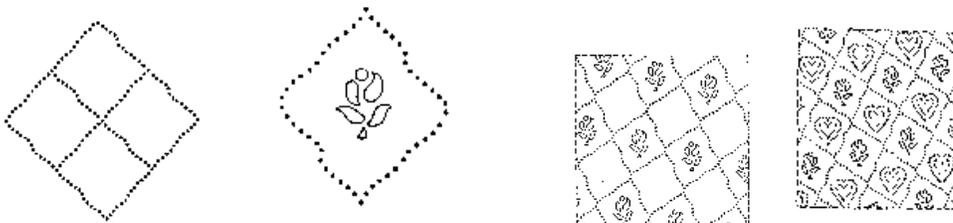


*A Winthrop & Weinstine blog dedicated to bridging the gap between legal & marketing types.*

## [Quilted Toilet Paper Design Flushed As Functional](#)

August 3, 2011 by [Steve Baird](#)

As the court ruled, and repeatedly reminded: "Toilet paper. This case is about toilet paper."



Just last week the United States Court of Appeals for the Seventh Circuit enjoyed applying only a modicum of potty humor while deciding [Georgia Pacific Consumer Products LP v. Kimberly-Clark Corporation](#), a case involving alleged [non-traditional trademark rights](#) in Georgia-Pacific's Quilted Diamond Design embossed on the surface of toilet paper (shown above):

- "Georgia-Pacific unrolled this suit against Kimberly-Clark, alleging unfair competition and trademark infringement under the Lanham Act, for Kimberly-Clark's introduction of its redesigned toilet paper."
- "We review the district judge's grant of summary judgment *de novo*, viewing all facts in favor of the nonmoving party. . . . Therefore, despite the fact that the judge dutifully plied her opinion, we now wipe the slate clean and address Georgia-Pacific's claims."

Actually, I think the court could have enjoyed itself even more with this case, since most agree double ply humor is far superior than single ply, especially when it's on a roll.

Returning to the substance in hand, the Seventh Circuit Court of Appeals agreed with the district court that Georgia-Pacific's Quilted Diamond Design, found on the surface of Quilted Northern brand toilet paper -- and [made recognizable from the television commercials with cartoon quilters](#) -- "is functional and therefore cannot be protected as a registered trademark."

It is unfortunate for Georgia-Pacific that it was unable to capture both patent protection for a limited term and trademark protection for eternity.



They are not necessarily mutually exclusive intellectual property rights, but as this decision painfully demonstrates, if planning, coordination, and great care is not exercised, any hope of eternal trademark protection will be wiped away.

As you may recall, I've emphasized the [importance of legal and marketing types working together in graceful collaboration](#) to stand a reasonable chance of avoiding the many pitfalls in creating valid and protectable traditional and non-traditional trademark rights ([Furminator](#), [Smash Burger](#), and [Bawls Guarana](#)).

But, this decision, rejecting trademark protection for the above-depicted federally-registered design trademarks, highlights the importance of not only having talented legal and marketing types working together for common intellectual property goals, but also, the equally strong need for very close collaboration between patent counsel and trademark counsel.

The Seventh Circuit relied on these points in concluding that Georgia-Pacific's Quilted Diamond Design is functional and not capable of trademark protection:

1. The claimed Quilted Diamond Design trademarks overlap with several Georgia-Pacific utility patents, making this strong evidence of functionality.
2. Each of the utility patents discusses the benefits of the Quilted Diamond Design, making this strong evidence of functionality.
3. The patent specifications all refer to the Quilted Diamond Design's utilitarian benefits of softness, bulk, and non-nesting.
4. The preferred embodiment language in the patents matches the claims in the patents, making this further evidence of functionality.

"Thus, reading the language of the patents, we find that the 'central advance' claimed in the utility patents is embossing a quilt-like diamond lattice filled with signature designs that improves (perceived) softness and bulk, and reduces nesting and ridging. This is the same 'essential feature' claimed in the trademarks. Thus, the language of the patents -- the claims, abstracts, and preferred embodiment -- is 'strong evidence' that the Quilted Diamond Design is functional and Georgia-Pacific has failed to offer evidence that the design is merely incidental."

After exhausting its coverage of how the utility patents purged any hope of trademark protection in the Quilted Diamond Design, the Seventh Circuit Court of Appeals then moved on to probe whether any of Georgia-Pacific's advertising "touts the utilitarian advantages of the asserted design."

Of great importance to marketing types, the court found evidence of functionality in Georgia-Pacific advertising too, which made these product claims:

1. "Quilted to Absorb";
2. "Quilted to create thousands of places for moisture to go";



3. "Our two softest layers of premium tissue are gently quilted together to give you and your family exceptional softness and comfort"; and
4. "Quilted Northern Ultra with a unique new quilted design for more quilting and comfort than ever before."

Accordingly, the Court of Appeals concluded "the language in the ads is clear -- the Quilted Diamond Design is unequivocally linked to functional benefits such as absorbency, softness, and comfort." Moreover, it found that the advertising claims touted the improved quality of the toilet paper due to the Quilted Diamond Design.

Last, the Court of Appeals examined the availability of alternative designs for the toilet paper's purpose. It noted that although hexagons or octagons or other non-diamond designs may very well possess the same utilitarian benefits of the Quilted Diamond Design, "the fact that there are numerous alternative designs does not, on its own, render the design nonfunctional and incidental."

As to the interplay between patent and trademark protection, the Seventh Circuit "explained that functionality polices the division between patent and trademark law, and if a design is functional the owner cannot trademark the design and block innovation. Georgia-Pacific, whether intentionally or not, patented their Quilted Diamond Design and claimed it to be functional. They must now live with that choice and can benefit only under the protection of a patent, not that of a trademark."

[For Dan's coverage on another Georgia-Pacific trademark case from last year, involving paper towels and dispensers, see [here](#).]

[For other coverage of Kimberly-Clark on DuetsBlog, see [here](#).]

