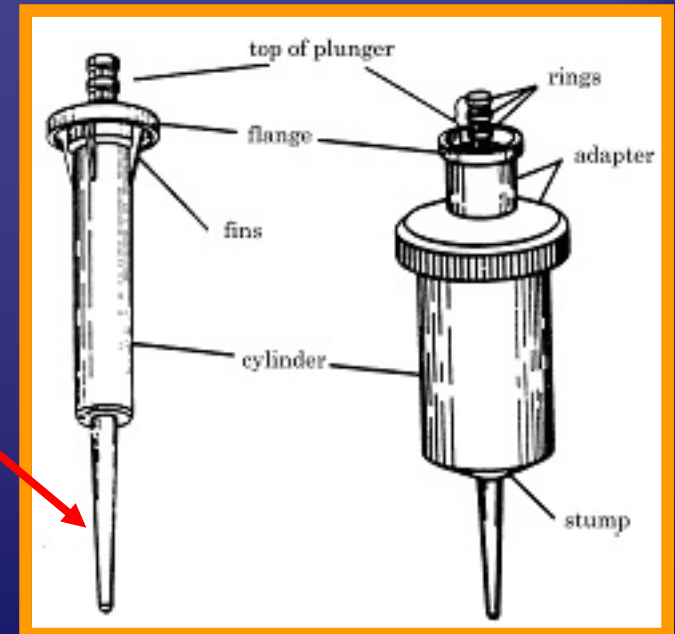
1. The flange
2. The fins supporting the flange
3. **The plunger head**
4. **The plunger ribs**
5. The length of the tips
6. The sizes of the syringes
7. The coloring scheme
8. The angle of the stump on the larger sizes





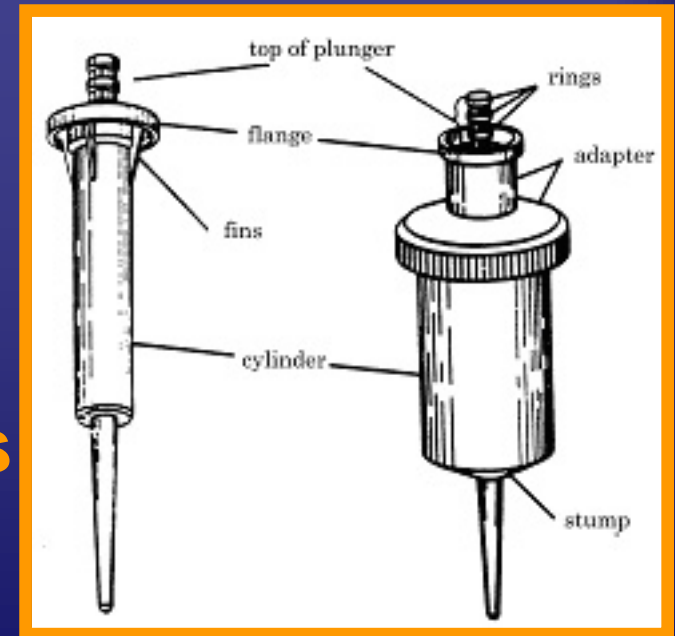
# Eppendorf's Claimed Trade Dress

1. The flange
2. The fins supporting the flange
3. The plunger head
4. The plunger ribs
5. **The length of the tip**
6. The sizes of the syringes
7. The coloring scheme
8. The angle of the stump on the larger sizes



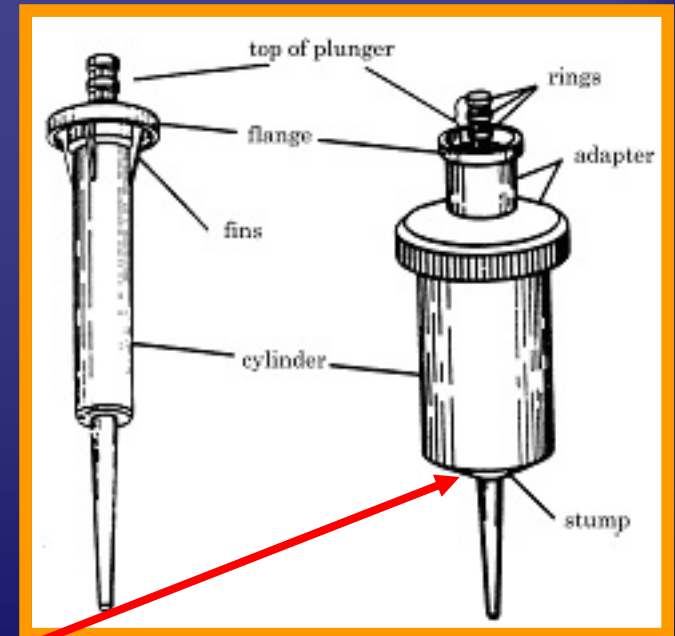
# Eppendorf's Claimed Trade Dress

1. The flange
2. The fins supporting the flange
3. The plunger head
4. The plunger ribs
5. The length of the tips
6. **The sizes of the syringes**
7. **The coloring scheme**
8. The angle of the stump on the larger sizes



# Eppendorf's Claimed Trade Dress

1. The flange
2. The fins supporting the flange
3. The plunger head
4. The plunger ribs
5. The length of the tips
6. The sizes of the syringes
7. The coloring scheme



8. **The angle of the stump on the larger sizes**



**TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23, 58 USPQ2d 1001 (2001)**

- Portable road traffic sign supported by two rear springs that assisted the sign in resisting twisting in the wind
- Utility patent expired
- Alternative designs: hiding the springs or using more than two springs

## TrafFix Devices (Cont.)

- Clarified *Qualitex* competitive disadvantage analysis as only relating to aesthetic functionality:

“Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.”

## TrafFix Devices (Cont.)

- Supreme Court rejected reliance on alternative design possibilities:

“There is no need, furthermore, 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. ... Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. 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.”

## TrafFix Devices (Cont.)

- After *TrafFix*, the hallmarks of non-functionality in a utilitarian context are ornamental, incidental and arbitrary aspects of the device

(terms borrowed from *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10-11 (2d Cir. 1976), and *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977)).

- Simplicity in design points the other way



**Eppendorf - Netheler - Hinz GmbH v.  
Ritter GmbH 289 F.3d 351, 62 USPQ2d  
1534 (5<sup>th</sup> Cir. 2002)**

- Ruled for Ritter, finding that Eppendorf had not established nonfunctionality of claimed trade dress
- Treated alternative designs as “irrelevant”

**Other courts have also rejected  
reliance on design alternatives to  
determine functionality, e.g.:**

*Tie-Tech Inc. v. Kinedyne Corp.*,  
296 F.3d 778, 63 USPQ2d 1587 (9<sup>th</sup> Cir. 2002)

*Antioch Co. v. Western Trimming Corp.*,  
347 F.3d 150, 68 USPQ2d 1673 (6<sup>th</sup> Cir. 2003)

The main case cited in support of the continued vitality of a design alternative analysis in a non-aesthetic functionality context is *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422 (Fed. Cir. 2002)

- TTAB had found conveyor-line guide rail configurations to be functional based on all four *Morton-Norwich* factors, including the lack of alternatives
- The Federal Circuit affirmed. Accordingly, the holding was merely that TTAB had not erred in considering that issue.
- However, Judge Dyk expressed support for continuing to consider alternative designs in the first instance, quoting Professor McCarthy

The line between utilitarian and aesthetic functionality is not always clear.

- In some cases, the aesthetics are quasi-utilitarian.
  - Roof tile case (*M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001))
- There are also mixed cases, where some aspects of the trade dress may be aesthetic and some utilitarian (e.g., *Sunbeam* and some clothing cases)
- Some issues tend to be purely aesthetic
  - Jewelry
  - Restaurant decor

## Possible design alternative rules in utilitarian cases:

- Alternative designs are irrelevant to utilitarian functionality
- Absence of alternative designs can be considered to prove functionality, but existence of alternative designs cannot be used to prove non-functionality
- Where utilitarian functionality must be resolved as an issue of fact, alternative designs enter the mix both ways

*(Mark Bric Display Corp. v. Joseph Struhl Co., Inc.,*  
2003 WL 21696318, 2003 U.S. Dist. LEXIS 12933 (D.R.I. 2003)  
(fn. 7))