

Trademark Review

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Louboutin Can't Stop Sales of All Red-Soled Shoes

The Second Circuit Court of Appeals ruled that Christian Louboutin has trademark rights in its “lacquered red sole on footwear” (the “Red Sole mark”) for women’s high fashion designer footwear, but that Yves Saint Laurent (“YSL”) did not infringe by selling its entirely red women’s shoes.

For 20 years, Christian Louboutin has made women’s shoes with shiny red-lacquered soles. Louboutin’s shoes are considered “high-fashion” and can cost as much as \$6,000. In 2008, Louboutin was issued a U.S. trademark registration for the red sole of a shoe. After YSL started selling red shoes with red soles, Louboutin sued YSL for trademark infringement in U.S. District Court in New York. The district court ruled that Louboutin’s trademark was invalid as a matter of law because colors are aesthetically functional in the fashion industry.

On appeal, the Second Circuit rejected the district court’s ruling that a single-color trademark can never be valid in the fashion industry. The Second Circuit held that Louboutin’s Red Sole mark had acquired secondary meaning among consumers as a brand identifier and that Louboutin had valid trademark rights in the Red Sole mark. This ruling may help other designers who are trying to establish trademark rights in a single color used in the fashion industry, such as Tiffany’s blue boxes or Tommy Hilfiger’s green buttonholes.

The Second Circuit held, however, that Louboutin’s trademark is limited to shoes which have a red lacquered sole and a contrasting color on the shoe upper. Thus, the court held that YSL’s entirely red shoe did not infringe Louboutin’s trademark rights because it lacked such contrast. The court also directed the U.S. Patent and Trademark Office to limit Louboutin’s registration to only those shoes where the red lacquered sole contrasted with the shoe upper.

Christian Louboutin SA et al v. Yves Saint Laurent America Holding Inc., (Case No. 11-3303, (2nd Cir. Sept. 5, 2012)).

DirecTV Is Granted a Registration for N3D

DirecTV’s 6 applications to register N3D for broadcasting, transmission and programming services that include content with 3-D visuals were rejected by the Examining Attorney at the Patent and Trademark Office on the basis that the mark is merely descriptive of the services. The Examining Attorney argued that in the context of DirecTV’s services, consumers will view the “N” in the mark to mean “in” and thus, the consumers will see that mark as “in 3-D.” On appeal, the Trademark Trial and Appeal Board (“TTAB”) disagreed with the Examining Attorney and reversed the refusals to register. DirecTV argued that “N” does not sound identical to “in”, nor is “N” a normal abbreviation of “in.” The TTAB sided with DirecTV and found that consumers would have no expectation

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that N3D stands for “in 3-D” even when they encounter the mark in connection with DirecTV’s services rendered in 3-D format. The TTAB did comment that competitors could still use the term “in 3-D” to describe their services and thus, there is no threat that granting registrations for the N3D mark would remove a descriptive term from the public domain. Thus, the TTAB’s comments strongly suggest that DirecTV is entitled to only a very narrow scope of protection for its N3D mark.

In re DirecTV LLC (TTAB Sept. 11, 2012).

No Two Lip Prints Are the Same?

JL Beverage Co, LLC (“JL”), the maker of Johnny Love Vodka, sued Beam Inc. in Nevada Federal District Court over use of a lip design on Beam’s PUCKER Flavored Vodka bottles. JL’s infringement claim was based on its own lip design. Both marks are shown below:



JL’s Mark



Beam’s Mark

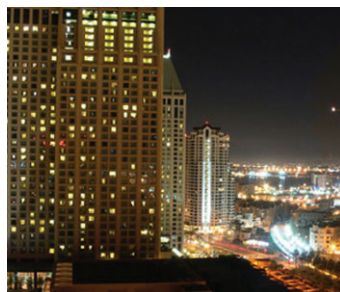
The court denied JL’s motion for a preliminary injunction, finding the lip marks are not similar and, taken as a whole, are dramatically different. The court found many differences in the lips images, such as the fact Johnny Love uses its lips image to replace the letter “O” while Beam’s lips image stands alone, is much bigger and appears to be the focal point of the label. In addition, the JL lips show only a few creases and are in a rounded “O” shape, while the Beam lips image is oval and elongated with more creases. Finally, the court noted that the JL labels are silver with minimal wording while Beam’s bottles use purple and white lettering and display images of fruit and colored ink blots.

JL Beverage Co. LLC v. Beam Inc. et al., Case number 2:11-cv-0017 (D.C. Nevada, Sept. 26, 2012).

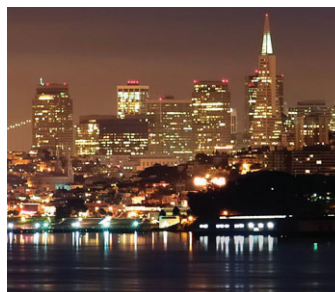
Knobbe Martens Offices



Orange County



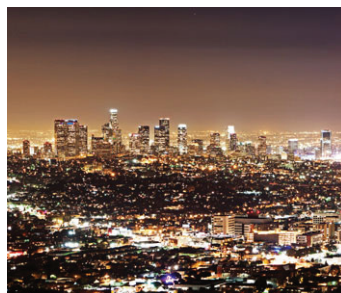
San Diego



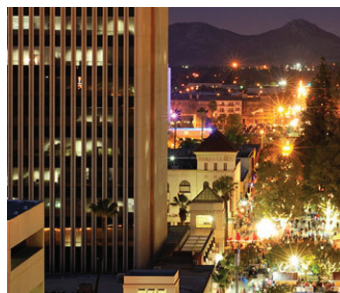
San Francisco



Silicon Valley



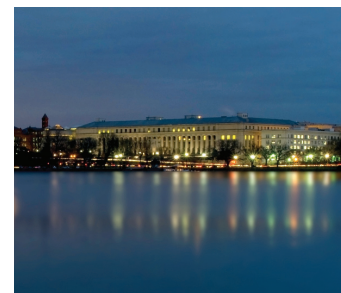
Los Angeles



Riverside



Seattle



Washington DC

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