



# Trademark Review

VOLUME 3 | ISSUE 7 JULY 2013

## The Power Shifts Back to Kelly-Brown

The Second Circuit Court of Appeals reversed the dismissal of Kelly-Brown’s trademark infringement claims against Oprah Winfrey. Kelly-Brown owns the registered trademark OWN YOUR POWER for motivational seminars. Kelly-Brown sued Winfrey for infringement following Winfrey’s use of “Own Your Power” as a major headline on its monthly O Magazine, as the title of a promotional event that included a motivational seminar, and as a prominently featured aspect of the Oprah website.



Previously, the Southern District of New York granted Winfrey’s motion to dismiss the lawsuit, finding that Winfrey’s use constitutes fair use. Fair use is available as a defense to a trademark infringement claim if the defendant’s use of the term is not as a trademark, or is used in a descriptive manner, and is made in good faith. The lower court found that the use of “Own Your Power” was simply a headline and was not used as a trademark – it was used to describe the action it hoped readers would take, and there was no plausible pleading of bad faith.

On appeal, the Second Circuit reversed. The court clarified that in the Second Circuit, an allegation of trademark infringement only needs to allege that the defendant has used the term “in commerce” and does not need to plead that the defendant has used the term “as a mark.” The court found Kelly-Brown sufficiently plead a use in commerce. As to the fair use defense, the court found that the facts as plead suggest that Winfrey was building a new brand under the “Own Your Power” name, and thus, there is an issue of fact as to whether Winfrey’s use constituted trademark use. Similarly, “Own Your Power” is not clearly descriptive as applied to the services offered by Winfrey. Finally, the facts as plead suggest that in the process of conducting clearance

### In This Issue

- The Power Shifts Back to Kelly-Brown
- The Color Black Is Aesthetically Functional for Floral Boxes
- Louboutin’s Red Soled Shoes Keep Marching On
- Multiple Fashion Retailers Can Enjoy Use of “Saturday”



searching, Winfrey may have known of Kelly-Brown's registration for OWN YOUR POWER, and if so, Winfrey's adoption of the phrase may not have been in good faith.

*Kelly-Brown v. Winfrey*, 106 USPQ2d 1875 (2nd Cir. May 31, 2013).

## **The Color Black Is Aesthetically Functional for Floral Boxes**

The Trademark Trial and Appeal Board (TTAB) refused FTD's application to register the mark shown below in the color black for flowers and live cut floral arrangements:



The TTAB agreed with the trademark examining attorney that the color black has significance in the floral industry which extends to floral packaging. The examining attorney argued that in the context of floral arrangements, black is associated with stylish or formal events and in other contexts may connote grief or condolence, and is a critical color in connection with Halloween displays. The TTAB ruled there is a strong competitive need for competitors to use the color black for their packaging. Thus, the proposed mark is considered "aesthetically functional" and not entitled to registration.

*In re Florists' Transworld Delivery, Inc.*, 106 USPQ2d 1784 (TTAB 2013).

## **Louboutin's Red-Soled Shoes Keep Marching On**

After the recent ruling by the Second Circuit that Louboutin has a valid trademark in its red lacquer shoe sole, Christian Louboutin has now filed suit against Charles Jourdan in New York federal court. Louboutin alleges Jourdan has supplied infringing and counterfeit versions of Louboutin's shoes bearing the distinctive red soles under the Charles Jourdan label to retailers in New York.

*Christian Louboutin SAS et al. v. Charles Jourdan Fashion Footwear LLC et al.*, (Case No. 1:13-cv-03776, SDNY).

## **Multiple Fashion Retailers Can Enjoy Use of "Saturday"**

Saturdays Surf LLC sells men's clothing under the mark SATURDAYS SURF NYC. Saturdays Surf objected to Kate Spade LLC's use of KATE SPADE SATURDAY for a line of women's apparel. Saturdays Surf voiced its objections in correspondence, blog posts, and in social media comments. In response, Kate Spade, LLC sued Saturdays Surf seeking a declaratory judgment that Kate Spade's use of KATE SPADE SATURDAY does not infringe Saturdays Surf's trademark. Saturday Surf counterclaimed for infringement.

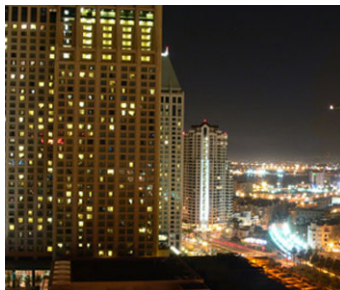
The court ruled there was no infringement, primarily because the Kate Spade mark includes Kate Spade's popular name which is a famous house mark for the company's line of women's fashion goods. Further, the court found that the word "Saturday" is not a distinctive mark. The court was also influenced by the differences in each party's customers, because Kate Spade markets primarily to women, while Saturdays Surf sells menswear.

*Kate Spade LLC v. Saturdays Surf LLC*, (Case No. 1:12-cv-09260, SDNY June 18, 2013).

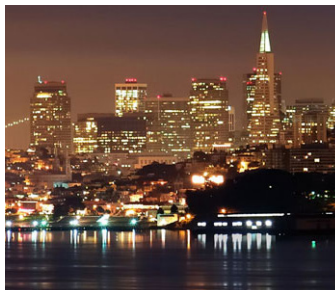
## Knobbe Martens Offices



Orange County



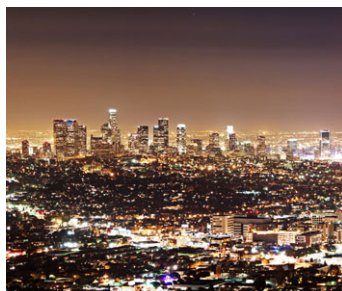
San Diego



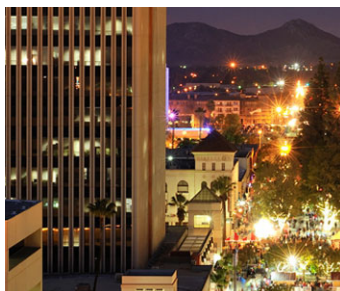
San Francisco



Silicon Valley



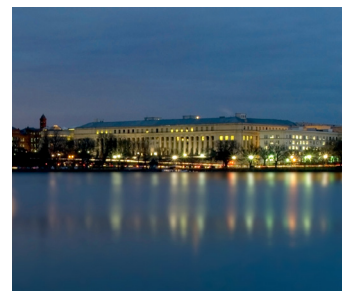
Los Angeles



Riverside



Seattle



Washington DC

© 2013 Knobbe Martens Olson & Bear LLP, a Limited Liability Partnership including Professional Corporations. All rights reserved. The information contained in this newsletter has been prepared by Knobbe, Martens, Olson & Bear, LLP and is for general informational purposes only. It does not constitute legal advice. While every effort has been made to ensure the accuracy of the information contained in this newsletter, Knobbe Martens Olson & Bear LLP does not guarantee such accuracy and cannot be held liable for any errors in or any reliance upon this information. Transmission of this newsletter is neither intended nor provided to create an attorney-client relationship, and receipt does not constitute an attorney-client relationship. You should seek professional counsel before acting upon any of the information contained in this newsletter.

### Who We Are

Over 95% of our litigators hold technical degrees, including electrical engineering, computer science, mechanical engineering, chemistry, chemical engineering, biochemistry, biology, and physics. Many of our litigators are former Federal Circuit or district court clerks. With eight offices, Knobbe Martens represents clients in all areas of intellectual property law.

- Exclusive practice in the area of intellectual property since 1962
- More than 250 lawyers, many of whom have advanced degrees in various technologies
- Internationally recognized leaders in IP across a vast spectrum of technology areas