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# Practice Tips



## Federal Circuit Report

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### Federal Circuit Weighs in on Converse's Midsole Trade Dress

On October 30, 2018, the Federal Circuit *weighed in* on Converse's Chuck Taylor trade dress infringement lawsuit. Converse had filed over 30 lawsuits in the U.S. District Court for the Eastern District of

New York in October of 2014, alleging trademark infringement of its famous Chuck Taylor designs by Fila, Tory Burch, Ralph Lauren, and Aldo, among others. Some of the district court cases settled in a few months, while others lasted over two years. Converse also filed a complaint with the International Trade Commission (ITC), asking for a general exclusion order to stop infringing products from entering

the United States. *Converse, Inc. v. International Trade Commission*, Appeal U.S. International Trade Commission, No. 337-TA-936. The ITC handed down its *decision* in June of 2016, holding that while the Chuck Taylor trade dress covered by U.S. Trademark Registration Nos. 3,258,103 and 1,588,960 are valid and enforceable, Chuck Taylor's midsole trade dress covered by U.S. Trademark Registration No. 4,398,753 is invalid based on lack of secondary meaning.

Trade dress is usually defined as the "total image and overall appearance" of a product, or the totality of the elements, and "may include features such as size, shape, color or color combinations, texture, graphics." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992). Unlike word marks and product-packaging trade dress, product-design trade dress is never inherently distinctive, and thus, secondary

	<p><b>U.S. Trademark Registration No. <u>3,258,103</u> (held valid and enforceable by the ITC).</b>  <b>Description:</b> The mark consists of a three-dimensional tread design located on the outsole of a shoe. The broken lines and the shapes thereof are intended to show the environment in which the mark is used and are not claimed as a feature or boundary of the mark.  <b>Registration Date:</b> June 3, 2007</p>
	<p><b>U.S. Trademark Registration No. <u>1,588,960</u> (held valid and enforceable by the ITC).</b>  <b>Description:</b> The mark consists of a three-dimensional sole of shoe design.  <b>Registration Date:</b> March 27, 1990.</p>
	<p><b>U.S. Trademark Registration No. <u>4,398,753</u> ('753) (held invalid by the ITC).</b>  <b>Description:</b> The mark consists of the design of the two stripes on the midsole of the shoe, the design of the toe cap, the design of the multi-layered toe bumper featuring diamonds and line patterns, and the relative position of these elements to each other. The broken lines show the position of the mark and are not claimed as part of the mark.  <b>Registration Date:</b> September 10, 2013.</p>

meaning must be shown for a trade dress in a product design to be protectable. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 216 (2000).

Although Converse noted that it first began using its ‘753 Chuck Taylor midsole trade dress in 1932, the trade dress was not registered until 2013. The Federal Circuit clarified that registered trade dress carries a presumption of secondary meaning prospectively from the date of registration. Prior to the date of registration, the mark owner must show acquired secondary meaning prior to the first infringing use for each accused infringer.

Thus, for infringing uses that began after September 10, 2013, the registration date of the ‘753 mark, Converse is entitled to a presumption of secondary meaning. For uses that began prior to the registration date, Converse must show that it acquired secondary meaning prior to the first infringing use for each alleged infringer, without

the benefit of the presumption. The Federal Circuit proceeded to vacate the ITC’s determination that Converse’s trade dress lacked secondary meaning.

The Federal Circuit further clarified that a six-factor test must be applied to determine if a trade dress has acquired secondary meaning. The test involves weighing the following factors: (1) association of the trade dress with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark.

In assessing factor (2), the Federal Circuit stated that the most relevant evidence is the trade dress owner’s and third parties’ use in the five-year period before first use or infringement.

The Federal Circuit remanded to the ITC to further analyze secondary meaning.

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