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Judge Terence Evans leaves behind an IP legacy

Judge Terence T. Evans of the 7th U.S. Circuit Court of Appeals died last week at age 71. He became a federal district court judge in Milwaukee in 1979 and was elevated to the appeals court in 1995. His opinions are known for their clarity and plain language; he once told the Chicago Daily Law Bulletin “we should try to simplify [the law] and make it more understandable.”

Evans was an avid golfer and sports enthusiast. He was a storyteller and a punster. His opinions are peppered with references to movies, music and modern culture. In his 16 years on the appeals court, Evans wrote several important trademark and copyright opinions and when I read of his death I thought it would be fitting to write about his legacy in intellectual property law. In fact, the last opinion he wrote, issued just two weeks before his death, was a trademark case. It was the perfect vehicle for his unique brand of legal writing.

The case to which I refer is *Georgia-Pacific Consumer Products LP v. Kimberly-Clark Corp.* 2011 WL 3200702 (7th Cir., July 28, 2011). The subject matter: toilet paper. Evans began the opinion in characteristic style: “Toilet paper. This case is about toilet paper. Are there many other things most people use every day but think very little about? We doubt it. But then again, only a select few of us work in the rarified air inhabited by top-rate intellectual property lawyers who specialize in presenting and defending claims of unfair competition and trademark infringement under the Lanham Act.” I enjoyed the good-natured jab at intellectual property lawyers.

The case involved a clash between two toilet paper titans — Georgia-Pacific (Quilted Northern brand) claimed that Kimberly-Clark (Cottonelle brand) infringed upon Georgia-Pacific’s “quilted diamond design” embossed on each sheet. Georgia-Pacific claimed the design to be a trademark and it owns a federal registration for the mark.

At issue was whether the quilted diamond design could serve as a trademark. The defendant argued that it could not because the design is “functional.” In the trademark world, a functional feature of a product cannot be protected by trademark



Inside IP Law

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law. A design 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.

Before addressing the merits, Evans could not resist a few instances of word play, first by mentioning that “Georgia-Pacific unrolled this suit against Kimberly-Clark” and then, after noting that the standard of review is *de novo*, he quipped that “despite the fact that the [district] judge dutifully plied her opinion, we now wipe the slate clean and address Georgia-Pacific claims.” He obviously kept his sense of humor to the end. Despite these lighthearted comments, the judge took his task seriously, noting that “in a \$4 billion industry designs are very important. Market share and significant profits are at stake.”

The court ruled that the quilted diamond design was indeed functional and thus could not be protected as a trademark. The most potent evidence of functionality was found in the plaintiff’s own utility patents and advertising, both of which touted how the diamond design made for better toilet paper (including benefits such as “improved bulk and puffiness” and “increased softness”).

Another of Evans’ notable trademark cases was *Central Manufacturing v. Brett*, 492 F.3d 876 (7th Cir. 2007). The plaintiff in the case was a company controlled by the irrepressible trademark claimant Leo Stoller — a name well-known to most

trademark attorneys. Stoller’s companies owned numerous trademark registrations of dubious validity and he conducted a cottage industry of demanding license fees from unwitting users of similar marks and bringing lawsuits against those who did not comply. Evans described Stoller in these words: “Leo Stoller is no stranger to trademark litigation. ... In fact, were there a Hall of Fame for hyperactive trademark litigations, Stoller would be in it. And, like George Brett, he would have gotten in on the first ballot.” The reference to Brett, a star for the Kansas City Royals in the 1980s, was apt, since Brett was the defendant in the case (for using the mark “Stealth” as his company’s brand on baseball bats). The court held that Stoller’s trademark was invalid for failure to prove that he ever actually used the mark in commerce. The opinion shows Evans at his best as a sports fan and a storyteller. The opinion begins with the judge’s description of the Pine Tar Incident, in which a ninth inning game-winning home run by Brett was overturned by the umpire because the pine tar on Brett’s bat was too high on the bat. Evans pointed out that “baseball, like our legal system, has appellate review.” The umpire’s ruling was later overturned by the commissioner and Brett’s heroic home run was reinstated. Evans related the incident with all the sports writing skill of Red Smith. George Brett’s Stealth baseball bats continue to be sold at sports outlets everywhere.

There is another notable aspect of Evans’ opinion in the *Brett* case. In it, the judge invited readers to view the entire pine tar incident online, providing a URL link to a video on YouTube. This reference by Evans is thought to be the first time YouTube was ever cited in a court opinion.

Evans liked to grab the reader’s attention with the very first line of his opinions. In *Billy-Bob Teeth, Inc. v. Novelty, Inc.*, 329 F.3d 586 (7th Cir. 2003), a copyright case involving “novelty teeth” (oversized, crooked and chipped teeth that fit over a person’s real teeth for humorous effect) he penned the perfect opening, illustrating his

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grasp of the popular culture of the time: “When International Man of Mystery Austin Powers gazes at the comely British agent Vanessa Kensington and purrs ‘groovy baby’ or ‘oh behave!’ he always smiles, exposing a set of teeth that the best orthodontist in the world could not improve. They are ugly, and therein lies their beauty, at least from a financial point of view.” Evans went on to apply the Copyright Act’s statute of frauds (§204(a)) in a fair and reasonable way by allowing an after-the-fact document assigning the copyright to the plaintiff to be effective as of the date of the original oral agreement between the parties. To have ruled otherwise would have elevated form over substance and deprived the plaintiff of a valid claim due to a technicality. (In addressing an incidental evidentiary ruling in the case, the judge noted that the abuse of discretion standard

for such rulings “is not without teeth”). For another copyright case demonstrating that the judge was in tune with modern movies, see *Murphy v. Eddie Murphy Productions, Inc.*, 611 F.3d 322 (7th Cir. 2010), where he recounts the major movie roles and memorable characters played by Eddie Murphy of “Saturday Night Live” fame.

One could go on at length recounting the bon mots of Evans, but I will close with reference to one more copyright decision authored by Evans. In *Incredible Technologies, Inc. v. Virtual Technologies, Inc.*, 400 F.3d 1007 (7th Cir. 2005), Evans got a chance to deal with a subject he dearly loved: golf. Not real golf like he addressed in *Olinger v. U.S. Golf Association*, 205 F.3d 1001 (7th Cir. 2000), but video golf. The plaintiff, creator of the most popular video golf game, claimed that the defendant’s

competing video golf game infringed its copyright. Undoubtedly, Evans’ familiarity with the sport helped him decide the issues in the case, some of which required a determination of whether certain features of the video game were functional or represented common aspects of the game of golf (“scenes a faire”); in either case they could not be protected by copyright. Recalling perhaps some of his less pleasant moments on the links, Evans explained that “sand traps and water hazards are a fact of life for golfers, real and virtual.” The court affirmed the lower court’s ruling denying a preliminary injunction due to an insufficient likelihood of success on the copyright claim.

Again, his opening line in the opinion stands out, and contains, I suspect, a hint of self-revelation: “As anyone who plays it knows, golf can be a very addicting game.”