

Blog Post

TTAB Seals Fate of Trade Dress Claims for Design Covered By Utility Patent

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It is natural for manufacturers to seek to widen their intellectual property protection. In the seminal case *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 US 23 (2001), the Supreme Court struck down the plaintiff’s attempt to expand the reach of its expired utility patents by claiming trade dress protection in those designs. The Supreme Court ruled that “functional” designs could never be protected trade dress.

The United States Patent and Trademark Office, Trademark Trial and Appeal Board (“TTAB” or the “Board”) last week provided further instruction in how to interpret trade dress claims in light of expired patents in *Poly-America, L.P. v. Illinois Tool Works, Inc.*, Cancellation No. 92056833 (October 18, 2017). In this case, the Board cancelled a nearly fifty-year-old registration for the design of resealable plastic sandwich bags.

Background

Illinois Tool Works, Inc. (“Illinois Tool Works”) was the owner by assignment of three registrations for the product configuration for resealable food bags:

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The registered marks all consisted of a horizontal stripe adjacent the bag top. Though the registrations' drawings showed the line in the color red, the registrations themselves made no particular color claims.

Poly-America, L.P., a competing plastic bag manufacturer who hoped to get into the resealable food bag business and was concerned that it would be sued for infringement, petitioned the Board to cancel of all three of Illinois Tool Works' registrations on the ground that they were functional.

Trade Dress Functionality

In contrast to conventional trademarks such as names, words and logos, which are typically used on the product, labels and packaging, product configuration trademarks provide rights in the appearance of the product itself. Product configuration (also called “trade dress”) can sometimes merit trademark protection and registration so long as it is not functional and is distinctive enough so that consumers understand it to be an indicator of source.

Trade dress is considered to be functional if it is essential to the use or purpose of the article **or** if it affects the cost or quality of the article. There are several categories of evidence that courts use to determine whether a particular design is functional: (1) the existence of a utility patent disclosing the utilitarian advantages of the design; (2) advertising materials in which the originator of the design touts the design’s utilitarian advantages; (3) the availability to competitors of functionally equivalent designs; and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product. If functionality is established, courts need not look into the other categories of evidence such as the availability of alternatives and cost information.

The Existence of Patents

As mentioned above, one category of evidence used to assess functionality is whether a utility patent discloses the utilitarian advantages of the design. A utility patent is strong evidence that the claimed features for which an applicant or registrant seeks trademark protection are essential to the use or purpose of the article.

In this case, Poly America introduced into the record expired U.S. Patent No. 3,054,434 (the “434 patent”), issued to the predecessor of Illinois Tools Works. The ’434 patent is for an “article such as a pouch or

similar container having a new and improved resilient type fastener structure particularly adapted to minimize accidental separation of the engaged portion of the fastener structure when subject to load forces.”

The patent included the following disclosure:

... In order to facilitate identification of the flanges as means to assist in the separation of the strips when they are engaged together, the flanges may be colored differently than the strips themselves. Excellent results may be obtained where the strips are of a clear color while one or both of the flanges are of a red color.

The patent further disclosed:

said lateral portion being above the longitudinal centerline of the marginal portions when engaged, and a separating flange on the marginal portion of at least one of said strips for separating the strips and the rib and groove elements and disengaging the lock, *said flange being colored differently than the strips to facilitate identification of the flange and assist in separation of the strips. (Emphasis added).*

A side by side comparison of the marks in the trade dress registrations and Figure 1 of the '434 patent showed remarkable similarity.



Illinois Tool Works argued that there were no utilitarian advantages described by the patent with respect to the claimed trade dress, stating that more than 50 years of experience in the plastic bag industry has taught that the initial belief set forth in the patent was incorrect; there has never been any functionality to use of the color line on the bag.

The Board looked to the prosecution history of the '434 for clarification. The Board saw that in response to an initial and subsequent rejection of the color line, the inventor argued that the claim ultimately amended to the relevant claim in the patent, which “affords an advantage, and cannot be regarded as obvious without a basis in the prior art.” Rather than disclaiming that claim based upon the inventor’s asserted realization that the color line conferred no functional advantage, the inventor persuaded the Patent Examiner to include that claim. Additionally, Illinois Tool Works’ predecessor touted various advantages in its marketing materials to prospective purchasers of the bags. It even listed the '434 in advertising brochures, which said “the color flange immediately identifies the point of opening.”

The Board concluded: “Simply put, [Illinois Tool Works’] predecessors having availed themselves of the protection of the '434 patent until its expiration, Respondent’s convenient change of heart falls far short of convincing us that the features described in the sixth claim were never functional and may now be the subject of trademark protection.” The patent, its specification and the statements made in the prosecution disclosed the functionality of the marks. Therefore, the Board cancelled the trade dress registrations.

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