

# RED IN THE EYE OF THE BEHOLDER: THE CASE FOR AESTHETIC FUNCTIONALITY

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The famous saying “[b]eauty is in the eye of the beholder”<sup>1</sup> aptly describes the doctrine of aesthetic functionality in trademark law. A product that consumers purchase because of a purely aesthetic feature cannot be protected as a trademark because of the aesthetic functionality doctrine.<sup>2</sup> Called an oxymoron by Thomas McCarthy,<sup>3</sup> the aesthetic functionality doctrine has puzzled practitioners, courts, and experts in trademark law since it emerged over seventy years ago.<sup>4</sup> Courts have criticized the doctrine as over-inclusive<sup>5</sup>, and some have even failed to see the importance of having it at all. Fortunately, not all courts have given up on aesthetic functionality because they recognize the doctrine’s place within intellectual property. The aesthetic functionality doctrine denies trademark protection of product

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1. MARGARET WOLFE HUNGERFORD, “THE DUCHESS,” *Molly Bawn*, 140 (1878). Although the idea behind this maxim originated years before Hungerford wrote *Molly Bawn*, she is credited as the first to use the exact phrase. See Bridget Ilene Delaney, *Phrase Origins: Beauty is in the Eye of the Beholder*, YAHOO! VOICES (June 15, 2010), <http://voices.yahoo.com/phrase-origins-beauty-eye-beholder-6194556.html>.

2. Aesthetic products are

chosen over competing products primarily because the design appeals visually, and purchased mainly for their decorative value. In this context, a competitor normally imitates the proven design not in the hope of inducing the consumer to believe he is buying the goods of the first manufacturer, but because that particular design is the one which embodies the essential thing the purchaser wants.

3 LOUIS ALTMAN & MALLA POLLACK, *CALLMANN ON UNFAIR COMP., TR. & MONO* § 19.9 (4th ed. 2012).

3. 1 J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 7.81 (4th ed. 2012). McCarthy believes that aesthetic functionality is an “unwarranted expansion of the utilitarian functionality policy.” *Id.* In his treatise, McCarthy states that appending both utilitarian and aesthetic to functionality is “misleading semantics.” *Id.* He goes on to state that “[o]rnamental aesthetic designs are the antithesis of utilitarian designs.” *Id.*

4. See Erin M. Harriman, *Aesthetic Functionality: The Disarray Among Modern Courts*, 86 *TRADEMARK REP.* 276, 276 (1996).

5. See *infra* notes 75–76 and accompanying text.

features that—if granted exclusively to a single producer—would put competitors at a significant non-reputation-related disadvantage.<sup>6</sup>

Trademark law guarantees consumers assurance that a particular entity made the product they are purchasing and protects aesthetic product features only to the extent that a decorative feature's "primary purpose is to identify and distinguish goods from others."<sup>7</sup> Aesthetic functionality balances the goal of preventing consumer confusion with the societal interest in preventing monopolies over product features that are desired for their aesthetic value rather than for their source-identifying value.<sup>8</sup> Notably, "aesthetic functionality is *independent* of source significance."<sup>9</sup> A feature that is deemed functional renders the feature unprotectable, whether or not that feature indicates source.<sup>10</sup> In functionality cases, trademark owners have argued that trademarked features—which defendants have challenged as functional—identify the sources of the features and therefore should not be found functional.<sup>11</sup> This argument, however, is not sufficient to support the claim that a product feature should be protected by trademark law; the argument does not address an important concern—whether competitors can compete effectively in a market without the use of the protected feature.

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6. *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33 (2001) (quoting *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 165 (1995)).

7. Deborah J. Krieger, *The Broad Sweep of Aesthetic Functionality: A Threat to Trademark Protection of Aesthetic Product Features*, 51 *FORDHAM L. REV.* 345, 363 (1982).

8. See A. Samuel Oddi, *The Functions of "Functionality" in Trademark Law*, 22 *HOUS. L. REV.* 925, 927–28 (1985).

9. Brief for Law Professors as Amicus Curiae Supporting Defendants-Counter-Claimants-Appellees, *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012) (No. 11-3303-cv), 2012 WL 59424, at \*2 (emphasis added). Under the Lanham Act, functionality is a defense to infringement of marks, even against marks that have achieved incontestable status. 15 U.S.C. § 1115(b)(8) (2006); see also Michael Grynberg, *Things Are Worse than We Think: Trademark Defenses in a "Formalist" Age*, 24 *BERKELEY TECH. L.J.* 897, 920–21 (2009); Keith M. Stolte, *Functionality Challenges to Incontestable Trademark Registrations Before and After the Trademark Law Treaty Implementation Act*, 92 *TRADEMARK REP.* 1094, 1094–95 (2002).

10. See *Traffix Devices, Inc.*, 532 U.S. at 33. The Supreme Court in *Traffix* concludes that "[i]t is proper to inquire into a significant non-reputational-related disadvantage in cases of [a]esthetic functionality." *Id.* (internal quotation marks omitted). This inquiry is not focused on the reputational disadvantage of competitors' lack of access to source-identifying features protected by trademark, but instead is focused on if there is a "competitive necessity for the feature." *Id.* In other words, if trademark law protects this feature, could others compete fairly and effectively in the marketplace without the feature? If the answer is no, then a finding of aesthetic functionality is in order.

11. See *Pagliero v. Wallace China Co.*, 198 F.2d 339, 340 (9th Cir. 1952); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1126–27 (Fed. Cir. 1985); *Wallace Intern. Silversmiths, Inc. v. Godinger Silver Art Co., Inc.*, 916 F.2d 76, 80 (2d Cir. 1990).

The U.S. Supreme Court recognized the importance of competition in aesthetic functionality cases in *TrafFix Devices, Inc. v. Marketing Displays Inc.*<sup>12</sup> Specifically the Court declared that “[i]t is proper to inquire into a ‘significant non-reputation-related disadvantage’ in cases of [a]esthetic functionality . . . .”<sup>13</sup> Although some commentators and courts regard the Supreme Court’s language as dicta,<sup>14</sup> the Court’s recognition of aesthetic functionality legitimizes its place in trademark law.

The recent cases of *Maker’s Mark Distillery, Inc. v. Diageo North America, Inc.* (“*Maker’s Mark*”)<sup>15</sup> and *Christian Louboutin S.A. v. Yves Saint Laurent America Holdings, Inc.* (“*Louboutin*”)<sup>16</sup> have interpreted the doctrine of aesthetic functionality and applied the test set out by the U.S. Supreme Court in *TrafFix*.<sup>17</sup> In *Maker’s Mark*, the Sixth Circuit took an appeal concerning the use of a red dripping wax seal by two different alcoholic beverage manufacturers—Makers’ Mark bourbon and Reserva de la Familia tequila.<sup>18</sup> Maker’s Mark Distillery—known for its famous bourbon—started using a red dripping wax seal on its bourbon bottles in the 1950s.<sup>19</sup> Jose Cuervo—a tequila maker—began selling Reserva de la Familia tequila in the United States in 2001.<sup>20</sup> Reserva de la Familia bottles were also closed with a red dripping wax seal.<sup>21</sup> Maker’s Mark wanted to protect its use of red dripping wax seals in the alcohol industry, thus it sued Jose Cuervo for infringement of its trade dress.<sup>22</sup> As a defense to the infringement allegation, Jose Cuervo raised the aesthetic functionality defense, claiming that the red dripping wax seal was aesthetically functional.<sup>23</sup> A few months after the Sixth Circuit decided *Maker’s Mark*, the Second Circuit also addressed the doctrine of aesthetic functionality.<sup>24</sup> Louboutin—the maker of pricey red-soled shoes

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12. *TrafFix Devices, Inc.*, 532 U.S. at 33 (2001).

13. *Id.*

14. *See infra* notes 93–94 and accompanying text.

15. *Maker’s Mark Distillery, Inc. v. Diageo N Am., Inc.* (*Maker’s Mark II*), 679 F.3d 410 (6th Cir. 2012), *aff’g* 703 F. Supp. 2d 671 (W.D. Kent. 2010).

16. *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.* (*Louboutin II*), 696 F.3d 206 (2d Cir. 2012).

17. *TrafFix Devices, Inc.*, 532 U.S. 23 (2001).

18. *Maker’s Mark II*, 679 F.3d at 414.

19. *Id.* at 417.

20. *Id.*

21. *Id.*

22. *See id.*

23. *Maker’s Mark Distillery, Inc. v. Diageo N. Am., Inc.* (*Maker’s Mark I*), 703 F. Supp. 2d 671, 686 (W.D. Kent. 2010).

24. *Louboutin II*, 696 F.3d 206 (2d Cir. 2012). The Second Circuit released its decision on Sept. 5, 2012, while the Sixth Circuit had decided *Maker’s Mark II* on May 9, 2012. *Maker’s Mark II*, 679 F.3d at 410.

often seen on the red carpet worn by celebrities—sued Yves Saint Laurent (“YSL”)—another fashion powerhouse—after YSL announced its plan to make an entirely red shoe.<sup>25</sup> Like Cuervo in the Sixth Circuit, YSL also raised the aesthetic functionality defense, claiming that Louboutin’s famous red soles were aesthetically functional.<sup>26</sup> Although courts rarely apply the doctrine, within the last year these two circuits have made aesthetic functionality central in their discussion of whether the color red should be protected by trademark law.<sup>27</sup>

This Note examines the aesthetic functionality doctrine, its important place within intellectual property law, and two courts’ recent attempts at applying the doctrine. The Second Circuit correctly decided the case of *Louboutin* by finding that no per se rule forbids color from trademark protection in the fashion industry and by narrowing Louboutin’s trademark protection to just the red sole. Applying the Supreme Court’s aesthetic functionality test from *TrafFix*, the Second Circuit gave clarity to the fact-specific analysis needed in an aesthetic functionality case. In contrast, the Sixth Circuit in the *Maker’s Mark* case failed to apply aesthetic functionality properly by disregarding the function that dripping wax seals play in the alcohol beverage industry. Its sparse reasoning did not set a clear precedent for lower courts to follow. Confusingly, the court refused to affirmatively acknowledge aesthetic functionality’s place within its Circuit even though the court applied the doctrine.

Part I begins with an overview of the relationships between trademark law and the other branches of intellectual property. Then it traces the evolution of the aesthetic functionality doctrine. Part II provides a synopsis of the most recent cases applying the doctrine: *Maker’s Mark* in the Sixth Circuit and *Louboutin* in the Second Circuit. Part III explains that the Sixth Circuit in *Maker’s Mark* failed to apply aesthetic functionality correctly, whereas that the Second Circuit in *Louboutin* created a well-defined analytic framework for courts to follow when implementing the *TrafFix* aesthetic functionality test.

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25. Casey Hall & Will Ashenmacher, *Trademarks and the Aesthetic Functionality Doctrine*, LEGAL CURRENT (Nov. 30, 2012), <http://legalcurrent.com/2012/11/30/trademarks-and-the-aesthetic-functionality-doctrine/>.

26. *Louboutin S.A. v. Yves Saint Laurent Am., Inc. (Louboutin I)*, 778 F. Supp. 2d 445, 449 (S.D.N.Y. 2011).

27. *See Maker’s Mark II*, 679 F.3d at 418.

## I. THE EVOLUTION OF THE AESTHETIC FUNCTIONALITY DOCTRINE

### A. SITUATING AESTHETIC FUNCTIONALITY WITHIN INTELLECTUAL PROPERTY LAW

The aesthetic functionality doctrine is situated in an area of substantial overlap between the three branches of intellectual property: patent, copyright, and trademark.<sup>28</sup> Due to this overlap, courts have found the doctrine to be confusing and difficult to apply.<sup>29</sup> However, the goals of trademark law illuminate the role of the aesthetic functionality doctrine within intellectual property law and suggest how it should be applied. The principal purpose of trademark law is to prevent consumers from mistakenly purchasing goods from the wrong manufacturer.<sup>30</sup> To prevent such consumer confusion, trademark law allows manufacturers exclusive use of a trademark to identify their goods. A trademark allows a manufacturer to distinguish his goods from those of others and prohibits other manufacturers from adopting any mark likely to be confused with the original trademark.<sup>31</sup> Trademarks also reduce “information and transaction costs by allowing consumers to estimate the nature and quality of goods before purchase.”<sup>32</sup> Trademark law not only provides protection to words, phrases, logos, and symbols, but also provides protection for trade dress.<sup>33</sup> Trade dress is defined as “the design and packaging of materials, and even the design and shape of a product itself, if the packaging or product configuration serve[s] the same source-identifying function as trademarks.”<sup>34</sup> Where a competitor has chosen to emulate a distinctive product trade dress in a way that causes consumer confusion, it has committed trademark infringement just as if it had copied

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28. See Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1504–05 (2004); Mitchell M. Wong, *The Aesthetic Functionality Doctrine and the Law of Trade-Dress Protection*, 83 CORNELL L. REV. 1116, 1154–65 (1998); ROBERT P. MERGES, PETER S. MENELL & MARK A. LEMLEY, *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 908–09 (5th ed. 2010).

29. See Erin M. Harriman, *Aesthetic Functionality: The Disarray Among Modern Courts*, 86 TRADEMARK REP. 276, 276 (1996).

30. STEPHEN F. MOHR & GLENN MITCHELL, *FUNCTIONALITY OF TRADE DRESS: A REVIEW AND ANALYSIS OF U.S. CASE LAW 1* (Int’l Trademark Ass’n 2d ed. 1994).

31. *Id.*

32. MERGES, MENELL & LEMLEY, *supra* note 28, at 733. Because trademark law focuses on consumers, there traditionally “has been nothing in trademark law analogous to the desire to encourage invention or creation that underlies (at least in part) patent and copyright law. . . . Rather, the fundamental principles of trademark law have essentially been ones of tort: unfair competition and the tort of deception of the consumer.” *Id.* at 735.

33. MCCARTHY, *supra* note 3, § 8:1.

34. MERGES, MENELL & LEMLEY, *supra* note 28, at 744.

the product's brand name.<sup>35</sup> Discussion of the aesthetic functionality doctrine occurs almost exclusively in trade dress cases because a trade dress often encompasses not just a source indicator but also "a useful product feature [that should] not be unfairly monopolized."<sup>36</sup>

Trademark protection of distinctive product features creates a potential conflict with patent and copyright law.<sup>37</sup> Unlike copyrights and patents, trademarks are not mentioned in the Constitution.<sup>38</sup> The Constitution expressly authorizes Congress "[t]o promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."<sup>39</sup> The copyright and patent systems allow inventors to reap the benefits of their creative, new, or inventive work by providing a limited monopoly that creates strong rights for a limited time.<sup>40</sup> After the prescribed period of protection, works are made available to the public to freely copy.<sup>41</sup> This bargain balances the rights granted to inventors and creators against the costs to society of granting those rights.<sup>42</sup>

Trademarks serve a different purpose; they are not granted to protect new, useful, or creative works.<sup>43</sup> Instead, trademark law protects marks—sometimes indefinitely—to assist consumers in purchase decisions and to encourage trademark owners to establish their goods in the marketplace.<sup>44</sup> With each area having distinct goals, overlap should not occur between the different forms of intellectual property protection unless a product feature meets the separate requirements for more than one branch of intellectual

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35. Joel W. Reese, *Defining the Elements of Trade Dress Infringement under Section 43(a) of the Lanham Act*, 2 TEX. INTELL. PROP. L.J. 103, 105 (1993–1994).

36. See ANNE GILSON LALONDE, 1 GILSON ON TRADEMARKS § 2A.04 (2012).

37. MCCARTHY, *supra* note 3, § 7.64.

38. MERGES, MENELL & LEMLEY, *supra* note 28, at 733; Krieger, *supra* note 7, at 354–56.

39. U.S. CONST. art. I, § 8, cl. 8.

40. See *Mazer v. Stein*, 347 U.S. 201, 219 (1954). The Supreme Court explained,

The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and useful Arts.' Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.

*Id.*

41. See Moffat, *supra* note 28, at 1484–86.

42. See *id.* at 1483–89.

43. See *id.* at 1488–89; MERGES, MENELL & LEMLEY, *supra* note 28, at 735.

44. See Gregory J. Battersby, *Intellectual Property under the Bright Lights of Broadway*, 67 N.Y. ST. B.J. 28, 30 (1995); MCCARTHY, *supra* note 3, § 2.2.

property protection.<sup>45</sup> However, unwarranted overlap does occur when trademarks protect product features better protected by patent and/or copyright law.<sup>46</sup> “Backdoor patents” and “mutant copyrights” can occur when manufacturers attempt to gain trademark protections for items that fall within the subject matter of patent or copyright.<sup>47</sup> If trademark protection is granted to features that fall within the purview of patent and copyright law, what was intended to be a limited yet strong monopoly can become a perpetual monopoly. The functionality doctrine prevents against such a misuse of intellectual property law.<sup>48</sup>

### 1. *The Functionality Doctrine*

To protect against this misuse of trademark law, courts developed the functionality doctrine, which prohibits parties from claiming exclusive rights in product features or packaging designs that are functional.<sup>49</sup> In 1938, in one of the earliest and most famous functionality cases, *Kellogg Co. v. National Biscuit Co.*, the U.S. Supreme Court denied trademark protection for National Biscuit Company’s (“NABISCO”) pillow-shaped biscuit in part due to the fact that the shape was functional.<sup>50</sup> The Court articulated the test for functionality as one of cost and quality of the article, holding that the pillow shape must be used by competitors or “the cost of the biscuit would be increased and its high quality lessened if some other form was substituted for the pillow-shape.”<sup>51</sup> The court recognized NABISCO’s right to a reward for its creation of the pillow-shaped process, but noted that NABISCO had already enjoyed a monopoly over its pillow-shaped design under an expired

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45. See Wong, *supra* note 28, at 1156–61. “A feature that affects market demand for reasons other than the reputation of its source is presumed to be an aspect which ought not be monopolized by trademark.” *Id.* at 1139.

46. See Moffat, *supra* note 28, at 1499, 1504–12.

47. See *id.* at 1475–76.

48. See Wong, *supra* note 28, at 1154 (“There are two apparent purposes for the functionality doctrine: (1) to prevent the perpetual monopolization of valuable product features, and (2) to partition the law of intellectual property between trademark and other forms of protection (e.g., copyright and patent).”).

49. See MOHR & MITCHELL, *supra* note 30, at 2. Specifically, Mohr and Mitchell note:

The doctrine of functionality in trademark law evolved out of the conflict between the need to protect the public from confusion as to the source of a product with a particular trade dress and the policy to encourage free and fair competition in the marketplace through the free use of unpatented product features that enhance a product’s performance.

*Id.*; see also MCCARTHY, *supra* note 3, § 7.63 (noting that functionality was not codified until 1998); Oddi, *supra* note 8, at 928.

50. *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 122 (1938).

51. *Id.*

patent.<sup>52</sup> The Court reasoned that once NABISCO's patent had expired, it was no longer entitled to exclusive rights under trademark law due to the public expectation that a patented process—like the pillow-shape design process—is free for all to copy at the end of its term.<sup>53</sup> Therefore, the Court used the functionality doctrine to deny trademark protection for a product with an expired patent to prevent a perpetual monopoly over the pillow-shaped biscuit.<sup>54</sup> Other courts applied this test to find products such as a two-colored match and a milk bottle cap to be functional and therefore undeserving of trademark's perpetual protection.<sup>55</sup>

In early functionality cases, courts took a strictly utilitarian approach: only those product features found absolutely necessary to the product's use were found functional and thus unprotectable under trademark law.<sup>56</sup> Courts focused on quality and cost in determining if a product feature was functional, asking (1) whether the feature is “essential to the use or purpose of the article,” or (2) if it “affects the cost or quality of the article.”<sup>57</sup> Aesthetic functionality evolved to complement utilitarian functionality in its effort to stop trademark protection from being granted to features better protected by patent or copyright.<sup>58</sup>

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52. *Id.* at 119–20. “It is self-evident that on the expiration of a patent the monopoly granted by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property. It is upon this condition that the patent is granted.” *Id.* (quoting *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896)).

53. *Id.* at 122 (reasoning that it is not unfair that Kellogg shared in the goodwill of Shredded Wheat because “[s]haring in the goodwill of an article unprotected by patent or trade-mark is the exercise of a right possessed by all-and in the free exercise of which the consuming public is deeply interested”).

54. *Id.*

55. *See* *Diamond Match Co. v. Saginaw Match Co.*, 142 F. 727 (6th Cir. 1906) (holding that a two-colored match head serves an essential function); *Goodyear Tire & Rubber Co. v. Robertson*, 25 F.2d 833 (4th Cir. 1928) (holding that a design consisting of something mechanically functional is not registerable as a trademark); *In re Walker-Gordon Lab. Co.*, 53 F.2d 548 (C.C.P.A. 1931) (holding that a milk bottle cap is a functional part of the bottle).

56. Krieger, *supra* note 7, at 359–62 (describing the history and progression of the utilitarian functionality standard through the years).

57. *Louboutin II*, 696 F.3d 206, 219 (2d Cir. 2012) (quoting *Inwood Labs. Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982)).

58. Wong, *supra* note 28, at 1159–60; *see also* Reese, *supra* note 35, at 119 (“The legitimate purpose that the aesthetic functionality concept serves is that it prevents the protection of certain features which would not technically fit within the utilitarian definition, but which would still be necessary to effectively compete in the same product market.”).



## 2. *Aesthetic Functionality's Beginnings*

The aesthetic functionality doctrine emerged in a comment in the 1938 Restatement (First) of Torts.<sup>59</sup> “When goods are bought largely for their aesthetic value, their features may be functional because they definitely contribute to that value and thus aid the performance of an object for which the goods are intended.”<sup>60</sup> The comment noted that a candy box in the shape of a heart for Valentine’s Day may be classified as aesthetically functional<sup>61</sup> because of the nearly universal association between love and the human heart.<sup>62</sup> Moreover, there are no alternative designs or shapes to satisfy the aesthetic desires of customers in the same way.<sup>63</sup>

The aesthetic functionality doctrine did not come to the forefront of trademark law until 1952 when the Ninth Circuit decided *Pagliari v. Wallace China Co.*<sup>64</sup> In *Pagliari*, the court held that floral designs printed on hotel china were functional because the designs appealed to consumers.<sup>65</sup> Therefore, the court denied trademark protection for Wallace’s design.<sup>66</sup> Wallace had emphasized repeatedly that the floral design was an “essential selling feature” of the china and that consumers were buying the china because of the designs.<sup>67</sup> The court established and applied the “important ingredient” test.<sup>68</sup> Under this test, “if the particular feature is an important ingredient in the commercial success of the product, the interest in free competition permits its imitation in the absence of a patent or copyright.”<sup>69</sup> When the court applied the “important ingredient” test to the facts of the case, the Ninth Circuit found Wallace’s design functional.<sup>70</sup>

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59. MCCARTHY, *supra* note 3, § 7.79.

60. RESTATEMENT (FIRST) OF TORTS § 742 cmt. a (1938).

61. *Id.*

62. *See Heart (symbol)*, WIKIPEDIA, [http://en.wikipedia.org/wiki/Heart\\_\(symbol\)](http://en.wikipedia.org/wiki/Heart_(symbol)) (last modified Jan. 24, 2013).

63. *See* GILSON LALONDE, *supra* note 36, § 2A.04[5][a][i]. However, Newman in his article notes that a manufacturer of marbles could potentially trademark a heart-shaped box because the heart-shaped packaging would not give the same tremendous advantage over other marble producers as it would for candy producers on Valentine’s Day. *See* Stephen J. Newman, *Kill the “Mere Color” Rule: Equal Protection for Color Under the Lanham Act*, 61 U. CHI. L. REV. 1595, 1602 (1994).

64. *Pagliari v. Wallace China Co.*, 198 F.2d 339, 343 (9th Cir. 1952).

65. *Id.*

66. *Id.*

67. *Id.* The Ninth Circuit agreed that the floral design was essential and found that “[t]he attractiveness and eye-appeal of the design sells the china.” *Id.* at 343–44.

68. *Id.* at 343.

69. *Id.*

70. *Id.* The court in *Pagliari* stated:

Although not mentioned by the Ninth Circuit in its decision, *Pagliari* was a case of a mutant copyright. Wallace could not protect the design via copyright because he failed to provide a copyright notice upon the first publication of his floral plate designs.<sup>71</sup> Only after losing the opportunity to protect his floral design under copyright and discovering that competitors were using his design without permission, did Wallace look to trademark law for protection.<sup>72</sup> As explained above, trademark law is not in place to grant a monopoly to the first person that produces an innovative or creative design; rather, it serves the purpose of indicating the origin of a product.<sup>73</sup> If the Ninth Circuit had allowed Wallace trademark protection over the floral plate designs, the court would in effect have granted protection for an unlimited amount of time to a design better protected by copyright law.<sup>74</sup>

*Pagliari's* “important ingredient” test created much controversy over the implementation of aesthetic functionality. Many courts found application of

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If the particular feature is an important ingredient in the commercial success of the product, the interest in free competition permits its imitation in the absence of a patent or copyright. On the other hand, where the feature or, more aptly, design, is a mere arbitrary embellishment, a form of dress for the goods primarily adopted for purposes of identification and individuality and, hence, unrelated to basic consumer demands in connection with the product, imitation may be forbidden where the requisite showing of secondary meaning is made. Under such circumstances, since effective competition may be undertaken without imitation, the law grants protection.

*Id.*

71. MERGES, MENELL & LEMLEY, *supra* note 28, at 909 n.15.

72. *See Pagliero*, 198 F.2d at 342.

73. *See Louboutin II*, 696 F.3d 206, 216 (2d Cir. 2012). As the court noted, [T]rademark law is *not* intended to protect innovation by giving the innovator a *monopoly* over a useful product feature. Such a monopoly is the realm of patent law or copyright law, which seek to encourage innovation, and not of trademark law, which seeks to preserve a vigorously competitive market for the benefit of consumers.

*Id.* (citations omitted) (internal quotation marks omitted).

74. When discussing the concept of functionality in trademark law, many commentators only refer to the interplay between patents and trademarks thus, leaving the possibility of backdoor copyrights out of the discussion. However, such commentators fail to recognize that after a copyright expires, the owner could attempt to use trademark law to gain perpetual protection of an appealing design. The aesthetic functionality doctrine protects the public's dual interests in (1) protected functional designs eventually being released into the public domain for anyone to freely copy after their patent or copyright has expired and (2) functional designs not being protected at all if the designs do not fall within the domain of the patent or copyright system. *See* MERGES, MENELL & LEMLEY, *supra* note 28, at 909–10.

the test as encompassing too many trademarks.<sup>75</sup> Some commentators suggested that *Pagliero's* broad definition of aesthetic functionality would preclude protection for any product design that is aesthetically pleasing.<sup>76</sup> Since *Pagliero*, courts have taken various approaches to aesthetic functionality. Circuits that recognize aesthetic functionality—including the Ninth Circuit—have abandoned or limited *Pagliero's* interpretation of aesthetic functionality. Other courts have adopted a different test, while some courts have rejected aesthetic functionality altogether.<sup>77</sup>

Courts limiting the doctrine have attempted to “balance the source identification benefit of trade dress protection for aesthetic features against the threat to free competition posed by such protection” by “focusing on the extent to which trade dress protection forecloses alternative designs.”<sup>78</sup> Many courts have relied on the test proposed in the Third Restatement, which attempted to narrow the scope of *Pagliero* and the original comment from the 1938 Restatement of Torts:

A design is functional because of its aesthetic value only if it confers a significant benefit that cannot practically be duplicated by the use of alternative designs. Because of the difficulties inherent in evaluation of the aesthetic superiority of a particular design, a finding of aesthetic functionality ordinarily will be made only when the objective evidence indicates a lack of adequate alternative designs. Such evidence typically is available only when the range of alternative designs is limited either by the nature of the design feature or by the basis of its aesthetic appeal. The ultimate test of aesthetic functionality, as with utilitarian functionality, is whether the recognition of trademark rights would significantly hinder competition.<sup>79</sup>

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75. See, e.g., *Kleene Corp. v. Paraflex Indus. Inc.*, 653 F.2d 822, 825 (3d Cir. 1981) (rejecting the *Pagliero* test because it is overbroad and discourages creativity); *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co., Inc.*, 916 F.2d 76, 80 (2d Cir. 1990) (noting that the *Pagliero* test “discourages both originators and later competitors from developing pleasing designs.”); *Ferrari S.P.A. v. Roberts*, 944 F.2d 1235, 1247 (6th Cir. 1991) (also expressing criticism of the doctrine due to its discouragement of the development of appealing designs).

76. See MOHR & MITCHELL, *supra* note 30, at 12.

77. MCCARTHY, *supra* note 3, § 7.80. See Mark P. McKenna, *(Dys)Functionality*, 48 HOUS. L. REV. 823, 848–49 (2012) (explaining that the Federal Circuit, Eighth Circuit, and the Eleventh Circuit have refused protection for features on the basis of aesthetic functionality; other courts are skeptical of the doctrine; and the Ninth Circuit is not consistent with its application of the doctrine).

78. BARTON BEEBE ET AL., TRADEMARKS, UNFAIR COMPETITION, AND BUSINESS TORTS 101 (2011).

79. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 cmt. c (1995).

Another way that some courts have applied aesthetic functionality while limiting *Pagliari* is by looking at whether competitors can compete effectively without use of the product feature.<sup>80</sup> This analysis has often been used in conjunction with the available alternative designs test in courts' decisions of whether trademark protection would significantly hinder competition.<sup>81</sup>

The inconsistency in the application of the aesthetic functionality doctrine in the circuit courts was due in part to the lack of clarity from the Supreme Court on how to decide if a product feature was aesthetically functional or not.<sup>82</sup> Unfortunately as discussed below, even after the Supreme Court more clearly articulated the doctrine, confusion still existed among the circuits due to some courts and commentators interpreting the Court's words as dicta.<sup>83</sup>

It was not until 1995, that the U.S. Supreme Court recognized aesthetic functionality. In *Qualitex Co. v. Jacobson Products Co.*, the Court stated that the functionality doctrine "forbids the use of a product's feature as a trademark where doing so will put a competitor at a significant disadvantage because the feature is essential to the use or purpose of the article or affects its cost or quality."<sup>84</sup> The court endorsed the Restatement (Third) of Unfair Competition's view that the "ultimate test for aesthetic functionality . . . is whether the recognition of trademark rights would significantly hinder competition."<sup>85</sup>

In 2001, the Supreme Court revisited aesthetic functionality in the case of *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, interpreting the central question in *Qualitex* to be one of aesthetic functionality.<sup>86</sup> The Court laid out a two-part test for functionality. First, a court must inquire if the product feature "is

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80. See Erin M. Harriman, *Aesthetic Functionality: The Disarray Among Modern Courts*, 86 TRADEMARK REP. 276, 289, 291, 292 (1996).

81. See *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co., Inc.*, 916 F.2d 76, 79–80 (2d Cir. 1990) (quoting *Stormy Clime Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 976–77 (2d Cir. 1987) (internal quotation marks omitted)); *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*, 280 F.3d 619, 642–44 (6th Cir. 2002).

82. The Supreme Court did not refer to aesthetic functionality until 1995 in *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995) and did not clarify its two-part functionality test until 2001 in *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).

83. See *infra* notes 93–94 and accompanying text.

84. *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 169 (1995) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982) (internal quotation marks omitted)).

85. *Id.* at 170 ("[I]f a design's aesthetic value lies in its ability to confer a significant benefit that cannot practically be duplicated by the use of alternative designs, then the design is functional." (internal quotation marks omitted) (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 cmt. c (1995))).

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

essential to the use or purpose of the article or if it affects the cost or quality of the article.”<sup>87</sup> This is considered the traditional utilitarian functionality test.<sup>88</sup> If the answer is yes, the inquiry stops and the product feature is found functional. If the answer is no, then the court “proceed[s] further to consider if there is a competitive necessity for the feature.”<sup>89</sup> Proceeding to the second prong, the court should inquire if “exclusive use . . . would put competitors at a significant non-reputation-related disadvantage.”<sup>90</sup> The *TrafFix* test separated the analyses courts should conduct for utilitarian functionality and aesthetic functionality.<sup>91</sup> After *TrafFix*, courts always inquire first if the product feature is functional the utilitarian way and then, if it survives the first inquiry, courts will determine if the feature is aesthetically functional.<sup>92</sup>

Although the Supreme Court articulated an aesthetic functionality test, some scholars argue that the Court has not created precedent for lower courts to follow because its comments on the doctrine were merely dicta and were not dispositive to the issue the Court was deciding in either of those cases.<sup>93</sup> This confusion has led to continuing reluctance of some circuit courts to apply the doctrine.<sup>94</sup> However, the Second Circuit in *Louboutin* provided some clarity on how the doctrine can be more effectively applied. The Second Circuit’s approach creates a more reasonable balance between a company’s interest in protecting its marks and the market’s interest in protecting the use of product features that have functional purposes.

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87. *Id.* at 32 (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982)).

88. Orit Fischman Afori, *The Role of the Non-Functionality Requirement in Design Law*, 20 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 847, 857 (2009–2010).

89. *TrafFix*, 532 U.S. at 33.

90. *Id.* at 32 (quoting *Qualitex Co.*, 514 U.S. at 165).

91. *See Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1071–72 (9th Cir. 2006); *Dippin’ Dots, Inc. v. Frosty Bites Distrib., LLC*, 369 F.3d 1197, 1203 (11th Cir. 2004).

92. *See Louboutin II*, 696 F.3d 206, 220 (2d Cir. 2012).

93. *See, e.g., Yevgeniy Markov, Raising the Dead: How the Ninth Circuit Avoided the Supreme Court’s Guidelines Concerning Aesthetic Functionality and Still Got Away with It in Au-Tomotive Gold*, 6 NW. J. TECH. & INTELL. PROP. 197, 197 (2008) (explaining that the *TrafFix* court never “reached the issue of aesthetic functionality on the merits, but rather merely suggested its application to other related cases”); Alexandra J. Schultz, Comment, *Looks Can Be Deceiving: Aesthetic Functionality in Louboutin and Beyond*, 15 TUL. J. TECH. & INTELL. PROP. 261, 267 (2012) (noting that “the Supreme Court’s language has been considered dicta by several commentators and has not been followed consistently.”).

94. *See Bd. of Supervisors for La. State Uni. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 487–88 (5th Cir. 2008) (“Our circuit has consistently rejected the concept of aesthetic functionality. . . . We do not believe that the Court’s dictum in *TrafFix* requires us to abandon our long-settled view rejecting recognition of aesthetic functionality.”).

## II. 2012: THE YEAR OF AESTHETIC FUNCTIONALITY, BOURBON, AND SHOES

During the past year, high profile cases in the Second and Sixth Circuits have shined the spotlight on the aesthetic functionality doctrine.<sup>95</sup> Interestingly, both courts upheld the validity of the features after the plaintiffs had limited their marks from their original approved trademark applications.<sup>96</sup> Both circuits recognized the Supreme Court's discussion of the aesthetic functionality doctrine in *TrafFix*, but the Sixth Circuit stated in *Maker's Mark* that it was dicta while the Second Circuit followed it as binding precedent in *Louboutin*.<sup>97</sup>

### A. MAKER'S MARK V. JOSE CUERVO: THE BATTLE FOR THE SEAL

Figure 1: Maker's Mark's Seal v. Jose Cuervo's Seal<sup>98</sup>



In *Maker's Mark*, the court examined whether the aesthetic functionality doctrine prohibited protection of a signature red dripping wax seal on a

95. See Katherine Laatsch Fink, *Seeing Red: Recent Developments in the Trademark Functionality Doctrine*, BANNER & WITCOFF INTELLECTUAL PROPERTY UPDATE FALL/WINTER 2012, [http://www.bannerwitcoff.com/\\_docs/library/articles/Seeing%20Red%20%20Recent%20Developments%20in%20the%20Trademark%20Functionality%20Doctrine.pdf](http://www.bannerwitcoff.com/_docs/library/articles/Seeing%20Red%20%20Recent%20Developments%20in%20the%20Trademark%20Functionality%20Doctrine.pdf) (last visited at Feb. 20, 2013).

96. *Maker's Mark* narrowed its trademark to only red dripping wax seals. Its original approved application included all dripping wax seals on the neck of a bottle regardless of color. *Maker's Mark II*, 679 F.3d 410, 417 (6th Cir. 2012). The Second Circuit in *Louboutin* modified *Louboutin*'s trademark to only include the color red on the soles of the shoes. *Louboutin II*, 696 F.3d 206, 228 (2d Cir. 2012).

97. *Maker's Mark II*, 679 F.3d at 418; *Louboutin II*, 696 F.3d at 221.

98. *Maker's Mark Wins Trademark Protection for Signature Red Wax Seal*, TEQUILATOWN (May 9, 2012), <http://www.tequilatown.net/news/makers-mark-wins-trademark-protection-for-signature-red-wax-seal/>.

bourbon bottle.<sup>99</sup> Bourbon occupies a unique place in American culture and commerce, with Maker's Mark in the center of it.<sup>100</sup> The Samuels family—founder of Maker's Mark distillery—has produced whiskey since the eighteenth century.<sup>101</sup> In 1953, Bill Samuels, Sr. created the recipe for Maker's Mark bourbon.<sup>102</sup> Since 1958, the company has bottled bourbon for commercial sale using a red dripping wax on its Maker's Mark bourbon bottles.<sup>103</sup> Samuels' wife got the idea for the Maker's Mark's dripping wax from “antique cognac bottles that were commonly dipped in wax.”<sup>104</sup> Maker's Mark's “purpose in adopting a dripping wax seal was to impart a sense of elegance and a hand-crafted image.”<sup>105</sup> After the *Wall Street Journal* published an article about its bourbon and the red dripping wax seal, Maker's Mark gained national attention.<sup>106</sup> Consequently, Maker's Mark registered the seal as a trademark in 1985.<sup>107</sup>

Ten years after Maker's Mark registered the red dripping wax seal as a trademark, Jose Cuervo began producing a premium tequila called Reserva de la Familia.<sup>108</sup> Cuervo decided to use a red dripping wax seal on its bottles to create an artisan look.<sup>109</sup> In 2001, Jose Cuervo introduced Reserva de la Familia tequila to the United States in bottles with a red dripping wax seal vaguely similar to the Maker's Mark seal.<sup>110</sup> Because of Maker's Mark's existing trademark registration, Jose Cuervo's use of the red dripping wax set the stage for trademark litigation.

### 1. District Court Litigation

Two years after Jose Cuervo introduced Reserva de la Familia to the United States with a red dripping wax seal, Maker's Mark initiated a lawsuit against Cuervo seeking an injunction for state and federal trademark

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99. *Maker's Mark II*, 679 F.3d at 417.

100. *Id.* at 416.

101. *Id.*

102. *Id.*

103. *Id.* at 417.

104. *Wax Museum History: 1958*, MAKER'S MARK, <http://www.makersmark.com/#!/wax-museum/history/9-1958> (last visited Jan. 23, 2013).

105. Brief for the Appellants at 39, *Maker's Mark II*, 679 F.3d 410 (6th Cir. 2012) (Nos. 10-5508, 10-5586, 10-5819), 2011 WL 5320863 (referring to Samuels's testimony).

106. *Maker's Mark II*, 679 F.3d at 417.

107. *Id.*

108. *Id.*

109. See Brett Barrouquere, *Judge limits wax seal on liquors to Maker's Mark*, BUSINESSWEEK (Apr. 2, 2010, 4:31 PM), <http://www.businessweek.com/ap/financialnews/D9ER586G0.htm>.

110. *Maker's Mark II*, 679 F.3d at 417.

infringement.<sup>111</sup> Cuervo then discarded its use of the dripping wax seal and opted for a red, straight-edge wax seal.<sup>112</sup> In response to Maker's Mark's trademark infringement allegation, Cuervo challenged Marker's Mark's trademark registration claiming that the red dripping wax seal was functional under both utilitarian and aesthetic functionality doctrines.<sup>113</sup> The district court rejected the utilitarian functionality defense based on testimony from experts that "numerous functionally equivalent methods exist to seal a bottle."<sup>114</sup> Furthermore, the court found that Maker's Mark did not intend for its wax seal to serve any function.<sup>115</sup> With regard to aesthetic functionality, the district court found Cuervo's argument<sup>116</sup> unpersuasive and concluded that red is "not the only pleasing color of wax that competitors may employ on their product, nor does it put competitors at a significant non-reputation related disadvantage to be prevented from using red dripping wax."<sup>117</sup> Therefore, the court found that aesthetic functionality was inapplicable and did not invalidate Maker's Mark's trademark.<sup>118</sup> Unhappy with the decision, Cuervo appealed.<sup>119</sup>

## 2. *The Sixth Circuit Limits Red Dripping Wax Seals to Maker's Mark*

In an opinion that begins with the line, "All bourbon is whiskey, but not all whiskey is bourbon," Judge Boyce upheld the district court's decision to protect Maker's Mark's red dripping wax seal and also granted an injunction barring Cuervo from using a similar dripping wax seal.<sup>120</sup> Relying on the Supreme Court's discussion of aesthetic functionality in *TrafFix*, the Sixth Circuit stated that "where an aesthetic feature (like color), serves a significant

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111. *Id.*

112. *Maker's Mark I*, 703 F. Supp. 2d 671, 682 (W.D. Kent. 2010). Note that Maker's Mark brought a separate case before the district court concerning Cuervo's use of all red wax seals. *Id.* at 682 n.5.

113. *Id.* at 684–86.

114. *Id.* at 685.

115. *Id.*

116. Memorandum in Support of Defendants' Motion for Partial Summary Judgment at 15, *Maker's Mark I*, 703 F. Supp. 2d 671 (W.D. Kent. 2010) (No. 303CV00093), 2008 WL 2543463 (Cuervo argued that "[p]roduct functionality may encompass aesthetic features which confer benefits and cannot practically be duplicated by the use of alternative designs").

117. *Maker's Mark I*, 703 F. Supp. 2d at 686. The court further stated that "[t]here are other ways of making a bottle look artisanal or unique" and that it was not convinced that it would be difficult or costly to design around Maker's Mark's wax seal. *Id.*

118. *Id.* at 687. The district court thus declined to address if the aesthetic functionality doctrine is valid in the Sixth Circuit because the court found the doctrine inapplicable in this case. *Id.* at 687 n.15.

119. *Maker's Mark II*, 679 F.3d 410, 417 (6th Cir. 2012).

120. *Id.* at 414, 419.



function . . . courts should examine whether the exclusive use of that feature by one supplier would interfere with legitimate competition.”<sup>121</sup> Next, the court put forth two tests under the competition theory of functionality: the comparable alternatives test and the effective competition test.<sup>122</sup> The comparable alternatives test asks whether protecting certain features would leave enough comparable alternatives for competitors to use.<sup>123</sup> The effective competition test asks whether protecting certain features would hinder a competitor’s ability to compete effectively in the market.<sup>124</sup> After the court defined these tests, the court agreed with the district court on its findings and concluded that aesthetic functionality was not applicable here.<sup>125</sup> The court did not conduct its own factual analysis regarding aesthetic functionality but instead relied on the district court’s findings.<sup>126</sup> Confusingly, the court questioned the validity of the doctrine in the Sixth Circuit choosing not to affirmatively recognize the doctrine while still applying it.<sup>127</sup> The court concluded that “even assuming we were to recognize aesthetic functionality doctrine, regardless of which test we would apply under that doctrine . . . Cuervo’s appeal on this claim does not succeed.”<sup>128</sup> Therefore, the court found that Maker’s Mark’s trademark was valid and that the company had exclusive use of the red dripping wax seal on all alcoholic beverage bottles.<sup>129</sup>

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121. *Id.* at 418 (quoting *Antioch Co. v. W. Trimming Corp.*, 347 F.3d 150, 155 (6th Cir. 2003)).

122. *Id.* The court looked to a previous Sixth Circuit case, *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*, which explained that the two most common tests of aesthetic functionality under the competition theory were the comparable alternatives test and the effective competition test. *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*, 280 F.3d 619 (6th Cir. 2002). The court in *Abercrombie & Fitch Stores, Inc.* had relied on Mitchell M. Wong’s article, *The Aesthetic Functionality Doctrine and the Law of Trade Dress Protection*, to support its use of these tests. *Id.*; see also Wong, *supra* note 28, at 1144–49. Wong notes that the competition theory “is currently the prevailing theory in the courts and is embraced by the Restatement (Third) of Unfair Competition.” Wong, *supra* note 28, at 1142. The Identification Theory, the original theory of functionality, was applied in *Pagliero* and has in the past years gone out of favor. *Id.* at 1132, 1142. Wong explains that “the competition theory allows more features to be trademarked than the identification theory.” *Id.* at 1144.

123. *Maker’s Mark II*, 679 F.3d at 418 (quoting *Abercrombie & Fitch Stores, Inc.*, 280 F.3d at 642).

124. *Id.* Notably, the court applies these tests without decisively the aesthetic functionality doctrine. *Id.*

125. *Id.* at 419; see *supra* Section II.A.1.

126. *Maker’s Mark II*, 679 F.3d at 418–19.

127. *Id.* at 418.

128. *Id.*

129. *Id.* at 425.

## B. LOUBOUTIN: A RED-LEATHER DECISION THAT PLEASURES EVERYONE

Figure 2: Louboutin's Red Sole v. YSL's Red Shoe<sup>130</sup>

In *Louboutin*, the court examined whether a shoe company can trademark the color red on the outsole of its shoes, and if so, whether an entirely red shoe infringes on that mark.<sup>131</sup> Since 1992, Christian Louboutin has painted the outsides of his women's high-heeled shoes with a high-gloss red lacquer.<sup>132</sup> Louboutin's unique design has paid off over the years by capturing the attention of the high-fashion industry. Film stars, A-list celebrities, and many other consumers pay "as much as \$1000" to own a pair of the red-soled shoes.<sup>133</sup> In 2008, Louboutin registered his red outsole as a trademark with the U.S. Patent and Trademark Office ("USPTO").<sup>134</sup> As a result of his marketing efforts, Louboutin's red sole is today "instantly recognizable, to those in the know, as Louboutin's handiwork."<sup>135</sup> In 2011, Yves Saint Laurent (YSL)—another fashion powerhouse—created a line of monochrome shoes in a variety of colors: purple, green, yellow, and red.<sup>136</sup> Each shoe featured the same color on the entire shoe. For example, the red version is all red; including the insole, heel, upper, and outsole.<sup>137</sup> YSL's decision to create shoes with red outsides caught the attention of Louboutin,

130. *Christian Louboutin and Yves Saint Laurent Finally Resolve the "Red Sole" Battle*, FOOYOH (Oct. 17, 2012), [http://fooyoh.com/iamchic\\_fashion\\_fashionshow/8055637](http://fooyoh.com/iamchic_fashion_fashionshow/8055637).

131. *Louboutin II*, 696 F.3d 206, 211–12 (2d Cir. 2012).

132. *Id.* at 213.

133. *Louboutin I*, 778 F. Supp. 2d 445, 447–48 (S.D.N.Y. 2011).

134. *Louboutin II*, 696 F.3d at 211–12.

135. *Id.* at 213 (quoting the district court's finding that Louboutin's efforts have led to widespread recognition of his red sole shoes) (internal quotation marks omitted).

136. *Id.*

137. *Id.*

who worried that consumers would be confused by similarity between the two shoes.<sup>138</sup>

1. *District Court Litigation*

Louboutin initiated a lawsuit against YSL alleging trademark infringement and requesting a preliminary injunction against YSL barring marketing of any shoe with the identical red used by Louboutin or any red that could potentially cause consumer confusion.<sup>139</sup> YSL responded by seeking cancellation of Louboutin's mark on the grounds that red outsoles are aesthetically functional.<sup>140</sup> The district court denied Louboutin's request for an injunction and also stated a *per se* rule that color could not be protected by trademark in the fashion industry.<sup>141</sup>

The court reasoned that significant non-trademark functions existed in choosing the red color for the outsoles of the Louboutin shoes, including that the color red is sexy, engaging, and attracts men to women who wear the shoes.<sup>142</sup> Furthermore, the court reasoned that the use of the red outsoles served non-trademark functions other than source identifying and that protection would significantly hinder competition.<sup>143</sup> In its analysis, the district court considered implications beyond the high-fashion shoe market and beyond the color red on the outsole. The court envisioned a world in which—if protection was granted—Louboutin would be able to claim exclusive use of the particular shade of the color red on all shoes and possibly even other clothing.<sup>144</sup> Therefore, the court found the outsoles aesthetically functional.<sup>145</sup> Louboutin appealed the district court's decision.<sup>146</sup>

2. *The Second Circuit Reverses the Per Se Rule that Colors are Aesthetically Functional in Fashion*

The Second Circuit established a threefold functionality analysis. An inquiry regarding aesthetic functionality only occurs if the product feature first passes the test for utilitarian functionality.<sup>147</sup> First, courts should

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138. *Id.*

139. *Id.*

140. *Id.* at 214.

141. *Louboutin I*, 778 F. Supp. 2d 445, 453–57 (S.D.N.Y. 2011).

142. *Id.* at 453–54 (reasoning that “[t]o attract, to reference, to stand out, to blend in, to beautify, to endow with sex appeal—all comprise nontrademark functions of color in fashion”).

143. *Id.*

144. *Id.* at 454.

145. *Id.* at 457.

146. *Louboutin II*, 696 F.3d at 215.

147. *Id.* at 220.

“address the two prongs of the *Inwood* test: asking whether the design feature is either (1) essential to the use or purpose or (2) affects the cost or quality of the product at issue.”<sup>148</sup> Next, courts should then turn to the competition inquiry set forth in *Qualitex* and ask whether the protected use would have a significant effect on competition.<sup>149</sup> According to the Second Circuit, this competition inquiry should only be made if the design passes the “traditional functionality” test, referring to utilitarian functionality.<sup>150</sup> Furthermore, the court noted that an ornamental feature is aesthetically functional and ineligible for protection when protection of the feature would significantly hinder competition, but clarified that “distinctive and arbitrary arrangements of predominantly ornamental features that do *not* hinder potential competitors from entering the same market with differently dressed versions of the product are non-functional[,] and [are] hence eligible for [trademark protection].”<sup>151</sup> After finding that the district court had not applied the aesthetic functionality test properly, the court reversed the district court’s *per se* rule.<sup>152</sup> Then, the court modified *Louboutin*’s trademark only to extend to the use of a red sole that contrasts with the adjoining upper portion of the shoe and ordered the USPTO to modify the mark accordingly.<sup>153</sup>

Not only did the Second Circuit find against the *per se* rule of functionality for color in the fashion industry, but it also set out considerations important in applying the aesthetic functionality doctrine in other arenas.<sup>154</sup> For example, the court reasoned that in making the determination that a product feature is aesthetically functional, “courts must carefully weigh the competitive benefits of protecting the source-identifying aspects of a mark against the competitive costs of precluding competitors from using that feature.”<sup>155</sup> Because the aesthetic function and branding success could be difficult to distinguish, this analysis must be highly fact specific.<sup>156</sup> The court continued with the recognition that in conducting the aesthetic functionality inquiry, courts must consider both the trademark

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148. *Id.*

149. *Id.*

150. *Id.*

151. *Id.* at 222 (quoting *Fabrication Enters., Inc. v. Hygienic Corp.*, 64 F.3d 53, 59 (2d Cir. 1995 (quoting *Stormy Clime Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 977 (2d Cir. 1987)) (internal quotation marks omitted) (emphasis added).

152. *Id.* at 223–24.

153. *Id.* at 228. The court did not address whether the modified mark would be functional. See Ryan Davis, *USPTO Rebuffs Louboutin Bid to Broaden Red Sole Mark*, LAW360 (Jan. 18, 2013, 5:51 PM), <http://www.law360.com/ip/articles/408586.f>.

154. *Louboutin II*, 696 F.3d. at 221–24.

155. *Id.* at 222 (internal quotation marks omitted).

156. *Id.*

holder's right to enjoy benefits of its efforts and the public's right to a "vigorously competitive market."<sup>157</sup> The court also clarified that the functionality defense does not guarantee the greatest range for creative outlets but only the ability to compete fairly in the market.<sup>158</sup>

### III. THE DIFFERENCE BETWEEN BOURBON AND SHOES

The recent decisions in the Sixth and Second Circuits have left trademark owners asking whether the aesthetic functionality doctrine is going to be a viable legal defense, and if so, how the doctrine will evolve. The Sixth Circuit in *Maker's Mark* declined to explore aesthetic functionality as it applies to the red dripping wax seal and instead adopted the district court's cursory reasons of why the dripping wax seal was not aesthetically functional. Choosing not to affirmatively recognize a much-needed doctrine in intellectual property, the question remains whether the doctrine is a viable defense in the Sixth Circuit.<sup>159</sup> Conversely, the Second Circuit in *Louboutin* chose to accept aesthetic functionality and the Supreme Court's rule in *TrafFix* while adding clarity to the future of aesthetic functionality. Although each circuit analyzed the color red and whether it was aesthetically functional, their analyses differed significantly.

The Sixth Circuit should have fully accepted aesthetic functionality as an important doctrine in trademark law. Instead, the court in *Maker's Mark* coyly noted that it had not yet adopted aesthetic functionality nor chosen which test(s) it would apply if it did adopt the doctrine.<sup>160</sup> Then, it proceeded to describe the tests under aesthetic functionality that it would use and the outcome under those tests.<sup>161</sup> Structuring its opinion this way does not provide helpful guidance to courts, trademark owners, or potential infringers. Of course, one could argue that the Sixth Circuit had already provided direction in this regard. In *Abercrombie & Fitch Stores, Inc.*,<sup>162</sup> the Sixth Circuit also dealt with the doctrine of aesthetic functionality. In a footnote explaining its acceptance of the competition theory, the court expressly adopted aesthetic functionality, contrary to its claims in *Maker's Mark*.<sup>163</sup> In *Abercrombie & Fitch Stores, Inc.*, the court cited *Antioch Co. v. W. Trimming*

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157. *Id.*

158. *Id.* at 223.

159. See CALLMANN *supra* note 2, § 19:9 n.46.

160. See *Maker's Mark II*, 679 F.3d 410, 418 (6th Cir. 2012).

161. See *id.*

162. *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*, 280 F.3d 619, 641 (6th Cir. 2002).

163. See *id.* at n.16.

*Corp.*<sup>164</sup> for support.<sup>165</sup> Although the court in *Antioch Co.* discussed Thomas McCarthy's unfavorable view on aesthetic functionality, it did not expressly find the aesthetic functionality doctrine invalid.<sup>166</sup> Furthermore, the *Antioch Co.* case concerned utilitarian functionality and not aesthetic functionality, so the court's comments on McCarthy's views could be considered dicta on the subject of aesthetic functionality. Conversely, the court in *Abercrombie & Fitch Stores, Inc.* specifically stated that aesthetic functionality governed.<sup>167</sup> Given its inconsistent statements, the Sixth Circuit has not clearly announced its stance on aesthetic functionality. The *Maker's Mark* case provided the Sixth Circuit an important opportunity to affirm the doctrine, but instead the court questioned the validity of the doctrine.<sup>168</sup>

Additionally, the court in *Maker's Mark* did not allocate the space needed to conduct an in-depth fact-specific analysis, which the *Louboutin* court concluded is key to the application of aesthetic functionality.<sup>169</sup> Because this area of law lacks clarity and other courts will look to the *Maker's Mark* decision for guidance on the doctrine, the Sixth Circuit should have explained clearly and concisely why the red dripping wax seal was not aesthetically functional.<sup>170</sup> The court does not examine the industry in question or how an injunction on the use of the dripping wax seal would affect competitors.<sup>171</sup> Moreover, the court does not state why an injunction would not put competitors at a significant non-reputation related disadvantage.<sup>172</sup>

In applying aesthetic functionality to the red dripping wax seal, *Maker's Mark's* analysis fell flat. As with the heart-shaped candy box for Valentine's day, the purpose of the dripping wax seal in the alcohol industry is to convey emotions that are not easily conveyed by other bottle seals.<sup>173</sup> The Sixth

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164. *Antioch Co. v. W. Trimming Corp.*, 347 F.3d 150, 156 (6th Cir. 2003).

165. *Maker's Mark II*, 679 F.3d at 418.

166. *See Antioch Co.*, 347 F.3d at 156.

167. *Abercrombie & Fitch Stores*, 280 F.3d at 641.

168. *See Maker's Mark II*, 679 F.3d at 418–19.

169. *See Louboutin II*, 696 F.3d 206, 222 (2d Cir. 2012); *Maker's Mark II*, 679 F.3d at 418.

170. *See* Brian Wright, *Sixth Circuit Declines to Clarify Aesthetic Functionality Test (or Even Whether the Doctrine has been Adopted in this Circuit): Maker's Mark's Wax Seal Trademark Protected and not Functional*, FARUKI IRELAND & COX P.L.L. INTELLECTUAL PROPERTY, (May 21, 2012 3:10 PM), <http://businesslitigationinfo.com/intellectual-property/archives/sixth-circuit-declines-to-clarify-aesthetic-functionality-test-or-even-whether-the-doctrine-has-been-adopted-in-this-circuit-makers-marks-wax-seal-trademark-protected-and-not-functional/>.

171. *See Maker's Mark II*, 679 F.3d at 419.

172. *See id.*

173. *See supra* notes 59–63 and accompanying text; *Adhesive Wax Seals*, NOSTALGIC IMPRESSIONS, [http://www.nostalgicimpressions.com/Adhesive\\_Wax\\_Seals\\_s/4.htm](http://www.nostalgicimpressions.com/Adhesive_Wax_Seals_s/4.htm) (last visited Feb. 11, 2013).

Circuit in *Maker's Mark* concluded that the red dripping wax seal was not aesthetically functional due to the availability of other alternative seals for competitors in the market.<sup>174</sup> Yet as numerous witnesses testified, dripping wax seals in various colorings including red, “communicate to consumers that the product is hand-crafted, vintage, and of high quality—and do so in a way that cannot practically be duplicated by the use of alternative designs.”<sup>175</sup> By continuing protection of Maker's Mark's red dripping wax seal, the court granted Maker's Mark a monopoly over a way to convey a message to consumers that its product is artisanal and handcrafted.<sup>176</sup> Other alcoholic beverage companies, beyond the bourbon industry—where real confusion might have existed—can now only use straight wax seals of red color.<sup>177</sup> The court took away the ability to convey the style and nostalgia that consumers want while sipping a glass of liquor from an old fashioned bottle of whiskey, bourbon, or tequila.

As the Second Circuit noted in *Louboutin*, “a product feature's successful source indication can sometimes be difficult to distinguish from the feature's aesthetic function.”<sup>178</sup> However, in *Maker's Mark*, the red wax should have been found to be aesthetically functional because colors other than red do not convey the same message of artisanal or familiarity as the red color on a wax seal.<sup>179</sup> Wax seals have historically been of the color red or black.<sup>180</sup> Maker's Mark knew<sup>181</sup> or should have known this when they created their name and bottle, and Maker's Mark probably used the red dripping wax seal

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174. *Maker's Mark II*, 679 F.3d at 418.

175. See Brief for the Appellants at 35, *Maker's Mark II*, 679 F.3d 410 (6th Cir. 2012) (Nos. 10-5508, 10-5586, 10-5819), 2011 WL 5320863.

176. See *Bar Fight: Cuervo and Maker's Mark Duke it Out Over Red Wax*, BLOOMBERG LAW – YOUTUBE (May 23, 2012), <http://www.youtube.com/watch?v=9Pgl4V9AURU>. Just after the seven minute mark of this audio, Chris Springman, law professor at the University of Virginia School of Law tells Bloomberg Law's Josh Block about the case and that the wax seal sends a message about the quality of the liquor as well as a sense that the product is handcrafted. *Id.*

177. See Jonathan Stempel, *Update 1 – Maker's Mark Wax Seal Deserves Trademark – Court*, REUTERS, (May 9, 2012 2:59 PM), <http://www.reuters.com/article/2012/05/09/makers-mark-seal-lawsuit-idUSL1E8G9G2U20120509> (stating that Maker's Mark's dripping seal is “off limits to competitors”).

178. See *Louboutin II*, 696 F.3d 206, 222 (2d Cir. 2012).

179. See Christine Meyer, *The History of Melting Wax for Seals*, EHOW, [http://www.ehow.com/about\\_6584557\\_history-melting-wax-seals.html](http://www.ehow.com/about_6584557_history-melting-wax-seals.html) (last visited Jan. 30, 2013) (noting that the most common colors for wax seals were red and black, the colors used by artisans since the 11th century).

180. See *id.*

181. See *Wax Museum History: 1958 supra* note 104 (stating that Samuel's wife got the idea for the red dripping wax from an antique cognac bottle).

due to its artisanal connotations.<sup>182</sup> If the Sixth Circuit had found Maker's Mark's dripping red wax seal functional, the effect would be that other alcoholic beverage companies could use a dripping wax seal.<sup>183</sup> Importantly, this would not take away Maker's Mark right to sell its bourbon, and most likely Maker's Mark would still keep its protection on its overall bottle design. Maker's Mark would not lose its ability to protect its goodwill, but would lose its ability to monopolize an aesthetically pleasing way to seal a bottle.<sup>184</sup>

A few months after *Maker's Mark*, the Second Circuit's *Louboutin* decision removed critics' fears that aesthetic functionality would be applied too broadly in the fashion industry, leaving little room for creativity in source indication. By interpreting the Supreme Court's language on aesthetic functionality in both *TrafFix* and *Qualitex* as validating the doctrine, the Second Circuit paved the way for other circuits to apply the aesthetic functionality doctrine.<sup>185</sup> Moreover, the court managed to do this without granting an unlimited monopoly for Louboutin on the color red. Instead, the court narrowed its finding of protection only to the outsole of the shoes and therefore allowed the fashion industry to continue to use the aesthetically pleasing red color in other ways.<sup>186</sup> This Solomonian result pleased everyone—the court upheld Louboutin's trademark but allowed YSL to sell its all-red shoes.<sup>187</sup>

The Second Circuit correctly acknowledged the purpose of the functionality doctrine: to prevent trademark law from granting a monopoly

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182. One of Maker's Mark's arguments against finding its dripping wax seal aesthetically functional—allowing other alcoholic beverage companies to use a dripping wax seal—could be the amount of time, money, and effort the company spent in creating its brand and image around this dripping wax seal. This argument fails because functionality disregards source indication in its analysis. If courts allowed perpetual monopolies for any design that came *first* even if it was functional, companies would start using and commercializing features that they knew would hinder competition from fellow companies in their market.

183. See *Bar Fight: Cuervo and Maker's Mark Duke it Out Over Red Wax*, *supra* note 176. Just after the three minute and thirty second mark, Professor Springman explains that if a mark is found functional, the trademark is invalid. Therefore, it is available to be freely copied.

184. If a feature is found functional, it loses trademark protection and therefore its monopoly over use of the feature.

185. See *Louboutin II*, 696 F.3d 206, 221 (2d Cir. 2012).

186. *Id.* at 224 (embracing the view that “[t]he purpose of the functionality defense is to prevent advances in functional design from being *monopolized* by the owner of the mark . . . in order to encourage competition and the broadest dissemination of useful design features” (internal quotation marks omitted)).

187. Hannah Elliott, *Both Sides Claim Victory in YSL v. Louboutin Shoe Case*, FORBES (Sept. 5, 2012, 5:31 PM), <http://www.forbes.com/sites/hannahelliott/2012/09/05/both-sides-claim-victory-in-ysl-v-louboutin-shoe-case/>.



to a useful product feature.<sup>188</sup> The court noted that both forms of functionality—utilitarian and aesthetic—are needed to prevent problematic monopolies and protect the public domain.<sup>189</sup> This reasoning is in line with the original creation of the doctrine by the courts.<sup>190</sup> By accepting aesthetic functionality and reiterating its purpose to protect against unwarranted monopolies, the Second Circuit legitimized aesthetic functionality. However, the court did not stop there; it also explained that aesthetic functionality should be examined only if a product feature has passed the utilitarian functionality test.<sup>191</sup> The Second Circuit rightly stated this standard and gave greater guidance on how to apply aesthetic functionality.<sup>192</sup>

Conducting a thorough, fact-specific analysis, the Second Circuit held that a mark is aesthetically functional and therefore ineligible for trademark protection *only* if protection of the mark significantly undermines competitors' ability to compete in the relevant market.<sup>193</sup> The court explained that it must balance the “‘competitive benefits of protecting the source-identifying aspects’ of a mark against the ‘competitive costs of precluding competitors from using the feature.’”<sup>194</sup> It also noted some concerns about confusion of successful source identification and functionality.<sup>195</sup> Being aware of these concerns stops courts from finding a product feature aesthetically functional “merely because it denotes the product’s desirable source.”<sup>196</sup> Although the fact that the feature indicates a product’s source is not dispositive in the aesthetic functionality analysis, it is important not to confuse good branding with features needed to compete in the market.<sup>197</sup> Furthermore, the Second Circuit crucially noted that the doctrine does not guarantee the greatest range for competitors’ creative outlets but instead only the ability to compete fairly in a given market.<sup>198</sup>

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188. See *Louboutin II*, 696 F.3d at 218.

189. See *id.* at 218–19.

190. See *supra* Part I.

191. See *Louboutin II*, 696 F.3d at 219–20.

192. Lisa Shuchman, *Louboutin Red-Shoe Decision Clarifies ‘Aesthetic Functionality’ IP Doctrine*, CORPORATE COUNSEL (Sept. 7, 2012), [http://www.law.com/corporatecounsel/PubArticleCC.jsp?id=1202570408982&Louboutin\\_RedShoe\\_Decision\\_Clarifies\\_Aesthetic\\_Functionality\\_IP\\_Doctrine&slreturn=20121026213527](http://www.law.com/corporatecounsel/PubArticleCC.jsp?id=1202570408982&Louboutin_RedShoe_Decision_Clarifies_Aesthetic_Functionality_IP_Doctrine&slreturn=20121026213527).

193. *Louboutin II*, 696 F.3d at 222. In an article written about the *Louboutin* decision, attorney Michelle Mancino Marsh of Kenyon & Kenyon explains that the Second Circuit’s decision will help other courts because it sets out a test. Shuchman, *supra* note 192.

194. See *Louboutin II*, 696 F.3d at 222.

195. See *id.*

196. See *id.*

197. See *id.*

198. See *id.* at 223–24.

The straightforward test described and applied by the court can accomplish the sometimes-conflicting consumer goals of “being assured enough product differentiation to avoid confusion as to source and in being afforded the benefits of competition among producers.”<sup>199</sup> Although the Second Circuit did not apply the functionality test to Louboutin’s court-modified mark (limited to the red-sole only), the court’s test creates an opportunity for other courts to apply the doctrine effectively because the opinion clarifies what considerations are important.<sup>200</sup> Moreover, the Second Circuit confirms that the analysis is highly fact-specific.<sup>201</sup> This approach serves as an answer to critiques that the doctrine is too broad and is over-inclusive because it provides courts with the flexibility needed to address different cases of aesthetic functionality. The Second Circuit’s analytic framework prevents courts from creating per se rules forbidding protection of colors and encourages courts to do a more fact-specific analysis that considers the characteristics of the market and whether or not a particular feature has aesthetic value that would be unfair to protect.

*Louboutin* proves an exemplary application of the aesthetic functionality doctrine. In the fashion industry, color is likely to be labeled as functional because it is perceived as available to everyone in the industry.<sup>202</sup> As both the district court and Second Circuit noted, “color can serve as a tool in the palette of a designer, rather than as mere ornamentation.”<sup>203</sup> This leads to the possibility of color being useful to the creator to express a value that consumers want, such as red being known for energy, passion, and sex appeal.<sup>204</sup> Therefore, the Second Circuit correctly limited Louboutin’s trademark to the shoe’s red sole only. The court’s holding ensures that other competitors in the high-fashion shoe industry can still use the vibrant red color.

Louboutin’s red outsole differs from Maker’s Mark’s red dripping wax seal because while Louboutin created the distinction that the red outsole is synonymous with quality, Maker’s Mark used an existing symbol of quality and artisanal value and incorporated it in the design of its bourbon bottle.<sup>205</sup>

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199. *See id.* at 224 (quoting *Stormy Clime Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 978–79 (2d Cir. 1987)).

200. *See id.* at 212.

201. *See id.* at 222.

202. *See Louboutin I*, 778 F. Supp. 2d 445, 450 (S.D.N.Y. 2011).

203. *See Louboutin II*, 696 F.3d at 223 (citing *Louboutin I*, 778 F. Supp. 2d at 452–53).

204. *See Louboutin I*, 778 F. Supp. 2d at 452.

205. *See* Tyler Baker and Ted Max, *Second Circuit Digs its Heels into Louboutin Dispute; Finds ‘Red Sole’ Trademark Protectable, but Limited in Scope*, FASHION & APPAREL L. BLOG, (Sept. 19, 2012), <http://www.fashionapparelblog.com/2012/09/articles/ipbrand-protection/>

Louboutin constructed a design to indicate that the shoes with the red outsoles were shoes made by Louboutin. Consumers interested in high fashion shoes do not buy the red sole shoes because they find two-toned shoes aesthetically pleasing; they buy the shoes because they want to be seen wearing Louboutins.<sup>206</sup> Conversely, part of the appeal of Maker's Mark's bourbon is that the red dripping wax indicates value, not just source. Although the wax does indicate that the bourbon is made by Maker's Mark, it also attracts consumers to purchase the bottle of bourbon because of the artisanal quality that the red wax seal conveys.<sup>207</sup> Unlike Louboutin's red sole, the red dripping wax seal should be available to other competitors because it has an aesthetic value important to the industry and significant beyond source identification.

#### IV. CONCLUSION

For many years, courts, practitioners, academics, and the public have misunderstood the doctrine of aesthetic functionality. Criticizing it as confusing and unnecessary, some courts refused to recognize the doctrine, therefore allowing the possibility of indefinite protection for product features intended only for the limited protection of patent or copyright law. In 2001, the Supreme Court, in its *TrafFix* decision legitimized the doctrine by offering its view on the test that should be applied. In 2012, application of the aesthetic functionality doctrine by the Second Circuit and the Sixth Circuit illuminated the fact that doctrine has an important place within trademark law and intellectual property more generally. Although the Sixth Circuit failed to apply the aesthetic functionality test properly and did not explicitly recognize the doctrine in its Circuit, the Second Circuit provided clarity on how the doctrine should be applied. In the future, courts should avoid following the Sixth Circuit's analysis in *Maker's Mark* because the court wrongly decided that the red dripping wax seal was not functional. Moreover, the Sixth Circuit did not conduct an in-depth factual analysis, which is critical

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second-circuit-digs-its-heels-into-louboutin-dispute-finds-red-sole-trademark-protectable-but-limited-in-scope/.

206. See Irene Rubaum-Keller, *Are Louboutins Really Worth the Splurge? An Investigative Report (Sort Of)*, THE BLUSH (Mar. 27, 2012), <http://theblush.com/2012/03/27/are-these-louboutin-shoes-really-worth-the-money/>.

207. See Aaron B. Thalwitzer, *Maker's Mark Trademark Battle: Jose Cuervo Can't Use Dripping Red Wax*, TACTICALIP (June 4, 2012 6:00 PM), <http://tacticalip.com/2012/06/04/makers-mark-trademark-battle-jose-cuervo-cant-use-dripping-red-wax/> ("Anyone who has seen a bottle of Maker's Mark knows the temptation. You just want to touch that shiny, rubbery, and oh-so-red wax with its I-don't-give-a-damn drips around the neck of the bottle.").

to the application of the aesthetic functionality doctrine. Rather, courts should follow the precedent set by the Second Circuit in *Louboutin*, because it serves as a model for how to thoroughly and carefully apply the Supreme Court's aesthetic functionality test.