IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division

WCM INDUSTRIES, INC., *Plaintiff,* v. ANDREW HIRSHFELD, *Commissioner of Patents*, *Defendant.*	Case No. 1:20-cv-00558 Hon. Liam O'Grady

ORDER

This matter comes before the Court on the parties' cross motions for summary judgment. Dkt. 54 (Plaintiff's Motion) and Dkt. 110 (Defendant's Motion). The matter was fully briefed, and the Court dispensed with oral argument.

For the reasons provided herein, the Defendant's Motion for Summary Judgment is hereby **GRANTED,** and the Plaintiff's Motion for Summary Judgment is hereby **DENIED**. The Court accordingly grants summary judgment in favor of the Defendant.

I. FACTUAL BACKGROUND

Plaintiff applied to register its Overflow Cap Mark as trade dress for "use in association with 'Plumbing products, namely, a bathtub overflow drain cap'" on August 3, 2017. Dkt. 55 at 1. After due consideration, the Trademark Trial and Appeal Board (TTAB) of the United States Patent and Trademark Office (USPTO) found that the Overflow Cap Mark was not eligible for registration as trade dress because it was functional. Dkt. 11 at 16.

The TTAB determined that the Overflow Cap Mark was functional based on the fact that

its design was represented in the utility patents for Plaintiff's drain system, as well as the TTAB's perception that the outer appearance of the cap was dictated by its inner structure. *Id.*

II. LEGAL STANDARD

Under 15 U.S.C. § 1071(b)(1), an applicant for registration of a mark may appeal a TTAB decision against it by initiating a civil action. By pursuing this action in a federal district court, WCM has empowered itself to introduce new evidence. *Glendale Int'l Corp. v. U.S. Pat. & Trademark Off.*, 374 F. Supp. 2d 479, 484 fn. 7 (E.D. Va. 2005). The Court reviews the entire record de novo. *Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 156 (4th Cir. 2014).

The trade dress of a product consists of its image and overall appearance. *Ashley Furniture Indus., Inc. v. SanGiacomo N.A. Ltd.*, 187 F.3d 363, 368 (4th Cir. 1999). To determine whether the maker of an item is entitled to register it as trade dress, the Lanham Act requires that (1) the alleged trade dress is primarily non-functional and (2) the alleged trade dress either (a) is inherently distinctive or (b) has acquired a secondary meaning. *Rothy's, Inc. v. JKM Techs., LLC*, 360 F. Supp. 3d 373, 380 (W.D. Va. 2018) (quoting *Lance Mfg., LLC v. Voortman Cookies Ltd.*, 617 F.Supp.2d 424, 432 (W.D.N.C. 2009)).

The Supreme Court has articulated a preference against granting trade dress status because "product design almost invariably serves purposes other than source identification." *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29, 121 S. Ct. 1255, 149 L. Ed. 2d 164 (2001).

III. DISCUSSION

Trade dress registration, like trademark registration, is meant to promote competition by protecting the features of a product that identify it as the product of its manufacturer. *CTB, Inc. v. Hog Slat, Inc.*, 954 F.3d 647, 656 (4th Cir. 2020). The trade dress is the product's image taken in totality, and may include "size, shape, color or color combinations, texture, graphics, or even

particular sales techniques." *Id.* (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 fn. 1, 112 S.Ct. 2753, 120 L.Ed.2d. 615 (1992)).

In order to prevail on a trade dress claim, the party seeking registration must first show that the article they wish to register as trade dress is non-functional. The functionality doctrine, as it is known, serves to differentiate between patent and trademark law. Trademark law promotes competition by protecting a brand's reputation, while patent law promotes competition by ensuring that one brand cannot claim a monopoly on a useful product feature in perpetuity. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164–65, 115 S.Ct. 1300, 131 L.Ed.2d 248 (1995); *McAirlaids, Inc. v. Kimberly-Clark Corp.*, 756 F.3d 307, 310 (4th Cir. 2014). Thus, the proper avenue for the protection of a functional article is patent law, not trademark law. Functionality is a complete defense in a trademark infringement action, *McAirlaids*, 756 F.3d at 310, and precludes registration of an article as trade dress.

A product feature is functional where it is essential to the use or purpose of the article or if it affects the cost or quality of the article. *Id.* If manufacturers were permitted to register functional products or product elements as trade dress, it would merely grant a perpetual monopoly over a beneficial feature, unfairly disadvantaging competitors as well as consumers by depressing competition in the marketplace. *Qualitex*, 514 U.S. at 165. Another way to recognize functionality is to question whether one manufacturer's exclusive use of the feature would put competitors at a significant disadvantage unrelated to reputation. *TrafFix*, 532 U.S. at 32 (quoting *Qualitex*, 514 U.S. at 165).

In order to determine functionality, the Court considers the *Morton-Norwich* factors: (1) whether there are utility patents that disclose the utilitarian advantages of the design; (2) whether there is advertising material focusing on the utilitarian advantages of the design; (3) whether there

are functionally equivalent alternative designs which competitors may use; and (4) any facts indicating that a design results in comparatively simple or cheap method of manufacturing the product in question. *CTB, Inc.*, 954 F.3d at 657–58.

The first two *Morton-Norwich* factors carry the most weight. Regarding the third factor, the Fourth Circuit has found that "[w]hether or not… some other alternative design, serves the same purpose does not render Plaintiff's engineering-driven… design arbitrary or non-functional." *CTB, Inc. v. Hog Slat, Inc.*, 954 F.3d 647, 663 (4th Cir. 2020).

Concerning the first factor, the evidentiary record contains evidence of utility patents which include the Overflow Cap Mark. The product's design is present in the Plaintiff's utility patents for their overflow drain system as a whole. One such patent, for an "overflow assembly for bathtubs and the like," refers to "a decorative cap [that] is frictionally engaged onto protrusions located on the outer surfaces" of the mechanism as a whole. Dkt. 111-1 at 15. [1] Another patent states that the cap "serves to cover the overflow pipe fitting hardware" and "includes a surface which is bounded by a sidewall." Dkt. 111-8 at 12.[2] Two separate patents state that "[t]he cap also employs at least one notch that allows for water to flow from the cap through the elbow and into the overflow pipe of the plumbing system." Dkt. 111-9 at 30,[3] Dkt. 111-10 at 31.[4]

The Plaintiff has also used these utility patents to protect their Innovator line of products, including the design of the Overflow Cap Mark, in litigation. During a deposition for one such suit, a representative of the Plaintiff said that the cap has the "functional purpose" of preventing items from entering the drainpipe. Dep. of Michael Higgins, Dkt. 111-2 at 6. In a complaint filed by the Plaintiff with the United States International Trade Commission concerning an alleged

[1] U.S. Patent No. 8,166,548
[2] U.S. Patent No. 8,302,220
[3] U.S. Patent No. 8,321,970
[4] U.S. Patent No. 8,584,272

patent infringement, the Plaintiff stated that its utility patents are:

> directed to a screwless bathtub overflow and drain assembly comprising a self-centering fitting, which aligns itself at installation, and provides a self-sealing overflow when installed. The assembly is free of screws, thereby facilitating ease of installation. And the assembly includes a decorative cap which snaps on to an associated nut element, eliminating the possibility of cross-threading or damaging components of the assembly.

In a complaint filed in the Western District of Tennessee, the Plaintiff claimed that another seller was infringing upon the Plaintiff's patents by selling a product that, according to the photograph provided, included a screwless overflow cap with an open notch at the 6 o'clock position of the sidewall. Dkt. 111-7 at 8.

Concerning the second factor, the evidentiary record also contains advertisements, created and disseminated by the Plaintiff, that tout the functional advantages of this particular design for an overflow drain cap. These advertisements refer to the product made from this design as the "Watco 901 Hi-Flow Innovator Overflow." Dkt. 60-1 at 2. The inclusion of "Hi-Flow" in the name of the product strongly suggests that its flow capacity is a practical advantage and thus that this design, in the eyes of its manufacturer, has a functional benefit as well as an aesthetic one. Advertisements also proclaim that it has "[t]wice the capacity of traditional overflow faceplates." *Id.* Another advertisement says that this particular overflow drain cover "provides twice the overflow capacity of one- or two-hole overflow faceplates." *Id.* at 5. The phrase "no screws and high flow" is also used in advertisements, *id.* at 8; the juxtaposition of the product's flow capacity and its screwless application suggests that both are considered by the manufacturer to be benefits in a practical sense.

Finally, the Court has evidence, in the form of U.S. Patent No. 10,563,385, that the design of the Overflow Cap Mark is comparatively simple or cheap to manufacture. Dkt. 111-18 at 28 ("It is one aspect of some embodiments of the present invention to provide an overflow cover

interconnection system that is inexpensive to manufacture and efficient to install.").

The Court declines to address the third *Morton-Norwich* factor, functionally equivalent alternative designs, because the issue of alternative designs is irrelevant where the first two factors are satisfied according to both the Fourth Circuit and the Supreme Court. This is because "the functionality [of a certain design] means that competitors need not explore whether other [designs] might be used." *TrafFix*, 532 U.S. at 33–34; *see also CTB, Inc.*, 954 F.3d at 662.

To succeed on a trade dress claim under the Lanham Act, a plaintiff must show that the alleged trade dress is non-functional *and* that the alleged trade dress either is inherently distinctive or has acquired a secondary meaning. *Rothy's, Inc.*, 360 F.Supp.3d at 380. Because the Plaintiff has failed to demonstrate the non-functionality of the Overflow Cap Mark, there is no need to continue this analysis into the issue of inherent distinctiveness or secondary meaning.

IV. CONCLUSION

The Plaintiff has failed to satisfy its burden of proof in showing that the Overflow Cap Mark it seeks to register as trade dress is non-functional, and so the Plaintiff is not entitled to trade dress registration. For this reason, the Plaintiff's Motion for Summary Judgment is hereby **DENIED** and the Defendant's Motion for Summary Judgment is hereby **GRANTED**.

It is **SO ORDERED.**

April 6, 2021
Alexandria, Virginia

Liam O'Grady
United States District Judge