

YOU CAN'T SIT WITH US: FURNITURE'S FUTURE IN FIGHTING PHONIES

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INTRODUCTION

In 1956, American designers Charles and Ray Eames created the Eames Lounge and Ottoman for furniture

manufacturer and retailer Herman Miller.¹ The design is as charming as it is innovative. The chair is an inspired combination of molded plywood—a groundbreaking process that took the Eameses four years to perfect—and luxurious, tufted leather that resembles a baseball mitt.² More than a half century later, the Eames Lounge is considered the most iconic chair from the Mid-Century Modern Era and one of the most comfortable chairs in the world.³ The chair and many other articles designed by the Eameses are permanent exhibits at the Museum of Modern Art in New York City.⁴

The chair’s fame and success makes it a target for *counterfeit copies*—some virtually indistinguishable from the original—by companies like Rove Concepts, MCM Classics, and Modern Furniture Knockoff.⁵ Rove Concepts

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¹ JOHN NEUHART, MARILYN NEUHART & RAY EAMES, *EAMES DESIGN 207* (Charles Miers ed., 1989).

² *See id.* at 27, 59–60, 207. The Eameses went through thirteen different styles for the arm of the chair alone before settling on the final version. EAMES DEMETRIOS, *AN EAMES PRIMER* 172 (2001).

³ MARTIN EIDELBERG, THOMAS HINE, PAT KIRKHAM, DAVID A. HANKS & C. FORD PEATROSS, *THE EAMES LOUNGE CHAIR: AN ICON OF MODERN DESIGN* 10 (2006) [hereinafter *ICON OF MODERN DESIGN*] (describing the chair as having obtained “iconic status,” “emblematic of the Modern Movement,” and “an icon of Mid-Century Modern”); Simona Ganea, *10 Most Comfortable Lounge Chairs Ever Designed*, HOMEDIT, <http://www.homedit.com/most-comfortable-lounge-chairs/> [<https://perma.cc/GH5J-KFD2>] (last visited Oct. 24, 2014).

⁴ DEMETRIOS, *supra* note 2, at 170.

⁵ *See Charles Lounge Chair and Ottoman Rubber Shock Mounts Palisander Rosewood in 100% Italian leather Many color options Eames Style, MCM CLASSICS*, <https://mcmclassics.com/products/charles-leather-lounge-chair-and-ottoman-palisander-walnut-or-ebony-ash-eames-style-many-options> [<https://perma.cc/6X4Z-FWFZ>] (last visited Oct. 20, 2014); *Rove*

includes the design story of Charles and Ray Eames to sell its counterfeit copies.⁶ It mentions the design duo's work toward perfecting their products and their fame, yet fails to admit that the products it ships to consumers in the U.S. are counterfeit and in direct conflict with U.S. law.⁷ Practices like this tend to not only blur the true meanings of "authentic or original," but, even worse, promote a belief among the public that the practice is legal.

Trade dress law combats these illegal practices. Herman Miller successfully registered the Eames Lounge design with the Principle Register of the United States Patent and Trademark Office (USPTO).⁸ Moreover, it succeeded in asserting this trade dress in lawsuits against Alpha Design, Inc. and Nuevo Americana, Inc.⁹ It might surprise some that

Lounge Chair with Ottoman, ROVE CONCEPTS, <http://www.roveconcepts.com/rove-lounge-chair-ottoman.html> [<https://perma.cc/GL8D-2VLW>] (last visited Mar. 3, 2015) (listing an Eames Lounge Chair copy as "inspired by Charles and Ray."); *Case Study Chair and Ottoman*, MODERN FURNITURE KNOCKOFF, <http://www.modernfurnitureknockoff.com/index.php/lounges/1410-pbcase-study-chair-a-ottoman> [<https://perma.cc/H53P-WWYF>] (last visited Oct. 20, 2014) (listing the Eames Lounge copy as its number one best seller).

⁶ See, e.g., *Rove Lounge Chair with Ottoman*, ROVE CONCEPTS, <http://www.roveconcepts.com/rove-lounge-chair-ottoman.html> [<https://perma.cc/GL8D-2VLW>] (last visited Mar. 3, 2015) ("Inspired by the familiarity and comfort of an old baseball mitt, the husband and wife team of Charles and Ray created a style icon. It led to the creation of the Rove Lounge Chair and Ottoman.").

⁷ *Id.*

⁸ U.S. Trademark, Registration No. 2,716,843.

⁹ *Herman Miller Inc. v. Alphaville Design Inc.*, No. C 08-03437 WHA, 2009 WL 3429739, at *1, *10 (N.D. Cal. Oct. 22, 2009) (granting permanent injunction against infringer Alphaville in a default judgment and awarding \$500,000 in statutory damages to Herman Miller); Consent Judgment and Decree at 1-2, *Herman Miller, Inc. v. Nuevo Americana, Inc.*, No. 1:12CV01225 (W.D. Mich. Jan. 28, 2013)

Herman Miller was able to acquire trade dress rights to this iconic chair.¹⁰ Some suggest that intellectual property law cannot protect a piece of furniture because furniture is “functional.”¹¹ However, this is an over-simplification of the current state of trade dress law for furniture articles.

This Note analyzes how trade dress law and the United States Trademark Act (Lanham Act) apply to furniture designs. Specifically, this Note describes the circuit split regarding the consideration of alternative designs under the first prong of the functionality test after *TrafFix v. Marketing Displays, Inc.*, 532 U.S. 23 (2001), and analyzes the split’s effect on determining functionality of modern furniture. Finally, this Note explains why modern furniture can acquire trade dress, that is, exclusive use of a design, without putting competitors at a significant disadvantage.

This Note proceeds in four parts. Part I describes the knockoff phenomenon and its effects on the furniture industry and public. Part II provides an overview of ways to protect the intellectual property of furniture, discussing copyright, patents, trademarks, and trade dress. Part III analyzes how the various non-functionality doctrines among the federal circuit courts and USPTO affect trade dress actions and applications for furniture articles. This analysis shows that the nonfunctionality requirement does not always bar furniture articles from acquiring trade dress. However,

(granting judgment by the infringing party’s consent and decreeing that Herman Miller owns all rights throughout the United States to the product configuration trade dress of the Eames Lounge, the Aluminum Group, and the Softpad).

¹⁰ Consent Judgment and Decree at 1-2, *Herman Miller, Inc. v. Nuevo Americana, Inc.*, No. 1:12CV01225 (W.D. Mich. Jan. 28, 2013).

¹¹ Kimberly Allen Richards, *Comment: Should Furniture Become Fashion-Forward? Applying Fashion’s Copyright Proposals to the Furniture Industry*, 11 WAKE FOREST J. BUS. & INTELL. PROP. L. 269, 269, 271, 273 (2010).

this section posits that courts will hamstring trade dress protections over elements of furniture design as a result of the circuit split. Part IV concludes with some significant policy concerns. In summation, society benefits when a legal monopoly is effectively granted for a particular design, given the following: 1) the role the furniture industry has in the U.S. economy; 2) the display of social responsibility of furniture companies like Herman Miller; 3) the cheapening of design by knockoffs; and 4) the durability of authentic furniture articles.

I. PROTECTING FURNITURE DESIGNS IN INTELLECTUAL PROPERTY LAW

This section discusses the relevant intellectual property laws applicable to protecting furniture designs, giving special attention to trade dress law.

A. Copyright Law

In 1790, the First Congress enacted the first copyright law under the authority of Article 1 of the U.S. Constitution, which secures the exclusive right of inventors to their works “[t]o promote the Progress of Science and useful Arts.”¹² Congress has subsequently revised the Copyright Act in approximately forty-year intervals.¹³ The present copyright law, enacted by the Copyright Act of 1976, protects “original works of authorship fixed in a tangible medium of expression.”¹⁴ This protection covers “pictorial, graphic, and sculptural works” and “endures for a term

¹² U.S. CONST. art. I, § 8, cl. 8; H.R. REP. No. 94-1476, at 47 (1976), *as reprinted in* U.S.C.C.A.N. 5659, 1976 WL 14045.

¹³ H.R. REP. No. 94-1476, at 47 (1976), *as reprinted in* U.S.C.C.A.N. 5659, 1976 WL 14045.

¹⁴ 17 U.S.C. § 102(a) (2012).

consisting of the life of the author and 70 years after the author's death.”¹⁵ However, copyright law does not protect useful articles that are not conceptually or physically separate from its pictorial, graphic, or sculptural features.¹⁶ Accordingly, courts have extended copyright protection only to ornamental furniture designs such as intricate woodworking, or to other separable designs, but not to the product’s configuration.¹⁷ Thus, the furniture industry has turned to patents and the law of trade dress to protect its intellectual property.¹⁸

B. Design and Utility Patents

Under the same Constitutional authority as copyright, furniture designs may acquire intellectual property protection through design and utility patents.¹⁹ Utility patents cover the invention or discovery of a “new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement

¹⁵ 17 U.S.C. § 102(a)(5) (2012); 17 U.S.C. § 302(a) (2012).

¹⁶ 17 U.S.C. §§ 101–102; Kimberly Allen Richards, *Comment: Should Furniture Become Fashion-Forward? Applying Fashion’s Copyright Proposals to the Furniture Industry*, 11 WAKE FOREST J. BUS. & INTELL. PROP. L. 269, 277–78 (2010) (describing how courts have labeled this separation the “conceptual separability” test).

¹⁷ *See* *Universal Furniture Intern v. Collezione Europa USA*, 618 F.3d 417, 434 (4th Cir. 2010) (finding protectable expression in separable designs of acanthus leaves on dresser and suggesting that the shape or configuration of the furniture would not receive similar protection); *Amini Innovation Corp. v. Anthony California, Inc.*, 439 F.3d 1365, 1368 (Fed. Cir. 2006) (finding protectable expression in the carved ornamental woodwork of bed frames).

¹⁸ Kimberly Allen Richards, *Comment: Should Furniture Become Fashion-Forward? Applying Fashion’s Copyright Proposals to the Furniture Industry*, 11 WAKE FOREST J. BUS. & INTELL. PROP. L. 269, 273 (2010).

¹⁹ U.S. CONST. art. I, § 8, cl. 8.

thereof.”²⁰ Some features of furniture, such as novel assembly of supporting parts for contour-conforming seat panels, acquire utility patents.²¹ Once the utility patent expires, the patented invention enters the public domain, and then others may copy the functional features disclosed in the patent.²² This quid pro quo of limited exclusivity for full disclosure encourages advancement in product design and manufacture because it invites the inventor to disclose the invention and enjoy the fruits of his or her labor.²³

Design patents cover the invention of a “new, original, and ornamental design for an article of manufacture.”²⁴ The term of the design patent is fourteen years.²⁵ The USPTO granted Charles Eames many design patents for the ornamental designs of his furniture for Herman Miller.²⁶ However, because the Eameses designed their furniture during the mid-century, the designs transcended the fourteen-year patent period.²⁷ Considering the durability and popularity of Eames furniture, this was no surprise. Thus, to continue ownership over such iconic

²⁰ 35 U.S.C. § 101 (2015).

²¹ See, e.g., U.S. Patent No. 2,554,490 (filed Mar. 1, 1947).

²² *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 26, 29–30, 34–35 (2001).

²³ *Id.* at 34–35.

²⁴ 35 U.S.C. § 171 (2015).

²⁵ 35 U.S.C. § 173.

²⁶ U.S. Patent No. D150,683 (filed Mar. 27, 1947) (covering the design of the LCW chair by Charles Eames); U.S. Patent No. D219,212 (filed Mar. 3, 1969) (covering the design of the La Chaise by Charles Eames for Herman Miller); U.S. Patent No. D210,940 (filed Jan. 30, 1967) (covering the design of the padded seat by Charles Eames for Herman Miller).

²⁷ See *ICON OF MODERN DESIGN*, *supra* note 3, at 10 (discussing mid-century modern furniture and icons of design).

designs, some other body of law is required. Accordingly, manufacturers that have continuously produced and marketed older, iconic designs may protect their intellectual property through trade dress law per the Lanham Act.

C. Trademarks

The Lanham Act derives its authority under the Commerce Clause of the United States Constitution—not the Patent and Copyright Clause.²⁸ In comparison to copyright and patents, trademark law shifts the focus away from protecting original design to protecting the owner’s exclusive right to distinguish his or her product,²⁹ preventing others from free-riding on a company’s extensive marketing expenditures and goodwill,³⁰ and preventing consumers from becoming confused as to product origin.³¹

The purpose of trademark law is “to protect producers from illegitimate diversions of their trade by competitors” and to avoid confusing consumers.³² The Lanham Act provides, in part:

²⁸ Ethan Horwitz & Benjamin Levi, *Fifty Years of the Lanham Act: A Retrospective of Section 43(a)*, 7 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 58, 61 (1996). Congress initially tried enacting the Trademark Act under the authority of the Copyright and Patent Clause of the U.S. Constitution but the Supreme Court invalidated it because it hinged on the wrong constitutional power. *Id.*

²⁹ See Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 *NOTRE DAME L. REV.* 1839, 1841 (2007).

³⁰ J. THOMAS MCCARTHY, 1 *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 2:15 (4th ed. 2016).

³¹ *Id.* at § 3:6 (“If two products answer with trademarks that are similar, then the customer is likely to be confused and buy one product, thinking it comes from a source from which it really does not originate. This is the purest form of injury resulting from trademark infringement—the diversion of sales caused by customer confusion.”).

³² McKenna, *supra* note 29 at 1839, 1841.

The intent of this chapter is to . . . mak[e] actionable the deceptive and misleading use of marks . . . to prevent fraud and deception . . . by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks.³³

The Lanham Act defines a trademark as “any word, symbol, or device . . . used by a person . . . to identify and distinguish his or her goods . . . and to indicate the source of the goods, even if that source is unknown.”³⁴ The Supreme Court established that the appearance or design feature of a product *is* a trademark and is referred to as the product’s trade dress.³⁵ Congress subsequently amended the Lanham Act to recognize the concept.³⁶ Accordingly, furniture articles are eligible for protectable trade dress because they are products that can exhibit source-identifying features, assuming that the article in question satisfies the other requisite elements.

The other requisite elements for a trade dress registerable with the USPTO are functionality and distinctiveness.³⁷ When an applicant files his or her mark with the USPTO, a trademark examiner will first determine whether the mark is functional by asking if the feature of the trade dress is “essential to the use or purpose of the article or

³³ Lanham Act, 15 U.S.C. § 1127 (2012).

³⁴ *Id.*

³⁵ *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28 (2001) (“The design or packaging of a product may acquire a distinctiveness which serves to identify the product with its manufacturer or source.”); *Qualitex Co. v. Jacobson Products Co.*, 541 U.S. 159, 162 (1995).

³⁶ *TrafFix Devices, Inc.*, 532 U.S. at 28. For the purposes of this article, the term “mark” will include a product’s trade dress and trademark.

³⁷ TMEP § 1202.02 (5th ed. 2007).

if it affects the cost or quality of the article.”³⁸ The next inquiry is whether the product feature has acquired distinctiveness, also known as secondary meaning.³⁹ A feature acquires secondary meaning “when the public views the primary significance of the product packaging as identifying the source of the product rather than the product itself.”⁴⁰ Thus, if the product feature is functional or does not have secondary meaning, it is not registerable on the Principal Register of the USPTO.

Additionally, the Lanham Act imposes civil liability on a person who misuses a mark to sell a good or package a product if the use is likely to confuse “the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods . . . by another person.”⁴¹ A plaintiff must prove the following elements in a civil claim of trade dress infringement pertaining to furniture: 1) the trade dress is clearly defined and inherently distinctive or has acquired secondary meaning; 2) defendant’s use of the mark is likely to confuse as to source or sponsorship; and 3) the asserted trade dress is non-functional.⁴² Courts presume the trade dress is non-functional if it is already registered with the USPTO.⁴³ However, as Part III will explain, courts have not uniformly applied the third requirement of non-functionality.

³⁸ *Id.* § 1202.02(a) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)).

³⁹ *Id.* § 1202.2(b).

⁴⁰ *Id.* § 1202.2(b)(ii) (quoting *Wal-Mart Stores, Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 211 (2000)).

⁴¹ 15 U.S.C. § 1125 (2012).

⁴² MCCARTHY, *supra* note 30, at § 8:1.

⁴³ *Id.*

II. CURRENT KNOCKOFF AND COUNTERFEITING PRACTICES

The Lanham Act defines a counterfeit as a “spurious mark” that is sold without certification.⁴⁴ A spurious mark is “identical with, or substantially indistinguishable from, a registered mark.”⁴⁵ Similarly, a “knockoff” is the colloquial term for “colorable imitation,” which is “any mark which so resembles a registered mark” that it is likely to confuse or deceive the consumer.⁴⁶ In the furniture industry, copies of classic designs like the Eames Lounge Chair do not just resemble the original—they are visually indistinguishable versions of the original.⁴⁷ Accordingly, companies that produce copies that are visually indistinguishable from the originals are producing counterfeit copies. For this Note, manufacturers that contract with designers for manufacture and use of their designs are “authorized manufacturers.” The designs such companies manufacture are termed “original” or “authentic.”

Some scholars argue that the knockoff and counterfeit trades cause little harm.⁴⁸ One claim is that harm

⁴⁴ 15 U.S.C. § 1127.

⁴⁵ *Id.*

⁴⁶ *Id.*

⁴⁷ Interview with Ross Atwood, Digital Media Director, Eames Office in Barre, Vt. (Feb. 17, 2015) (stating that it is almost impossible for consumers to distinguish a copy from the original in the pictures available from some web stores selling counterfeits).

⁴⁸ Zachary J. King, *Knock-off My Mark, Get Set, Go to Jail? The Improprieties of Criminalizing Post-Sale Confusion*, 88 N.Y.U. L. REV. 2220, 2247–48 (2013); Malla Pollack, *Your Image Is My Image: When Advertising Dedicates Trademarks to the Public Domain—With an Example from the Trademark Counterfeiting Act of 1984*, 14 CARDOZO L. REV. 1392 (1993) (arguing that the communicative aspect of trademarks in the post-sale confusion context places them in the public

from intellectual property theft is low because the methodology estimating lost sales and tax revenue—between \$200 billion and \$250 billion a year and the loss of 750,000 jobs in the United States⁴⁹—relies on suspect assumptions and are thus inconclusive.⁵⁰ This claim also assumes that a consumer who buys a counterfeit is unlikely to buy the authentic product.⁵¹ However, this criticism is flawed.⁵² Furniture is a 166 billion dollar industry in the United States.⁵³ Although there are no methodologically sound estimates detailing how much of the total lost revenue is attributable to the knockoff and counterfeit trade of furniture articles, it does not follow that there is no resulting financial harm. Mid-century modern and modern furniture designers, the focus of this Note, are considered the biggest victims within the furniture industry as more companies import knockoffs and counterfeit goods from Asia to sell them in the United States.⁵⁴ For example,

domain and that therefore there should be no civil or criminal cause of action).

⁴⁹ Eric R. Waltmire, *How to Secure Your Client's Brand Against Counterfeiting Operations in Asia*, 22 DCBA BRIEF 46 (2009).

⁵⁰ King, *supra* note 48, at 2247 (arguing that organizations “took an estimate of the total number of counterfeit items sold . . . then multiplied by the full retail price of genuine articles”).

⁵¹ *Id.*

⁵² Waltmire, *supra* note 49, at 46.

⁵³ STEPHANIE H. MCCULLA, ALYSSA E. HOLDREN & SHELLY SMITH, THE 2014 ANNUAL REVISION OF THE NATIONAL INCOME AND PRODUCT ACCOUNTS 17 (2014), available at http://www.bea.gov/scb/pdf/2014/08%20August/0814_2014_annual_nipa_revision.pdf [<https://perma.cc/C9Y8-PABT>].

⁵⁴ Interview with Ross Atwood, *supra* note 47 (observing that companies in the business of selling knockoffs most frequently copy mid-century modern and modern furniture). Mid-century modern and modern

Manhattan Home Design sells “replicas” (another label that signifies the product is a copy, and in this case, an unauthorized copy of an original design).⁵⁵ The company, which imports furniture from China,⁵⁶ recently secured government contracts with New York City to supply furniture for Times Square Plaza, and the departments of corrections and transportation.⁵⁷ Another store boasts as its clientele: MTV, Marriot Hotels, and Hilton Hotels and Resorts.⁵⁸ These clients substituted the knockoff design in place of buying the original, but they are arguably within the same consumer class that can afford originals. Considering the aforementioned clients’ purchase of knockoffs alone, intellectual property theft in the furniture industry has considerably affected potential sales and profits of authorized manufacturers licensed to produce original

designs are the focus of this Note because these designs are more likely to be copied.

⁵⁵ Jenny T. Slocum & Jess M. Collem, *The Evolving Threat and Enforcement of Replica Goods*, 33 W. NEW ENG. L. REV. 789, 791 (2011) (“The word “replica” to describe these same goods eliminates the consumer’s perception of any illegality of the goods.”); see *Classic Lounge Chair & Ottoman Black*, MANHATTAN HOME DESIGN <http://www.manhattanhomedesign.com/eames-lounge-chair-and-ottoman.html> (last visited Apr. 3, 2016) (“The Eames inspired Lounge Chair *vitra replica* is one of the most famous mid-century modern pieces.”) (emphasis added).

⁵⁶ Interview with Scherry Khabul, Sales Associate, Manhattan Home Design, in New York, N.Y. (Mar. 6, 2015) (stating that most of Manhattan Home Design’s furniture is imported from China).

⁵⁷ *Goldmans Sachs Initiative Yields Results for Small Businesses*, COMMUNITY COLLEGE DAILY (June 15, 2012), <http://www.ccdaily.com/Pages/Workforce-Development/Goldman-Sachs-initiative-yields-results-for-small-businesses.aspx> [<https://perma.cc/QG3Y-585K>].

⁵⁸ *Featured Clients*, ROVE CONCEPTS, <http://www.roveconcepts.com/> [<https://perma.cc/G9M6-LSEE>] (last visited Oct. 23, 2014).

works.

Not only do knockoffs and counterfeits cause economic loss, they are more likely to be inferior in quality. The Global Intellectual Property Center published a brand protection manual, which argues:

Because the counterfeiter is unlikely to have access to the same quality raw goods as the legitimate manufacturer and has no incentive to institute quality control practices or procedures, the resulting counterfeit product is most assuredly inferior in quality.⁵⁹

Indeed, a comparison between knockoff dealers and companies like Herman Miller, Emeco, and Knoll reveals a sharp contrast between furniture quality control policies. For example, Herman Miller's concurrent five-year and twelve-year warranties, quality control, and extensive testing procedures for the chair suggest that Herman Miller manufactures durable, quality Eames Lounge Chairs.⁶⁰ Knoll, another modern furniture company, offers a twelve-

⁵⁹ GLOBAL INTELLECTUAL PROPERTY CENTER, INTELLECTUAL PROPERTY PROTECTION AND ENFORCEMENT MANUAL: A PRACTICAL AND LEGAL GUIDE FOR PROTECTING YOUR INTELLECTUAL PROPERTY RIGHTS 3 *available at* http://www.ipr-policy.eu/media/pts/1/Brand_Enforcement_Manual_FINAL.pdf [<https://perma.cc/K5JG-WXY2>].

⁶⁰*See* *Materials*, HERMAN MILLER, https://www.hermanmiller.com/content/dam/hermanmiller/documents/materials/reference_info/Quality_Standards_Textiles.pdf [<https://perma.cc/57PS-UW2Z>] (last visited Oct. 22, 2014) (giving detailed break-down of testing procedures Herman Miller uses for its furniture); *see also* Policies, HERMAN MILLER (last visited Oct. 22, 2014) http://www.hermanmiller.com/content/dam/hermanmiller/documents/policies_legal/HMI_Warranty.pdf (outlining warrantee and policies) [<https://perma.cc/LUM4-MM8P>].

year warranty for some of its chairs⁶¹; same for Steelcase.⁶² Yet another prominent American furniture manufacturer, Emeco, has a lifetime warranty for its famous Navy Chair that is made to last 150 years.⁶³

Conversely, knockoff retailers do not offer comparable warranties. MCM Classics, for example, offers a sixty-day warranty and explicitly excludes an infringement warranty.⁶⁴ Manhattan Home Design offers a one-year warranty on all of its products.⁶⁵ Rove Concepts offers a limited five-year warranty for structural damage but limits its warranty covering workmanship-related failures to one year.⁶⁶ An exact copy of Emeco's Navy was subjected to the Emeco stress test.⁶⁷ The unlicensed copy folded under the

⁶¹ *Selling Policy*, KNOLL, <http://www.knoll.com/selling-policy> [<https://perma.cc/SY7T-J76R>] (last visited Oct. 22, 2014).

⁶² *Americas Limited Lifetime Warranty*, STEELCASE, <http://www.steelcase.com/content/uploads/2015/01/Steelcase-Americas-Warranty-2016.pdf> [<https://perma.cc/2HFU-XK8G>] (last visited Mar. 3, 2016).

⁶³ *Warranty*, Emeco, <http://www.emeco.net/support#warranty> [<https://perma.cc/4TEV-34WD>] (last visited Mar. 3, 2016).

⁶⁴ *See Policies*, MCM CLASSICS, <https://web.archive.org/web/20141110181220/http://www.mcmclassics.com/policies/> (last visited Oct. 21, 2004) (guaranteeing products for 60 days and excluding warranty of fitness for a particular purpose, merchantability, or infringement, and a waiver of any claim a customer may have against it).

⁶⁵ *Store Policies*, MANHATTAN HOME DESIGN, <http://www.manhattanhomedesign.com/privacypolicy.html> [<https://perma.cc/ACR5-25AV>] (last visited Oct. 23, 2014).

⁶⁶ *Store Policy*, ROVE CONCEPTS (last visited Oct. 22, 2014) *available at* http://www.roveconcepts.com/store-policy_65.html [<https://perma.cc/V5ZT-UU7J>].

⁶⁷ *An Emeco Navy Chair knock-off getting the "stress test"*, DESIGN MILK (Nov. 18, 2013), <http://design-milk.com/emeco-navy-chair->

weight.⁶⁸ Similarly, Be Original Americas conducted a stress test by jumping on knockoffs of Fritz Hansen Series 7 chairs from two undisclosed companies.⁶⁹ With just two or less jumps on each chair’s spine, they collapsed under the jumper’s weight.⁷⁰ In comparison, the original Series 7 withstood seven or more jumps without budging.⁷¹ Thus, the risk of poor product quality may be higher for purchasers of knockoffs compared to those who purchase furniture articles made by authorized U.S. manufacturers such as Emeco, Herman Miller, Steelcase, and Knoll.⁷²

good-design/ (showing the effect on two chairs after a stress test) [https://perma.cc/NV2R-645R].

⁶⁸ *Id.*

⁶⁹ Be Original Americas, *Fritz Hansen's Series 7 Chair: Knockoffs vs. The Original*, YOUTUBE (Jul. 24, 2013), <https://www.youtube.com/watch?v=UTfcie56ZK0> [https://perma.cc/P2JR-ADPL]. Be Original Americas is an organizational movement supported by members, including furniture manufacturers Herman Miller and Fritz Hansen, whose goal is to “establish a set of industry standards that encourages consumers, the architecture/design community, producers, dealers and media partners to fully support creativity and authenticity in order to invest in the future of design, incentivize innovation and give back to the industry and the people it serves.” *About Us*, BE ORIGINAL AMERICAS, <http://www.beoriginalamericas.com/about-us/> [https://perma.cc/8KGG-B86N] (last visited Apr. 8, 2015).

⁷⁰ *Id.*

⁷¹ *Id.*

⁷² Emeco manufactures all of its products in the United States. *Emeco's Environmental Policies*, EMECO, <http://www.emeco.net/environmental-policies> (last visited Mar. 4, 2015). Six out of ten Herman Miller manufacturing facilities are in the United States. *Fact Sheet*, HERMAN MILLER, http://www.hermanmiller.com/content/dam/hermanmiller/documents/news_events_media/Fact_Sheet.pdf (last visited Mar. 3, 2016). Steelcase has multiple manufacturing facilities in the United States and abroad. *Sustainable Facilities*, STEELCASE,

Iconic, original furniture articles are also capable of retaining value. The price of the Eames Lounge Chair in 1961 was \$653.⁷³ Adjusted for inflation, in 2014 the chair would be worth \$5,204.⁷⁴ Remarkably, an authentic, new Eames Lounge sells for \$4,559.⁷⁵ Conveyance of Herman Miller products to an original owner's successors is a common practice.⁷⁶ A vintage Eames Lounge can sell for \$3,000 to \$7,000.⁷⁷ The chair's success in the vintage marketplace confirms its durability and fixed value. Thus, by buying the original, the consumers get the look, a piece of history, and durable furniture that they may convey to their successors. Knockoffs may provide the classic look, but without the longevity.

<http://www.steelcase.com/en/company/sustainability/pages/operations-facilities.aspx> [<https://perma.cc/NNE7-LME8>] (last visited Mar. 4, 2015). Knoll has three manufacturing sites in the United States and one in Ontario, Canada. *Knoll Environmental Manufacturing*, KNOLL, <http://workplaceelements.com/wp-content/uploads/2011/11/Knoll-Environmental-Manufacturing.pdf> [<https://perma.cc/APZ7-55CU>] (last visited Mar. 4, 2015).

⁷³ *MidCentury Modern furniture prices in 1961 vs today*, THE ARCHETYPE DAD (Jul. 23, 2014) <http://archetypedad.blogspot.com/2014/07/midcentury-modern-icons-prices-in-1961.html> [<https://perma.cc/7L98-7EXT>] (last visited Nov. 15, 2014).

⁷⁴ *Id.*

⁷⁵ *Eames Lounge Chair and Ottoman*, HERMAN MILLER STORE, <http://store.hermanmiller.com/Products/Eames-Lounge-Chair-and-Ottoman> [<https://perma.cc/XBG3-RN9G>] (last visited Oct. 20, 2014) (selling for \$4,559).

⁷⁷ The Jetsetrnv8r, *Vintage Furniture – Real or Fake? Eames Lounge Chair & Ottoman* <http://jetsetrnv8r.wordpress.com/2008/09/14/vintage-furniture-%E2%80%93-real-or-fake-eames-lounge-chair-ottoman/> [<https://perma.cc/2GAG-U8AU>] (last visited Oct. 24, 2014).

Knockoffs also spur unfair labor practices. Whereas Emeco and Herman Miller manufacture their furniture in the U.S.,⁷⁸ some companies sell knockoffs manufactured offshore.⁷⁹ Indeed, two U.S. customs agencies “seized more than \$196 million in Intellectual Property Rights (IPR) infringing goods in 2007, which is an increase of 26 percent in domestic value over the previous year.”⁸⁰ Regrettably, offshore manufacturers do not observe similar fair-labor practices.⁸¹ For instance, counterfeit products are linked to child labor.⁸² Two intellectual property attorneys attribute the problem to the lack of meaningful regulation in some countries:

Without any supervision, manufacturers of counterfeit goods are therefore free to exploit the socially irresponsible and otherwise prohibited resources of child labor. . . . [I]t is estimated that child workers make up as much as twenty percent of the workforce in China and contribute significantly to the manufacture of counterfeit products. This cheap and “illegal” workforce lowers the cost of manufacture and increases the profits associated with the goods and fosters the replica industry.⁸³

By contrast, the film *Food=Waste* commended Herman

⁷⁸ *Emeco’s Environmental Policies*, *supra* note 72; *Fact Sheet*, *supra* note 72.

⁷⁹ See Interview with Scherry Khabul, *supra* note 56 (stating that some of Manhattan Home Design’s furniture is made in China).

⁸⁰ Waltmire, *supra* note 49, at 46.

⁸¹ Jenny T. Slocum & Jess M. Collen, *The Evolving Threat and Enforcement of Replica Goods*, 33 W. NEW ENG. L. REV. 789, 794 (2011).

⁸² *Id.*

⁸³ *Id.* at 794–95 (2011) (citing Dana Thomas, *Deluxe: How Luxury Lost its Luster* 205 (2007)).

Miller's domestic factory because it circulates natural air in place of air conditioning, has natural sunlight, and overall, "[t]he building respects the people inside of it."⁸⁴ Likewise, Bill Birchard commended Herman Miller's socially conscious business model in his book, *Merchants of Virtue: Herman Miller and the Making of a Sustainable Company*.⁸⁵ Birchard praises Herman Miller's awarding of stock options to all employees—from the custodians and plant workers to the CEO.⁸⁶ The company's all-inclusive approach resulted in increased employee productivity, and Herman Miller received numerous awards for its generous business model.⁸⁷

By the same token, much of what is manufactured today is "destined for the trash heap."⁸⁸ Today's consumer culture degrades our environment with increased waste and resource depletion.⁸⁹ The concept of "cradle-to-cradle" design offers a solution to waste and resource depletion by promoting good design processes that use materials that are safe to use and reuse while honoring social fairness and

⁸⁴ FOOD=WASTE (VPRO Backlight 2007).

⁸⁵ See generally, BILL BIRCHARD, *MERCHANTS OF VIRTUE: HERMAN MILLER AND THE MAKING OF A SUSTAINABLE COMPANY* (2011).

⁸⁶ *Id.* at 94 (2011) ("By 1995, every full-time employee who had worked for at least a year, from the janitors in the plants to the CEO, had become a stockholder.").

⁸⁷ See *Id.* at 9, x (commending Herman Miller's 20-year record of awards).

⁸⁸ THE NAVY CHAIR BROCHURE, EMECO, [https://web.archive.org/web/20130509072815/\[https://perma.cc/R8BE-MRJM\]](https://web.archive.org/web/20130509072815/[https://perma.cc/R8BE-MRJM]) (last visited Mar. 4, 2016).

⁸⁹ FOOD=WASTE, *supra* note 84 (explaining how high consumption exacerbates the waste problem and suggesting compostable materials in place of toxic ones).

human dignity.⁹⁰ This includes processes such as upcycling and recycling, in contrast to downcycling.⁹¹ The film *Food=Waste* again commended Herman Miller for making its chairs according to the “cradle-to-cradle” concept.⁹² Similarly, Emeco confronts the waste problem by the very fact that its chairs are made to last, and some consist of 65% recycled polyethylene terephthalate (PET), basically Coca-Cola bottles.⁹³ Finally, Steelcase obtained LEED-CI Platinum and ISO 14001 certificates for its multiple Michigan manufacturing facilities.⁹⁴ The Platinum LEED-CI is the highest level a commercial project may receive under the U.S. Green Building Council’s rating system for environmental standards and underscores responsible sustainability efforts.⁹⁵

⁹⁰ *William McDonough: Cradle to Cradle Design* (Ted Talk Feb. 2005), https://www.ted.com/talks/william_mcdonough_on_cradle_to_cradle_design?language=en [<https://perma.cc/5CM2-WYPS>] (last visited Mar. 4, 2015).

⁹¹*Id.*

⁹² *FOOD=WASTE*, *supra* note 89.

⁹³ THE NAVY CHAIR BROCHURE, EMECO, https://web.archive.org/web/20130509072815/http://www.emeco.net/client/emeco/dynamic/articles/1emeco-navy_1752.pdf [<https://perma.cc/R8BE-MRJM>] (last visited Mar. 4, 2016) (“We called it the 111 Navy Chair because every chair we make keeps 111 plastic bottles out of the landfill.”).

⁹⁴ *Sustainable Facilities*, KNOLL, <http://www.steelcase.com/en/company/sustainability/pages/operations-facilities.aspx> [<https://perma.cc/QA4U-NP63>] (last visited Mar. 4, 2015).

⁹⁵ *Guide to LEED Certification: Commercial*, Certification Levels, USGBC, <http://www.usgbc.org/cert-guide> [<https://perma.cc/PJU9-EMDW>]; LEED, USGBC, <http://www.usgbc.org/leed> [<https://perma.cc/F7JY-G5AC>] (last visited Mar. 5, 2015).

III. THE CIRCUIT SPLIT ON THE NON-FUNCTIONALITY DOCTRINE

Furniture manufacturers and designers can use trade dress law to combat knockoff and counterfeiting practices described above. However, as this Note maintains, a primary obstacle to brandishing trade dress ownership against copycats is the inconsistent application of the non-functionality doctrine.

The non-functionality doctrine says that if an article's design is functional, it will by no means acquire trade dress.⁹⁶ This doctrine is used to prevent trademark law from imposing unacceptable competitive burdens on competitors, for instance, by precluding a user's control of a useful product feature, and to strike a proper balance between trademark law and patent law.⁹⁷

As many scholars have recognized, the circuit courts are divided on what has evidentiary value in determining functionality.⁹⁸ The Supreme Court in *TrafFix Devices, Inc. v. Marketing Displays, Inc.* clarified some aspects of confusion with regard to functionality in general, such as the order of decision and the weight to give to a feature's expired utility patents.⁹⁹ There remains a debate on whether courts

⁹⁶ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164–65 (1995).

⁹⁷ *Id.* at 164 (“The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.”).

⁹⁸ See generally Margreth Barrett, *Consolidating the Diffuse Paths to Trade Dress Functionality: Encountering TrafFix on the Way to Sears*, 61 WASH. & LEE L. REV. 79, 94–109 (2004) (analyzing how circuit courts use different standards to determine functionality); MCCARTHY ON TRADEMARKS § 7:69 (4th ed.) (explaining the plethora of definitions of functionality among the circuit courts).

⁹⁹ *TrafFix Devices, Inc.*, 532 U.S. at 30 (2001).

may consider the existence of alternative designs as evidence of nonfunctionality.¹⁰⁰ That is not to say that the mere existence of alternative designs is determinative of non-functionality, just whether their availability may be a factor.

TrafFix clarified the order of decision. According to the Supreme Court in *TrafFix*, a court should first examine whether a product feature is essential to the use or purpose of a product and whether such features affect the product's cost or quality.¹⁰¹ This Note refers to this first step as the first prong of utilitarian functionality. If a court still does not find the feature to be functional and aesthetic functionality is at issue, then the next inquiry is about whether exclusive use of a product feature would create a significant non-reputation related disadvantage and whether there are alternative designs available.¹⁰² This Note refers to the inquiry into aesthetic functionality as the second prong of functionality. A feature that creates a non-reputation related disadvantage with no available alternative designs will almost certainly show that the product feature is functional and may not be protectable by trade dress law.¹⁰³ If the product feature is still non-functional, a court may continue on to the other requisite elements of secondary

¹⁰⁰ *Id.* See also Tracey McCormick, *Will TrafFix "Fix" the Splintered Functionality Doctrine?: TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 40 HOUS. L. REV. 541, 543, 556–57 (2003) (arguing that *TrafFix* is “not likely to provide lower courts with enough guidance to resolve the courts of appeals split over the proper legal standard for functionality.”); Vincent N. Palladino, *Trade Dress Functionality After TrafFix: The Lower Courts Divide Again* 93 TRADEMARK REP. 1219, 1231 (2003) (arguing that refusing to consider alternative designs “runs afoul of *TrafFix*.”).

¹⁰¹ *TrafFix Devices, Inc.*, 532 U.S. at 33–34.

¹⁰² *Id.*

¹⁰³ *Id.*

meaning and likelihood of confusion.¹⁰⁴

The contested issue among the circuit courts is whether a court should consider alternative designs when addressing the functionality of the product design.¹⁰⁵ The Court of Appeals for the Federal Circuit interprets *TrafFix* to mean that evidence regarding alternative designs and competitive need is only irrelevant when a product is functional under the *Inwood* standard.¹⁰⁶ That means that when a product is functional based solely on cost or quality factors,¹⁰⁷ the mere existence of alternative designs will not save it; however, *TrafFix* did not foreclose courts from considering the alternatives.¹⁰⁸ Conversely, other courts interpret the *TrafFix* proposition to demand that, under the first prong of utilitarian functionality, they *may not* consider alternative designs.¹⁰⁹

The Trademark Manual of Examining Procedure (TMPE) applies the understanding of *TrafFix* proposed by

¹⁰⁴ *Id.* at 33.

¹⁰⁵ See Amy B. Cohen, *Following the Direction of TrafFix: Trade Dress Law and Functionality Revisited*, 50 IDEA 593, 658–59 (2010) (discussing the split in courts using the evidence of alternative designs when first determining a product design's functionality).

¹⁰⁶ *Valu Eng'g, Inc. v. Rextord Corp.*, 278 F.3d 1268, 1274–75 (Fed. Cir. 2002) (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982) (“[i]n general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.”)).

¹⁰⁷ *TrafFix*, 532 U.S. at 33. Remember the traditional rule in *TrafFix*: an article is functional if it is essential to the use or purpose of the article, *or* affects the cost or quality of the article. This is utilitarian functionality. *Id.*

¹⁰⁸ *Valu Eng'g, Inc.*, 278 F.3d at 1276.

¹⁰⁹ *Eppendorf-Netheler-Hinz GMBH v. Ritter GMBH*, 289 F.3d 351, 358 (5th Cir. 2002).

the federal circuit.¹¹⁰ The TMEP uses the *In re Morton-Norwich* decision, which provides a basis to consider the following evidence:

- (1) The existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered;
- (2) Advertising by the applicant that touts the utilitarian advantages of the design;
- (3) Facts pertaining to the availability of alternative designs; and
- (4) Facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.¹¹¹

Other courts have stated that the above factors have evidentiary value when determining what is essential to the use or purpose or what affects the cost or quality of the article (the first prong of utilitarian functionality).¹¹²

The pressing question for furniture manufacturers becomes, how does the circuit split over the elements of determining functionality affect trademark protection for chair designs? How does a judge look at a chair and determine which design feature is functional and which is not? Are the interpretations consistent with the purpose of the Lanham Act? Some scholars dislike the fact that trade dress can effectively grant a monopoly over a design

¹¹⁰ See TMEP 1202.02(a)(iii)(A) (explaining the doctrine of functionality as per *Valu Eng'g., Inc.*).

¹¹¹ TMEP 1202.02(a)(v) (Evidence and Considerations Regarding Functionality Determinations) (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-1341(C.C.P.A. 1982)).

¹¹² See, e.g., *Specialized Seating, Inc. v. Greenwich Indus., L.P.*, 472 F.Supp.2d 999, 1011 (N.D. Ill. 2007) (applying the Morton-Norwich factors to a trade dress infringement claim).

feature.¹¹³ But, as this Note argues, given the realities of copycat furniture and the purpose of the Lanham Act, this critique is not warranted.

A. *Post-TraFFix Chair Configuration Cases: Heptagon Creations, Pride Family Brands, and Specialized Seating*

One exemplary case from the camp of courts that fails to consider the *Morton-Norwich* factors, or evidence of alternative designs, is *Heptagon Creations, Ltd. v. Core Marketing Group LLC*. Here, the U.S. District Court for the Southern District of New York cited *TraFFix* in applying the functionality doctrine but without the understanding that alternative designs are evidence for non-functionality.¹¹⁴ Heptagon Creations brought the action against the defendant's interior design firm for recreating digital copies of Heptagon's furniture to attract potential buyers of a listed apartment building.¹¹⁵ Heptagon Creations designed nine furniture pieces that it alleged were comprised of non-functional and artistic elements.¹¹⁶ The Cocoon Chair had "textured seating material and tree trunk cocoon siding."¹¹⁷ The district court rejected Heptagon's request for

¹¹³ See Cohen, *supra* note 105, at 595, 692 (arguing for denial of trade dress protection to product configuration because it would promote competition and "would eliminate the conflict with patent law and the confusion created by the functionality doctrine").

¹¹⁴ *Heptagon Creations, Ltd. V. Core Group Mktg., LLC*, No. 11 CIV. 01794 LTS, 2011 WL 6600267, *1, *7 (S.D.N.Y. 2011), *aff'd*, 507 Fed.Appx. 74 (2d Cir. 2013) (citing *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 117 (2d Cir. 2001)). The court cited *Yurman* for the functionality test, which articulated the same test set forth by the *TraFFix* Court. *Id.*

¹¹⁵ *Heptagon Creations, Ltd.*, 2011 WL 6600267, at *1.

¹¹⁶ *Id.* at *7.

¹¹⁷ *Id.*

trade dress on this piece, reasoning that because the design element—the carved tree trunk—comprised the seat and armrest, it was “‘essential to the use or purpose of the [furniture piece]’ or ‘affect[ed] the cost or quality of the [furniture piece].’”¹¹⁸ The court quickly dismissed the opportunity to protect the other furniture pieces at issue by simply stating, “[t]he same holds true for the salient features of the other eight pieces of furniture.”¹¹⁹

Similarly, in *Pride Family Brands, Inc. v. Carl’s Patio, Inc.*, a manufacturer sought to establish common law trade dress in particular and general tropical design elements of its furniture collection.¹²⁰ The Florida district court recognized the two categories of functionality but primarily barred trade dress using the second.¹²¹ First, in a footnote, the court found one design feature barred by the first category of functionality:

One of the claimed elements, a lashing that connects the leaf to the arm of the Coco Isle chair is essential to the construction of the chair as Plaintiff’s CEO even conceded and it is therefore functional under the first category.¹²²

In its analysis of whether *aesthetic* functionality should bar the trade dress at issue, the court stated that the brown and beige finishes, natural fabric colors, and the cast embellishments that resemble bamboo nodes evoke a tropical feel, which patio furniture companies commonly

¹¹⁸ *Id.*

¹¹⁹ *Id.*

¹²⁰ *Pride Family Brands, Inc. v. Carl’s Patio, Inc.*, No. 12–21783–CIV, 2014 WL 347040, *1 (S.D. Fla. Jan. 30, 2014).

¹²¹ *Id.* at *3.

¹²² *Id.* at n.9.

use.¹²³ The plaintiff could not acquire trade dress protection in the tropical motif because doing so would foreclose other tropical patio furniture companies from using the natural, tropical furniture elements.¹²⁴

Both *Pride Family Brands* and *Heptagon* courts failed to consider evidence of alternative designs or the *Morton-Norwich* factors in their analyses under the first utilitarian functionality prong. Although the court in *Pride Family Brands* focused on the aesthetic functionality doctrine to bar trade dress on a furniture motif, the court's footnote regarding utilitarian functionality offers insight into its position regarding the meaning of "essential." According to the court, that which *connects* a design to an arm of a chair meets the "essential to the use or purpose" standard.¹²⁵ Similarly, the court in *Heptagon* reasoned that a design element that "comprised" the seat and armrest rendered the furniture article functional.¹²⁶ These positions, which are akin to the logic of other circuit courts,¹²⁷ confuse utility and function by trumpeting the role of a design feature that merely accommodates the article and its purpose. This was also a result of piecemeal analysis of an article that the court

¹²³ *Id.* at *4.

¹²⁴ *Id.*

¹²⁵ *Id.* at *3–*4 (quoting *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 165 (1995)).

¹²⁶ Interestingly, functionality was not a contested issue before the court. *Heptagon* provided information about why the furniture was not a useful article for the purpose of its copyright claim but did not provide similar information for its trade dress infringement claim such as evidence showing an availability of alternative designs. *Heptagon Creations, Ltd.*, 2011 WL 6600267 at *7.

¹²⁷ Vincent N. Palladino, *Trade Dress Functionality After TrafFix: The Lower Courts Divide Again*, 93 TRADEMARK REP. 1219, 1233–34 (discussing the circuit court decisions that equate utility with functionality).

should have viewed as a whole.¹²⁸ Part III will further discuss these issues.

In contrast to the logic of the two cases above, the U.S. District Court for the Eastern District of New York applied a very different test in determining the likelihood of success of a plaintiff's trade dress infringement claim in *Blumenthal Distributing, Inc. v. Executive Chair, Inc.*¹²⁹ In *Blumenthal*, the defendant manufactured colorable imitations of the overall appearance of two Blumenthal office chairs.¹³⁰ The court stated the requirement that the product design be nonfunctional but did not use *TrafFix*'s standard regarding the feature being essential to the use or purpose or affecting the cost or quality of the piece.¹³¹ The analysis focused more on the non-generic look of the chair and the alternative designs available; thus, after concluding that trade dress protection for the chair would not hinder legitimate competition in the office chair industry, the chair design was found nonfunctional for the purposes of the preliminary injunction.¹³²

In *Specialized Seating, Inc. v. Greenwich Industries, LP*, the district court cited *TrafFix*'s proposition that a functional design is essential to the use or purpose or affects

¹²⁸ The brief analysis under the first prong of functionality in the footnote did not analyze the functionality of the furniture piece as a whole. Interestingly in a previous case, the same court had established that analysis of the design at issue requires a review of each element of the trade dress as a whole. *Vital Pharmaceuticals, Inc. v. American Body Bldg. Products, LLC*, 511 F. Supp. 2d 1303, 1313 (S.D. Fla. 2007) (“[T]he inquiry is an overall examination of the Plaintiff's bottle shape, the bottle neck, and the vertical lettering.”).

¹²⁹ *Blumenthal Distributing Inc., v. Exec. Chair, Inc.*, No. CV-10-1280, 2010 WL 5980151 (E.D.N.Y. Nov. 9, 2010).

¹³⁰ *Id.* at (*1).

¹³¹ *Id.* at *7.

¹³² *Id.*

the cost or quality of the product feature and applied the *Morton-Norwich* factors.¹³³ This was all still under the first prong of analysis for determining utilitarian functionality.¹³⁴ The district court found that the folding x-frame chair design at issue was functional and not entitled to trade dress protection.¹³⁵

On appeal, the Seventh Circuit affirmed the district court's findings and never reached the issue of aesthetic functionality.¹³⁶ Expired utility patents covered all aspects of the chair except for the "b-back" design.¹³⁷ The Seventh Circuit court believed the b-back design was also a functional shape, in that it affected the cost or quality, because it was incorporated as a solution to a specific problem to folding chairs (not buckling when concertgoers sit on the backs of the chairs) and achieved a favorable strength-to-weight ratio without operating as a distinctive, ornamental, source identifier.¹³⁸ The court considered the alternative designs but noted that all of the alternative designs for folding chairs were functional because they also "represent different compromises along the axes of weight, strength, kind of material, ease of setup, ability to connect ('gang') the chairs together for maximum seating density, and so on."¹³⁹ The court noted that distinctive elements could be nonfunctional if added to aid consumers in

¹³³ *Specialized Seating, Inc. v. Greenwich Industries, L.P.*, 472 F.Supp.2d 999, 1010, 1013-14 (N.D. Ill. 2007).

¹³⁴ *Id.*

¹³⁵ *Id.* at 1014.

¹³⁶ *Specialized Seating, Inc. v. Greenwich Indus., LP*, 616 F.3d 722, 726-27 (7th Cir. 2010).

¹³⁷ *Id.* at 725.

¹³⁸ *Id.* at 726-27.

¹³⁹ *Id.* at 727.

determining origin.¹⁴⁰ For instance, *W.T. Rogers Co. v. Keene* concerned the functionality of a stackable letter tray with irregular hexagonal cutout end caps.¹⁴¹ Although the cutouts provided structural stability, separated the trays, and reduced the weight and cost, their irregular hexagon shape was nonfunctional.¹⁴² In contrast to the *Keene* case, the design at issue in *Specialized Seating* lacked a distinctive, functionless shape.¹⁴³ The manufacturer even touted the functionality of the chair’s design in its advertisements.¹⁴⁴ Thus, the chair was not eligible for trade dress protection.¹⁴⁵

B. Analysis: Chairs and the Future of Trade Dress

The judicial opinions discussed above exhibit several problems that, if continued, could severely curtail furniture manufacturers from acquiring trade dress protections for otherwise registerable chairs.¹⁴⁶ These problems include: courts’ piecemeal analyses; conflating utility and functionality resulting in misapplication of the term “essential” in a way that contravenes the purpose of the Lanham Act and case law; and refusal to consider as evidence the alternative designs under the first prong of functionality.

¹⁴⁰ *Id.*

¹⁴¹ *Id.* (citing *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 339–40 (7th Cir.1985)).

¹⁴² *Specialized Seating, Inc.*, 616 F.3d at 727.

¹⁴³ *Id.* at 727–28.

¹⁴⁴ *Specialized Seating, Inc. v. Greenwich Industries, L.P.*, 472 F.Supp.2d 999, 1014 (N.D. Ill. 2007).

¹⁴⁵ *Id.* at 727–28.

¹⁴⁶ Assuming the manufacturer does not also fail to meet the elements of secondary meaning and likelihood of confusion. See *supra* Part II for a discussion on requisite elements to receive product trade dress.

The first problem is the aforementioned post-*TrafFix* courts' focus on the individual elements of an article without reckoning with the totality of the appearance. Many circuits have determined that the proper inquiry is to view the article's combination of features as a whole so that together, the nonfunctional elements acquire trade dress when arranged distinctively.¹⁴⁷ Unlike the piecemeal analysis in *Heptagon* and *Pride Family Brands*, the *Specialized Seating* court correctly and carefully considered both functional elements that comprised the folding chair and the chair's functionality as a whole. Had the court applied the fragmentary analysis like the previous cases, the shape of the b-back design may have been functional under the "essential to the use or purpose" rule for the sole reason that it comprises the chair's backrest. However, the backrest was functional for the reason that it affected the cost or quality of the chair because it was a solution to a problem of folding

¹⁴⁷ See *Tools USA and Equipment Co. v. Champ Frame Straightening Equipment, Inc.*, 87 F. 3d 654, 658 (4th Cir. 1996) ("[T]he critical functionality inquiry is not whether each individual component of the trade dress is functional, but rather whether the trade dress as a whole is functional."); see also *LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 76 (2nd Cir.1985) ("[B]y breaking [plaintiff's] trade dress into its individual elements and then attacking certain of those elements as functional, [defendant] misconceives the scope of the appropriate inquiry."); *Fuddruckers, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 842 ("We examine trade dress as a whole to determine its functionality; functional elements that are separately unprotectable can be protected together as part of a trade dress.") (internal citation omitted); *Hartford House, Ltd. v. Hallmark Cards, Inc.* 846 F.2d 1268, 1272 ("a trade dress may be a composite of several features in a certain arrangement or combination which produces an overall distinctive appearance. In this context, the question is whether the combination of features comprising the trade dress is functional."); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1538 (11th Cir. 1986) ("That individual elements of packaging are functional does not, however, render the package as a whole unprotect[able]") *cert. denied*, 481 U.S. 1041 (1987).

chairs, and the alternative designs of other folding chairs, although abundant, similarly incorporated solutions to the same problem.

The next problem is conflating utility and functionality. The opinions in *Heptagon* and *Pride Family Brands* show that when a court applies *TrafFix* and does not consider design alternatives or any of the *Morton-Norwich* factors, the decision will turn on the meaning of “essential” if the challenged design does not otherwise affect the cost or quality of the article.¹⁴⁸ Neither court wrote more than a couple of sentences analyzing why the features were essential to the use or purpose of the chair.¹⁴⁹ They applied the term “essential to the use or purpose” as most people would in everyday speech. This phrase alone does not provide enough information and requires a supporting definition, or else courts will continue to use it to mean that anything that serves a utilitarian purpose, or has a use, is functional. That application is a misunderstanding of the Supreme Court and the Restatement’s stance on functionality.¹⁵⁰

A layman’s use of “function” and “utility” is inappropriate because the terms are legal terms of art.

¹⁴⁸ See *Heptagon Creations, Ltd.*, 2011 WL 6600267 at *7 (applying only the test that asks whether the feature is essential to the use or purpose of the piece); *Pride Family Brands, Inc.*, 2014 WL 347040 at n.9.

¹⁴⁹ The heart of the analysis in *Heptagon* was essentially one sentence long. *Heptagon Creations, Ltd.*, 2011 WL 6600267 at *7 (“[T]he seating material and tree trunk cocoon siding actually comprise the chair’s seat and arm rests and so are features that are essential to the use or purpose of the furniture piece.”) (internal quotation marks omitted); see also *Pride Family Brands, Inc.*, 2014 WL 347040 at n.9 (“One of the claimed elements, a lashing that connects the leaf to the arm of the Coco Isle chair is essential to the construction of the chair.”).

¹⁵⁰ Restatement (Third) of Unfair Competition § 17 (1995); See Palladino, *supra* note 127, at 1232 (explaining how the Supreme Court’s case law is consistent with the Restatement).

Indeed, the judicial opinions discussed thus far understand the meaning of “essential to the use or purpose” differently because of their understanding of the concepts of utility and function. The Restatement provides: “A packaging or product feature is not functional merely because the feature serves a utilitarian purpose.”¹⁵¹ Similarly, “the Supreme Court’s *Inwood*, *Qualitex*, and *TrafFix* decisions . . . recognize that utility is not the equivalent of functionality.”¹⁵² The standard left room for *useful* features—as long as they are not essential to the product. *Specialized Seating* illustrated this point in the example: a distinctive shape of an article (hexagonal cutouts) can acquire protection even though it also provides structural stability.¹⁵³

When the courts in *Pride Family Brands* and *Heptagon* refused to grant protection to a design feature because it “comprised” the chair or “connected” two parts of the chair, they conflated utility and functionality. An ornamental feature that connects two parts of a chair obviously is useful in that it is a connector, but this alone does not show it is functional under the standard because “essential” further qualifies functional.¹⁵⁴ Accordingly, the meaning of “essential to the use or purpose” is not synonymous with useful, *per se*. Furthermore, the design element should not have to be useless and physically separate from the article’s primary function (providing a seat). If it did, the test would effectively become the strict

¹⁵¹ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 cmt. b (AM. LAW INST. 1995).

¹⁵² See Palladino, *supra* note 127, at 1232.

¹⁵³ *Specialized Seating, Inc.*, 616 F.3d at 727.

¹⁵⁴ That standard of course being that which is essential to the use or purpose of the article.

physical separability test that is unique to copyright law.¹⁵⁵ What is more, if the physical separability principle were forced upon trade dress law, then chair designs would never acquire trade dress.¹⁵⁶

As indicated above, the *Heptagon* court’s denial of trade dress on the grounds that the design element comprised the chair is an example of conflating utility and functionality. That said, there is still a problem of not further defining the term “essential.” District courts in the Second and Ninth Circuits have adopted supporting definitions to promote a more cohesive understanding of what “essential” means. For instance, a Federal District Court in the Second Circuit supplemented the term with the following definition: “[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.’”¹⁵⁷ This supplemental definition also supports the conceptual and legal separation between utility and function by the very fact that it provides more information for courts to interpret and comprehend. More courts need to adopt similar approaches because if there is no cohesion in defining and applying the term, predictability for common law trade dress protection in infringement actions diminishes. What is more, market competition diminishes because some actors and industries are protected while furniture is not.

Many chairs pre-*TrafFix* acquired trade dress protection due, in large part, to evidence of the existence of

¹⁵⁵ See *supra* Part II (discussing copyright law and chair configurations).

¹⁵⁶ *Id.*

¹⁵⁷ *Krueger Int’l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 605 (S.D.N.Y. 1996) (quoting *Warner Bros., Inc. v. Gay Toys, Inc.*, 724 F.2d 327, 331 (2d Cir.1983)); see also *Adidas-Salomon AG v. Target Corp.*, 228 F. Supp. 2d 1192, 1202 (D. Or. 2002) (citing *Morton-Norwich*, 671 F.2d at 1342).

alternative chair designs that serve the same overall purpose or function as the challenged design.¹⁵⁸ In comparison, the courts in *Heptagon* and *Pride Family Brands* did not consider alternative designs for the contested features and the designs at issue consequently failed to acquire trade dress.¹⁵⁹ Thus, if a court's decision turns on the meaning of "essential," without a supplemental definition and without consideration of alternative designs or the *Morton-Norwich* factors under the first utilitarian prong, it will hamstring furniture manufacturers from acquiring trade dress protection.

There is one additional issue with courts discounting alternative designs within the first prong of functionality. As discussed, a purpose of the nonfunctionality doctrine is to prevent trademark law from putting a competitor at a significant disadvantage as a result of another's exclusive

¹⁵⁸ See *Gasser Chair Co., Inc. v. Infanti Chair Mfg. Corp.*, 943 F.Supp. 201, 214 (E.D. N.Y. 1996), *aff'd* 47 U.S.P.Q.2d 1208 (Fed. Cir. 1998) (concluding that the overall chair designs at issue were not functional in light of the presence of a number of other chairs on the market serving the same function with a different appearance); *Krueger Int'l., Inc. v. Nightingale, Inc.*, 915 F. Supp. 595, 607–08 (S.D.N.Y. 1996) (finding that the plaintiff "has a protectable trade dress in the overall look" of its stacking chair, because the functions of the chair were to provide a place to sit and to stack, and "many other designs serve these functions equally well"); *Contour Chair Lounge Co. v. True-Fit Chair, Inc.*, 648 F.Supp. 704, 710, 714 (E.D. Mo. 1986) (finding that the overall configuration of the subject chair was nonfunctional, because "[a] variety of other chair designs functioning in the same manner as the Contour chair, but without its distinctive configuration, are available to manufacturers seeking to compete with Contour").

¹⁵⁹ The court barred the tropical motif with the doctrine of aesthetic functionality. However, the footnote that barred trade dress on its utilitarian functionality was not a motif; rather, it was a uniquely distinctive design. See *supra* Part III (discussing how the court applied the functionality doctrine in *Heptagon* and *Pride Family Brands*).

right to a useful feature.¹⁶⁰ Logic demands consideration of alternative designs to determine whether competitors will actually be disadvantaged. In other words, alternative designs may enable competitors to compete equally well without incorporating the challenged design. Therefore, discounting the availability of alternatives undercuts the nonfunctionality doctrine's purpose.

IV. POLICY DISCUSSION

Giving trade dress protection to distinctive chairs will only prevent competitors from using the design in a way that will likely confuse consumers—it will not prevent competitors from using functional elements. This is partly because in the realm of mid-century modern furniture, the design of a chair was not as much the result of utilitarian pressures as aesthetic choices.¹⁶¹ And during that era, there was an explosion of diversity in chair designs.¹⁶² The

¹⁶⁰ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164–65 (1995) (“The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.”).

¹⁶¹ See ELIZABETH ARMSTRONG, *BIRTH OF THE COOL: CALIFORNIA ART, DESIGN, AND CULTURE AT MIDCENTURY* 31 (2007) 180–81 (“The well-designed consumer products conceived by the Eames office most often derived their final ‘look’ from a technical solution. But they were also an epic artistic feat; Ray[] [Eames’] sculptural seat elements floated like ethereal pads above the structural frames. . . . Each plywood element became architecture/sculpture in its own right.”).

¹⁶² See DEMETRIOS, *supra* note 2, at 36 (discussing the Museum of Modern Art's Organic Designs in Home Furnishings competition, which drew 585 competing designs in 1940). The organizer of the competition wanted to see design evolve because there had been no outstanding design developments in recent years in the field of home furnishings. *Id.*

Eameses worked with a sculptor to fragment their organic shell forms into steel grids.¹⁶³ In other words, diverse, artistic visions often serve as the impetus for a chair's design. Protecting the overall look of such chairs will not result in a monopoly protection for *necessary elements*. Therefore, there should be little concern about burdens placed on competitors if the law prevents them from copying classic designs like the Eames Lounge Chair or modern designs like Philippe Starck's Victoria Ghost Chair. In light of the abundance of alternative chair designs, courts can grant trade dress to many mid-century and modern designs without burdening competition.

Moreover, allowing copycats to benefit off the goodwill of an established mark is unfair. As previously stated, a purpose of trademark law is to protect the owner's exclusive right to distinguish his or her product so that he or she may receive the benefit of his or her extensive marketing expenditures.¹⁶⁴ To this point, one scholar succinctly noted that the manufacturer bears the "entire economic burden of innovation while the competition rides freely by unlimited imitation and is thus rationally dissuaded from independent investment."¹⁶⁵ Likewise, manufacturers that produce exact copies of the classics or other popular designs do not copy for the sake of its better design (that which makes the product cheaper, faster, lighter, or stronger); they copy in order to get a piece of the market success that is attributed to that "look."

¹⁶³ *Id.* at 177–88.

¹⁶⁴ See MCCARTHY *supra* note 30 and accompanying text.

¹⁶⁵ See Dorota Niechwiej Clegg, *Aesthetic Functionality Conundrum and Traderight: A Proposal for a Foster Home to an Orphan of Intellectual Property Laws*, 89 IOWA L. REV. 273, 308 (2003); see also Verizon Communications Inc. v. FCC, 535 U.S. 467, 552 (2002) ("No company will invest billions of dollars . . . if competitors who have not invested a penny of capital, nor taken an ounce of risk, can come along and get a free ride on the investments and risks of others.") (citations omitted).

Protecting a classic chair’s trade dress will help combat this unfair and deceptive practice—a concern Congress addressed by enacting the Lanham Act.¹⁶⁶

Finally, there is much to gain from ensuring trade dress protection is available to authentic articles made by companies like Emeco, Herman Miller, Knoll, and Steelcase. These domestic companies help in relieving the trade deficit, display social and environmental responsibility, and produce durable, reliable furniture articles that knockoffs (legal or illegal) have yet to match.¹⁶⁷ Fortunately, these companies have had some success in asserting their trade dress rights against infringers.¹⁶⁸

CONCLUSION

Thirteen years after the *TrafFix* decision, there is still a split in the circuit courts on how to interpret the functionality standard. From the more recent case law

¹⁶⁶ Lanham Act, 15 U.S.C. § 1127 (2012) (“The intent of this chapter is to . . . to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions”); see also MCCARTHY, *supra* note 30, at § 2:9 (“In developing the law of unfair competition and trademark infringement, the courts have taken a logical approach. There is a strong desire to protect the rights of the first user of the mark. This arises from a sense of basic fairness, more than from any particular concept of property law.”).

¹⁶⁷ See *supra* Part I.

¹⁶⁸ *Alphaville Design, Inc. v. Knoll, Inc.*, Stipulated Permanent Injunction ¶ 3; *Herman Miller Inc. v. Alphaville Design Inc.*, No. C 08-03437 WHA, 2009 WL 3429739, at *1 (N. D. Cal. 2009); Consent Judgment and Decree, *Herman Miller, Inc. v. Nuevo Americana, Inc.*, No. 1:12CV01225 (W.D. Mich. Nov. 5, 2012) (granting judgment by the infringing party’s consent and decreeing that Herman Miller owns all rights throughout the United States to the product configuration trade dress of the Eames Lounge, the Aluminum Group, and the Softpad).

pertaining to the functionality of chair designs, three main observations can be made. First, courts will severely curtail the trade dress eligibility of a chair if they continue to unpredictably apply a piecemeal analysis to design elements. Second, courts will curtail eligibility if they continue to conflate utility and functionality or overlook the comprehensive definition of “essential.” Finally, courts will contravene the purpose of the functionality doctrine—avoiding burdens on competition—if they do not consider as evidence the alternative designs under the first prong of functionality. The future of trade dress registrations on the Federal Register for classic designs (like the Eames Lounge Chair) is solid; such designs will continue to be registerable because the TMEP requires examiners to apply the *Morton-Norwich* factors.¹⁶⁹ However, if a competitor challenges a design, the product owner, even with incontestable trademark status, must overcome the burdens of inconsistency and misapplication in the federal courts.¹⁷⁰

Furniture companies that manufacture authentic designs such as Herman Miller, Emeco, Knoll, and Steelcase better serve society’s interest in relieving the trade deficit, supporting socially and environmentally responsible companies and durable, reliable furniture. The purpose behind the functionality doctrine and trademark law at large pertains to free and fair competition. Free riding off the aforementioned companies’ expenditures is a patently unfair practice that courts should prevent.

¹⁶⁹ See TMEP, *supra* note 111 and accompanying text (quoting and explaining the *Morton-Norwich* factors).

¹⁷⁰ Even though some classic furniture designs have registered trade dress, functionality is a defense in an infringement action; therefore, even the registered and uncontestable classics are subject to reevaluation of functionality. *Specialized Seating, Inc.*, 616 F.3d at 724.

