

Haynes Boone Represents INTA in Supreme Court Amicus Brief

October 19, 2021 Jason Bloom

PRACTICES Trademark and Advertising

Serving as counsel of record for the International Trademark Association (INTA), Haynes Boone Partner [Jason Bloom](#) co-wrote [an amicus brief filed by INTA](#) in the U.S. Supreme Court in *Sulzer Mixpac AG v. A&N Trading Company*.

At issue before the high court is the proper test for determining when a product's source-identifying design (i.e., trade dress) is functional and therefore not subject to trademark protection. The suit arose after A&N marketed mixing tips, used to blend components for dental applications, that were the same colors as Sulzer's trademarked "candy-colored" dental mixing tips. Earlier this year, the U.S. Second Circuit Court of Appeals ruled that Sulzer's trademarked product coloring was not protected by trademark law because the coloring was functional. The court concluded that because Sulzer's candy colors corresponded to the size of the Sulzer products they were "useful" to practitioners and therefore functional.

In September, Sulzer Mixpac filed a cert petition, asking the Supreme Court to reverse the Second Circuit's ruling and reassert the proper test for determining aesthetic functionality in trademark cases.

In its amicus brief, filed on Oct. 18, 2021, INTA argues that the Supreme Court should grant Sulzer Mixpac's petition and reverse the Second Circuit's ruling, which INTA argues is representative of a recent trend among circuit courts to depart from the Supreme Court's established tests for assessing functionality in trademark cases.

"Although this Court has established clear tests for determining whether product features are functional, lower courts have since then diverged from or failed to follow these tests, sowing confusion and weakening protection for source-identifying trade dress," INTA states in its brief. "Trademark owners cannot rely on the circuits to produce consistent decisions on issues of their trade dress functionality."

Bloom, who serves on the U.S. Subcommittee of INTA's International Amicus Committee, authored the amicus brief with Claudia Ray of Kirkland & Ellis, LLP, Jack Allen Wheat of McBrayer, PLLC, and Vijay Toke of Pillsbury Winthrop Shaw Pittman LLP.

Bloom is a partner in the Intellectual Property Section and Head of the Copyright Practice Group at Haynes Boone and has tried a broad array of intellectual property and business cases in state and federal courts. INTA previously retained Bloom to co-write a Supreme Court amicus brief, in *Fourth Estate Public Benefit Corporation v. Wall-Street.com, LLC*.

With more than 6,500 member organizations in 185 countries, INTA supports the advancement of trademarks and related intellectual-property concepts as essential elements of trade and commerce. In its amicus brief, the organization noted that its members and consumers stand to benefit from a clear, nationwide functionality standard.

Haynes Boone is an international corporate law firm with offices in Texas, New York, California, Charlotte, Chicago, Denver, Washington, D.C., London, Mexico City and Shanghai, providing a full spectrum of legal services in energy, technology, financial services and private equity. With 600 lawyers, Haynes Boone is ranked among the largest U.S.-based firms by *The National Law Journal*, *The American Lawyer* and *The Lawyer*. It was recognized for excellence in the BTI Consulting Group's 2021 "A-Team" report, which identifies the law firms that in-house counsel commend for providing superior client service.

The below publication covered the brief:

[Law360](#)

[INTA](#)