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The Functionality Doctrine in Trade Dress and Copyright Infringement Actions: A Call for Clarification

by

BETH F. DUMAS*

Introduction

When protecting the design features of a useful article, the outcome of an infringement suit depends on one concept: functionality. The design features of a useful article may qualify for both trade dress protection under section 43(a) of the Lanham Act,1 and copyright protection under the 1976 Copyright Act.2 Trade dress protection extends to the appearance of an article, such as its shape or exterior detail.3 Similarly, copyright protection extends to the pictorial, graphic and sculptural features of an article's appearance, and may be available for the shape and exterior detail of an article.4 However, in both trade dress infringement actions5 and copyright infringement actions,6 protection will be denied if the design features of the article are also considered functional. Although functionality is a common defense, courts employ different tests for determining functionality in trade dress and copyright infringement actions.

The functionality doctrine is an elusive one; courts have achieved greater success in devising and verbalizing the tests for determining functionality for copyright infringement actions than for trade dress infringement actions. The trade dress arena is especially problematic because the federal courts have developed a myriad of functionality tests. According to one attorney litigating trade dress claims, "the concept of 'functional-
ity' is one that has confused and split the federal circuits, leaving federal
district judges, at best, nonplussed as to how to explain functionality to a
jury. Stewart, "Functionality" Under Lanham Act Confuses and Splits Appeals Courts, Nat'l

Fashioning an understandable and proper jury charge often takes
a great deal of judicial and attorney time. This Note discusses the functionality doctrine in copyright infringe-
ment actions and section 43(a) trade dress infringement actions. Part I
focuses on the copyright law definition of functionality and discusses the
currently accepted copyright test for functionality, as well as earlier tests.
Part II of this Note examines the functionality doctrine in trade
dress infringement actions. This author believes that the federal courts
need to adopt functionality tests which are most capable of practical and
uniform application, and which effectuate rather than reiterate the policy
goals behind the functionality doctrine. Toward this end, Part II synthe-
sizes functionality tests from recent case law because as it stands now,
opinions are complicated by nine different verbal formulations of
functionality. Justice Coffey recently made this observation in Schwinn Bicycle Co. v. Ross Bicycles,
870 F.2d 1176, 1188 (7th Cir. 1988); see also infra § IIIA of this note.

Finally, Part III succinctly restates and critiques these functionality
tests. This Note contends that the courts should acknowledge the difference between "mechanical" and "non-mechanical" products. Specifi-
cally, for mechanical products, the courts should use the "dictated by
superior utilitarian characteristics" test. To determine whether the fea-
tures of a non-mechanical product are functional, courts should borrow
copyright law's conceptual separability requirement and its accompany-
ing "independent judgment" test.

7. Stewart, "Functionality" Under Lanham Act Confuses and Splits Appeals Courts, Nat'l
8. Id.
9. Justice Coffey recently made this observation in Schwinn Bicycle Co. v. Ross Bicycles,
870 F.2d 1176, 1188 (7th Cir. 1988); see also infra § IIIA of this note.
11. See Brandir Int'l, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987)
(aesthetic elements can be identified as reflecting the designer's artistic judgment, exercised
independently of functional considerations).

Applying the "independent judgment" test, if the feature is not conceptually separable
from the physical design of the non-mechanical product, such that the feature cannot be identi-
fied as reflecting the designer's independent judgment, exercised independently from mechani-
cal or utilitarian influences, then the feature is functional and should be denied trade dress
protection.
I

Copyright Infringement Actions

A. Overview

Copyright law grants exclusive rights to the creators of "original works of authorship." Protection is not limited to the fine arts; it also encompasses the designs of useful articles. As the U.S. Supreme Court stated in the landmark case Mazer v. Stein: "Individual perception of the beautiful is too varied a power to permit a narrow or rigid conception of art." The Court held that original works of art do not cease to be eligible for copyright protection as works of art simply because they are embodied in useful articles. Specifically, Mazer upheld the copyrightability of a statuette depicting a female dancer that was used as a lamp base. The 1976 Copyright Act adopted the Mazer holding by declaring works of artistic craftsmanship eligible for copyright protection.

12. 17 U.S.C. § 102 (1988). Section 102(a) sets forth the "[s]ubject matter of copyright, in general." It provides, in part: "(a) Copyright subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." Id.


15. Id.

16. Id. at 202, 219.

17. In Mazer, the Court applied the 1909 Copyright Act to determine that "works of art" incorporated in the designs of useful articles are copyrightable. At the time of its decision, the 1909 Copyright Act provided copyright protection to "all the writings of an author," including "Works of Art; models or designs for works of art." Copyrights Act, ch. 320, § 5, 35 Stat. 1075, 1077 (1909). Although the 1909 Act did not explicitly provide copyright protection to the design elements of useful articles, the Court pointed to a 1948 Copyright Office Regulation that expanded the scope of copyright protection to include works of artistic craftsmanship, subject to a functionality requirement:

Works of art: (Class G)-(a) In General. This class includes works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian function are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as works belonging to the fine arts, such as paintings, drawings and sculpture. 37 CFR § 202.8 (1949). In reaching its decision, the Mazer court endorsed this regulation. See Mazer, 347 U.S. at 212-14; Barnhart Inc. v. Economy Cover Corp., 773 F.2d 411, 416 (2d Cir. 1985).

After the Mazer decision, the Copyright Office issued new regulations to reflect the Mazer interpretation of "works of art." These regulations stated in part:

(c) If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing as a work of art, such features will be eligible for registration. 37 C.F.R. § 202.10(c) (1959) (as amended June 18, 1959 (revised 1978)).

The 1976 Copyright Act adopted both the Copyright Office Regulations and the Mazer decision. H.R. REP. No. 1476, 94th Cong., 2d Sess 54-55, 105, reprinted in 1976 U.S. CODE
The Copyright Act provides that the design features of a useful article may be copyrightable as a pictorial, graphic or sculptural work. The Copyright Act defines a useful article as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is itself normally a part of a useful article is considered a 'useful article.'" The dictionary defines utilitarian as something "characterized by or aiming at utility as distinguished from beauty or ornament.

The Copyright Act, however, denies protection to the design features of useful articles when those design features are considered functional. Only those pictorial, graphic and sculptural features that can be identified as being physically or conceptually separable from the functional aspects of the article are protected by copyright. Therefore, functionality arises as a defense to copyright infringement actions. But the Copyright Act is silent as to a test for separability, leaving the courts with the task of determining when an element is separable.

18. 17 U.S.C. § 102(a). Pictorial, graphic and sculptural works are just one category of copyrightable subject matter. Id. In addition, 17 U.S.C. § 113(a) specifically grants copyright protection to useful articles: "Scope of exclusive rights in pictorial, graphic and sculptural works: Subject to the provisions of subsections (b) and (c) of this section, the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise." (emphasis added).


21. 17 U.S.C. § 101 states:

"Pictorial, graphic and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, technical drawings, diagrams and models. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

22. In defining "pictorial, graphic and sculptural works," the Copyright Act sets forth the basis of this limitation: "The design of useful articles . . . shall be considered a pictorial, graphic or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101 (emphasis added). The House Report accompanying the 1976 Copyright Act further declares that copyright protection for useful articles extends to those aesthetic elements that "physically or conceptually, can be identified as separable from the utilitarian aspects of the article." H.R. REP. NO. 94-1476, 94th Cong., 2d Sess. 46, 55 (1976), reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5668 (emphasis added).
B. Policy Considerations

The statutory provisions governing the copyrightability of useful articles reflect Congress' concern with removing efficient and aesthetically pleasing new designs from the public domain. Specifically, Congress intended the functionality doctrine to ensure (1) the availability of competition, (2) the availability of quality products, and (3) the advancement of technology through copying and modification. The separability test "draw[s] as clear a line as possible between copyrightable works of applied art and uncopyrightable works of industrial design."  

Alternatively, the functionality doctrine can be viewed as an application of copyright law's idea-expression distinction. By granting protection to expressions, rather than ideas, the law provides a limited monopoly rather than a complete monopoly. This results in the maximum benefit to society: giving an individual a monopoly over his original expression encourages that person to create artistic works, while prohibiting a monopoly on ideas encourages others to create artistic works. When an idea can only be expressed in a limited number of ways, the idea and expression merge. A concern for the negative effect of granting a monopoly on ideas takes priority and protection is denied. Similarly, the functionality doctrine limits the monopoly granted on the design of useful articles. When the functional element cannot be separated from the aesthetic elements, a merger of the functional and artistic aspects has occurred, and protection physically or conceptually is denied.  


24. H.R. Rep. No. 1476, 94th Cong., 2d Sess. 54, reprinted in 1976 U.S. Code Cong. & Admin. News 5659, 5668. Legislation granting copyright protection to industrial designs has been proposed, but not enacted, further confirming Congress' concern with not removing efficient and pleasing new designs in useful articles from the public domain. See H.R. Rep. No. 1476, 94th Cong., 2d Sess. 46, 49-50, reprinted in 1976 U.S. Code Cong. & Admin. News 5659, 5662-63. The bill would have granted protection to the two-dimensional or three-dimensional features of shape and surface that make up the appearance of an article, but do not satisfy the current physical or conceptual separability requirement of copyright law. Design patents for pleasing new designs of useful articles are difficult to obtain because the requirements of novelty and non-obviousness are difficult to satisfy. Id. The Department of Justice opposed the legislation on policy grounds, arguing that design patents were as far as the law should go in protecting industrial or ornamental designs. H.R. Rep. No. 2223, tit. II, § 210(b)(2), 94th Cong., 1st Sess. at 139-40 (1975). Design patents are currently available to inventors of ornamental designs of useful articles, but they are extremely difficult to obtain because patent law requires inventions to be novel and non-obvious. In the opinion of the Department of Justice, the burdens of the proposed legislation outweighed the benefits. Id.

C. Tests Developed by the Courts

The federal courts have fashioned various tests for determining when an aesthetic feature is physically or conceptually separable from the functional elements of an article. One test, physical separability, exists when the aesthetic features of an object remain intact after removing all features necessary for the utilitarian function of the article. For example, a ceramic figurine attached to the handle of a coffee mug or the animal figurine placed on the hood of a Jaguar automobile are physically separable. When the coffee mug and car are removed, the figurines remain. Conversely, the figurines can be removed without altering the usefulness of the handle or the car.

Determining conceptual separability is more complex. The Second Circuit's "independent judgment" test from Brandir v. Cascade seems likely to become the generally accepted standard. Under this test, conceptual separability exists if the aesthetic elements can be identified as reflecting the designer's artistic judgment, exercised independently of functional influences. If the design elements reflect a merger of aesthetic and functional considerations, then the artistic aspects of the work are not conceptually separable. In Brandir, the court held that the ribbon design of a bike rack was not copyrightable because the design was significantly influenced by the functional requirements of a bike rack. As proof of this, the court noted that the rack's creator had altered the design to save space.

Although the Brandir court's "independent judgment" test has emerged as a dominant standard, two earlier Second Circuit cases applied different tests, which illustrate the difficulty of determining conceptual separability. In Kieselstein-Cord v. Accessories by Pearl, Inc., the court used an "I know it when I see it" approach in finding the shape of a

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27. Id. § 2.08(B), 2-98.
29. Id. at 1145, 1146-47 (citing Denicola, "Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles," 67 Minn. L. Rev. 707, 741, 745 (1983)).
30. Id. at 1145.
31. Id. at 1147.

In support of the "independent judgment" test, the Brandir court argued that it was consistent with the Kieselstein-Cord and Barnhart decisions. In Kieselstein-Cord, the artistic aspects of the belt reflected purely aesthetic choices which were made independently from the buckle's function. In Barnhart, by contrast, the distinctive features of the torsos were incorporated to further the usefulness of the torso as mannequins. Brandir, 834 F.2d at 1145-46.
belt buckle conceptually separable from its utilitarian function. However, the court offered almost no rationale for its finding, noting only that the belt was used as a necklace by some, had been accepted by the Metropolitan Museum of Art, and that the design was the result of the author’s inspiration.

The same court devised the “necessity” test in Barnhart v. Economy Cover Corp. Under this test, a feature is not conceptually separable if it is in any way required by the utilitarian function. In Barnhart, the plaintiff created mannequins with anatomical features embodying the shape and detail of a shirt. The court denied copyright protection after deciding that a mannequin torso must have some configuration of the chest and some width of the shoulder in order to serve its utilitarian function.

The dissent in Barnhart discussed several different tests: the “primary/subsidiary” test, the “market approach” and the “ordinary observer” test. The “primary/subsidiary” test states that conceptual separability exists whenever the decorative or aesthetically pleasing aspects of the article are primary and the utilitarian function is subsidiary. The subjective nature of this test, however, would make it difficult for the trier of fact. Under the “market approach,” conceptual separability exists whenever there is any substantial likelihood that the article would be marketable to a significant segment of the community solely for its aesthetic qualities. The “ordinary observer” test asks whether the ordinary observer experiences two separate conceptions: an appreciation of the feature as an artistic work, and a recognition of the feature as functional. If the two impressions are not entertained simultaneously, then conceptual separability exists. Arguably, this test would still deny copyright protection to designs of useful articles that are simply aesthetically pleasing and thus would not subvert the intent of Congress. As with the “primary/subsidiary” test, the ethereal nature of the ordinary observer test would also make it difficult for a trier of fact to apply.

33. 632 F.2d at 993.
34. Id.
35. Id. at 991. According to the creator, his inspiration for the shape of the buckle was the shape of the Winchester rifle of Old West fame. Id.
36. Barnhart, 773 F.2d at 418.
37. Id. at 419.
38. Id. at 421.
39. Id.
40. Id. at 421-22.
41. Id. at 422-23. The Barnhart dissent endorsed this test. Id.
42. See id.
43. Id. at 419 n.5.
Trade Dress Infringement Actions

A. Overview

The term "trade dress" encompasses a complex composite of features: size, color, texture, and graphics. Trade dress protection extends to both the appearance of the product and its packaging. Originally, trade dress protection was not available for the design of a product itself.

Section 43(a) of the Lanham Act provides a federal cause of action for trade dress infringement. In order to succeed on a 43(a) claim, the plaintiff must prove that the trade dress has acquired secondary meaning among consumers and that a likelihood of confusion among consumers as to the source of competing products exists. Additionally, there must be a finding that the design features to be protected are not functional.


46. The Court of Customs and Patent Appeals (CCPA), which had appellate jurisdiction over trademark registration decisions of the Patent and Trademark Office (PTO), originally ruled that products themselves were not the proper subject matter of trademarks and thus were not protectible under existing trademark and unfair competition law. Oddi, The Functions of "Functionality" in Trademark Law, 76 TRADEMARK REP. 308, 313 (1986).

47. Lanham Trademark Act § 43(a), 15 U.S.C. § 1125(a) (1988). Section 43(a) provides a federal cause of action for trade dress infringement via its prohibition against false designations of origin, and false or misleading representation. See Hartford House, 846 F.2d at 1271; Brunswick, 832 F.2d at 516-17.

The creator or manufacturer of a product may also formally register the trade dress as a trademark. Id. This Note, however, focuses on infringement actions based on § 43(a) of the Lanham Act. Even though the cases examined in this Note were decided prior to Congress' revision of § 43(a) in 1988, the revisions make no mention of functionality. The most significant change in § 43(a) is the addition of a civil remedy for misleading advertising.

48. Hartford House, 846 F.2d at 1271.

49. The courts are split as to whether the plaintiff or the defendant carries the burden of proving the functionality issue. Some courts require the defendant to prove functionality. See id. at 1271; Brunswick, 832 F.2d at 520; LeSportsac, Inc. v. K-Mart Corp., 754 F.2d 71, 76 (2d Cir. 1985); Vaughn Mfg. Co. v. Brikam Int'l, Inc., 814 F.2d 346, 349 (7th Cir. 1987). Other courts require the plaintiff to prove non-functionality. See San Francisco Mercantile v. Beeba's Creations, 704 F. Supp. 1005, 1007 (C.D. Cal. 1988) (citing First Brands Corp. v. Fred Meyer, Inc., 809 F.2d 1378, 1381 (9th Cir. 1987); Remcraft Lighting Prods. Inc. v. Maxim Lighting,
Courts often refer to this as the non-functional requirement or the functionality defense.  

B. Policy Considerations

Trade dress protection is a specialized form of unfair competition and trademark laws. Unfair competition law is based on the theory that in order for "free competition" to be truly "free," it must also be "fair." Trade dress law protects against unfair competition by preventing the wrongful diversion of trade. It also protects against consumer deception by preventing the use of a confusingly similar trade dress. As the Supreme Court explained:

By applying a [trade dress] to goods produced by one other than the [trade dress] owner, the infringer deprives the owner of the goodwill which he has spent energy, time and money to obtain... At the same time, the infringer deprives consumers of their ability to distinguish among the goods of competing manufacturers.

The functionality doctrine prevents the otherwise inevitable clash between free competition and trademark protection that occurs when trade dress protection is extended beyond a product's packaging to its design. Although functional products or features can indicate source to the consumer, "there is an overriding public policy of preventing their monopolization by preserving the public right to copy. A certain amount of purchaser confusion may even be tolerated in order to give the public the advantages of free competition."
C. Problems with Trade Dress Functionality Tests

The task of outlining trade dress functionality tests requires distillation because the courts rarely set forth a clear, summary definition of functionality. Instead, the courts engage in discussions sprinkled with case law quotations and policy platitudes. Policy goals are difficult enough for the courts to understand and apply, let alone a jury.\(^58\) There is a split among courts as to whether the functionality issue is to be decided as a matter of law or fact.\(^59\) Either way, courts should be constructing clear and practical tests so attorneys can know what types of evidence to present.

Another problem in trade dress law is the courts' failure to distinguish between what this author denotes as "mechanical products" and "non-mechanical products;" when devising functionality tests. A "non-mechanical product" is a product that does not have an intrinsic utilitarian function. Toys, greeting cards and jewelry are examples of non-mechanical products. Most of the functionality tests devised by the courts lend themselves to mechanical products; when courts try to apply the tests used for mechanical products in cases involving non-mechanical products, confusion results.\(^60\)

D. The Functionality Tests

1. The Second Circuit and the "Essential to Use/Affects Cost or Quality" Test

Under this test, a feature is functional if it is "essential to use or purpose . . . or affects the cost or quality of the article."\(^61\) A feature is "essential to use or purpose" if the feature is "dictated by the functions to be performed; a feature that merely accommodates a useful function is

\(^{58}\) Most of the cases examined in this Note are appeals from grants or denials of preliminary injunctions. In such cases a judge, rather than a jury, decides the functionality issue. Hartford House, Ltd. v. Hallmark Cards, Inc., 846 F.2d 1268, 1273 (10th Cir. 1988); Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 520 (10th Cir. 1987); LeSportsac, Inc. v. K Mart Corp., 754 F.2d 71, 78 (2d Cir. 1985).

\(^{59}\) LeSportsac, 754 F.2d at 76 (citing Vuitton et Fils S.A. v. J. Young Enterprises, 664 F.2d 769, 775 (9th Cir. 1981)) (question of fact); Clamp Mfg. Co., Inc. v. Enco Mfg. Co., Inc., 870 F.2d 512, 514 (9th Cir. 1989) (mixed question of law and fact).

\(^{60}\) See generally American Greetings, Co. v. Dan-Dee Corp., 807 F.2d 1136 (3d Cir. 1986) (tummy graphics on stuffed animals).

not enough."\(^6\) A feature "affecting the cost and quality of an article is one which permits the article to be manufactured at a lower cost . . . or one which constitutes an improvement in the operation of the goods."\(^6\)

The availability of alternative designs will not result in a finding of non-functionality if the alternative designs would affect the cost or quality of the product.\(^6\) The test, originally Supreme Court dictum in a trademark infringement case,\(^5\) was adopted by Second Circuit in *Warner Bros. v. Gay Toys*.\(^6\)

A subsequent Second Circuit case, *LeSportsac, Inc. v. K-Mart Corp.*, used a variation of this test: the "not essential to use/primarily serves to identify" \(^5\) test. Phrased negatively, a feature is *not* functional if it: (1) is not essential to use or purpose, or does not affect cost or quality,\(^6\) and (2) primarily serves to identify the producer.\(^6\) The lower court applied this test to find that the combination and arrangement of design elements on plaintiff's fashion bags were non-functional, and the *LeSportsac* appellate court affirmed.\(^7\)

The "primarily serves to identify" component of this test is a modified version of the now disfavored "aesthetic functionality" doctrine.\(^7\) Under the "aesthetic functionality" doctrine, a feature is functional if it is an "important ingredient in the product's commercial success."\(^7\) Thus, if a product was purchased because its features made it aesthetically pleasing, those features are functional.\(^7\) The *LeSportsac* court

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\(^6\) 724 F.2d 327 (2d Cir. 1983). Applying this test, the court found that the symbols on a toy car were not functional, but merely enabled consumers to identify the toy car with a popular television show. The car, called the "General Lee," was featured in the television show *Dukes of Hazard*. Id. at 329.

\(^6\) 754 F.2d 71 (2d Cir. 1985).

\(^6\) Id. at 76.

\(^6\) Id. at 78. The second prong of the test is set forth as a hypothetical question for the factfinder during a trial on the merits. The *LeSportsac* court was reviewing the district court's granting of a preliminary injunction. Id.

\(^6\) Id. at 76.

\(^7\) 832 F.2d 513, 518 (10th Cir. 1987) (discussing *LeSportsac*, 754 F.2d 71 (2d Cir. 1985)).

\(^7\) Pagliero v. Wallace China Co., 198 F.2d 339, 343 (9th Cir. 1952). Courts commonly cite *Pagliero* to represent the "aesthetic functionality" doctrine.

\(^7\) *See generally id.; Keene Corp. v. Faraflex Indus.*, 653 F.2d 822, 823-25 (3d Cir. 1981); *Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 427 (5th Cir. 1984); *Fletcher, The Defense of "Functional" Trademark Use: If What Is Functional Cannot Be A Trademark, How Can A Trademark Be Functional?*, 75 TRADEMARK REP. 249 (1985); *Krieger, The Broad Sweep of
modified the doctrine by subordinating it to the issue of consumer identification. The trier of fact decides whether consumers are primarily motivated to purchase product “A” rather than a competitor’s product because (1) they find product “A’s” combination of design features more aesthetically pleasing than a competitor’s product, or (2) product “A’s” features distinguish the goods as genuine rather than imitation. If the latter, then the product’s “look” primarily serves a legitimate trademark purpose: to identify the source of the product. Accordingly, the features qualify for trade dress protection even though they are also an “‘important ingredient’ in the product’s commercial success.”

The “aesthetic functionality” doctrine has been the subject of considerable controversy. Several circuits have rejected the doctrine, but its fate in the Second Circuit remains unclear. Although the LeSportsac court criticized the doctrine as over-inclusive, the court stated that the test might be appropriate in certain circumstances. Unfortunately, the court failed to specify which circumstances.

In summary, the Second Circuit employs two approaches. Each approach first considers whether a feature is essential to the use or purpose of the article, and whether it affects the cost or quality of the article. However, the “not essential to the use/primarily serves to identify” test adds an identification component, which requires a finding of functionality if the feature primarily serves an aesthetic function instead of identifying the producer of the goods.

Subsequent cases in the Second Circuit have utilized both approaches. In Brandir International v. Cascade Pacific, the appellate court endorsed the “essential to use/affects cost or quality” test. More re-

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74. LeSportsac, 754 F.2d at 78.

75. See generally Oddi, supra note 46, at 337-38; Krieger, supra note 73; Fletcher, supra note 73; Note, The Problem of Functional Features: Trade Dress Infringement Under Section 43(a) of the Lanham Act, 82 COLUM. L. REV. 77, 88 nn.84 & 85 (1982).


77. LeSportsac, 754 F.2d at 77-78.

78. See id. at 78.

79. 834 F.2d 1142, 1148 (2d Cir. 1987). The appellate court remanded the case because the record contained no insufficient evidence of alternative designs, which the court stated was necessary to determine whether the design elements of plaintiff’s bicycle rack were essential in terms of cost and quality. Id.

For the purposes of plaintiff’s copyright infringement claim, the appellate court found that the design was functional. The court applied the “independent judgment” test. Id. at 1146-47; See supra notes 28-31 and accompanying text.
cently, in *Inverness Corp. v. Whitehall Laboratories*, a lower court applied the test to find that the cap and container of a depilatory roll-on were not functional. With respect to use and purpose, the court stated that alternative designs were conceivable which would serve the same functions of covering the applicator and enabling the container to stand on a shelf and be comfortably held in the hand. In *I. Appel Corp. v. Munsingwear, Inc.*, a lower court used the “not essential to use/primarily serves to identify” test to find that the design features of plaintiff’s sports bra were functional.

2. The “Competitively Essential/Available Alternatives” Test

The “competitively essential/available alternatives” test was endorsed by the Tenth Circuit and rejected by the Third Circuit. Under this test, if a feature “must be slavishly copied in order for the product to be equally functional,” then the feature is competitively essential and, therefore, functional. But if the feature “enables the second-comer simply to market his product more effectively,” then the feature is not competitively essential. To decide these issues, the court looks at the availability of alternative designs. In *Brunswick Corp. v. Spinit Reel*, a Tenth Circuit case, the court held that the precise shape and configuration of a fishing reel’s front cover were not competitively essential, and thus not functional. In support of its finding, the court stated that other shapes equally comfortable to hold could be used to pick up and let out fishing line in a manner which is also easy to use. Although the court referred to equally comfortable alternative designs, it rejected the “essential to use/affects cost or quality” test which also looks at the availability of alternative designs.

The “competitively essential/available alternatives” test does not limit functional features to features which are essential to a product’s mechanical operation. Although the *Brunswick* court implicitly rejected

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81. *Id.* The defendant did not present evidence on quality and cost, even though the court apparently, placed the burden of proving functionality on the defendant.
82. 646 F. Supp. 685, 687-89 (S.D.N.Y. 1986) (citing Lesportsac, 754 F.2d at 76, 78).
83. *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 519 (10th Cir. 1987).
85. *Brunswick*, 832 F.2d at 519.
86. *Id.* at 519-20.
87. *Id.* at 517. The district court in *Brunswick*, which also found that the features were not functional, applied the “essential to use/affects quality” test. The *Brunswick* appellate court stated that the district court’s use of this test, however, did not prevent the court from affirming the court’s finding because the district court implicitly considered whether the design was competitively “indispensable.” *Id.* at 519-20.
the “aesthetic functionality” doctrine, it maintained that for products with an aesthetic function, “a feature intrinsic to the aesthetic appeal of those products” may not be entitled to trade dress protection. The court recognized the difficulty of deciding when such a feature is functional, and only added that “the decision should nevertheless rest on whether alternative appealing designs or presentations of the product can be developed.”

Subsequently, in *Hartford House Ltd. v. Hallmark Cards, Inc.*, the Tenth Circuit applied the *Brunswick* “competitively essential/available alternatives” test to a combination of aesthetic features—the cover designs of non-occasion greeting cards. Although the shape, printing, colors, and illustrations could each be functional, the court examined the combination of these features and found that the card’s “look” was not functional. Because “virtually every product is a combination of functional and non-functional features,” the court reasoned that a rule denying protection to all combinations of features that included a functional feature “would emasculate the law of trade dress infringement.” Several other circuit courts support this proposition, holding that a combination of features may be non-functional, even though the combination includes functional features.

As the *Brunswick* court suggested, the *Hartford House* court relied upon the availability of alternative combinations to decide that the cover designs were not functional: “[a]n emotional non-occasion greeting card can be folded, colored, shaped, cut, edged, and designed in infinite ways and still function to send its message.”

The Third Circuit disagreed with the theory behind the “competitively essential/available alternatives” test in *Keene Corp. v. Paraflex Industries, Inc.*: “merely because there are other shapes and designs ‘which

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88. See id. at 518.
89. Id. at 519.
90. Id.
91. 846 F.2d 1268, 1272-74 (10th Cir. 1988).
92. Id. at 1272-74. “Paper, verse and ink are functional features of a greeting card. The design and amalgamation of those features in a uniform fashion with other features, however, has produced the non-functional Blue Mountain ‘look.’ ” Id. at 1274 (quoting Hartford House Ltd. v. Hallmark Cards, 647 F. Supp. 1533, 1540 (D. Colo. 1986)).
93. Id. at 1272 (quoting American Greetings Corp. v. Dan-Dee Imports, Inc., 807 F.2d 1136, 1143 (3d Cir. 1986)).
defendant could use and still produce a workable product, the design used is not thereby non-functional." 96 In other words, the test takes an unnecessarily narrow view of functionality.

3. The Third Circuit’s “Utilitarian” and “Value as A Product” Tests

The “utilitarian” test focuses on the extent to which the design feature is related to the utilitarian function of the product. If the design is “not significantly related to the utilitarian function of the product, but is merely arbitrary,” then the design is not functional. 97 Applying this test, the Keene court held that the design of a wall-mounted luminaire was intrinsically related to its function rather than an arbitrary expression of aesthetics because the luminaire must be architecturally compatible with the structure on which it is mounted. 98 Additionally, the court noted that because only a limited number of such designs could be architecturally compatible, trade dress protection would stifle competition. 99

In devising the “utilitarian” test, the Keene court rejected the “aesthetic functionality” test. Its interpretation concentrated on the commercial desirability of the feature without considering a feature’s utilitarian function. 100 The court criticized the test as an unnecessary disincentive for the development of imaginative and attractive designs because more appealing designs might not qualify for protection. 101

The authority of the Keene test is questionable in light of a later Third Circuit case, AmericanGreetings Co. v. Dan-Dee Corp., 102 which instead used the “value as a product” test. The “value as a product” test replaces utilitarian value with something akin to intrinsic value and uses producer identification as a yardstick. If a product’s feature is “substantially related to its value as a product or service” in the sense that it is “part of the ‘function’ served,” then the feature is functional. 103 But, if


97. Id. at 825.

98. Id. at 826.

99. Id. at 827.

100. Id. at 825.

101. Id. “As our ambience becomes more mechanized and banal, it would be unfortunate were we to discourage use of a spark of originality which could transform an ordinary product into one of grace. The doctrine of aesthetic functionality need not be construed in such a manner for it to fulfill its important public policy function of protecting free competition.” Id.

102. 807 F.2d 1136 (3d Cir. 1986).

103. Id. at 1142 (quoting United States Gold Ass’n v. St. Andrews Systems, Datamax, 749 F.2d 1028, 1033 (3d Cir. 1984))
"the primary value of a particular feature is the identification of the provider," then it is not functional.\textsuperscript{104}

In American Greetings, the plaintiff manufactured a line of teddy bears known as Care Bears.\textsuperscript{105} The controversy settled around the bears' "tummy graphics:" the placement of varying illustrations against a white oval background on the bear's abdominal area. Applying the "value as a product" test, the trial court declared that the purpose of the Care Bear was "to help children and adults express their feelings and share them with others."\textsuperscript{106} The lower court then held that the tummy graphics were functional because they conveyed the emotional message of each bear using symbols that are typically associated with the message.\textsuperscript{107} For example, the "Tenderheart Bear" heart graphic conveyed the message "love and caring," and the "Friend Bear's" two smiling daisies conveyed the message "friendship." The placement of the graphics against a white background on the bear's stomach was considered part of the tummy graphics and, thus, part of the functional feature which the defendant was entitled to use in the best way possible.\textsuperscript{108} The appellate court affirmed both findings.\textsuperscript{109}

At first glance, the approach used in American Greetings is neat and workable. A closer examination of the opinion, however, illustrates the potential for confusion. The lower court concluded, and the appellate court agreed, that the plaintiffs could have a protectible interest in the Care Bears' overall appearance even though the tummy graphics were an essential feature of that overall appearance.\textsuperscript{110} Assuming that the plaintiff could establish secondary meaning, the district court stated that the defendant "could be required to select alternative non-functional features and utilize imitated functional ones in such a way as to avoid confusion as to source if...feasible."\textsuperscript{111} Although the appellate court approved of the district court's finding, it conceded that it did not know whether the defendant could design such a product.\textsuperscript{112}

\textsuperscript{104} \textit{Id.}
\textsuperscript{105} \textit{Id.} at 1136.
\textsuperscript{106} \textit{Id.} at 1143 (quoting American Greetings Corp. v. Dandee Imports, Inc., 619 F. Supp. 1204, 1210 (D.N.J. 1985)).
\textsuperscript{107} \textit{Id.}
\textsuperscript{108} \textit{Id.} at 1142-43.
\textsuperscript{109} \textit{Id.} at 1149.
\textsuperscript{110} \textit{Id.} at 1143.
\textsuperscript{111} \textit{Id.} at 1144.
\textsuperscript{112} \textit{Id.} at 1145.
4. The Fifth Circuit's "Dictated by Superior or Optimal Utilitarian Characteristics" Test

The "dictated by superior or optimal utilitarian characteristics" test is a two-part test designed to determine whether protection would hinder competition. The test asks (1) whether the feature is an utilitarian feature, as opposed to an aesthetic feature and (2) whether the feature is "superior or optimal in terms of engineering, economy of manufacture, or accommodation of utilitarian function or performance." A design which merely increases utility is not functional, and commercial success and marketing effectiveness do not make the feature "superior or optimal."  

The Fifth Circuit devised this test in *Sicilia Di R. Biebow & Co. v. Cox*, after rejecting the trial court's application of other functionality tests. Although the appellate court did not decide whether the design of plaintiff's plastic lemon and lime juice bottles were functional, the court suggested how its "dictated by superior or optimal utilitarian characteristics" test might be applied. The court noted that a molded plastic bottle can have an infinite variety of forms or designs and still function to hold liquid. In other words, because no one form was necessary or optimal, the designs may not be functional. At trial, the plaintiff introduced into evidence three other plastic citrus juice bottles resembling lemons or limes which dispensed juice by squeezing and had different volumes, heights and caps. The defendant argued that plaintiff's bottle was functional because the supermarket display racks restricted the consumer's line of vision; compelling the defendant to use a different height and shape would make it more difficult for consumers to read its label. The court agreed that copying plaintiff's shape would enable the defendant to market his product more successfully, but noted that the


114. See id. at 428. This last point is not explicitly made but can be drawn from the court's discussion of other tests and its application of the facts. The court stated: "To define functionality in terms of commercial success or marketing effectiveness, [as defendant suggests] would permit a second comer to copy the distinctive dress of a product whenever it became successful and consumers became accustomed to its dress." *Id.*

115. 732 F.2d 417 (5th Cir. 1984) (rejecting trial court's finding that plaintiff's bottle design was functional, and remanding). The trial court had applied the aesthetic functionality doctrine. *Id.* at 427-28. The appellate court also felt the trial court incorrectly used the *Keene* court's "competitively essential/available alternatives" test. *Id.* at 428.

116. *Id.* at 429.

117. *Id.* (citing *In re Morton-Norwich Products, Inc.*, 671 F.2d 1333, 1342 (C.C.P.A. 1982)).

118. *Id.* at 429.

119. *Id.* at 426-27.
"dictated by superior or optimal utilitarian characteristics" test did not consider commercial success or marketing effectiveness.\textsuperscript{120}

The Seventh Circuit rejected the "dictated by superior or optimal utilitarian characteristics" test in \textit{Schwinn Bicycle Co. v. Ross Bicycles, Inc.} because of concern that the defendant-copier would have difficulty proving that a feature is optimal, or "the best possible way to achieve a result."\textsuperscript{121}

5. The Seventh Circuit's "Effective Competition" Test

Under the \textit{Schwinn} court's "effective competition" test a design feature is necessary for effective competition, and thus functional, "if it is one that is costly to design around or do without, rather than one that is costly to have."\textsuperscript{122} The cost comparison is between the plaintiff's design and alternative designs, not the defendant's design.\textsuperscript{123} Surprisingly, the court also stated that the aesthetic appeal of a design may make it functional,\textsuperscript{124} a comment which is reminiscent of the aesthetic functionality doctrine.\textsuperscript{125}

6. The Ninth Circuit Analysis

The Ninth Circuit's approach to functionality is inconsistent and unclear. Recently, in \textit{Clamp Manufacturing Co., Inc. v. Enco Manufacturing Co},\textsuperscript{126} the Ninth Circuit purported to use a factors analysis. The factors include: "the existence of an expired utility patent disclosing the utilitarian advantage of the design sought to be protected as a trademark; the extent of advertising touting the utilitarian advantages of the design; the availability of alternative designs; and whether a particular design results from a comparatively simple or cheap method of manufacture."\textsuperscript{127} The court, then proceeded to disregard some of these factors. The design of the clamp in question was previously covered by a utility patent, was advertised for its utilitarian design, and was not designed in an arbitrary or distinctive manner. Even so, the Ninth Circuit upheld

\begin{flushright}
\textsuperscript{120} Id. at 428-29.  \\
\textsuperscript{121} Schwinn Bicycle Co. v. Ross Bicycles, Inc., 870 F.2d 1176, 1189 (7th Cir. 1989). In rejecting this test, the court criticized an earlier Seventh Circuit case opinion, Vaughan Mfg. Co. v. Brikam Int.'l, Inc., 814 F.2d 346, 350 (7th Cir. 1987). \textit{Schwinn}, 870 F.2d at 1188.
\\textsuperscript{122} Id. at 1189 (reiterating the approach used in W.T. Rogers Co. v. Keene, 778 F.2d 334 (7th Cir. 1985)).  \\
\textsuperscript{123} Id. at 1191.  \\
\textsuperscript{124} Id. at 1190-91.  \\
\textsuperscript{125} See supra notes 71-74 and accompanying text.  \\
\textsuperscript{126} 870 F.2d 512 (9th Cir. 1989).  \\
\textsuperscript{127} Id. at 516 (citing \textit{In re Morton-Norwich Prods., Inc.}, 671 F.2d 1332, 1340-41 (C.C.P.A. 1982)).
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the trial court's finding that the design was not functional. Earlier cases in the Ninth Circuit, however, used the "essential to use" or "affects cost/quality" test.

III

The Proper Test

To decide which test is best, we must briefly reexamine the rationale behind unfair competition law and its offspring, trade dress protection. Unfair competition law is designed to protect free competition by ensuring fair competition. Trade dress protection guards against unfair competition by preventing wrongful diversion of trade and prevents consumer deception by prohibiting the use of confusingly similar trade dress. Although functional features may identify a product's source and thus seem to justify protection, the overriding public policy of preventing monopolization prohibits protection of functional features. In essence, the non-functional requirement provides a public right to copy functional features.

A. Policy Goals in Relation to the Nine Existing Standards

The proper functionality test should effectuate these policy goals, without sacrificing clarity and uniformity of application. The nine tests for determining functionality, discussed in section II of this Note, are summarized and critiqued below, in order of increasing desirability.

(1) The "aesthetic functionality" test: a feature is functional if it is an important ingredient in the commercial success of the product; thus, aesthetically pleasing features are designated functional if consumers are motivated to purchase the product by its aesthetic appeal.

The "aesthetic functionality" test has been criticized as over-inclusive by the courts and commentators. Arguably, in order to satisfy the requirement of secondary meaning a product must have acquired some

128. Id. at 516 (trial court's finding was not clearly erroneous).
129. Stx, Inc. v. Trik Stik, Inc., 708 F. Supp. 1551, 1557 (N.D. Cal. 1988); Rachel v. Banana Republic, Inc., 831 F.2d 1503, 1506-07 (9th Cir. 1987). In Rachel, the court defined "use" as the actual benefit that consumers wish to purchase. The court upheld the trial court's finding that the features of a synthetic animal head created for wall display in stores was functional. The court reasoned that the plaintiff sought to create realistic reproductions, and so the design features (eyes, nose, etc...) were functional. Rachel, 831 F.2d at 1506-07.
131. See id.
132. See Pagliero v. Wallace China Co., 198 F.2d 339, 343 (9th Cir. 1952).
133. See supra notes 71-76, 100 and accompanying text. The Court of Customs and Patent Appeals, which originally had appellate jurisdiction over trademark registration decisions of the Patent and Trademark Office, consistently refused to adopt the aesthetic functionality doctrine. Oddi, supra note 46, at 338 (citing In re Mogen David Wine Corp., 328 F.2d 925, 932-33
degree of commercial success. As one court explained, defining “functionality as anything that is ‘an important ingredient in the commercial success’ of a product would almost always permit a second comer freely to copy the trade dress of a successful product that has accumulated goodwill.” The test also provides a disincentive for development of imaginative and attractive designs. Although the encouragement of imaginative and attractive designs is not a goal of unfair competition law, discouragement of such innovation is an unnecessary side effect.

(2) The “competitively essential/available alternatives” test: a combination of features is functional if protection of the configuration would hinder competition or impinge upon the rights of others to compete effectively because alternative designs are not available.

The “competitively essential/available alternatives” test fails to adequately define what it means to “hinder competition or impinge upon the rights of others to compete effectively.” Accordingly, the test seems to be nothing more than a restatement of the policy goals behind the functionality doctrine; it lacks any qualitative analysis of efficiency when considering the availability of alternative designs. Paradoxically, the broad scope of the test may result in an unnecessarily narrow view of functionality; a design is not made non-functional merely because there are other shapes and designs which can be used while still producing a workable product.

(3) The “value as a product” test: a feature is functional if it substantially relates to the value of the product as a product, as opposed to primarily serving to identify the producer.

This test is too broad and subjective. The trier of fact is given the difficult task of determining the intrinsic value of the product. Additionally, the emphasis on product identification may clash with the overriding public policy of preventing monopolization, because functional features may simultaneously identify the producer.

(4) The “utilitarian” test: a feature is functional if it is significantly related to the utilitarian function of the product or feature, rather than

134. Sicilia Di R. Biebow, 732 F.2d at 428.
135. See Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 519 (10th Cir. 1987); Hartford House Ltd. v. Hallmark Cards, Inc., 846 F.2d 1268, 1272-73 (10th Cir. 1988); see supra notes 84-96 and accompanying text.
136. Brunswick, 832 F.2d at 519.
merely arbitrarily related. A product's design is not non-functional simply because alternative designs are available.\textsuperscript{140}

This test suffers from vagueness because it does not explain when the design of a product is “significantly related to its utilitarian function.”\textsuperscript{141} “Arbitrary selection” of a design is a conclusion rather than a definition. Otherwise, the court would not have explicitly rejected a test based on the availability of alternative designs.

(5) The “factors analysis”: the existence of an expired utility patent, advertising touting the product’s utilitarian advantages, the availability of alternative designs, and whether the design results from a comparatively simple or cheap method of manufacture all may indicate that the design features are functional.\textsuperscript{142}

The factors analysis is difficult to judge because the authoring court did not fully apply it.\textsuperscript{143} A major weakness of the test is its use of advertising as a factor. A product may advertise its utilitarian design to a greater extent than actually exists.

(6) The “essential to use/affects cost or quality” test: a feature is functional if it is essential to use or purpose, or affects cost or quality.\textsuperscript{144}

This test provides well defined criteria, and serves the goals of the functionality doctrine without being too broad.\textsuperscript{145} A design feature is “essential” only if the feature is dictated by the functions to be performed; a feature that merely accommodates a useful function is not enough. A design feature “affecting the cost or quality of an article” is one which permits the article to be manufactured at a lower cost or one which constitutes an improvement in the operation of the good.\textsuperscript{146}

(7) The “not essential to use/primarily serves to identify” test: a feature is functional if it is not essential to use or purpose, or affects cost or quality, and primarily serves to identify the producer.\textsuperscript{147}

\textsuperscript{140} See Keene Corp. v. Paraflex Indus., 653 F.2d 822, 825, 827 (3d Cir. 1981); supra notes 96-101 and accompanying text.
\textsuperscript{141} Keene, 653 F.2d at 825.
\textsuperscript{142} See Clamp Mfg. Co., Inc. v. Enco Mfg. Co., 870 F.2d 512 (9th Cir. 1989); supra text accompanying notes 97-129.
\textsuperscript{143} Id.
\textsuperscript{144} See Warner Bros., Inc. v. Gay Toys, Inc., 724 F.2d 327, 331-32 (2d Cir. 1983); supra notes 61-66 and accompanying text.
\textsuperscript{145} The fact pattern of Inverness Corp. v. Whitehall Laboratories, 678 F. Supp. 436 (S.D.N.Y. 1988), provides a good example. The court held that the design of a roll-on depilatory container and cap were not functional. Because different designs can be employed without affecting the cost of production or the container's ability to stand on a shelf or to be comfortably held, protection would not result in monopoly. Id. at 440.
\textsuperscript{146} See Gay Toys, 724 F.2d at 331; LeSportsac, Inc. v. K-Mart Corp., 754 F.2d 71, 76 (2d Cir. 1985).
\textsuperscript{147} See LeSportsac Inc. v. K-Mart Corp., 754 F.2d 71, 76-78 (2d Cir. 1985) and supra notes 67-77 and accompanying text.
The "not essential to use/primarily serves to identify" test, a variation of the previous test, goes beyond the functionality doctrine to consider the question of consumer identification, which properly is part of the secondary meaning requirement. By partially defining "non-functional" features as features that also primarily serve to identify the producer,\(^\text{148}\) the test clashes with the policy goals behind the functionality doctrine. As one court explained, it is not that functional features "cannot or do not indicate source to the purchasing public, but that there is an overriding public policy of preventing their monopolization and preserving the public right to copy."\(^\text{149}\)

(8) The "effective competition" test: a feature is functional if it is necessary for effective competition; a feature that is costly to design around or do without is necessary for effective competition, and the aesthetic appeal of a feature may also make it necessary for effective competition.\(^\text{150}\)

Arguably, this test is similar to the "essential to use/affects cost or quality" test, although not as clearly written. The aesthetic appeal prong, however, makes the test susceptible to the same criticism levelled at the aesthetic functionality doctrine.\(^\text{151}\)

(9) The "dictated by superior utilitarian characteristics" test: a feature is functional if it is dictated by the product's utilitarian characteristics, and if the feature is superior or optimal in terms of engineering, economy of manufacture, or accommodation of utilitarian function or performance.\(^\text{152}\)

The criteria used to determine functionality under this test seem capable of clear and uniform application, and serve the policy goals behind the functionality doctrine. If a feature is not "superior or optimal," then it naturally follows that a finding of non-functionality will not result in a monopoly because alternative designs are available that are at least as useful or efficient.

The test, however, confines the functionality defense to intrinsically mechanical products. An intrinsically mechanical product's primary aim is utility, rather than beauty or ornament. The test criteria preclude a finding of functionality for non-mechanical products, those which primarily produce a mental relation in users rather than help them perform a physical task. Toys and greeting cards are examples of non-mechanical products. Non-mechanical products primarily perform a mental rather

\(^{148}\) Id.

\(^{149}\) In re Diester Concentrator Co., 289 F.2d 496, 504 (C.C.P.A. 1961).

\(^{150}\) See Schwinn Bicycle Co. v. Ross Bicycles, Inc., 870 F.2d 1176, 1188-91 (7th Cir. 1989); supra notes 122-25 and accompanying text.

\(^{151}\) See supra text accompanying notes 133-34.

\(^{152}\) See Sicilia Di R. Biebow & Co. v. Cox, 732 F.2d 417, 428-29 (5th Cir. 1984); supra notes 113-20 and accompanying text.
than a mechanical function. For example, toys and greeting cards are non-mechanical products because they are intended to produce mental reaction in the user. Thus, engineering, economy of manufacture, or accommodation of utilitarian function or performance are not useful criteria for non-mechanical products. Arguably if this test had been applied in American Greetings, the tummy graphics on the stuffed animals would have been held not functional, because their design does not affect economy of manufacture. A finding of functionality would require a court to stretch the meaning of the word utilitarian. However, a finding of functionality does not seem appropriate because the graphics perform the function of helping children and adults express their feelings.\textsuperscript{153}

Because the "dictated by superior utilitarian characteristics" test cannot be applied to non-mechanical products, another test is necessary. One option is not to impose any functionality requirement. But, the policy goal behind the functionality doctrine and unfair competition law works to ensure that competition is free and fair.\textsuperscript{154} No reason exists as to why competition should be any less fair in the marketplace for non-mechanical products. As indicated previously, it is not that non-mechanical products serve no function, but that they serve a mental rather than a mechanical function. When there are too few means of conveying or eliciting a particular emotional message or response, the danger of monopoly exists. On the other hand, a broad test like the aesthetic functionality doctrine is inappropriate because it provides a disincentive to creators of pleasing designs and could deny trade dress protection to all non-mechanical products.

B. Borrowing from Copyright Law to Achieve a Workable Test

In trade dress infringement actions involving non-mechanical products, courts should borrow copyright law's "conceptually separable" requirement.\textsuperscript{155} If the feature of a non-mechanical product is not conceptually separable from the physical design of the product then the feature is functional and should be denied trade dress protection.

The fact that conceptual separability is part of copyright law does not preclude its use in trade dress infringement actions. Although the purposes of trade dress protection and copyright protection differ, their non-functionality requirements each serve to prevent unwarranted mo-

\textsuperscript{153} The American Greetings court found the tummy graphics functional because they were substantially related to the value of the product as a product: they helped children and adults express their feelings. American Greetings Corp. v. Dan-Dec Imports, 807 F.2d 1136, 1142-43 (3d Cir. 1986).

\textsuperscript{154} See Oddi, supra note 46 at 311-312.

\textsuperscript{155} See supra text accompanying notes 123.
nopolies. Trade dress infringement actions further require that the feature must have acquired secondary meaning, and that the alleged infringing use must produce a likelihood of confusion in order for the plaintiff to prevail. These elements assure that policy goals of trademark law are achieved.

To date, courts have not explicitly recognized the difference between mechanical products and non-mechanical products when fashioning trade dress functionality tests. When dealing with mechanical products the functionality test should be:

A feature is functional if (1) it is dictated by the product's utilitarian characteristics or function, and (2) it is essential in terms of engineering, economy of manufacture, or accommodation of utilitarian function or performance.

If the product is non-mechanical, or without an intrinsic utilitarian function, the test should be:

A feature is functional if it is not conceptually separable from the design of the product.

Then, the currently dominant test in copyright law should be applied:

A feature is conceptually separable if the non-mechanical characteristics can be identified as reflecting the designer's independent judgment, exercised independently from functional influences.

IV

Conclusion

The functionality tests outlined herein for trade dress infringement cases should help courts write clearer opinions and choose the most effective test. Furthermore, courts should consider distinguishing between "mechanical products" and "non-mechanical" products, and adopt a test for each. The "dictated by superior utilitarian characteristics" test is ideally suited to mechanical products. For non-mechanical products, courts should borrow copyright law's conceptually separable test.

156. See supra text accompanying notes 25-66.
157. See supra text accompanying notes 51-57.