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EXPERT INTERVIEW

Q&A: Trademark expert Tom Williams on Converse shoe design fight

By Patrick Hughes

Tom Williams of Ulmer & Berne explains the intricacies of Converse's dispute with Skechers and other shoe companies it says infringed the trade dress of its iconic Chuck Taylors. He also answers questions about what the U.S. Court of Appeals for the Federal Circuit's recent ruling in that ongoing dispute means for trademark holders.

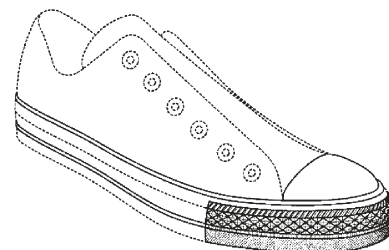
Thomson Reuters: In *Converse Inc. v. International Trade Commission*, No. 2016-2497, 2018 WL 5536405 (Fed. Cir. Oct. 30, 2018), Converse convinced a Federal Circuit panel to toss an ITC decision that found the midsole design of Chuck Taylor All Star shoes was invalid as a trademark and therefore not enforceable against Skechers and other companies that made sneakers with allegedly infringing designs. What led to the commission's decision?

Tom Williams: The ITC held that Converse failed to establish protectable rights in its asserted Chuck Taylor trade dress.

It is difficult to establish protectable rights in product configuration trade dress. As an initial matter, the claimant needs to articulate the allegedly distinctive and nonfunctional elements that comprise the trade dress.

Converse claimed trade dress rights in essentially three elements of the sneaker: the stripes on the midsoles, the toe cap and the bumper.

Among other proofs, the claimant must then prove that the trade dress has acquired distinctiveness as a mark or, as the Federal Circuit described it, "acquired secondary meaning." The ITC held that Converse failed to do so.



Converse's trademark is depicted in a single drawing in the registration.

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EXPERT ANALYSIS

Must patent applicants pay for the PTO's attorneys in district court?

J. Michael Jakes of Finnegan, Henderson, Farabow, Garrett & Dunner reflects on what it means when a patent applicant, challenging a patent examiner's rejection in federal court, must pay the U.S. Patent and Trademark Office for "all the expenses."

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The Federal Circuit reversed and remanded the decision because it believed the ITC's analysis was flawed. But Converse is not out of the woods.

TR: Converse filed a trademark claim with the ITC to get an injunction barring shoes the company said had midsoles that were too similar to its midsole design. Is it common to file a trademark suit with the ITC?

TW: It is not common to file a trademark case in the ITC. The ITC is a specialized tribunal, which can only provide limited — yet powerful — remedies for a prevailing trademark owner. Perhaps the strongest remedy is a general exclusion order, which bars all infringing imports, regardless of their source.

However, unlike a district court action, the prevailing plaintiff cannot obtain a profits disgorgement, nor can it recover its damages or attorney fees.

Converse must now prove that its Chuck Taylor trade dress acquired secondary meaning prior to Skechers' first use of the accused design.

TR: Trademark registration is prima facie evidence that a trademark is enforceable. Yet, the Federal Circuit found Converse's 2013 federal registration for its Chuck Taylor trade dress, even if it were valid, would be of no help against Skechers. Why is that?

TW: The Federal Circuit held that Converse's 2013 federal registration could not be enforced against Skechers because Skechers began using the accused design prior to 2013. Therefore, the presumption of validity provided by the registration was inapplicable. The Federal Circuit held that the registration's presumption of validity did



not apply to infringement that began prior to registration.

TR: What does Converse have to do to prove its Chuck Taylor design is enforceable against Skechers? Will a survey of potential customers help?

TW: Without the benefit of its federal registration, Converse is left with its common law rights in the trade dress. Consequently, Converse must now prove that its Chuck Taylor trade dress acquired secondary

meaning prior to Skechers' first use of the accused design.

A present-day consumer survey will not aid that inquiry. Converse must essentially go back in time to gather proofs regarding secondary meaning as of Skechers' first use. On that topic, the Federal Circuit noted that the "most relevant" proofs would be evidence of acquired secondary meaning existing during the five-year period immediately preceding the first infringing use.

TR: Following the Federal Circuit's decision, is there a chance that the Chuck Taylor trade dress registration could be revived on remand?

TW: Yes. The Federal Circuit held that the registration was inapplicable to Skechers and the other parties remaining in the case because their allegedly infringing uses predated the registration. On remand, the ITC may revisit whether it should have invalidated the federal registration.

The dissent argued that the ITC should not have addressed the validity of the registration because it could not be asserted against Skechers and the remaining parties. If the ITC agrees, it may vacate its prior ruling invalidating the registration.

TR: What impact could the Federal Circuit's decision have on future trade dress disputes?

TW: This decision clarifies that the presumption of "acquired secondary meaning" associated with registration does not apply retroactively in trade dress cases. The presumption is effective only as of the registration date. As a result, trade dress owners seeking to challenge infringements beginning prior to registration must be prepared to prove up their prior common law rights.

It is important to note, however, that the Federal Circuit's trademark law holdings are not binding precedent in other federal circuits. **WJ**