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Fashion and IP Roundup – Nontraditional Marks and the Careful Selection of Forum, Infringing Articles and Even Media By Brand Owners Can "Make or Break" the Winning Strategy

IP Buzz

Three recent skirmishes involving fashion brand owners and their non-traditional marks provide strategy tips for those looking to defend their brands against alleged copycats. This past year, the “red sole” trademark owned by designer Christian Louboutin, the trade dress of the “Clyde” bag by designer Monica Botkier, and the Adidas “four stripe” design on sneakers were all favorably enforced against perceived infringers.

1. The Red Sole Case.

In *Christian Louboutin S.A. v. Yves Saint Laurent America Holding Inc.*, the Second Circuit allowed trademark protection for the Louboutin red sole, finding that “it is the contrast between the sole and the upper [part of the shoe] that causes the sole to ‘pop,’ and to distinguish its creator.” At the same time, it concluded that designer Yves Saint Laurent’s monotone red suede pump (including a red colored sole as well) *did not infringe* Louboutin’s mark. In overturning the lower court decision against Louboutin, which denied Louboutin’s motion for a preliminary injunction against YSL and held that Louboutin was not entitled to corner the market on a color, both sides claimed “total victory” in the dispute.

Practice pointer: when laying a nontraditional trademark on the line through a lawsuit against a well-armed and well-financed opponent, don’t choose an “infringer” that doesn’t closely hew to the four corners of your trademark registration (here: a *contrasting* red sole).

2. “K’ is for Knockoff”—Monica Botkier and the Copycat Clyde Bags—a Social Media Strategy.

In 2011, designer Monica Botkier sent a cease and desist letter to Sears Holdings Corp., the exclusive retailer of Kim, Kourtney, and Khloé Kardashian’s “Kardashian Kollection” clothing and accessories line. Botkier claimed that the Kardashian Kollection “simply copied” Botkier’s “Clyde” bag and sought support from the Council of Fashion Designers of America. Going “viral,” Botkier blogged that, “it’s upsetting because it’s a trademarked shape for us, and people recognize it by sight... It’s not necessarily about sticking on a fake label, you are actually taking someone’s design idea.” In the end, Sears pulled the Kardashian Kollection bag from its retail stores and its website, Sears.com, without Botkier filing suit.

Practice pointer: when selecting a target to enforce a trade dress case against, consider using all forms of pressure to get the copies removed from distribution. Here, Botkier successfully used social media to press its point that it was not okay for a celebrity “designer” to simply copy well known designs.

3. Adidas Goes Back to Oregon to Protect its Stripes.

After winning a sizable judgment against Payless for selling “four stripe” sneakers, Adidas is back in Oregon federal court, this time seeking to enforce its nontraditional “three stripe design” for sneakers against Wolverine, which owns Hush Puppies, CAT Footwear, and Merrell, among other brands. Adidas alleges that the case is “based on Wolverine’s knowing and intentional use of confusingly similar imitations of Adidas’ Three-Stripe Mark...” In this matter, the alleged infringing footwear designs contain between two to four stripes, and arguably aren’t as similar to the Adidas sneakers as the Payless shoes that were subject to an over \$300 million judgment. We will continue to follow and provide updates on this latest case.

Practice pointer: go to a forum where you can assert personal jurisdiction and rely on favorable past precedent, particularly if it is your own prior case.