

Nos. 09-16412-AA, 10-10092-A

IN THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

THE BOARD OF TRUSTEES OF THE
UNIVERSITY OF ALABAMA, a public corporation,

Appellee/Cross-Appellant,

v.

NEW LIFE ART, INC., and DANIEL A. MOORE,

Appellants/Cross-Appellees.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE
NORTHERN DISTRICT OF ALABAMA, WESTERN DIVISION
CIVIL ACTION NO. CV-05-00585

BRIEF OF AMICI CURIAE

**UNIVERSITY OF ARKANSAS
AUBURN UNIVERSITY
BOISE STATE UNIVERSITY
UNIVERSITY OF CINCINNATI
CLEMSON UNIVERSITY
UNIVERSITY OF CONNECTICUT
DUKE UNIVERSITY
FLORIDA STATE UNIVERSITY
UNIVERSITY OF FLORIDA
UNIVERSITY OF GEORGIA
GEORGIA INSTITUTE OF TECHNOLOGY
BOARD OF TRUSTEES OF THE UNIVERSITY OF ILLINOIS ACTING
FOR AND ON BEHALF OF THE UNIVERSITY OF ILLINOIS,
URBANA-CHAMPAIGN**

**UNIVERSITY OF KANSAS
UNIVERSITY OF KENTUCKY
LOUISIANA STATE UNIVERSITY
REGENTS OF THE UNIVERSITY OF MINNESOTA
UNIVERSITY OF MISSISSIPPI
THE CURATORS OF THE UNIVERSITY OF MISSOURI
UNIVERSITY OF NORTH CAROLINA
UNIVERSITY OF NOTRE DAME DU LAC
UNIVERSITY OF OKLAHOMA
UNIVERSITY OF SOUTH CAROLINA
UNIVERSITY OF TEXAS
UNIVERSITY OF UTAH
VANDERBILT UNIVERSITY
WEST VIRGINIA UNIVERSITY
UNIVERSITY OF WISCONSIN**

**IN SUPPORT OF APPELLEE/CROSS-APPELLANT THE BOARD OF
TRUSTEES OF THE UNIVERSITY OF ALABAMA, a public corporation,
AND REVERSAL IN PART**

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Nos. 09-09-16412-AA, 10-10092-A
The Board of Trustees of the University of Alabama v. New Life Art, Inc.

Certificate of Interested Persons and Corporate Disclosure Statement

The interested persons and entities are as follows:

1. University of Arkansas
2. Auburn University
3. Boise State University
4. University of Cincinnati
5. Clemson University
6. University of Connecticut
7. Duke University
8. Florida State University
9. University of Florida
10. University of Georgia
11. Georgia Institute of Technology
12. Board of Trustees of the University of Illinois acting for and on behalf of the University of Illinois, Urbana-Champaign
13. University of Kansas
14. University of Kentucky
15. Louisiana State University

Certificate of Interested Persons and Corporate Disclosure Statement
(continued)

16. Regents of the University of Minnesota
17. University of Mississippi
18. The Curators of the University of Missouri
19. University of North Carolina
20. University of Notre Dame du Lac
21. University of Oklahoma
22. University of South Carolina
23. University of Texas
24. University of Utah
25. Vanderbilt University
26. West Virginia University
27. University of Wisconsin
28. Pirkey, Louis T. and Hightower, Susan J., Pirkey Barber LLP
(attorneys for amici)

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Identity of the Amici Curiae

The following Amici Curiae (collectively, “Amici”) submit this brief in support of the Appellee/Cross-Appellant The Board of Trustees of the University of Alabama, a public corporation, in *University of Alabama Bd. of Trustees v. New Life Art Inc.*, CV 05-UNAS-PT-585-W (N.D. Ala. Nov. 2, 2009) (“District Court Opinion” or “Opinion”):

University of Arkansas
Auburn University
Boise State University
University of Cincinnati
Clemson University
University of Connecticut
Duke University
Florida State University
University of Florida
University of Georgia
Georgia Institute of Technology
Board of Trustees of the University of Illinois acting for and on behalf of the
University of Illinois, Urbana-Champaign
University of Kansas
University of Kentucky
Louisiana State University
Regents of the University of Minnesota
University of Mississippi
The Curators of the University of Missouri
University of North Carolina
University of Notre Dame du Lac
University of Oklahoma
University of South Carolina
University of Texas
University of Utah
Vanderbilt University
West Virginia University
University of Wisconsin

Statement of Interest of the Amici Curiae

Amici are major universities or their governing bodies. Some of these universities, namely Auburn, Florida, Florida State, Georgia, and Georgia Tech, reside within this Circuit. Others, namely Arkansas, Cincinnati, Clemson, UConn, Duke, Kentucky, LSU, Ole Miss, North Carolina, South Carolina, Vanderbilt, and West Virginia, play games regularly in this Circuit as members of the ACC, SEC, or Big East Conferences. The others of the Amici, namely Boise State, Illinois, Kansas, Minnesota, Missouri, Notre Dame, Oklahoma, Texas, Utah, and Wisconsin, are well-known within this Circuit as leading universities in the United States.

All of the Amici sponsor collegiate sporting events, including intercollegiate football games, as members of the National Collegiate Athletic Association. Among them, the Amici are members of the following athletic conferences: SEC, Big East, Big Ten, Big 12, ACC, Mountain West, and WAC. One (Notre Dame) is a major independent. The games of these teams are played throughout the United States.

Many thousands of persons attend the games of these universities, and millions more watch them on national or regional television. Replays of the games, or portions thereof, are broadcast in sports and news reports by television

stations all over the country. Photographs of game action are reproduced in hundreds of newspapers, magazines, and other publications.

Each of the Amici has its own particular combination of specific school colors. These colors are prominently displayed on the team uniforms as well as on the uniforms of student support groups such as bands and cheerleaders. The color combinations are viewed by those watching the games live as well as those watching on television or seeing replays or photographs. The color combinations are source identifiers, i.e., they are marks, because they serve to identify the team of one university and distinguish that team from others.

To accommodate its legion of fans who desire to identify with the team, each Amicus has a licensing program whereby it licenses use of its marks. The licensed marks are typically used in the color combination of the particular university. Licensed products such as T-shirts bearing the school colors of the university are often seen around campus and in many other places. The licensing program at each university allows the university to control the quality of the licensed products, so that, for example, messages detrimental to good sportsmanship can be prohibited. The licensing program also provides an important and increasing source of revenue to the university at a time when other revenue sources are being curtailed. These revenues often support athletics

programs, as well as scholarships for students and academic and scientific research.

Like Plaintiff-Appellee The Board of Trustees of the University of Alabama (“Appellee”), many of the Amici have experienced the unlicensed use of their marks.

The Amici therefore have trademark interests similar to those of the Appellee, and believe the Court should have the benefit of this brief on two matters of trademark law that are extremely important to the Amici: (1) that university color marks are not “weak marks,” and (2) that university color marks are not functional.

Source of Authority of Amici Curiae to File

Appellee consented to the filing of this brief, but Appellants did not. Therefore, a motion for leave of Court to file this brief is submitted herewith in accordance with FED. R. APP. P. 29(a).

Statement of the Issues

1. Did the District Court err in finding that Appellee’s color marks on its athletics uniforms are “weak,” or are such marks entitled to vigorous protection?
2. Did the District Court wrongly interpret the doctrine of trademark functionality as applied to the color marks used by universities on their athletics uniforms?

Summary of the Argument

Color schemes which serve as source identifiers have been recognized as trademarks for many years. Courts increasingly have acknowledged that university color schemes are non-functional and entitled to strong protection.

Argument

I. Image Control Is Critical to the Amici

Amici are major universities largely dependent on philanthropy – the generosity of multiple donors – to achieve their educational and related goals. The reputation or “image” of the Amici is critical in maximizing this philanthropy. Amici control their image, in part, by controlling those symbols that identify and distinguish them to the public – viz., their trademarks and service marks, which are typically presented in the specific school colors of each university, as well as those colors themselves.

The “product” the universities provide under their marks is quality education, enhanced by myriad extracurricular facets of the university experience: centuries of tradition, unique quality of campus life, and activities carried out by students and enjoyed by the wider community. Among the highest profile in the latter category are collegiate sporting events, the subject of the use of images of Alabama school uniforms by Defendants-Appellants New Life Art, Inc. and Daniel A. Moore (“Appellants”).

A. Fundamental Principle of Trademark Law: Control of One’s Image

A bedrock principle of trademark law is an owner’s right to control the use of its marks. This right furthers the twin functions of trademarks: serving the public need to rely on a mark as a symbol of source or sponsorship and providing mark owners the benefit of their economic investments. *See, e.g., Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995).

B. Amici Control Their Images through Licensing

Through licensing, i.e., permitting others to use the marks subject to the university’s standards of quality control, Amici are able to control the quality of products bearing their marks and prevent the projection of negative images of Amici to the public. Licensing also provides valuable resources to Amici.

Driven by the boom in television broadcasting of college sports that began in the 1970s, collegiate licensing is an important source of much-needed revenue to

support the educational missions of the Amici, with annual retail sales of college-licensed merchandise estimated at nearly \$4.3 billion worldwide in 2008. Jack Revoyr, *Non-Definitive History of Collegiate Licensing*, 88 TRADEMARK REP. 370, 371 (1998); *Top 100 Global Licensors*, LICENSE! GLOBAL, April 2009, 19, 22.¹ From a humble beginning – said to have been two dozen T-shirts printed with the University of California, Los Angeles brand in the early 1930s – hundreds of U.S. colleges and universities, including Amici, today license the commercial use of their name, mascot, and other marks. *See* Revoyr, 88 TRADEMARK REP. at 370-71.

C. Unauthorized Use of Amici’s Color Marks Threatens Their Ability To Control

Unauthorized use by third parties of the color marks of Amici threaten both key benefits derived from the right of Amici to control use of their marks. Without that right, Amici could not stop infringers from uses that appear to be approved by Amici but in fact are antithetical to their mission of education in a positive environment – an environment that instills in students a sense of good sportsmanship and fair play and reflects each university’s heritage and goals. In addition, Amici would lose crucial licensing revenues wrongfully taken by infringers who benefit from consumer desire for products associated with Amici.

¹ Available at <http://www.licensemag.com/licensemag/data/articlestandard//licensemag/172009/594392/article.pdf>.

Thus, protecting university color marks is not only doctrinally correct, as explained below, but also represents sound public policy.

II. Color Marks on University Athletic Uniforms Are Not “Weak Marks”

The District Court found that Appellee “has a weak mark as to the uniforms.” Addendum to Memorandum Opinion (“Addendum”), at 1 n.1, 4. Elaborating on this point, the District Court wrote: “The marks here concerned are the uniforms and their colors. These ‘marks’ do not lend themselves to TM type designations; nor would the general public usually consider them to be ‘marks.’” Opinion, at 12.

Ample case law shows the opposite to be the case. In fact, robust protection of these types of color marks and trade dress has become the norm.

Courts recognized that source-identifying color schemes could function as trademarks and merit protection as such long before the Supreme Court ruled in *Qualitex* that a single color could serve as a mark. In *Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 703 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982),² the Fifth Circuit held that, although a plaintiff could not preempt the use of red and yellow on lawn chemical packaging, it could “protect the combination of particular hues of these colors, arranged in certain

² Although not binding on this Court, *Chevron* is entitled to great weight because it is based on cases of the former Fifth Circuit that are binding precedent in the Eleventh Circuit. *AmBrit, Inc. v. Kraft Inc.*, 812 F.2d 1531, 1536 n.13 (11th Cir. 1986).

geometric designs, presented in conjunction with a particular style of printing, in such fashion that, taken together, they create a distinctive visual impression.” *See also National Ass’n of Blue Shield Plans v. United Bankers Life Ins. Co.*, 362 F.2d 374 (5th Cir. 1966) (concluding that BLUE SHIELD with a shield design was infringed by RED SHIELD with a similar shield design for medical insurance).

In discussing secondary meaning in *Bd. of Supervisors for La. State Univ. Agric. & Mech. College v. Smack Apparel Co.*, 550 F.3d 465 (5th Cir. 2008), *cert. denied*, 129 S. Ct. 2759 (2009), the Fifth Circuit agreed with the district court that the plaintiff universities’ marks (color schemes and other identifying indicia) were strong. The court noted “the importance generally placed on sports team logos and colors by the public”:

... [T]eam emblems and symbols are sold because they serve to identify particular teams, organizations, or entities with which people wish to identify. *See Boston Prof’l Hockey Ass’n v. Dallas Cap & Emblem Mfg., Inc.* [510 F.2d 1004, 1011 (5th Cir. 1975)]. We think this desire by consumers to associate with a particular university supports the conclusion that team colors and logos are, in the minds of the fans and other consumers, source indicators of team-related apparel. By associating the color and other indicia with the university, the fans perceive the university as the source or sponsor of the goods because they want to associate with that source.

Id. at 477-78.

Similarly, in *Texas Tech. Univ. v. Spiegelberg*, 461 F. Supp. 2d 510, 520 (N.D. Tex. 2006), Texas Tech University’s scarlet-and-black color scheme was found to have secondary meaning which identified and distinguished Texas Tech.

“Indeed, products which are sold in Lubbock, Texas, that bear the scarlet and black color scheme have become associated with a specific source – Texas Tech.” *Id.*

Smack and *Spiegelberg* continue the tradition of this Court’s opinion more than two decades earlier in *University of Georgia Athletic Ass’n v. Laite*, 756 F.2d 1535 (11th Cir. 1985). In *Laite*, the Court affirmed an injunction against sales of the defendants’ “Battlin’ Bulldog Beer,” repeatedly mentioning the fact that the infringing beer cans used Georgia’s red-and-black color scheme and pointing out that: “Had the cans of ‘Battlin’ Bulldog Beer’ been printed in different colors, or had the ‘Battlin’ Bulldog’ worn a different monogram on its sweater, we might have a different case. Instead, the cans are red and black, the colors of the University of Georgia, and the ‘Battlin’ Bulldog’ wears the letter ‘G.’” *Id.* at 1544.

The *Laite* Court explained that, under *Boston Professional Hockey Ass’n, Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004 (5th Cir.), *cert. denied*, 423 U.S. 868 (1975), the trademark infringement test of likelihood of confusion need not relate to the origin of the challenged **product**. “Rather, ‘confusion’ may relate to the public’s knowledge that the **trademark**, which is ‘the triggering mechanism’ for the sale of the product, originates with the plaintiff.” *Laite*, 756 F.2d at 1546. Appellee correctly argued in its motion for summary judgment that its color marks serve as the “triggering mechanism” for sales of products bearing those marks. *See*

also *Univ. of Pittsburgh v. Champion Prods. Inc.*, 686 F.2d 1040 (3d Cir.), *cert. denied*, 459 U.S. 1087 (1982).

Strong trade dress receives strong protection. *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1539 (11th Cir. 1986), *cert. denied*, 481 U.S. 1041 (1987). School color marks have become widely recognizable and very strong indicators of the source of university services. They are not “weak” marks.

III. The Appellee’s Color Marks Are Not Functional

The District Court ultimately did not find Appellee’s crimson-and-white color scheme to be functional. However, the District Court wrote: “Football uniform colors clearly perform a function. They help avoid confusion as to team members for the benefit of officials, opposing team members and spectators.” *Opinion*, at 12. Amici address the issue of functionality because they believe this interpretation of the doctrine of functionality in trademark law to be in error.

In Exhibit 5 to the *Opinion*, the District Court focused on the use of scarves by Harvard rowers in 1858. The District Court did not address the statement in the next paragraph of that exhibit that “the idea of using colors to *represent universities* was still new in the latter part of the 19th century.” *Id.* (emphasis added). As mentioned in Part I of its argument, the use and licensing of university colors has come a long way in the past 150 years, and particularly within the last few decades.

Of course, presumably every article of manufacture has some “function.” A T-shirt protects the upper part of the body from the elements and prevents rude exposure. Likewise, trademarks serve the function of identifying and distinguishing. *Vuitton Et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769, 774 (9th Cir. 1981).

The facts that competing football teams must (1) wear garments of some kind and (2) be able to distinguish each other in some way are a far cry from a conclusion that university color marks are functional as that term is used in trademark law.

A. University Color Marks Fail the Tests for Functionality

A product’s trade dress is protectable if it is “*primarily* non-functional.” *Epic Metals Corp. v. Souliere*, 99 F.3d 1034, 1038 (11th Cir. 1996). The functionality defense to trademark infringement arose to prevent use of the trademark laws to circumvent the patent laws, i.e., to obtain a perpetual monopoly on useful articles that otherwise could be protected by a limited-term patent. *See Qualitex*, 514 U.S. at 164. The defense was most relevant when protection was sought for product configurations such as those at issue in cases like *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001). The legitimate need

for competitors to use a *utilitarian* feature that is less expensive, of better quality, or more efficient to manufacture is the bedrock of the doctrine.³

The functionality doctrine serves two purposes. *Wilhelm Pudenz, GmbH v. Littlefuse, Inc.*, 177 F.3d 1204, 1207-08 (11th Cir. 1999). First, by ensuring that competitors remain free to copy useful product features, the doctrine prevents trademark law from undermining its own pro-competitive objectives. *Id.* Second, the functionality doctrine eliminates trademark monopolies of potentially unlimited duration on a product’s utilitarian features, thereby preventing trademark law from conflicting with patent law. *Id.* This second rationale is “particularly important.” *Id.*

The Supreme Court has established two tests for determining functionality. Under the first test, commonly referred to as the traditional test, “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.” *TrafFix*, 532 U.S. at 32 (quoting *Qualitex*, 514 U.S. at 165). Under the second test, which is commonly called the competitive necessity test, “a functional feature is one the ‘exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.’” *Id.* (quoting

³ It was not until 1998 that the word “functional” appeared in the Lanham Act. *See* 4A LOUIS ALTMAN & MALLA POLLACK, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS & MONOPOLIES § 26:6 n.16 (4th ed. 2007) (stating that prior to enactment of the Trademark Law Treaty Implementation Act of 1998, Pub. L. No. 105-330 (effective Oct. 30, 1998), “functional marks were held unregistrable by case law, though the Lanham Act was silent on the subject”).

Qualitex, 514 U.S. at 165). Where the design is functional under the traditional test, “there is no need to proceed further to consider if there is a competitive necessity for the feature.” *Id.* at 33.

In reality, however, university color marks serve neither function, and this case presents no real issue of *utilitarian* functionality. *Cf. Spiegelberg*, 461 F. Supp. 2d at 520 (rejecting the defendant’s argument that Texas Tech University’s scarlet-and-black color scheme is functional and stating: “The fact that a knit cap is scarlet and black or bears a ‘Double T’ does not affect the quality of the cap or its ability to keep one’s head warm.”).

A visit to a gym class in any school across America today would readily demonstrate that, just as was true with the Harvard rowers in 1858, any two different colors may be chosen to distinguish two competing teams. The difference of each team’s colors, regardless of what they are, is the functional characteristic, not the colors themselves. Each particular team’s colors contribute to its reputation and distinction and are not needed for the mere functionality of distinguishing teams on the field.

The benefits that flow from university color marks are marketing benefits. *See Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 428 (5th Cir. 1984) (rejecting “the suggestion that the doctrine of functionality insulates a second comer from

liability for copying the first comer's design whenever the second comer can merely cite marketing reasons to justify the copying.”).

Moreover, school colors signal the recognition and reputation of the particular school involved. This is precisely the type of function that the Supreme Court said is *not* implicated by the functionality doctrine. *Qualitex*, 514 U.S. at 169 (“The functionality doctrine . . . protects competitors against a disadvantage (*unrelated to recognition or reputation*) that trademark protection might otherwise impose, namely, their inability reasonably to replicate important *non-reputation-related* features.”) (emphases added).

Even before *Qualitex*, the Court recognized in *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 984 (11th Cir. 1983), that color (in that case, the dark brown of a checkbook carrying case) could reasonably be found nonfunctional. (“Admittedly, the carry-around case serves a function, but the particular design of the case is not functional.” *Id.* at n.33.)

As the Fifth Circuit explained in *Smack*:

In *Boston Hockey*, we held that emblems of a hockey team sold on embroidered patches had no demonstrated value other than their significance as the trademarks of the team. Relying on our decision in *Boston Hockey*, the district court here similarly held that the Universities’ color schemes, logos, and designs also had no significance other than to identify with the Universities and were therefore nonfunctional. We agree. Fans and other members of the public purchase Smack’s shirts only because the shirts contain the plaintiffs’ colors and indicia identifying the Universities’ football teams, just as people purchased the defendant’s emblems in *Boston*

Hockey only because they contained the hockey team’s trademarks. In other words, the presence of the plaintiffs’ marks serve no function unrelated to trademark.

Smack, 550 F.3d at 486 (footnotes omitted).

This case is readily distinguishable from cases in which a certain color is commonly used and understood to designate a type of product or feature (e.g., brown for chocolate, green for mint, blue for seafood, etc.). In *Dippin’ Dots, Inc. v. Frosty Bites Distrib., LLC*, 369 F.3d 1197, 1203-04 (11th Cir. 2004), *cert. denied*, 543 U.S. 1054 (2005), the colors of ice cream beads were functional because they indicated the flavor of the ice cream (e.g., pink for strawberry, white for vanilla, and brown for chocolate).⁴

The color marks of universities like Appellee and Amici “represent” those universities and serve as very strong indicators of source of their services and licensed goods, both on and off the field. The uniforms may perform a function, but any two different colors could. The appearance in the specific colors of a

⁴ Contrary to the suggestion in footnote 7 of *Dippin’ Dots*, Amici respectfully believe the color, shape, and size of the flash-frozen ice cream beads at issue did not serve “aesthetic functions” but utilitarian ones. The color code was based on flavor. 369 F.3d at 1203-04. “Size is also functional in this case because it contributes to the product’s creamy taste, which would be different in a larger ‘dot.’” *Id.* at 1206. “Likewise, the shape of dippin’ dots is functional because dripping the ice cream composition into the freezing chamber, as described in [the patent covering the product’s method of manufacture], creates a ‘bead’ that facilitates the product’s free flowing nature.” *Id.* Individually and collectively, the features of the ice cream beads at issue served *utilitarian* – not merely *aesthetic* – functions, and the *Dippin’ Dots* holding is not based on aesthetic functionality.

university's uniforms is not functional and the colors are not "functional" in the legal sense. *AmBrit*, 812 F.2d at 1539; *see also Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 203-04 (2d Cir. 1979).

Because university color marks do not meet the traditional or competitive necessity tests for utilitarian functionality, the only remaining question is whether they are "aesthetically" functional, a doctrine not recognized by this Court and rejected by a clear majority of its sister circuits.

B. Aesthetic Functionality Is Not Sound Public Policy

In contrast to utilitarian functionality, the concept of "aesthetic functionality" concerns whether purely aesthetic features may be functional and thus excluded from trademark protection. The "checkered history"⁵ of the aesthetic functionality doctrine began in earnest in 1952 with the decision of the Ninth Circuit Court of Appeals in *Pagliari v. Wallace China Co.*, 198 F.2d 339 (9th Cir. 1952). The doctrine was based on the perceived competitive need to copy an ornamental (as distinguished from utilitarian) feature of the product.

The doctrine has been criticized by commentators⁶ and rejected by most other courts. "[A]s a general matter courts have been loathe to declare unique,

⁵ *Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc.*, 457 F.3d 1062, 1064 (9th Cir. 2006), *cert. denied*, 127 S. Ct. 1839 (2007).

⁶ *See, e.g., Sicilia*, 732 F.2d at 427; *In re Mogen David Wine Corp.*, 328 F.2d 925, 933 (C.C.P.A. 1964) (Rich, J., concurring); 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 7.81 (4th ed. 2009) ("The notion of

identifying logos and names as functional.” *Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc.*, 457 F.3d 1062, 1068 (9th Cir. 2006), *cert. denied*, 549 U.S. 1282 (2007).

In *Sicilia*, decided shortly after the formation of the Eleventh Circuit, the Fifth Circuit considered the policy reasons why the aesthetic functionality doctrine would hinder, rather than promote, competition:

We think that too broad a view of functionality disserves the Lanham Act’s purpose of protecting product distinguishability. By restricting the doctrine of functionality, we preserve the ability of producers freely to select distinguishing designs and identifying marks. By linking functionality to a finding of competitive effect, however, we continue to promote free competition. A finding of functionality will, by definition, encompass a finding that competition would be unduly hindered unless close copying by a competitor is allowed. A finding of nonfunctionality, by contrast, will mean that a wide array of choices remain available to prospective competitors even though the plaintiff producer acquires a property right in a particular design or configuration.

Sicilia, 732 F.2d at 429-30 (citations omitted).

Even the Ninth Circuit, where the doctrine had the greatest viability, retreated from its acceptance of the doctrine in *Vuitton Et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769, 774 (9th Cir. 1981) (discussed in *John H. Harland*, 711 F.2d at 983 n.27), in which the Ninth Circuit said:

‘aesthetic functionality’ is an unwarranted and illogical expansion of the functionality policy, carrying it far outside the utilitarian rationale that created the policy. . . . ‘Aesthetic functionality’ is an oxymoron.”).

The policy expressed in *Pagliari* and the cases decided under it is aimed at avoiding the use of a trademark to monopolize a design feature which, in itself and apart from its identification of source, improves the usefulness or appeal of the object it adorns.

Reversing and remanding the District Court decision finding the design of a handbag aesthetically functional, the court there stated:

We disagree with the district court insofar as it found that any feature of a product which contributes to the consumer appeal and saleability of the product is, as a matter of law, a functional element of that product. Neither *Pagliari* nor the cases since decided in accordance with it impel such a conclusion.

Id. at 773. In its most recent pronouncement on aesthetic functionality, the Ninth Circuit Court of Appeals said the following:

Taken to its limits . . . this doctrine [aesthetic functionality] would permit a competitor to trade on any mark simply because there is some “aesthetic” value to the mark that consumers desire. This approach distorts both basic principles of trademark law and the doctrine of functionality in particular.

Au-Tomotive Gold, 457 F.3d at 1064.

The aesthetic functionality doctrine has not stood the test of time because it is bad public policy – it promotes confusion of consumers and allows one who would trade on the goodwill of another to be unjustly enriched – concepts that are antithetical to the purposes of the trademark and unfair competition laws.

C. This Court Should Not Adopt the Doctrine of “Aesthetic Functionality”

In *Boston Prof'l Hockey Ass'n*, this Court's predecessor distinguished aesthetic functionality from the defense of functionality, writing: “The principles

involved in those cases are not applicable to a trademark symbol case where the design or symbol has no demonstrated value other than its significance as the trademark of a hockey team.” *Id.* at 1013. In subsequent cases, the Fifth Circuit again considered the limits of the functionality doctrine and reaffirmed its commitment to the utilitarian functionality standard, explicitly rejecting the doctrine of aesthetic functionality. *Sno-Wizard Mfg., Inc. v. Eisemann Prods. Co.*, 791 F.2d 423, 427 n.3 (5th Cir. 1986) (“We explicitly rejected this test of ‘aesthetic functionality’ . . . in *Sicilia*.”). More recently, in *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 540 n.6 (5th Cir. 1998), the Fifth Circuit did not accept an invitation by the parties to overturn its aesthetic functionality precedent based on dicta in the Supreme Court’s *Qualitex* opinion.⁷

Although the Eleventh Circuit has not addressed the issue in as much detail as the Fifth, it held in *John H. Harland* that the following proposed jury instruction was an erroneous statement of law: “When a feature of goods or of its wrappers or container appeals to the consumer and *affects* his or her choice, that feature is functional.” 711 F.2d 982 n.27. The Court found that definition overly broad

⁷ Although the Supreme Court later mentioned “esthetic functionality” in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 33 (2001), that reference again was in dicta not necessary to the opinion and certainly not binding on this Court. Furthermore, the suggestion in the *TrafFix* dicta that *Qualitex* concerned aesthetic functionality is widely considered incorrect among trademark practitioners and commentators. *See, e.g.*, Christopher C. Larkin, *Qualitex Revisited*, 94 TRADEMARK REP. 1017, 1032 (2004).

because many nonfunctional features may appeal to the consumer and affect his or her choice. *Id.* The Court should not embrace aesthetic functionality here.

D. Even If the Aesthetic Functionality Doctrine Were Viable in This Court, the Marks Here Are Not “Aesthetically Functional”

As the Eighth Circuit has explained, “The functionality doctrine serves as a buffer between patent law and trademark law by preventing a competitor from monopolizing a useful product feature in the guise of identifying itself as the source of the product.” *Home Builders Ass’n of Greater St. Louis v. L&L Exhibition Mgt., Inc.*, 226 F.3d 944, 948 (8th Cir. 2000).

Part of the problem with the doctrine of aesthetic functionality is that its full reach is often underestimated. The full reach of that doctrine might allow those who want to trade on the goodwill of mark owners to claim that their use is “functional” when in fact it is source-identifying. What football fan seeing the crimson-and-white school uniforms used by Appellants would not believe that the shirt *identifies* the Crimson Tide and *distinguishes* Alabama from its opponents? This is the definition of a trademark.⁸ All benefits derived from use of university color marks are purely based on the reputations of those schools.

⁸ See Lanham Act Section 45, 15 U.S.C.A. § 1127 (defining “trademark” as a word, name, symbol, or device used to “identify and distinguish” goods).

1. The Only Advantage University Color Marks Provide Is Reputation-Related

The Supreme Court’s words in *Qualitex* bear repeating: “The functionality doctrine . . . protects competitors against a disadvantage (*unrelated to recognition or reputation*) that trademark protection might otherwise impose, namely, their inability reasonably to replicate important *non-reputation-related* features.” 514 U.S. at 169 (emphases added).

Here, competitive advantage flows from consumer association of the Color Marks with schools. This is the very essence of a reputation-related feature.

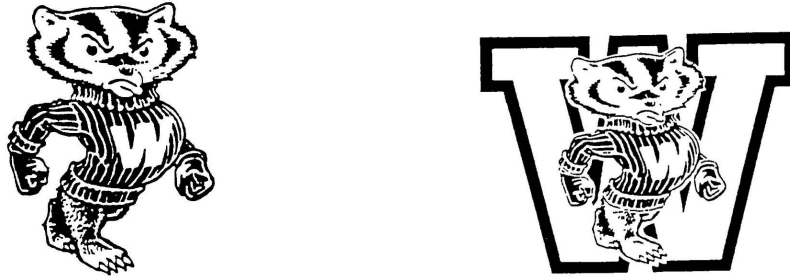
2. Taste, Preference, or Sports Team Support Cannot Render Color Functional

“Mere taste or preference cannot render a color – unless it is the best, or at least one, of a few superior designs – *de jure* functional.”⁹ *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 1353 (Fed. Cir. 1999) (internal quotation omitted).

The Trademark Trial and Appeal Board (“TTAB” or “the Board”), the administrative agency dedicated to deciding disputes over federal trademark registration, rejected an aesthetic functionality argument in *University Book Store v. University of Wisconsin Board of Regents*, 1994 WL 747886, 33 USPQ2d 1385 (TTAB 1994). In that case, retail store operators opposed the University of

⁹ The Federal Circuit has distinguished *de facto* functional features, which may have a function yet still be entitled to trademark protection as a source indicator, from *de jure* functional features, which are not. *Valu Eng’g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1374 (Fed. Cir. 2002).

Wisconsin's application to register, among other marks, the designs of its "Bucky Badger" mascot depicted below for use on clothing:



The TTAB concluded that the marks were not aesthetically functional because a significant portion of the purchasing public associated the marks with the University of Wisconsin as a source for the goods. *Id.* at *22, 1406. "Taken to its logical conclusion," the Board wrote, "opposers' argument would eliminate trademark protection and registrability for any popular and commercially successful design which is imprinted on clothing, irrespective of whether the design additionally is source-indicative to at least some consumers." *Id.*

The TTAB reiterated its rejection of a team mark aesthetic functionality argument in *Chicago Bears Football Club, Inc. v. 12th Man/Tennessee LLC*, 2007 WL 683778, 83 USPQ2d 1073 (TTAB 2007). In that case, the Chicago Bears opposed an application to register the mark 12th BEAR for T-shirts, among other goods. The applicant's functionality argument "apparently would allow others to register marks that are similar to registered marks in order to show support or

hostility to a sports team. American case law simply does not recognize such a right.” *Id.* at *14, 1084. The Board continued:

The mere fact that a trademark owner’s mark is associated with a movie, television show, *university, or sports team* does not mean that it is functional and available for others to use to promote their goods when the trademark owner is actively licensing the mark for related items. . . . We cannot conclude that applicant has any right to register its mark simply because it attempts to market its goods to a fan who wants “to communicate his allegiance and support of his team.” The trademark owner has a right to market its promotional items to those fans and to prevent others from marketing promotional items to the same fans by using a confusingly similar mark.

Id. at *14-*15, 1084 (emphasis added) (internal citation and footnote omitted).

Conclusion

Amici respectfully submit to the Court their analysis why precedent and policy both support the conclusion that university color marks, including the Alabama trade dress at issue in this case, are strong marks and not functional.

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CERTIFICATE OF COMPLIANCE

Pursuant to Rule 32(a)(7)(C) of the Federal Rules of Appellate Procedure, the undersigned certifies that:

1. This brief complies with the type-volume limitation of FED. R. APP. P. 29(d) and 32(a)(7)(B) because this brief contains 4,836 words, excluding the parts of the brief exempted by FED. R. APP. P. 32(a)(7)(B)(iii), as determined by the word processing system used to generate the brief.

2. This brief complies with the typeface requirements of FED. R. APP. P. 32(a)(5) and the type style requirements of FED. R. APP. P. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Office Word 2007 in Times New Roman font, 14 point.

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CERTIFICATE OF SERVICE

I hereby certify that I filed the foregoing **BRIEF OF AMICI CURIAE IN SUPPORT OF PLAINTIFF-APPELLEE THE BOARD OF TRUSTEES OF THE UNIVERSITY OF ALABAMA, a public corporation**, on June 30, 2010 by mailing the original and six (6) copies thereof to:

Clerk, United States Court of Appeals
for the Eleventh Circuit

I further certify that I served the foregoing **BRIEF OF AMICI CURIAE IN SUPPORT OF PLAINTIFF-APPELLEE THE BOARD OF TRUSTEES OF THE UNIVERSITY OF ALABAMA, a public corporation**, on June 30, 2010 by mailing a copy thereof and an electronic version by first-class mail, postage prepaid, in a sealed envelope, to the address of each counsel, as listed below:

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