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FERRARI -- CAN DILUTION BE THE STANDARD FOR LIKELIHOOD OF CONFUSION?

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In September of 1991, the Court of Appeals for the Sixth Circuit affirmed¹ a district court decision² that granted trademark/trade dress protection for the shape of an article (an automobile) under Section 43(a) of the Lanham Act.³ While such action by an appellate court is not unique,⁴ the majority and dissenting opinions of this decision are significant in two respects. First, in affirming the district court's finding of likelihood of confusion, the majority looked to the *public* as the relevant universe and essentially adopted a tarnishment or dilution test for determining likelihood of confusion.⁵ Second, in disagreeing with the majority's treatment of *Sears*,⁶ *Compco*,⁷ and *Bonito Boats*,⁸ the dissent voiced the *2 opinion that the very action taken by the Supreme Court in those cases inherently rejected the distinction of the cases urged by the majority.⁹ An examination of the majority's position and the dissent's position demonstrates that *Ferrari*, if consistently followed, represents a departure from the traditional treatment of likelihood of confusion under the Lanham Act.

I. The Ferrari Case

To understand the ramifications of the appellate court's actions, it is helpful to have an understanding of the facts of the case.

Ferrari is a well-known manufacturer of racing automobiles and grand touring cars. The company intentionally limits production of its road cars in an attempt to establish an image of exclusivity. Between 1969 and 1973, Ferrari produced an automobile known as the 365 GTB/4 Daytona. Of the approximately 1,400 Daytonas built, only 100 were originally built as convertibles ("Spyders"), although some of the others were later converted into Spyders. Daytona Spyders currently sell for one to two million dollars.

In 1984, Ferrari introduced the Testarossa. To date, Ferrari has produced only approximately 5,000 Testarossas, and the entire production of Testarossas is sold out for the next several years. The waiting period for receiving a Testarossa is around five years. The sales price of a new Testarossa is approximately \$230,000.

The defendant, Roberts, manufactured fiberglass kits that replicated the exterior features of Ferrari's Daytona Spyder and Testarossa automobiles. Roberts' copies were called the Miami Spyder and the Miami Coupe, respectively. The kit included

a one-piece body shell molded from reinforced fiberglass which was usually bolted onto the undercarriage of a “donor car” such as a Chevrolet Corvette or a Pontiac Fiero.

Roberts marketed the Miami Spyder (the counterpart to the one million to two million dollar Daytona Spyder) primarily through advertising in kit-car magazines. Most of the replicas were sold as kits for about \$8,500. A fully accessorized “turn-key” version was also available for around \$50,000. At the time of trial, Roberts had not completed a kit-car version of the Miami Coupe, but had obtained two orders for Miami Coupes. Roberts had originally built a Miami Coupe for the producers of the television program “Miami Vice” for use as a stunt car.

II. The Pertinent Findings in Ferrari

The district court found that Ferrari established by a preponderance of the evidence the element of secondary meaning; i.e., the exterior shape and features of the Daytona Spyder and the Testarossa are so associated in the public mind with Ferrari that the public distinguishes Ferrari from other automobile manufacturers by those shapes and features.¹⁰ This finding does not appear to have been seriously contested on appeal.

Additionally, Ferrari produced cumulative testimony supporting the position that “utility and economy of production are largely irrelevant factors in the exterior shapes and features of the Daytona Spyder and Testarossa.”¹¹ Hence, the district court found that Ferrari proved by a preponderance of the evidence that the exterior shapes and features of the Daytona Spyder and Testarossa are nonfunctional.¹² *3 On appeal, Roberts appears to have contested this finding on the basis of the doctrine of aesthetic functionality, which doctrine was implicitly rejected by the Sixth Circuit.¹³

On the issue of likelihood of confusion, the district court found that the exterior of Roberts’ Miami Coupe closely imitates that of Ferrari’s Testarossa, differing only where required by the frame of the donor car. Furthermore, comparison of photographs of the [Miami Spyder] . . . with photographs of the Daytona Spyder shows that the body of the Miami Spyder virtually mirrors the exterior of Ferrari’s Daytona Spyder.¹⁴ No evidence was offered to show actual confusion.

Relating to the sophistication and care exercised by a consumer, the district court stated that “there is no reason to doubt that the minimum sales price of Roberts’ kit for the Miami Spyder (\$8,500) would cause this hypothetical customer to exercise a high degree of purchaser care. Likewise, the evidence shows that Ferrari’s and Roberts’ vehicles are sold through very different marketing channels.”¹⁵

The district court placed particular emphasis upon the testimony of a private investigator who met with the defendant on two different occasions. The private investigator testified that the defendant affirmed that when looking at the Ferrari Testarossa and the Miami Coupe, one cannot tell the difference between the two. According to the private investigator, the defendant asserted that his company “build[s] and sells the same car.”¹⁶ The defendant also explained that while the Testarossa cost \$140,000, the Miami Coupe cost less than \$50,000, making it “more of a practical car.”¹⁷

Accordingly, the district court found that Roberts chose “exterior shapes and features of the Daytona Spyder and Testarossa with the intent of deriving benefit from the reputation of Ferrari.”¹⁸ This finding, coupled with findings relating to the similarity of the products, led the court to find a likelihood of confusion between the Miami Coupe and the Testarossa and between the Miami Spyder and the Daytona Spyder.

The district court, however, did *not* find that Roberts attempted to deceive his customers into believing that the source of his automobiles was Ferrari. The district court emphasized that “the only evidence on this issue tended to show that Roberts made efforts to apprise his customers that regardless of appearances his vehicles were not genuine Ferraris.”¹⁹ The district court, therefore, concluded that Ferrari could not recover under Tennessee’s common law tort of unfair competition.²⁰

Based on these findings, the district court permanently enjoined Roberts from manufacturing, selling, or distributing the Miami Coupe and the Miami Spyder and all variations thereof.²¹

On appeal, Roberts contended that the relevant consumers were the consumers at the point of sale, and that no likelihood of confusion existed with regard to those consumers. In response, the appellate court noted that the survey evidence in the case showed that members of the public, but not necessarily purchasers, were actually confused by the similarity of the products. The Court then concluded that Congress intended to protect the reputation of a manufacturer as well as to protect the purchaser, and that the Lanham Act’s protection, therefore, would not be limited to confusion at the point of sale. Moreover,

*4 “[b]ecause Ferrari’s reputation in the field could be damaged by the marketing of Roberts’ replicas, the district court did not err in permitting recovery despite the absence of point of sale confusion.”²²

In essence, the Court of Appeals for the Sixth Circuit did not affirm on the basis of a traditional likelihood of confusion. Rather, the Sixth Circuit reasoned that because the sale of the replicas *could* damage Ferrari’s reputation--dilute the distinctive quality of the Ferrari reputation--that Ferrari was entitled to injunctive relief.

III. The Practical Effect of the Decision of the Appellate Court on the Issue of Confusion

The basis of the Sixth Circuit’s decision is found in its construction of the 1967 amendment to the Lanham Act to delete the word “purchasers” from the likelihood of confusion standard. As the court noted, “[w]hen the Lanham Act was passed in 1946, its protection was limited to the use of marks ‘likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods or services.’”²³ Then, in 1967, this language was broadened to include use of marks “likely to cause confusion or mistake or to deceive,” without any reference to purchasers. The court particularly noted in this regard that, pursuant to Section 45 of the Lanham Act, 15 U.S.C. § 1127, the intent of the Lanham Act was, in part, to make actionable the deceptive and misleading use of marks in commerce.²⁴

The court then turned to a case involving counterfeit goods²⁵ for the proposition that post-sale confusion is also actionable. The court embraced the *Rolex Watch* court’s belief that such an interpretation of the Lanham Act is “necessary to protect against the cheapening and dilution of the genuine product and to protect the manufacturer’s reputation.”²⁶ The Sixth Circuit then quoted the following passage from *Rolex Watch*:

Individuals examining the counterfeits, believing them to be genuine Rolex watches, *might* find themselves unimpressed with the quality of the item and consequently be inhibited from purchasing the real time piece. Others who see the watches bearing the *Rolex trademarks* on so many wrists might find themselves discouraged from acquiring a genuine because the items have become too common place and no longer possess the prestige once associated with them.²⁷

The Court added that such damage “could occur here.”²⁸

Observing that the survey evidence in the case showed that members of the *public* but not necessarily *purchasers*, were actually confused by the similarity of the products, the Court concluded that since Congress intended to protect the reputation of the manufacturer as well as the purchasers, and because Ferrari’s reputation “could be damaged”, the district court did not err in permitting recovery “despite the absence of point of sale confusion.”²⁹

When one reviews the appellate court’s summary of the factors relating to confusion,³⁰ it becomes apparent that the case is one which basically proscribes the copying of a famous product regardless of efforts to avoid confusion. Secondary meaning (reputation) and copying were the only required elements of proof:

<i>Factors</i>	<i>Favor</i>
1. Strength of the mark [secondary meaning]	Ferrari
2. Relatedness of the goods	Ferrari
3. Similarity of the marks	Ferrari
4. Evidence of actual confusion	No evidence ³¹
5. Marketing channels used	Roberts
6. Likely degree of purchaser care	Roberts
7. Roberts’ intent in selecting ‘mark’	Ferrari
8. Likelihood of expansion of product lines	No evidence

*5 As shown on the chart, the strength of the mark essentially equates to secondary meaning or reputation. The relatedness of the goods, the similarity of the “marks” (i.e. trade dress), and Roberts’ intent all flow from the act of making a copy of the product. Since Roberts took pains to advise consumers that his product was not a Ferrari, there was no evidence that Roberts attempted to deceive customers regarding the source of the products. Rather the proof shows that Roberts was aware of fame of the product and made his own version of the famous product. There can be little doubt that Roberts hoped that the fame would prompt sales of his products. In the same vein, Roberts consistently identified himself as the true source of his products. Hence, applying the logic of the Sixth Circuit, only proof of reputation and copying are needed to establish infringement.³²

In jurisdictions wherein copying is either probative evidence of secondary meaning or raises a presumption of secondary meaning,³³ the risk is great that the only semblance of “trademark” considerations in *Ferrari* will disappear. At least in *Ferrari*, the plaintiff was required to prove secondary meaning and offered survey evidence toward that end.³⁴ Assuming the surveys were valid, proponents of the *Ferrari* case may argue that the proof showed that a consumer expectation was at issue--the expectation of Ferrari quality as evidenced by the proven association in the public’s mind between Ferrari and the shape of the car. If this element of proof is also satisfied by the act of copying, however, then all that is left is copying, and no legitimate trademark considerations remain. In such jurisdictions, the manufacturer would be entitled perpetual protection against copying merely upon proof of copying. Surely, Congress could not have intended such a result.

Moreover, if proof of “inherent distinctiveness” may be substituted for proof of reputation, the *Ferrari* analysis falls completely apart. If protectability is premised on inherent distinctiveness, then there is no proven “reputation” to be damaged. “Potential” reputation based upon the assertion that the feature is instantly capable of functioning as a mark cannot suffice. Absent such proof of reputation, the basis and justification for the finding of likelihood of confusion disappears. For the *Ferrari* analysis to have *6 any viability, proof of actual reputation or secondary meaning should be required, *Two Pesos*³⁵ notwithstanding.

Accordingly, while the *Ferrari* case does appear to be a case where the court effectively granted perpetual protection for the shape of an article of manufacture upon proof of copying, the case does also appear to encompass trademark interests by virtue of its requirement of proof of reputation or secondary meaning. So long as such proof of secondary meaning is required apart from any proof of copying, then there exists at least a suggestion of a consumer interest. Whether that consumer interest is a legitimate interest to be protected depends upon the propriety of the court’s reasoning that reputation should be protected apart from consumer confusion and upon the application of *Sears*, *Compco* and *Bonito Boats* to causes of action under Section 43(a) as discussed below.

IV. Is the *Ferrari* Decision Inconsistent with the Recent Actions of Congress In Connection With the Trademark Law Revision Act?

Before examining the interplay between Section 43(a) and the *Sears/Compco/Bonito Boats* doctrine, however, the construction of the likelihood of confusion doctrine to equate it to dilution warrants comment. As a part of the revision of the Lanham Act proposed by the Trademark Review Commission (TRC), the TRC proposed a provision designated as Section 43(c) which would have made actionable the dilution of a “famous mark.” The proposed provision required both that the mark be registered (presumably thereby giving notice to all concerned of the alleged rights in the mark) and that the *registered* mark be “famous.” The remedies provided under the provision were limited to only injunctive relief unless the subsequent user was shown to have willfully intended to trade on the registrant’s reputation or to cause dilution of the registrant’s mark.³⁶ If such willful intent were shown, then the other remedies of Section 35(a) were available subject to the principles of equity.³⁷

While the dilution provision was originally included in the proposed bill introduced to the Senate,³⁸ the dilution provision received opposition because of the effect such a provision might have upon constitutionally protected material such as satire and consumer reporting.³⁹ As a result of such opposition, the dilution provision was deleted. Accordingly, Congress had the opportunity to adopt an anti-dilution measure which by its terms was limited only to famous *registered* marks. Because of the perceived ramifications that such a measure could have on “consumer reporting, editorial comment, political advertising, and other constitutionally protected material,”⁴⁰ Congress declined to adopt the proposed statutory provision.

In support of the *Ferrari* decision, it may be argued that Congress’ reluctance to adopt a dilution provision focused upon the possibility that such a standard could inhibit constitutionally protected free speech, and did not represent a statement by Congress that it disfavored a dilution remedy for the situation presented by the *Ferrari* case. Yet it is clear that Congress had before it a limited and specific dilution provision which had been carefully drafted by the TRC with an eye to such concerns.

It is equally clear that Congress declined to adopt such a provision and the resulting broadening of trademark protection that the provision represented. In light of such action by Congress, it may be argued with equal force that, as a general principle, Congress declined to expand the scope of trademark protection *7 to include the concepts of “dilution” or “tarnished reputation” which were embraced by the Sixth Circuit in *Ferrari*.

V. The Interplay of *Sears*, *Compco*, and *Bonito Boats* with Section 43(a)

In *Day-Brite Lighting, Inc. v. Compco Corp.*⁴¹ and *Stiffel Company v. Sears Roebuck & Co.*⁴² the underlying appellate decisions leading to the well known *Sears*⁴³ and *Compco*⁴⁴ cases, the issues involved were classic trademark/trade dress issues of secondary meaning, functionality and likelihood of confusion. When confronted with these policy issues, the Supreme Court decided that the construction of the state law of unfair competition to proscribe copying of unpatented or uncopyrighted products directly conflicted with the federal policies embodied in the Constitution.⁴⁵ The inescapable question is if the construction of the state law is in conflict with the policy embodied in the Constitution, then how does the identical construction of a federal law of unfair competition to proscribe copying of such products not conflict with that same policy (regardless of whether a dilution standard is used)? This is a question raised by the dissent in *Ferrari* which apparently has never been addressed by any other federal court.

For example, the *Truck Equipment* case, which was cited by the majority in *Ferrari*, states that “[t]he protection accorded by the law of trademark and unfair competition is greater than that accorded by the law of patents because each is directed at a different purpose.”⁴⁶ The observation that two laws have different purposes, however, does not address the question of whether the manner in which those purposes are being implemented conflicts.

Indeed, a closer review of the *Truck Equipment* case suggests a possible misunderstanding by the Eighth Circuit of the issues involved in the underlying appellate decisions of *Sears* and *Compco*. In particular, the court stated the following regarding *Sears* and *Compco*:

The law of trademark and the issue of functionality and secondary meaning were not before the Court.

The issue before the Court was whether state law could extend the effective term of patent protection granted by the federal statutes. The focus of the Court was the Supremacy Clause of the Constitution.⁴⁷

While it is true that *Sears* and *Compco* were cases involving state law of unfair competition, a review of the underlying appellate decisions demonstrates that the basis of that state law of unfair competition involved the very trademark/trade dress issues which the Eighth Circuit said were not before the Supreme Court. Hence, it is clear that the Eighth Circuit never even reached the question of whether an identical construction of federal law under essentially identical principles to provide essentially identical relief to that criticized and proscribed in *Sears* and *Compco* would also conflict with the basic policy embodied in the Constitution.

The majority in *Ferrari* also refers to the language in *Compco* that a defendant can copy at will if the design is “not entitled to a design patent or other federal statutory protection”,⁴⁸ apparently suggesting that the existence of another federal statute ends the inquiry.⁴⁹ The fact that a cause of action *8 may be brought under another federal statute, however, does not preclude the possibility that the construction and application of that statute is in conflict with the Constitution or another federal statute. It is for this very reason that cases of statutory construction exist which emphasize that federal statutes should be construed in a manner such that they are consistent with each other.⁵⁰ To simply state that it is a different statute that has different purposes avoids and begs the question of whether the interpretation of that different statute and the implementation of those other purposes is improper.

The majority in *Ferrari* also cites *Dallas Cowboys Cheerleaders*⁵¹ for the proposition that other courts have explicitly held that *Sears* and *Compco* do not preclude Lanham Act protection of designs. This decision, however, also fails to address the apparent conflict present in *Ferrari*. Rather, the court in *Dallas Cowboys Cheerleaders* made clear that exclusive rights to the sale of a product were not involved:

In *Sears-Compco* the Court held merely that a state may not, through its law banning unfair competition, undermine the federal patent laws by prohibiting the copying of an article that is protected by neither a federal patent nor a federal copyright. For the Court to have held otherwise would have been to allow states to grant a monopoly to a producer where the federal government had specifically determined that free competition should prevail. This consideration does not apply in a trademark infringement action where the plaintiff does not assert exclusive rights to the sale of a product but merely to a mark indicating its origin or sponsorship. The question presented therefore is one of trademark law, and it is clear that *Sears-Compco* did not redefine the permissible scope of the law of trademarks insofar as it applies to origin and sponsorship.⁵²

The above language of the Second Circuit suggests that if, in a trademark infringement action, the plaintiff does “assert exclusive rights to the sale of a product” such as in *Ferrari*, a conflict might be found to exist. At the very least, the language suggests that in *Dallas Cowboys Cheerleaders*, the Second Circuit did not feel it needed to address the possibility of a conflict under such circumstances and distinguish *Sears* and *Compco* on that ground.

The other cases cited by the majority in *Ferrari* as distinguishing *Sears* and *Compco* essentially urge the same distinctions as the cases discussed above. The issue is still whether the conflict found to exist between the state law and the patent laws also exists between the substantively identical construction and application of the Lanham Act and the patent laws.

The Supreme Court stated in *Compco*:

That an article copied from an unpatented article could be made in some other way, that the design is “nonfunctional” and not essential to the use of either article, that the configuration of the article copied may have a “secondary meaning” which identifies the maker to the trade, or that there may be “confusion” among purchasers as to which article is which or as to who is the maker, may be relevant evidence in applying a State’s law requiring such precautions as labeling; however, and regardless of the copier’s motives, neither these facts nor any others can furnish a basis for imposing liability for or prohibiting the actual acts of copying and selling.⁵³

Clearly, *Sears* and *Compco* involved basic trademark principles.

Accordingly, if *Sears* and *Compco* have any validity as a matter of policy, then consistent with the above language, *Sears* and *Compco* suggest that the total prohibition of copying of an article susceptible to patent protection under trademark principles conflicts with the constitutional policy which allows protection against copying for such articles for only a limited time. As the dissent in *Ferrari* stated,

*9 Moreover, the Supreme Court in *Sears*, *Compco*, and *Bonito Boats* states unequivocally that an interrelationship exists between unfair competition and federal patent laws. The statutes at issue in *Sears*, *Compco*, and *Bonito Boats* were state unfair competition statutes similar to the Lanham Act in their purpose and objectives. By holding that these statutes conflict with federal patent laws, the Supreme Court implicitly rejected the distinction urged by the majority. Hence, the rationale applied in this trilogy of cases to state unfair competition laws applies with equal force to federal trademark laws.⁵⁴

This is an issue which does not appear to have been squarely addressed in *Ferrari* or preceding cases. To simply state that Section 43(a) is a federal statute does not change the underlying policy concerns. Given the language of Article 1, § 8, Clause 8 of the Constitution and of Section 43(a), this is an issue for which there is not a clear or totally desirable solution.

VI. The Dilemma: The Public Has the Right to Copy that which the Patent and Copyright Laws Leave in the Public Domain and the Public Has the Right to be Protected from Confusion

In *Bonito Boats*, the Supreme Court stated unequivocally that the “federal patent laws *do* create a federal right to ‘copy and to use.’”⁵⁵ At substantially the same time, Congress amended Section 43(a) of the Lanham Act to expressly state that a use of a device which is likely to cause confusion as to affiliation, connection, or association, shall be liable.⁵⁶ If the majority is correct that the different purposes of the statutes precludes any conflict, then *Ferrari* suggests that the owner of a “trade dress” which has acquired “secondary meaning” may receive permanent protection against the copying of that product. It seems that to state the remedy is to state the conflict.

Under *Ferrari*, this remedy is carried one step further. Under the analysis of *Ferrari*, the owner of a trade dress having secondary meaning is entitled to permanent protection against copying of that trade dress without regard to consumer (purchaser) confusion. The only issue is whether there might be an adverse effect on the reputation built up in the product from copying. It seems that this result is available to plaintiffs who have a product that is so outstanding that it generates its own public reputation or plaintiffs who have the funds to aggressively advertise and promote a product in a sufficient manner to create a reputation for the product. Under either scenario, the result is the same--the owner of a product having a provable reputation is entitled to seek permanent protection from copying.

If, however, the dissenting judge in *Ferrari* is correct that the purposes of these two laws do potentially conflict and must therefore be balanced and reconciled, how does one achieve that balance? The Supreme Court in *Sears* and *Compco*, when confronted by the conflict between state law and patent law, stated that the balance may be achieved by permitting copying,

but also allowing adequate labeling regarding the true source of the respective products. The dissent in *Ferrari* suggests that this same approach must be taken under § 43(a).⁵⁷

The anomaly arises from the fact that if the shape of the article does, indeed, effectively function as a trademark, then possibly any use of that “trademark” may suggest some kind of connection between the copier and the trade dress owner. Again, to state the remedy is to state the conflict.

One possible solution may be to vary the amount of labeling required proportionately with the strength of the trade dress. That is, the more famous the design the more distinguishing identification must be required. In a case like *Ferrari*, the resulting labeling requirements may have the net effect of *10 a permanent injunction. That is, if Roberts were required to label his copies in an especially prominent and permanent manner, such a labeling requirement might deter not only those who wanted to purchase Roberts’ car primarily because it looked like a Ferrari, but also those who wanted to purchase the car because they like the design and wanted it at an affordable price. Hence, any such relief must be balanced to preserve, both practically and theoretically, Roberts’ right to copy that which the patent law left in the public domain.

Footnotes

^{a1} Arnold, White & Durkee.

¹ Ferrari S.P.A. Esercizio v. Roberts, 944 F.2d 1235 (6th Cir. 1991), *cert. denied*, ____ U.S. ____, 112 S. Ct. 3028 (1992).

² Ferrari S.P.A. Esercizio v. Roberts, 739 F. Supp. 1138 (E.D. Tenn. 1990).

³ 15 U.S.C. § 1125(a) (1989).

⁴ *See, e.g.* Truck Equip. Serv. Co. v. Fruehauf Corp., 536 F.2d 1210 (8th Cir.), *cert. denied*, 429 U.S. 861 (1976) (exterior design of semi-trailer ruled a legally recognizable trademark); *but cf.* North Shore Laboratories Corp. v. Cohen, 721 F.2d 514 (5th Cir. 1983) (sale of similarly colored product did not constitute unfair competition).

⁵ 944 F.2d at 1243-6.

⁶ Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964).

⁷ Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964).

⁸ Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141 (1989).

⁹ 944 F.2d at 1253 (Kennedy, J., dissenting).

¹⁰ Ferrari S.P.A. Esercizio v. Roberts, 739 F. Supp. 1138, 1143-44 (E.D. Tenn. 1990).

¹¹ 739 F. Supp. at 1144.

¹² *Id.*

¹³ Ferrari S.P.A. Esercizio v. Roberts, 944 F.2d 1235, 1246-1247 (6th Cir. 1991), *cert. denied*, ____ U.S. ____, 112 S. Ct. 3028 (1992).

14 739 F. Supp. at 1145.

15 *Id.*

16 *Id.*

17 *Id.*

18 739 F. Supp. at 1144.

19 *Id.* at 1146.

20 *Id.* at 1147.

21 *Id.*

22 944 F.2d at 1245.

23 944 F.2d at 1244.

24 *Id.*

25 *Rolex Watch, U.S.A., Inc. v. Canner*, 645 F. Supp. 484, 495 (S.D. Fla. 1986).

26 944 F.2d at 1244 (citation omitted).

27 *Id.* at 1244-45 (emphasis added) (quoting *Rolex Watch*, 645 F. Supp. at 495).

28 *Id.* at 1245.

29 *Id.*

30 *Id.* at 1242.

31 Usually, the absence of proof of actual confusion is weighed in favor of the defendant. Here, the appellate court observed that purchasers were not confused, but that the public was confused by the similarity of the products. This may explain why this factor was not deemed to weigh for either side.

32 Theoretically, of course, the plaintiff must also prove the non-functionality of the shape sought to be protected. So long as courts continue to reject the doctrine of aesthetic functionality, however, absent improper advertising by a plaintiff (wherein the plaintiff basically admits to functionality), it will be a rare case wherein the plaintiff fails to prove non-functionality. The present case is a perfect example wherein plaintiff convinced the Court that in a car designed to go over 100 miles an hour “utility and economy of production are largely irrelevant factors.” Ferrari

S.P.A. Esercizio v. Roberts, 739 F. Supp. 1138, 1144 (E.D. Tenn. 1990).

33 *See, e.g.*, Osem Food Industries Ltd. v. Sherwood Foods Inc., 917 F.2d 161, 164-65 (4th Cir. 1990) (applying a presumption of secondary meaning); Brooks Shoe Manufacturing Co. v. Suave Shoe Corporation, 716 F.2d 854, 859-60 (11th Cir. 1983) (“[W]e believe that proof of intentional copying is probative evidence on the secondary meaning issue”); Thompson Medical Co. v. Pfizer Inc., 753 F.2d 208, 217 (2nd Cir. 1985); Audio Fidelity, Inc. v. High Fidelity Recordings, Inc., 283 F.2d 551, 557 (9th Cir. 1960), *cert. denied*, 371 U.S. 934 (1962).

34 739 F. Supp. at 1143.

35 Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 112 S. Ct. 2753 (1992).

36 Trademark Review Commission of the United States Trademark Association, *The United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors*, 77 Trademark Rep. 375, 458-459 (1987).

37 *Id.*

38 S.1883, 100th Cong., 2d Sess. § 36 (1988).

39 *See*, 134 CONG. REC. H.10419 (daily ed. Oct. 19, 1988) (Statement of Rep. Kastenmeir regarding Senate Bill 1883).

40 *Id.*

41 311 F.2d 26, 30 (7th Cir. 1962).

42 313 F.2d 115, 118 (7th Cir. 1963).

43 Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964) (involving the design of a pole lamp).

44 Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964) (involving the design of a lighting fixture).

45 U.S. CONST. art. I, § 8, cl. 8.

46 Truck Equipment Serv. Co. v. Fruehauf Corp., 536 F.2d 1210, 1215 (8th Cir.) *cert. denied*, 429 U.S. 861 (1976).

47 536 F.2d at 1214.

48 376 U.S. at 238 (emphasis added).

49 Ferrari S.P.A. Esercizio v. Roberts, 944 F.2d 1235, 1241 (6th Cir. 1991), *cert. denied*, ____ U.S.____, 112 S.Ct. 3028 (1992).

50 *See, e.g.*, Citizens to Save Spencer County v. E.P.A., 600 F.2d 844, 870 (D.C. Cir. 1979).

⁵¹ Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200 (2d Cir. 1979).

⁵² 604 F.2d at 204 (emphasis added).

⁵³ 376 U.S. at 238.

⁵⁴ 944 F.2d at 1253 (Kennedy, J., dissenting).

⁵⁵ Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 165 (1989).

⁵⁶ *Bonito Boats* was decided on February 21, 1989. Id. The amendment of § 43(a) was passed on November 16, 1988 and became effective on November 16, 1989. 15 U.S.C. § 1125(a).

⁵⁷ 944 F.2d at 1251 (Kennedy, J., dissenting).