Fashion and Protecting Shoe Designs

Presented by
Marylee Jenkins
Arent Fox LLP

Washington, DC | New York, NY | Los Angeles, CA | San Francisco, CA

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A Brief Overview of U.S. Patent Law
**Patent Law 101**

**What is a Patent?**

- A patent is a right granted to an inventor by the government that permits the inventor to exclude others from **making, using, selling, offering to sell** or **importing** the invention in the U.S. for a limited period of time.

**“Utility” vs “Design” Patents**

- **“Utility” Patents** – protect inventive *functional* aspects of a method, machine, article or composition (20 year term).
- **“Design” Patents** – protect inventive *ornamental* designs (15 year term).
Patent Law 101

Anatomy of a “Utility” Patent

• **Abstract:** Provides a brief overview of the invention.

• **Specification:** Provides a detailed description of the invention and often includes several examples.
  – The specification describes alternative embodiments of the invention (e.g., different parameters and configurations).
  – Note that the specification may disclose multiple inventions.

• **Drawings:** Illustrate aspects of the invention.

• **Claims:** Define the invention and constitute the *only* legally-enforceable aspect of a patent.
"Utility" Patent Claims

• Typically, a claim includes three main parts:
  • **Preamble**: An introductory phrase that summarizes the invention and its intended use or properties.
  • **Transition**: A phrase which connects the preamble to the body of the claim and sets forth whether the claim is open-ended or closed.
    • “comprising” = open-ended (*preferred*)
    • “consisting essentially of” = semi-closed
    • “consisting of” = closed
  • **Body**: A listing of the elements/_steps required by the claim.
“Utility” Patent Claims

Example: Nike’s U.S. Patent No. 5,595,004 (“Shoe sole including a peripherally-disposed cushioning bladder”)

Claim 1. A shoe comprising

- a sole having heel and forefoot areas, said sole having a perimeter and a central region, and comprising

- a bladder including a sealed, fluid-filled tube with resilient elastomeric walls disposed about the perimeter of said sole, said tube including medial and lateral portions and extending generally about the heel area of said sole and forward along the medial and lateral sides of the sole and generally about the forefoot area to define said central region between the medial and lateral portions, said central region occupying a substantial portion of the heel and forefoot areas,

- said bladder including upper and lower portions extending between the medial and lateral portions of said tube, said upper and lower portions and said medial and lateral portions defining therebetween a sealed, fluid-filled chamber having a thickness less than the thickness of the heel area of said tube, said sealed chamber isolated out of fluid communication from said tube.
Nike owns multiple U.S. utility and design patents directed to the air cushions featured in the soles of its athletic sneakers.
Examples of Footwear IP

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**FIG. 1.**

Exemplary “visible air” sole insert.

**FIG. 2.**

U.S. Patent No. 4,817,304
“Design” Patent Claims

- Include only 1 claim, which is directed to the **ornamental** aspects of the design shown in the figures.
- Can protect the design of physical articles (e.g., products or packaging) as well as the design of 2D images (e.g., product labels).
- **Broken lines** are used to identify unclaimed features of the design.

**Example:** Nike’s U.S. Design Patent No. D725,359 (“Shoe Sole”).
Examples of Footwear IP

Adidas owns several U.S. design patents directed to the “Yeezy” line of sneakers.

- **D775,804**
  - Upper pattern claimed

- **D775,805**
  - Stitched element claimed

- **Adidas® Yeezy Boost 350**
Patent Case Studies
Utility Patents


(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.
The Patent Infringement Statutes

Design Patents


Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than $250, recoverable in any United States district court having jurisdiction of the parties.
Crocs, Inc. v. Int'l Trade Comm'n, 598 F.3d 1294 (Fed. Cir. 2010)

• Crocs sells footwear under various U.S. patents, including U.S. Patent No. 6,993,858 (the “‘858 Patent”) and U.S. Patent No. D517,789 (the “D’789”).

• Crocs asserted both of these patents in an ITC action against a foreign company accused of importing infringing articles of footwear. The ITC found the ‘858 Patent invalid and no infringement of D’789.

• Crocs appealed this decision to the U.S. Court of Appeals for the Federal Circuit (“CAFC”).
Note the presence of square versus round holes on the accused product.
**Outcome**

- On appeal, the CAFC reversed the finding of no infringement because “the accused products embody the overall effect of the ‘789 design in sufficient detail and clarity to cause market confusion.” *Id.* at 1306.

- The CAFC also explained that the ITC misapplied the “ordinary observer” test by reducing the individual features of the claimed design into a detailed verbal description “checklist” instead of performing a side-by-side visual comparison of the figures against the accused product.

- On remand, the ITC issued an exclusion order barring the accused product.
Buscemi, LLC v. Styleline Studios Int’l. Ltd. et al.  
1:17-CV-03971 (S.D.N.Y. 2017)

- Buscemi sells luxury footwear and accessories, including a line of sneakers protected by United States Patent No. D787,172.
- While the application for D’172 was pending, Buscemi learned of the defendant’s sales of sneakers which would be encompassed by the claimed design upon issuance.
- Buscemi sent a C&D letter alerting the defendant that continued sales would constitute willful infringement of D’172 once the patent issues.
- The defendant choose to disregard this letter, resulting in litigation.

D’172

The Accused Product
Outcome

• Dismissed in view of a confidential settlement between the parties.

• At the time of settlement, the defendants had a pending motion for judgement on the pleadings before the court requesting a finding of non-infringement in view of the absence of an equivalent for the “lock” element shown on the heel of the claimed design.

• This case highlights the importance of pursuing multiple design patents for important product configurations/designs. Buscemi should have filed a second design patent in this family with the “lock” element shown in broken lines as an unclaimed feature.

• Nike currently has a patent infringement action pending against Puma where it has asserted 4 U.S. utility patents directed to flyknit and air cushion technology.

• The set of asserted patents includes U.S. Patent No. 9,078,488 (“the ‘488 patent), which is directed to an “Article of Footwear Incorporating a Lenticular Knit Structure.”
The ‘488 Patent Claims

Claim 1. An article of footwear including an upper and a sole structure attached to the upper, the upper incorporating a knitted component formed of unitary knit construction, the knitted component comprising: at least one lenticular knit structure including a first portion and a second portion disposed on opposite sides of the lenticular knit structure; and

- a base portion disposed adjacent to the at least one lenticular knit structure;

wherein the at least one lenticular knit structure extends away from the base portion on an exterior surface of the upper; and

wherein the first portion of the at least one lenticular knit structure is associated with a first visual effect when the upper is viewed from a first viewing angle and the second portion of the at least one lenticular knit structure is associated with a second visual effect when the upper is viewed from a second viewing angle that is different than the first viewing angle.

In short, claim 1 requires a specific knitting arrangement (a “lenticular knit structure”) which creates a visual effect that varies depending on the viewing angle.

• Nike has asserted that Puma’s “Ignite Speed Netfit” shoe (shown below) infringes the claims of the ‘488 Patent due to structure of the knitting on the upper of this shoe.

• Nike has also asserted U.S. Patent No. 7,401,420 (the “420 patent”) in this litigation, which is directed to an article of footwear having a particular air cushion in the sole.

• This litigation is currently ongoing, following Puma’s unsuccessful attempt to have the case dismissed last month.

• This case illustrates the importance of clearing both non-functional design aspects and functional aspects of footwear, as well as the value of obtaining patent protection for functional features of new footwear products.

• Significant functional aspects of footwear that should be considered include:
  • Air cushion technology in the sole;
  • Light-up or audio features (e.g., lights or speakers incorporated into footwear);
  • Outsole tread patterns (e.g., related to improved flexibility or other benefits);
  • Upper construction/knitting technologies (e.g., 3D printing and other custom design technologies).
Examples of Footwear IP

U.S. Patent No. D599,999 is one of many U.S. design patents directed to the ornamental design of Deckers’ UGG® boots.

D’999

An UGG® Boot

The Accused Product
A Brief Overview of U.S. Trade Dress Law
Trade Dress

• “The trade dress of a product is essentially its total image and overall appearance. It involves the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.” Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 765 n.1 (1992) (internal quotations and citations omitted).

• To be protectable, trade dress must be non-functional. A functional feature in the context of trade is one that “is essential to the use or purpose of the article or [that] affects the cost or quality of the article.” Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844 (1982).
Trade Dress Law 101

The Lanham Act Recognizes Two Classes of Trade Dress

1. Registered Trade Dress
   - Principal Register (for trade dress that is *inherently distinctive* or which has acquired a *secondary meaning*)
   - Supplemental Register

2. Common Law Trade Dress
   - Enforceable only if the trade dress is *inherently distinctive* or which has acquired a *secondary meaning*. 
**Trade Dress Protection**

**Trade Dress Requirements**

- Trade dress may be registered on the **Principal Register** under § 2 of the Lanham Act if it distinguishes the owner’s products from the products of others.
  - Distinctiveness can be either inherent or acquired (secondary meaning).

- Any “symbol, label, package, configuration of goods, . . . device, or any combination of the foregoing” may be registered on the **Supplemental Register** if the trade dress is “capable of distinguishing the applicant’s goods or services.” 15 U.S.C. § 1091(c).
  - Once a trade dress is distinctive, either through inherent distinctiveness or by acquiring secondary meaning, it may be registered on the Principal Register.
Trade Dress Case Studies
Trade Dress Law 101

Trade Dress Infringement Statute (primary)


(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

• Louboutin sells luxury footwear, with many designs featuring a prominent red-lacquered outsole.

• Louboutin applied to protect the red sole as registered trade dress (the “Red Sole Trademark”) and was granted federal registration in 2008.

• Three years later, in 2011, Yves Saint Laurent (“YSL”), released a collection of monochrome footwear in various colors, including red.

Int. Cl.: 25
Prior U.S. Cls.: 22 and 39
United States Patent and Trademark Office

TRADEMARK
PRINCIPAL REGISTER

CHRISTIAN LOUBOUTIN (FRANCE INDIVIDUAL)
24 RUE VICTOR MASSÉ
PARIS, FRANCE 75009

FOR: WOMEN'S HIGH FASHION DESIGNER FOOTWEAR, IN CLASS 25 (U.S. CLS. 22 AND 39).

THE COLOR(S) RED IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF A LACQUERED RED SOLE ON FOOTWEAR. THE DOTTED LINES ARE NOT PART OF THE MARK BUT ARE INTENDED ONLY TO SHOW PLACEMENT OF THE MARK.

SEC. 2(F)
SER. NO. 77-141,789, FILED 3-27-2007

NORA BUCHANAN WIL, EXAMINING ATTORNEY

• Louboutin filed a trademark infringement lawsuit against YSL in April 2011 in the S.D.N.Y

• Louboutin asserted that YSL was liable under the Lanham Act for claims including trademark infringement and counterfeiting, false designation of origin, unfair competition, and trademark dilution, in connection with Louboutin’s registration of the Red Sole Trademark.

• Louboutin also requested a preliminary injunction ("PI") preventing YSL from marketing its own red monochrome shoes or any other shoe incorporating the Red Sole Trademark.

• The S.D.N.Y denied Louboutin’s request for a PI primarily because “single-color marks are inherently ‘functional’ and that any such registered trademark [including Louboutin’s Red Sole Trademark] would likely be held invalid.”

• On appeal the Second Circuit reversed the S.D.N.Y.’s holding that a single color can never serve as a trademark in the fashion industry.

• The Second Circuit also found the Red Sole Trademark to be valid and enforceable, but only as to shoes having contrasting upper and sole color combinations.
  • “We limit the Red Sole Mark pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119, to a red lacquered outsole that contrasts with the color of the adjoining ‘upper.’” Id. at 228.

• The Second Circuit’s analysis hinged upon the fact that the acquired distinctiveness associated with the asserted mark was limited to shoes with this contrasting color scheme.
Questions?