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**THE NUCLEAR OPTION: AESTHETIC FUNCTIONALITY TO
CURB OVERREACHING TRADEMARK CLAIMS**

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I. INTRODUCTION

This essay examines the aesthetic functionality doctrine and the fact patterns of three recent cases where the doctrine should apply. The facts of these cases highlight how the aesthetic functionality doctrine could be applied to protect creativity and competition, and ensure robust freedom of expression. Importantly, this essay stresses that the doctrine should be considered in light of the vigorous policing of marks by mark owners, expanding trademark law protection and the benefits of aesthetic functionality over other tests.

Part I of this article sets forth an introduction. Part II provides a brief background of the problem of supposed “trademark bullying,” “trademark extortion,” or “aggressive trademark litigation tactics.” Part III reviews the functionality doctrine and the policies animating it. Part IV analyzes three cases as examples of how the aesthetic functionality doctrine could effectively protect creativity, competition and freedom of expression. Part V offers a brief conclusion.

II. POLICING TRADEMARKS

The subject matter and scope of protection of trademark law has expanded tremendously in the last 70 years.¹ This expansion has occurred because of the confluence of several important factors, including: new technology, such as the Internet; the value and importance of the brand—with valuations exceeding \$60 billion for one brand;² and the use of trademarks to protect licensing and merchandising markets, which may generate as much as \$187.2 billion in the sale of licensed products worldwide,³ including over \$3.9 billion for collegiate merchandising alone.⁴ Other contributing factors

¹ See Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 368–72 (1999) (explaining trademark expansion); Kenneth L. Port, *The Expansion Trajectory: Trademark Jurisprudence in the Modern Age*, 92 J. PAT. & TRADEMARK OFF. SOC’Y 474, 476–77 (2010) (discussing expansion, including availability of federal incontestability status and intent to use applications, expanded section 43(a) liability, dilution, and anti-cybersquatting law).

² See *Best Global Brands 2012*, INTERBRAND, <http://www.interbrand.com/en/best-global-brands/2012/Best-Global-Brands-2012.aspx> (last visited Oct. 25, 2012).

³ See *The Top 125 Global Licensors*, GLOBAL LICENSE! (Mar. 1, 2010), <http://www.licensemag.com/license-global/top-125-global-licensors>. Notably, “The Top 125 Global Licensors accounted for about \$165 billion in retail sales of licensed products representing almost 90 percent of the total market of \$187.2 billion worldwide.”

⁴ See *id.* (“THE COLLEGIATE LICENSING COMPANY” (IMG COMPANY) \$3.9B (PRIVATE), representing the total college market) (emphasis omitted).

include the expansion and importance of international markets, and the nature of trademark law itself.⁵ The scope of trademark rights is pushed by consumer perception, which to some extent is controlled by trademark holders and their risk adverse lawyers who vigilantly police their marks to protect their clients' valuable brands, and lobby Congress for expanded trademark protection.⁶ The policing of trademarks is driven by trademark doctrine and policy which partially provide the incentive to do so.⁷

This last issue—the vigorous policing of marks has led to so-called “trademark bullying” or “trademark extortion” through the use of cease and desist letters with the threat of litigation by companies with resources against entities with presumably less resources.⁸ Attorneys (of clients of any size and amount of resources) should police their clients' marks to ensure that those marks continue to receive a broad scope of trademark protection.⁹ Thus, if there is any arguable

⁵ See Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1916 (2007) (“Producers are able to frame just about any argument for broader protection in terms of consumer expectations, which they are in position to influence systematically through marketing. Moreover, once courts and Congress began to expand trademark law and committed it to consumer understanding, expansion became self-reinforcing—broader protection begets consumer expectations of greater control, which begets even broader protection.”); James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 YALE L.J. 882, 907-08 (2007) (explaining why licensing markets emerge when no licenses are needed); Michael A. Johnson, *The Waning Consumer Protection Rationale of Trademark Law: Overprotective Courts and the Path to Stifling Post-Sale Consumer Use*, 101 TRADEMARK REP. 1320, 1355 (2011) (“The proliferation of product placements, cease and desist letters from mark owners in response to unauthorized post-sale uses, and overly protectionist court decisions have all shaped consumer expectations so that consumers now believe that virtually any post-sale use of a mark must be authorized.”); Michael S. Mireles, Jr., *Towards Recognizing and Reconciling the Multiplicity of Values and Interests in Trademark Law*, 44 IND. L. REV. 427, 439 (2011) (“[T]he structure of trademark law itself, given the focus of trademark law on consumer perception, results in the vigorous enforcement and policing of trademark rights by trademark holders.”).

⁶ Mireles, *supra* note 5, at 439.

⁷ *Id.*

⁸ Recently, an alleged victim of so-called “trademark bullying” established a website for the discussion of issues surrounding trademark bullying. See *TrademarkBullying.org: No Form of Harassment is Okay*, http://trademarkbullying.org/Home_Page.html (last visited May 20, 2013). Notably, there does not appear to be a universally accepted definition of “trademark bullying.” See Trevor Little, *International - List of the Top 'Trademark Bullies' Renews Debate on Enforcement Strategies*, WORLD TRADEMARK REV., (Jan. 30, 2012), <http://www.worldtrademarkreview.com/daily/detail.aspx?g=8fc00cc3-ebe7-466f-a124-89d93d84f031> (last visited May 20, 2013).

⁹ Mireles, *supra* note 5, at 439.

infringing or diluting conduct, the zealous (prudent) lawyer sends a cease and desist letter which, in some cases, may dampen creativity and competition, and chill potential expression.¹⁰ In one particularly interesting case, *Salu, Inc. v. Original Skin Store*, the court stated:

[Plaintiff] Salu presents evidence that . . . [it] has continually contacted anyone who it feels is infringing in order to protect its mark. It has sent out over 300 cease and desist letters to alleged infringers in the last couple of years alone. Salu claims that with the exception of ESKINSTORE, this litigation, and one other case that settled out of court, “every other infringer receives [the] letter and stops infringing on [the] trademark.”¹¹

The topic of “trademark bullying” or “trademark extortion” has received a significant amount of attention. The United States Patent and Trademark Office [USPTO] recently requested public comment on trademark overreaching—bullying—and issued a study on the subject.¹² The request for comments initially used the word “bullies” or “bully” but eventually changed the title to “trademark litigation tactics.” The reason for the change may be, in part, because there appears to be a lack of consensus about what “trademark bullying” means. The failure to agree on the definition may be the result of a belief by some that all so-called “bullying” that may fall under some definitions of “trademark bullying” may not be negative in light of trademark law so as to justify such a label.¹³

Trademark bullying, at the least, seems to include litigation tactics that may involve using cease and desist letters and threats of litigation, where a trademark holder with more resources than a target entity

¹⁰ See William McGeveran, *Four Free Speech Goals for Trademark Law*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1205, 1206-07 (2008) (“Considerable anecdotal evidence suggests that the real action occurs outside the courthouse: markholders send cease-and-desist letters and threaten legal action against those using trademarks to facilitate speech, and the recipients frequently capitulate.”).

¹¹ *Salu, Inc. v. Original Skin Store*, No. CIV. S-08-1035 FCD/KJM, 2010 WL 1444617, at *2 (E.D. Cal. Apr. 12, 2010) (internal citations omitted).

¹² See USPTO.gov, *Request for Comments: Trademark Litigation Tactics*, U.S. PATENT & TRADEMARK OFFICE, http://www.uspto.gov/trademarks/bullies_survey.jsp (last updated Jan. 31, 2012 10:34:43 AM). The Secretary of Commerce was directed to investigate trademark litigation tactics by Congress. See Trademark Technical and Conforming Amendment Act of 2010, Pub. L. No. 111-146, 124 Stat. 66.

¹³ Professor McCarthy cautions that a trademark “enforcement program [should be] neither overly lax nor overly aggressive.” See 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:91 (4th ed. 2008).

asserts rights beyond the reasonable scope of its mark.¹⁴ For example, a trademark holder might assert its rights against a small business or artist that is using the mark in a way that would be protected under the law because of First Amendment interests.

The April 2011 USPTO Trademark Litigation Study described the results of its request for comments and outlined some of its planned activities to address trademark bullying.¹⁵ In summarizing some of the comments, the Trademark Litigation Study notes that:

Most of the direct respondents claimed at least some degree of first-hand knowledge of instances where unduly aggressive trademark litigation or pre-litigation tactics (e.g., cease-and-desist letters) were targeted at a small business. Many of these were directly involved in the issuance or receipt of cease-and-desist letters. . . . When asked if they currently encounter the problem of other trademark owners using their trademark rights to harass and intimidate another business beyond what the law might be reasonably interpreted to allow (e.g., is “trademark bullying a problem”), few commenters explicitly addressed whether and to what extent this issue is a significant problem. Given the limited number of comments and the varied nature of the commenters own experiences, the comments may be

¹⁴ Based on some enforcement of trademark rights, perhaps bullying should include what *should be* beyond a trademark holder’s scope of rights and is in its rights, as opposed to what *actually is* outside their rights. Some interesting cases of “trademark bullying” include enforcement of trademarks by professional sports teams against high schools. See Randall L. Newsome, *Cease and Desist: Finding an Equitable Solution In Trademark Disputes Between High Schools and Colleges*, 52 B.C. L. REV. 1833, 1853-63, 1868 (2011) (arguing that high schools may have a very good case against trademark infringement, but noting the ambiguity in whether high schools may infringe the trademarks of colleges). For a discussion of some of the other costs of aggressive trademark enforcement, see David E. Armendariz, *Picking on the Little Guy? Asserting Trademark Rights Against Fans, Emulators and Enthusiasts*, 90 TEX. L. REV. 1259, 1276-80 (2012).

¹⁵ DEP’T OF COMMERCE, REPORT TO CONGRESS: TRADEMARK LITIGATION TACTICS AND FEDERAL GOVERNMENT SERVICES TO PROTECT TRADEMARKS AND PREVENT COUNTERFEITING (2011) available at <http://www.uspto.gov/trademarks/notices/TrademarkLitigationStudy.pdf> (last visited May 20, 2013) [TRADEMARK LITIGATION STUDY]. This study has been criticized by many. See e.g., Adam Smith, *USPTO Silent as Attorneys Pour Scorn on Trademark Bullies Study*, WORLD TRADEMARK REV. (May 9, 2011), <http://www.worldtrademarkreview.com/daily/detail.aspx?g=54efa7ab-20b1-41c1-a8a5-4cbd8548e08f>; Timothy J. Callery, *Baiting the Hook: The Failure of the PTO Trademark Litigation Tactics Report To Dissuade Either Trademark Bullying or Trademark Baiting*, 64 ADMIN. L. REV. 909 (2012).

better viewed as anecdotal.¹⁶

The Trademark Litigation Study also stated that:

A handful of small business owners explained that they withdrew their trademark applications after receiving a cease-and-desist letter because they lacked the time or financial resources to litigate against a larger, wealthier company. This imbalance of resources was a common theme among many of the comments concerned with the threat of litigation, including one noting that litigation is too expensive to be a realistic option for many small businesses. Other commenters, however, recognized that cease-and-desist letters have a legitimate purpose, explaining that most are sent in good faith, and only a small percentage result from overzealous protection of a mark. Some commenters explained that trademark owners have an obligation to police their marks, and the cease-and-desist letter is a necessary, cost-effective part of the process.¹⁷

The results of the Trademark Litigation Study appear to be inconclusive and are perhaps helpful as a starting point for gathering more information about “trademark bullying.”¹⁸ However, the Trademark Litigation Study does seem to indicate that “trademark bullying” could be happening, but based on the comments received, also hedges on whether litigation enforcement activity that has occurred should be labeled “bullying.”¹⁹ There is no doubt that companies send cease and desist letters to one another, but whether those particular instances merit the label “trademark bullying” appears to be hard to justify based on the comments received by the USPTO.²⁰ Two other studies provide additional support for the argument that trademark bullying exists.²¹

The first is the study by Professor Port, which concluded that trademark extortion may explain why there is a rise in filings of

¹⁶ TRADEMARK LITIGATION STUDY, *supra* note 15, at 18.

¹⁷ *Id.* at 18-19.

¹⁸ *See generally id.*

¹⁹ *Id.*

²⁰ *Id.*

²¹ Kenneth L. Port, *Trademark Extortion: The End of Trademark Law*, 65 WASH. & LEE L. REV. 585, 631 (2008). *See also* William T. Gallagher, *Trademark and Copyright Enforcement in the Shadow of IP Law*, 28 SANTA CLARA COMPUTER & HIGH TECH. L. J. 453, 496 (2012).

trademark cases, but fewer reported decisions.²² The second study by Professor Gallagher found that:

[T]rademark and copyright lawyers and their clients sometimes enforce admittedly weak IP claims precisely because it can be an effective strategy with few downsides. As this study shows, aggressive trademark and copyright enforcement efforts often work, as enforcement targets frequently choose to capitulate or settle rather than resist claims on the legal merits, likely due to the costs and uncertainties inherent in IP litigation. Thus, this study supports the thesis that trademarks and copyrights can be and often are over-enforced in everyday legal practice.²³

While the USPTO Trademark Litigation Study focused on the impact of aggressive trademark litigation tactics on small businesses, it is noteworthy that the Chilling Effects Clearinghouse database, which attempts to collect examples of intellectual property overreaching through cease and desist letters, has mostly trademark cease and desist letters sent to Google since 2011 under a search for “trademark”—with almost no cease and desist letters sent to small businesses.²⁴ This does not mean that companies are not sending cease and desist letters to small companies and overreaching (see the case involving Salu, Inc. mentioned above), but that small companies and others may not be reporting them to the Chilling Effects Clearinghouse website. The Brand Geek blog offered to start collecting problematic cease and desist letters, but as of May 20, 2013, none have been posted.²⁵ The Legal Force Trademarkia has, however, published data concerning oppositions filed by “trademark bullies”—there are many examples, and the most bullied and the biggest bullies are available for view.²⁶

²² Port, *supra* note 21, at 633.

²³ Gallagher, *supra* note 21, at 496.

²⁴ See CHILLING EFFECTS CLEARINGHOUSE, <http://www.chillingeffects.org/> (last visited May 20, 2013); see also “Trademark” Search Results, *id.* (click “Search the Database”; then type in keyword “trademark”; then click the “Submit Search” button).

²⁵ Lara Pearson, *Brand Bully Basement*, BRAND GEEK (Oct. 10, 2011), <http://brandgeek.net/2011/10/10/brand-bully-basement/>. There is one opposition proceeding posted concerning Nestle. *Id.* It is unfortunate that people are not reporting instances of bullying.

²⁶ See Find a Trademark Bully, LEGALFORCE TRADEMARKIA, <http://www.trademarkia.com/opposition/opposition-brand.aspx> (last visited June 7, 2013). However, the website appears to fail to discuss why those oppositions include bullying behavior and not just solid trademark enforcement.

There have also been several well-publicized incidents involving cease and desist letters. For example, Louis Vuitton sent a cease and desist letter to a student intellectual property law group at the University of Pennsylvania because of their advertising for a symposium on fashion law.²⁷ Another example is the cease and desist letter and subsequent interaction between publishing house Penguin and former Penguin author David Thorne,²⁸ although there does not seem to be a Penguin cease and desist letter for Mr. Thorne's use of the Penguin logo on his blog.²⁹ Finally, there is the very popular, supposedly successful, cease and desist letter story concerning Jack Daniels.³⁰ Many seem to believe that this particular cease and desist letter by Jack Daniels was well done.³¹

Notably, a recent U.S. Supreme Court case, *Already, LLC v. Nike, Inc.*,³² provides an example of supposed trademark bullying. In that case, Nike alleged that its Air Force 1 trademark was infringed and diluted by Already's shoe lines "Sugars" and "Soulja Boys."³³ Already "filed a counterclaim contending that the Air Force 1 trademark is invalid."³⁴ Apparently, Nike, fearing loss of its Air Force 1 trademark, submitted a "Covenant Not to Sue," essentially stating that it "would not raise against Already or any affiliated entity any trademark or unfair competition claim based on any of Already's existing footwear designs" or "colorable imitation[s]."³⁵ In this particular case, Nike, an entity with substantial resources, apparently enforced its trademark against a small entity.³⁶ The question arises whether Nike's infringement and dilution claims were overreaching. Here, that seems to be the case. When the validity of its mark was challenged, Nike, "four months after Already counterclaimed," issued

²⁷ See Charles Coleman, *Louis Vuitton Sends Absurd Cease-and-Desist Letter to Penn Law Over Student Event Flyer (And More Fun with Trademark Abuse!)*, L. FASHION BLOG (Mar. 3, 2012), <http://lawoffashion.com/blog/story/03/03/2012/121>.

²⁸ See 27B/6, <http://www.27bslash6.com/covers.html> (last visited May 20, 2013).

²⁹ *Id.*

³⁰ See Charlie Minato, *Jack Daniels Wrote What Has to Be the Nicest Cease-and-Desist Order of All Time*, BUSINESS INSIDER (July 23, 2012), <http://www.businessinsider.com/jack-daniels-wrote-what-has-to-be-the-nicest-cease-and-desist-order-of-all-time-2012-7>.

³¹ *Id.*

³² *Already, LLC v. Nike, Inc.*, 133 S. Ct. 721 (2013).

³³ *Id.* at 725.

³⁴ *Id.*

³⁵ *Id.*

³⁶ *Id.*

the “Covenant Not to Sue” and moved to dismiss the case.³⁷ Unfortunately, the U.S. Supreme Court did not allow Already to pursue its counterclaim because the claim was moot, thus allowing Nike to continue to threaten third parties with trademark claims based on its Air Force 1 mark.³⁸

While a different competitor may also challenge Nike’s mark, they must have the resources to do so and may face bullying of another kind—importantly, in this case, Already also asserted that “Nike had intimidated retailers into refusing to carry Already’s shoes.”³⁹ Moreover, Justice Kennedy’s concurrence notes that, “[O]ver the past eight months, Nike has cleared out the worst offending infringers. Now Already remains as one of the last few companies that was identified on that top ten list of infringers.”⁴⁰ Justice Kennedy also discussed some of the harms that can occur from the threat of trademark infringement:

[C]harges of trademark infringement can be disruptive to the good business relations between the manufacturer alleged to have been an infringer and its distributors, retailers, and investors. The mere pendency of litigation can mean that other actors in the marketplace may be reluctant to have future dealings with the alleged infringer.⁴¹

The anticompetitive impact for trademark overreaching in some cases is real.⁴²

This context of vigorous policing is an important backdrop for a discussion of aesthetic functionality and illuminates the problem.⁴³

³⁷ *Id.*

³⁸ *Id.* at 733.

³⁹ *Id.* at 725-26. As the Supreme Court notes, the trademark holder has an incentive not to allow third party use, including issuing many covenants not to sue, and that a trademark holder may have to pay an alleged infringer’s attorney’s fees in exceptional cases. *Id.* at 731-32.

⁴⁰ *Id.* at 734.

⁴¹ *Id.* at 733-34.

⁴² For a discussion of the societal harms of abusive trademark litigation tactics, *See* Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 WIS. L. REV. 625, 650-52 (2011) (discussing “reduction in competition” and harm to “cultural expression and free speech”).

⁴³ Another way to combat abusive trademark litigation tactics is by “shaming.” *See id.* at 653-54. For a discussion of how other judicial sanctions may be incapable of stopping trademark bullying and a proposal for an administrative solution, *see* Irina D. Manta, *Bearing Down on Trademark Bullies*, 22 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 853, 858-71 (2012). Commentators have also proposed the adoption of a trademark notice and take down system similar to the Digital

The problem is not just unclear law. The problem is unclear law in the context of attorneys—notably zealously representing their clients—vigorously enforcing their clients’ marks to their broadest arguable extent under evolving consumer perception.⁴⁴

III. FUNCTIONALITY LAW

Functionality law is anything but clear.⁴⁵ Depending on the jurisdiction, there are two types of functionality: aesthetic and utilitarian.⁴⁶

There are arguably two rationales for the functionality doctrine: 1) to ensure that trademark law does not provide perpetual legal protection for subject matter better protected by utility patent law; and 2) to protect and promote competition.⁴⁷ Most would probably agree that both rationales can apply to utilitarian type functionality, but most likely would agree only the latter justifies aesthetic type functionality.⁴⁸

Importantly, if functionality applies, either aesthetic or utilitarian, that means that the mark holder’s trademark cannot receive legal

Millennium Copyright Act to prevent trademark bullying. See Jason R. Brege & Kelli A. Ovies, *Taking Down Trademark Bullying: Sketching the Contours of a Trademark Notice and Takedown Statute*, 12 WAKE FOREST J. BUS. & INTELL. PROP. L. 391 (2012).

⁴⁴ The problem may have been exacerbated by the recent U.S. Supreme Court decision, *Already v. Nike*, which may allow a trademark holder to escape a challenge to its mark by unilaterally issuing a “Covenant Not to Sue.” *Already*, 133 S. Ct. at 733-34. This removes a potential check on abusive trademark litigation tactics—the opportunity for the supposed infringer or diluter to eliminate the trademark holder’s mark. *Id.*

⁴⁵ GRAEME B. DINWOODIE & MARK D. JANIS, TRADEMARKS AND UNFAIR COMPETITION: LAW AND POLICY 158-59 (3d ed. 2010) (discussing the differing justifications of the functionality doctrine); see also Elizabeth W. King, *The Trademark Functionality Doctrine: Recast for Comprehension*, 5 LANDSLIDE 20, 21 (2012) (“For decades, trademark practitioners have wrestled with the functionality doctrine.”). For additional analysis of functionality doctrine, see generally Mark P. McKenna, *(Dys)functionality*, 48 HOUS. L. REV. 823 (2011).

⁴⁶ *Id.* Notably, at least two circuits have not adopted it or may not recognize the doctrine at all. See *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 487-88 (5th Cir. 2008) (“We do not believe that the Court’s dictum in *TraFFix* requires us to abandon our long-settled view rejecting recognition of aesthetic functionality.”); *Maker’s Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 418 (6th Cir. 2012) (“It seems we have not yet plainly stated which test we would apply under aesthetic functionality doctrine, . . . or that we have even adopted aesthetic functionality doctrine at all . . . We need not decide these questions today.”).

⁴⁷ *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll.*, 550 F.3d at 487.

⁴⁸ *Id.*

protection notwithstanding the mark's ability to serve as a trademark—generally to serve to identify and distinguish one person's goods or services from another and to indicate the source of those goods or services.⁴⁹ Thus, functionality and the policies that drive it trump other concerns in trademark law such as protecting the goodwill of the trademark owner or preventing consumer confusion.⁵⁰

An additional lack of clarity in functionality law concerns the standards for when functionality exists and how to apply those standards.⁵¹ In the U.S. Supreme Court's most recent discussion of functionality in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, the Court stated that the test for functionality asks whether the claimed trade dress is essential to the use or purpose of the article or affects its cost or quality.⁵² Thus, a product design may be functional if the appearance of a product impacts how it works, or its cost or quality—a dual spring design is a cost effective way to allow road signs to flex and remain upright in adverse wind conditions.⁵³ The Court also noted that after applying that test, courts could inquire as to whether the trade dress put competitors at a non-reputation related disadvantage—something not because of the functions of the trademark.⁵⁴

In determining if the second test is met, a court may inquire into competitive necessity or whether there are alternatives to the claimed trade dress.⁵⁵ Thus, if someone claimed the color black in connection with boat motors, the exclusive use of that color in connection with those goods would put competitors at a non-reputation related disadvantage, even though the color does not affect how the motor works.⁵⁶ The color can serve to make the motor look smaller and the color black matches many boat colors.⁵⁷ And, there are no alternatives to black to serve those purposes, so a competitor needs to use that color.⁵⁸ The *TrafFix Devices, Inc.* court seemed to indicate that the second test was to be applied in cases of aesthetic functionality and not utilitarian functionality, but that could be interpreted to mean that the

⁴⁹ See *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34 (2001) (“Functionality having been established, whether [MDI's dual-spring] design has acquired secondary meaning need not be considered.”).

⁵⁰ See *id.*

⁵¹ See generally *id.* at 32.

⁵² *Id.* at 35.

⁵³ See generally *id.*

⁵⁴ *Id.* at 33.

⁵⁵ *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1531-32 (Fed. Cir. 1994).

⁵⁶ *Id.*

⁵⁷ *Id.*

⁵⁸ *Id.*

utilitarian or aesthetic functionality inquiry involves applying both tests, and if either is satisfied, then the mark is functional and not protected.⁵⁹

Besides the benefit for certainty in the law, the aesthetic functionality doctrine should be clarified because it may serve to protect wide vistas of the creative arts and competition, and ensure robust freedom of expression. The potential benefits of the doctrine are particularly important because the subject matter of trademarks has expanded to protect almost any symbol that can be perceived as a trademark, including subject matter traditionally protected by copyright law—and it is continuously expanding.⁶⁰ For example, subject matter that may be protected by trademark law includes motion marks; colors, including a single color; music; three-dimensional objects; and holographs.⁶¹

Three recent cases highlight the expansion of trademark protection—in light of overreaching trademark claims by trademark holders—and how the aesthetic functionality doctrine may serve to reign in expansive trademark protection in the context of vigorous policing of trademarks.⁶²

IV. THE CASES AND THE APPLICATION OF THE AESTHETIC FUNCTIONALITY DOCTRINE

The following three recent cases provide some context to how the aesthetic functionality doctrine could be applied to protect creativity,

⁵⁹ *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001).

⁶⁰ *See* *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (holding that color alone can be protected by trademark law); *In re Clarke*, 17 U.S.P.Q.2d (BNA) 1238, 1239 (T.T.A.B. 1990) (holding that fragrance functions as a trademark); *In re Gen. Elec. Broad. Co.*, 199 U.S.P.Q. (BNA) 560, 562-64 (T.T.A.B. 1978) (Lefkowitz, J.) (holding that sound can function as a trademark); Jerome Gilson & Anne Gilson LaLonde, *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 TRADEMARK REP. 773, 773 (2005) (discussing non-traditional marks); Jerome Gilson & Anne Gilson LaLonde, *Getting Real with Nontraditional Trademarks: What's Next After Red Oven Knobs, the Sound of Burning Methamphetamine, and Goats on a Grass Roof*, 101 TRADEMARK REP. 186, 193-208 (2011) (reviewing non-traditional marks protected by trademark law).

⁶¹ *See generally* Jerome Gilson & Anne Gilson LaLonde, *Getting Real with Nontraditional Trademarks: What's Next After Red Oven Knobs, the Sound of Burning Methamphetamine, and Goats on a Grass Roof*, 101 TRADEMARK REP. 186, 193-214 (2011).

⁶² For an argument against aesthetic functionality, *see* Tracy Reilly, *Betty Boop Almost Lost Her "Bling-Bling": Fleischer Studios v. A.V.E.L.A. and the Re-Emergence of Aesthetic Functionality in Trademark Merchandising Cases*, 94 J. PAT. & TRADEMARK OFF. SOC'Y, 95, 120-31 (2012).

competition and free expression. This section also provides suggestions for the application of that doctrine.

The facts of the first two cases involve so-called defensive aesthetic functionality doctrine. Under this doctrine, if it applies, a court does not declare that the mark receives no protection in all circumstances as under an ordinary aesthetic functionality analysis. The court determines that the particular infringer's use of the trademark is aesthetically functional and the alleged infringer can thus continue using the mark.⁶³

The first case involves two 2011 Ninth Circuit opinions and the famous character "Betty Boop."⁶⁴ In *Fleischer Studios, Inc. v. A.V.E.L.A. Inc.*, one party claimed trademark protection over Betty Boop—her image, and word and character marks—and tried to stop another party from selling Betty Boop dolls, T-shirts, and handbags with her image.⁶⁵ The Ninth Circuit, in its first opinion, decided that the alleged infringers' use was covered by aesthetic functionality and the alleged mark holder could not stop that use.⁶⁶ The court reasoned, following the controversial *International Order of Job's Daughters v. Lindeburg & Co.*⁶⁷ decision, that A.V.E.L.A. was not using Betty Boop as a trademark but instead as a functional product and that Betty Boop was a prominent feature of the product, and A.V.E.L.A. never designated the merchandise as "official" or otherwise indicated sponsorship.⁶⁸ The court noted that there was no evidence of confusion.⁶⁹

The court, citing the U.S. Supreme Court's opinion in *Dastar Corp. v. Twentieth Century Fox Film Corp.*,⁷⁰ also essentially stated that trademark protection should not extend to a copyrighted work such as the Betty Boop character because then that character would never enter the public domain and this would frustrate copyright law.⁷¹

⁶³ For a discussion of defensive aesthetic functionality, see Anthony L. Fletcher, *Defensive Aesthetic Functionality: Deconstructing the Zombie*, 101 TRADEMARK REP. 1687 (2011).

⁶⁴ *Fleischer Studios, Inc. v. A.V.E.L.A. Inc.*, 636 F.3d 1115, 1124 (9th Cir.), *withdrawn and superseded by* *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958 (9th Cir. 2011).

⁶⁵ *Id.* at 1117-18, 1122.

⁶⁶ *Id.* at 1122-24.

⁶⁷ *Int'l Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 918 (9th Cir. 1980).

⁶⁸ *A.V.E.L.A. Inc.*, 636 F.3d at 1124.

⁶⁹ *Id.*

⁷⁰ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

⁷¹ *A.V.E.L.A., Inc.*, 636 F.3d at 1124. For a recent discussion of *Dastar*, see Mark P. McKenna, *Dastar's Next Stand*, 19 J. INTELL. PROP. L. 357 (2012).

Interestingly, after the filing of several amicus briefs by parties such as the Motion Picture Association, the International Trademark Association, and others, the Ninth Circuit withdrew the opinion and substituted it for another opinion relying on other grounds concerning an incomplete chain of title.⁷² Even in light of this withdrawal, some trademark lawyers have expressed concern that the Ninth Circuit did not explain why its prior opinion was wrong.⁷³ Because of this lack of explanation, the Ninth Circuit may have opened up the door to the use of defensive aesthetic functionality which could mean the end of licensing and merchandising, and the loss of billions of dollars to their clients.⁷⁴ Indeed, on remand, the district court found that the defendants' use of the word mark "Betty Boop" was aesthetically functional. In analyzing aesthetic functionality, the district court reasoned that:

Because, as noted above, Defendants' use of the mark is a decorative feature of their merchandise and is not source-identifying, "protection of the feature as a trademark would impose a significant non-reputation-related competitive disadvantage" on Defendants. Were Defendants to market their goods bearing the image of Betty Boop or Betty Boop movie posters without the words Betty Boop to identify the character, that would make their products less marketable than the same product that included the BETTY BOOP name.

⁷² *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958 (9th Cir. 2011).

⁷³ See e.g., Nancy Clare Morgan, *Aesthetic Appeal: The Blending of Aesthetics and Usefulness in Design Can Result in Challenges to the Theoretical Foundation of Trademark Law*, L.A. LAW, Feb. 2012, at 36, 38 (2012); see also Lee B. Burgunder, *The Scoop on Betty Boop: A Proposal to Limit Overreaching Trademarks*, 32 LOY. L.A. ENT. L. REV. 257, 257 (2012) ("The Ninth Circuit temporarily stunned marketers in 2011 when it ruled that Betty Boop did not serve as a trademark on merchandise due to aesthetic functionality and because protection would conflict with the copyright system. The opinion endangered merchandising rights in all trademarks and jeopardized the duration of trademark rights in images and media characters. The court soon withdrew the decision and substituted it with one that denied protection on technical grounds, leaving the controversies for another day.") and Charles E. Colman, *A Red-Leather Year for Aesthetic Functionality*, 4 LANDSLIDE 26, 30 (2011) ("It is difficult--perhaps impossible--to know what to make of the *A.V.E.L.A.* saga. Although the panel withdrew its aesthetic functionality-based opinion, the decision that took its place notably declined to endorse the position advocated by the above-mentioned amici—that *Auto Gold* is still the law of the Ninth Circuit. The panel's second opinion likewise declined to adopt INTA's characterization of *Job's Daughters* as "outdated and much-criticized.").

⁷⁴ Burgunder, *supra* note 73, at 258.

This is because the words Betty Boop serve to name the famous character depicted on those goods and are part and parcel of the movie posters printed on Defendants' merchandise. For example, Plaintiff points to one of Defendants' dolls that includes packaging bearing imagery from a Betty Boop movie poster, and a product tag that is a miniature reproduction of the movie poster. Both uses of the poster imagery bear the following text: "Adolph Zukor presents BETTY BOOP with HENRY the Funniest Living American". Removing the words BETTY BOOP from these items would render the textual aspect of the poster reproductions incomplete and the remaining words would be nonsensical. It would be obvious to the average consumer that such merchandise would be missing something. Clearly, merchandise that is missing something is less marketable and therefore at a competitive disadvantage. In addition, because Defendants' use of the Betty Boop word mark is not source identifying and simply does not trade on the "reputation" of any source, barring Defendants from using those words would "impose a significant non-reputation-related competitive disadvantage."⁷⁵

The district court's opinion provides a glimmer of hope that aesthetic functionality can be effectively applied by courts, at least in the context of word marks, but the question remains whether other courts will follow it.

The second case involves the University of Alabama and an artist.⁷⁶ In that case, the University of Alabama sued an artist for trademark infringement.⁷⁷ The artist painted limited edition paintings of famous plays with University of Alabama football players wearing crimson and white uniforms.⁷⁸ The infringement theory was apparently that consumers could believe there was some sponsorship or other relationship involving permission between the University of Alabama and the artist.⁷⁹ Notably, in this case, there was a

⁷⁵ *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 2012 WL 7179374, at *7 (C.D. Cal. 2012). The district court also alternatively found that defendants' use was covered by the descriptive fair use doctrine. *Id.* at *8.

⁷⁶ *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 677 F. Supp. 2d 1238 (N.D. Ala. 2009), *aff'd in part, rev'd in part*, 683 F.3d 1266, 1283 (11th Cir. 2012).

⁷⁷ *New Life Art, Inc.*, 677 F. Supp. 2d. at 1244-46.

⁷⁸ *Id.* at 1244-46.

⁷⁹ *Id.* at 1249.

relationship between the University of Alabama and the artist, and there was a license in place between the two parties.⁸⁰ Part of the dispute centered on whether the colors of the uniforms of the players were covered by the license.⁸¹ However, the district court decided in favor of the artist, noting that the case involved “fine art” and that the artist’s work was protected artistic expression, fair use or protected by the First Amendment.⁸² The Court noted that the artist’s paintings and the limited edition prints were not infringing, but that other merchandise such as T-shirts, cups, mugs, posters and calendars may be infringing.⁸³ Over two years later, the U.S. Court of Appeals for the Eleventh Circuit applied the *Rogers v. Grimaldi* test and found that Moore’s work did not constitute a violation of the Lanham Act.⁸⁴ The court reasoned that:

Therefore, we have no hesitation in joining our sister circuits by holding that we should construe the Lanham Act narrowly when deciding whether an artistically expressive work infringes a trademark. This requires that we carefully “weigh the public interest in free expression against the public interest in avoiding consumer confusion.” An artistically expressive use of a trademark will not violate the Lanham Act “unless the use of the mark has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless it explicitly misleads as to the source or the content of the work.”

In this case, we readily conclude that Moore’s paintings, prints, and calendars are protected under the *Rogers* test. The depiction of the University’s uniforms in the content of these items is artistically relevant to the expressive underlying works because the uniforms’ colors and designs are needed for a realistic portrayal of famous scenes from Alabama football history. Also there is no evidence that Moore ever marketed an unlicensed item as “endorsed” or “sponsored” by the University, or otherwise explicitly stated that such items were affiliated with the University. Moore’s

⁸⁰ *Id.* at 1244.

⁸¹ *Id.*

⁸² *Id.* at 1250.

⁸³ *Id.*

⁸⁴ *Univ. of Ala. Bd. of Trs. v. New Life Art*, 683 F.3d 1266, 1278-79 (11th Cir. 2012).

paintings, prints, and calendars very clearly are embodiments of artistic expression, and are entitled to full First Amendment protection. The extent of his use of the University's trademarks is their mere inclusion (their necessary inclusion) in the body of the image which Moore creates to memorialize and enhance a particular play or event in the University's football history. Even if "some members of the public would draw the incorrect inference that [the University] had some involvement with [Moore's paintings, prints, and calendars,] ... that risk of misunderstanding, not engendered by any overt [or in this case even implicit] claim ... is so outweighed by the interest in artistic expression as to preclude" any violation of the Lanham Act.⁸⁵

Importantly, the court did not address whether a trademark defense applied to the use of the marks on mugs and "other mundane objects." This leaves open the question of whether Moore's work applied to these other items would pass muster under *Rogers v. Grimaldi*. Indeed, if Moore or another artist created a work on a "mundane object" that work may fail the *Rogers v. Grimaldi* test if consumers would believe a license was required to create the work.

Under the facts of both cases it is easy to understand how potential "artists" or small companies with limited resources could be concerned. In one case, a party may not use a character even if it conceivably falls in the public domain to create new works because of a trademark merchandising right. In the other, a party may not create paintings of scenes in real life that have trademarks in them because under trademark law a trademark owner may claim a merchandising right. Under either case, there is a possibility that if there is an expected merchandising market because of the nature of the good then there may be a trademark infringement without a defense. The slippery slope seems clear and there are several problems with this type of reasoning and extending it. First, how do you determine what is merchandise or not? Maybe you could limit it to "traditional promotional goods" but what if LEGO sells plastic LEGO pieces, and then expands into creating characters, television shows, motion pictures, video games, and other audio-visual works traditionally protected by copyright law? Trademark protection has expanded to include motion marks, colors and sounds. Related to this question is whether LEGO will continue to control those works under a trademark

⁸⁵ *Id.* (citations omitted).

merchandising theory even if the copyright expires in various works. And, as mentioned before, the question of which “copyrighted work” is the referenced work is a complicated issue. Moreover, in the context of aggressive trademark tactics, an artist with minimal funding or a small business with limited funding may not litigate and may choose to capitulate. A robust aesthetic functionality defense may provide a disincentive to or eliminate overreaching trademark claims.

Accordingly, instead of relying on a defense based on the First Amendment or a substitutionary test for the likelihood of confusion,⁸⁶ courts could rely on defensive aesthetic functionality to justify or excuse an alleged infringer’s use. As long as there is no attempt to suggest some “official” licensing relationship, aesthetic functionality would preserve a producer’s ability to sell formerly copyright protected work as utilitarian functionality does for patent. Robust competition is preserved as consumers will have more choice and lower prices, and creativity is not stifled. And, the copyright owner has received their reward and the work, as in the *A.V.E.L.A.* case, should pass to the public domain.

In the *University of Alabama* case, defensive aesthetic functionality could excuse or justify the artist’s use and also hold the University of Alabama’s marks as valid. The University of Alabama thus cannot stop the artist’s use because to do so would effectively

⁸⁶ Notably, the jurisprudence concerning the First Amendment and trademark law is not entirely clear. There are multiple potential tests that courts may apply; although the leading test appears to be the test from *Rogers v. Grimaldi*. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989). In that case, the court examined the application of trademark law to a title of an expressive work. *Id.* The court stated that it needed to balance the expressive interest of the First Amendment against potential consumer confusion. *Id.* Unfortunately, the Circuits have at least three different ways of applying the *Rogers v. Grimaldi* test. See Nicolas Macri, *Holding Back the (Crimson) Tide of Trademark Litigation, The Eleventh Circuit Shields Works of Art from Lanham Act Claims in New Life Art*, 54 B.C.L. REV. 71, 78-80 (2013). Other Circuits have considered the First Amendment interest in different ways in trademark cases. See e.g., *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402–03 (8th Cir. 1987); *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1405 (9th Cir. 1997); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 970 (10th Cir. 1996). Importantly, in a recent case, a district court applied the *Rogers* test to dismiss a trademark complaint. *Rebellion Devs. Ltd. v. Stardock Entm’t, Inc.*, 2013 WL 1944888, at *3-6 (E.D. Mich. 2013). The use of *Rogers* to end a trademark litigation early is a welcome development. For additional discussion of the *Rebellion Devs. Ltd.* case, see Rebecca Tushnet, *Sins of a Trademark Owner: Rogers Applies Regardless of Intent*, REBECCA TUSHNET’S 43(B)LOG (May 23, 2013), http://tushnet.blogspot.com/2013/05/sins-of-trademark-owner-rogers-applies.html?utm_source=feedburner&utm_medium=email&utm_campaign=Feed%3A+RebeccaTushnets43blog+%28Rebecca+Tushnet%27s+43%28B%29log%29.

allow the University of Alabama to foreclose anyone from using their marks. This would not only place creators in the market for producing expressive works at some competitive disadvantage, but would also wholly preempt the market for the creation of those works in certain mediums.

A problem with using defensive aesthetic functionality, as alluded to earlier, is attempting to ascertain what is a non-reputation related disadvantage, because arguably the markets created for Betty Boop merchandise or works, and University of Alabama merchandise or works, are driven by demand created in part because of the popularity of the marks or copyrighted works. Arguably, this demand is all about a reputation related advantage. However, the argument cannot be that broad or defensive aesthetic functionality would never apply. The application of the defense would not fulfill its function of protecting competition. Consumers may purchase the item because of loyalty or some decorative reason,⁸⁷ although inquiring into the motivations of consumers is unlikely to provide much certainty with respect to the application of the doctrine unless there was a presumption favoring the application of aesthetic functionality.

The final case is the *Louboutin* case involving a shiny, lacquered red on the outsoles of high-priced, high-heeled shoes, which Louboutin claims as its trademark.⁸⁸ In this case the district court denied a preliminary injunction, in part, by essentially adopting a per se rule that a supposed trademark holder cannot use trademark law to control a single color in the fashion industry.⁸⁹ The district court applied the aesthetic functionality doctrine, but not the defensive type.⁹⁰ In highlighting the importance of color in the fashion industry, the court allowed competitors to use this color (or shade)—even on outsoles—because it is necessary for them to compete.⁹¹ The court noted several reasons why a competitor may want to use red—that are not reputation related—red symbolizes energy, it’s engaging, it’s sexy, it attracts men to women who wear these shoes.⁹² Moreover, competitors need the color to create coordinating outfits.⁹³ The court

⁸⁷ Int’l Order of Job’s Daughters v. Lindeburg & Co., 633 F.2d 912, 918 (9th Cir. 1980).

⁸⁸ Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc., 778 F. Supp. 2d 445, 448 (S.D.N.Y. 2011), *aff’d in part, rev’d in part*, 696 F.3d 206 (2d Cir. 2012).

⁸⁹ *Id.* at 457.

⁹⁰ *Id.* at 453.

⁹¹ *Id.* at 453-54.

⁹² *Id.*

⁹³ *Id.* at 454.

likened the importance of color to fashion as the same as fine art.⁹⁴
The court reasoned that:

Painting and fashion design stem from related creative stock, and thus share many central features. Both find common ground and goals in two vital fields of human endeavor, art and commerce. For the ultimate ends they serve in these spheres, both integrally depend on creativity. Fashion designers and painters both regard themselves, and others regard them, as being engaged in labors for which artistic talent, as well as personal expression as a means to channel it, are vital. Moreover, the items generated by both painters and fashion designers acquire commercial value as they gain recognition. Louboutin himself would probably feel his sense of *honneur* wounded if he were considered merely a cobbler, rather than an *artiste*. But, as a matter differing only in degrees and order of priority, Louboutin and Picasso both may also be properly labeled as men of commerce, each in his particular market.

The creative energies of painter and fashion designer are devoted to appeal to the same sense in the beholder and wearer: aesthetics. Both strive to please patrons and markets by creating objects that not only serve a commercial purpose but also possess ornamental beauty (subjectively perceived and defined). . . .

But, as an offshoot of color, perhaps most crucial among the features painting and fashion design share as commerce and art, are two interrelated qualities that both creative fields depend upon to thrive, and indeed to survive: artistic freedom and fair competition. In both forms, the greatest range for creative outlet exists with its highest, most vibrant and all-encompassing energies where every pigment of the spectrum is freely available for the creator to apply, where every painter and designer in producing artful works enjoys equal freedom to pick and choose color from every streak of the rainbow. The contrary also holds. Placing off limit signs on any given chromatic band by allowing one artist or designer to appropriate an entire shade and

⁹⁴ *Id.* at 452-54.

hang an ambiguous threatening cloud over a swath of other neighboring hues, thus delimiting zones where other imaginations may not veer or wander, would unduly hinder not just commerce and competition, but art as well.

The thrust and implications of the Court's analogy are clear. No one would argue that a painter should be barred from employing a color intended to convey a basic concept because another painter, while using that shade as an expressive feature of a similar work, also staked out a claim to it as a trademark in that context. If as a principle this proposition holds as applied to high art, it should extend with equal force to high fashion. The law should not countenance restraints that would interfere with creativity and stifle competition by one designer, while granting another a monopoly invested with the right to exclude use of an ornamental or functional medium necessary for freest and most productive artistic expression by all engaged in the same enterprise.⁹⁵

Unfortunately, the U.S. Court of Appeals for the Second Circuit determined that the district court's decision concerning aesthetic functionality was flawed.⁹⁶ Specifically, the Second Circuit decided that the district court's per se rule that a single color could not be protected in an industry was inconsistent with the U.S. Supreme Court's *Qualitex* decision.⁹⁷ Importantly, the Second Circuit did seem to indicate that *Qualitex* could be read to allow a per se rule in an industry, but stated that was "doubtful."⁹⁸ The Second Circuit also limited Louboutin's trademark to the lacquered red color with a contrasting upper sole.⁹⁹ This limitation allowed the Second Circuit to find that Yves Saint Laurent was not infringing Louboutin's trademark, while at the same time upholding Louboutin's

⁹⁵ *Id.* at 452-53.

⁹⁶ *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 212 (2d Cir. 2012). For additional discussion of the *Louboutin* decisions, see generally Reanna L. Kuitse, *Christian Louboutin's "Red Sole Mark" Saved to Remain Louboutin's Footmark in High Fashion, For Now . . .*, 46 IND. L. REV. 241 (2013); Alexandra J. Schultz, *Looks Can Be Deceiving: Aesthetic Functionality in Louboutin and Beyond*, 15 TUL. J. TECH. & INTELL. PROP. 261 (2012).

⁹⁷ *Christian Louboutin S.A.*, 696 F.3d at 223.

⁹⁸ *Id.*

⁹⁹ *Id.* at 226-27.

trademark.¹⁰⁰ Courts should follow the analysis of the district court in *Louboutin* and apply a “per se” approach to numerous types of marks, with the aesthetic functionality doctrine clearing the way for more creativity, and competition in specific industries. Aesthetic functionality could serve as a policy lever, similar to those in patent law,¹⁰¹ to prohibit overreaching in trademark law in specific industries.

V. CONCLUSION

Trademark holders vigorously protect their marks—and they have every reason to do so under trademark law and policy. However, trademark holders may essentially act as a “bully” when they overreach, and when they do, it is easily understandable how they can stifle artistic expression and creativity under the facts of these cases or a simple extension of the facts. A struggling artist or small company may not have the resources to fight the University of Alabama and may just give in and stop using the mark. Notably, the artist in the University of Alabama case paid hundreds of thousands of dollars in attorneys’ fees—how many struggling artists can afford to engage in years of litigation with such a high dollar cost.¹⁰² A strong aesthetic functionality defense may ensure a robust competitive market for artistic works in many mediums including those in supposed merchandising markets. While some circuits do not recognize the aesthetic functionality doctrine at all or apply it very narrowly—the time has come for courts to reexamine the doctrine because the stakes are high.

¹⁰⁰ *Id.*

¹⁰¹ Dan L. Burk & Mark A. Lemley, *Policy Levers in Patent Law*, 89 VA. L. REV. 1575, 1641 (2003).

¹⁰² Daniel Grant, *Free Speech vs. Infringement in Suit on Alabama Artwork*, N.Y. TIMES (Jan. 30, 2012), http://www.nytimes.com/2012/01/31/sports/ncaafootball/artist-still-fighting-alabama-over-football-paintings.html?pagewanted=all&_r=0.