

INTELLECTUAL PROPERTY LITIGATION

4th Circuit Upholds Denial of Trademark Registration for Timberland Boot Design

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On April 15, 2024, the U.S. Court of Appeals for the Fourth Circuit affirmed a district court decision denying trademark registration to TBL Licensing LLC (Timberland) for its Timberland boots.

Timberland had sought trademark registration for eight specific features of one its boots on the theory that the features were “distinctive” and that consumers identified those features with Timberland. However, the district court denied registration for those eight features on the grounds that (1) the boots, in fact, lacked such distinctiveness, including because it was not clear that consumer association stemmed from the eight specific features versus other features and (2) the features were functional, thereby rendering the boots ineligible for trademark registration.

On appeal, the Fourth Circuit (1) affirmed the district court’s finding on lack of distinctiveness



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and (2) therefore decided that it did not need to reach the functionality question.

The Lanham Act and Trademark Registration

The Lanham Act establishes a trademark registration system. Although trademark law is commonly known to protect words, it can also cover product designs, as the Lanham Act defines “trademark” as “any word, name, symbol, or device or any combination thereof” to “identify and distinguish...the sources of different goods.” *TBL Licensing v. Vidal*, 2024 WL 1609096, at *1 (4th Cir. Apr. 15, 2024) (citing 15 U.S.C. § 1127). A product design with such meaning can be registered as “trade dress,” a type of trademark, and receive the same protections (citing *Wal-*

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Mart Stores v. Samara Bros., 529 U.S. 205, 209-10 (2000).

At the same time, a product design can only receive registration if it is “distinctive” of the product versus others, see 15 U.S.C. § 1052(f), and if the mark is not “functional.” U.S. Patent and Trademark Office (USPTO), U.S. Department of Commerce, “Trademark Manual of Examining Procedure” §1202.02 (November 2023). A finding of either—lack of distinctiveness or functionality—is enough to deny registration. *TBL Licensing v. Vidal*, 644 F. Supp. 3d 190, 198 (E.D. Va. 2022).

To receive registration and its corresponding protections, the trademark’s owner must file an application with the USPTO for review and approval. 2024 WL 1609096, at *2. An examining attorney for the USPTO makes a decision about registration, which the applicant can

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appeal to the USPTO’s Trademark Trial and Appeal Board (TTAB).

If the TTAB upholds the USPTO’s initial decision, the Lanham Act provides an applicant with the ability to further challenge the decision in a district court action (citing 15 U.S.C. §1071(b)).

Case Background and the District Court’s Decision

In Timberland’s case, the USPTO’s examining attorney refused to register the Timberland boots’ design, finding it both functional and not distinctive. On appeal, the TTAB upheld the examining attorney’s decision,

finding that the design “lack[ed] distinctiveness.” As that finding provided sufficient grounds to affirm the examining attorney and deny registration, the TTAB did not consider the question of functionality.

Timberland proceeded to challenge the TTAB decision in the U.S. District Court for the Eastern District of Virginia. Unlike the TTAB, the district court made determinations on both the issue of distinctiveness and on functionality, resolving both in favor of the USPTO and the TTAB.

First looking at the design’s functionality, the district court recited four factors used in the Fourth Circuit to assess the issue: (1) the existence of utility patents disclosing the applied-for design; (2) advertisements and other promotional materials touting the functional benefit of the design; (3) the existence of alternative designs; and (4) any effect on the manufacturing or quality of the product. 644 F. Supp. 3d at 198.

However, the district court went on to explain that a “strong showing on the first two factors...compels a finding of functionality” (citing *CTB v. Hog Slat*, 954 F.3d 647, 658 (4th Cir. 2020); *In re Becton, Dickinson and Co.*, 675 F.3d 1368, 1372 (Fed. Cir. 2012)).

The district court appeared to have no trouble finding that the evidence bearing on the first two factors led on their own to a finding of functionality. 644 F. Supp. 3d 190, 198-99. Considering the record before the TTAB, as well as additional evidence presented to it, the district court noted that as to the first factor, at least one utility patent disclosed *each* feature of the boot design for which Timberland sought registration. Most of those patents had expired, meaning that the disclosed features

are in the public domain, and to grant trademark registration would “strip the public’s right to copy and benefit from these features,” which would be “antithetical to the pro-competitive objectives of both trademark and patent law.”

In considering the second factor on advertising, the court noted that the record was “replete” with advertising materials “extolling the functional benefits of each element of the applied-for design.” The court therefore saw no need to analyze the third and fourth factors.

The district court then turned to the issue of distinctiveness, looking to whether the design features have a secondary meaning, which requires a showing that “in the minds of the public, the *primary* significance of a product feature or term is to identify the source of the product rather than the product itself.”

To make its determination, the district court considered six factors: (1) advertising expendi-

The Fourth Circuit upheld the district court’s findings on all the other factors, generally finding that Timberland had not produced the circumstantial evidence sufficient to draw inferences of secondary meaning.

tures; (2) consumer studies linking the mark to a source; (3) record of sales success; (4) unsolicited media coverage; (5) attempts to plagiarize the mark; and (6) the length and exclusivity of the plaintiff’s use of the mark.

The court discounted Timberland’s consumer survey and marketing report due to a number of deficiencies, and found, in part, that Timberland’s advertising relied on the boots’ logo—not the features for which registration was sought.

The district court therefore found in the USPTO’s favor.

The Fourth Circuit’s Opinion

In response to the district court’s opinion, Timberland appealed. The Fourth Circuit first addressed Timberland’s challenge to the district court’s finding of functionality. It rejected Timberland’s argument that the district court erred in considering only two of the four factors for a functionality analysis. 2024 WL 1609096, at *5.

However, it chose not to make an ultimate determination affirming whether the district court did or did not err in its finding that the design was functional. The court did not need to make such a finding because the district court had not erred in finding that the design features Timberland sought to register had not acquired “a distinctive meaning leading consumers to associate the design with [Timberland].”

The panel then devoted the bulk of its opinion to analyzing the mark’s distinctiveness or lack thereof.

Before discussing the specific factors laid out by the district court on distinctiveness, the Fourth Circuit identified a “critical” point for its analysis. In determining distinctiveness, and whether the mark’s “primary significance” is identifying the source of the product, the public must perceive that the product comes from a single source (quoting *Tools USA & Equipment v. Champ Frame Straightening Equipment*, 87 F.3d 654, 660 (4th Cir. 1996)).

The court continued that some consumers might recognize the “whole boot,” but because Timberland only applied to register certain features, the court’s analysis could

only focus on those specific elements. 2024 WL 1609096, at *6.

The Fourth Circuit then considered the six factors that the district court assessed, arriving at the same conclusion. The panel first wrote that Timberland waived any challenge to the district court's findings about the deficiencies in its consumer survey. Therefore, Timberland did not have the "most direct and persuasive" evidence of secondary meaning from consumers, and therefore needed to "resort to circumstantial evidence" in reference to the other factors.

The Fourth Circuit then turned to advertising expenditures, which Timberland did challenge. Acknowledging that Timberland had spent over \$81 million marketing the boots in the United States over the previous six years, the court explained that such expenditures, absent indication that the spending actually translated into association of the boots with Timberland, as evidence carry less weight in establishing the secondary meaning required for distinctiveness here.

It found that the district court did not clearly err in its analysis by looking beyond pure expenditures to find that Timberland's advertisements pointed consumers to the boots generally, and did not call "special attention" to the specific features it sought to register.

The Fourth Circuit upheld the district court's findings on all the other factors too, generally finding that Timberland had not produced the circumstantial evidence sufficient to draw inferences of secondary meaning.

For example, on the "unsolicited media coverage" factor, despite a record including a

"ream of Instagram posts" and other media, Timberland—as with the advertising factor—did not show that the media coverage of the boots highlighted the specific features of the boots' design that were at issue in the litigation. To the contrary, the panel stated that many of those features Timberland sought to register were "imperceptible" in those images in the record.

As to "attempts to plagiarize" the mark, the existence of lookalikes in the market did not show that competitors copied the design of the Timberland boots specifically to confuse consumers about the source of the product. Instead, the court stated that the lookalikes cut against Timberland's position that Timberland is "uniquely associated" with the boots' design because, on the sixth factor of "continuous and exclusive use," widespread third-party use of substantially similar design indicates a lack of secondary meaning.

Conclusion

While in many respects straightforward, this case presents a few practical takeaways for future applicants seeking protection of their trade dress. First, absent direct evidence, including in the form of a consumer survey, a finding of distinctiveness may be more difficult when something less than the entire product design is submitted for registration. Second, where applicants may face evidentiary obstacles similar to those of Timberland, design patents may be another desirable means of obtaining protection for the product's design, depending on the facts and circumstances.