

Louis Vuitton Malletier v. Dooney & Bourke, Inc.: Resisting Expansion of Trademark Protection in the Fashion Industry

IN *LOUIS VUITTON MALLETTIER V. DOONEY & BOURKE, INC.*,¹ the United States Court of Appeals for the Second Circuit refused to expand trademark protection in the American fashion industry. The Second Circuit accomplished this by (1) focusing on an already established factor for likelihood of confusion,² (2) declining to expressly address the plaintiff's purpose for filing the lawsuit, and (3) remanding the trademark infringement issue to a district court disinclined to favor Louis Vuitton Malletier ("Vuitton").³

The *Dooney & Bourke* controversy is representative of fashion industry battles in the United States to increase protection for fashion designs against design piracy.⁴ Vuitton sought to expand current trademark protection to include the "unique" colors⁵ it incorporated into its already protected Toile Monogram trademark.⁶ Vuitton hoped to convince the Second Circuit that unique colors incorporated into an

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1. 454 F.3d 108 (2d Cir. 2006).

2. *Id.* at 117.

3. *Id.* at 118.

4. See *The Design Piracy Prohibition Act: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet and Intellectual Prop. of the H. Comm. on the Judiciary*, 109th Cong. 10–13 (2006) (testimony of Fashion Designer Jeffrey Banks). The fashion industry, represented by the CFDA (Council of Fashion Designers of America), is currently supporting The Design Piracy Act to try to expand copyright right protection to fashion designs. *Id.*; see also *Fashion Originators' Guild of Am., Inc. v. FTC*, 312 U.S. 457 (1941) (fashion designers organized and boycotted retailers who sold pirated designs, but this organization was held illegal under anti-trust laws by the Supreme Court).

5. Vuitton defined its Monogram Multicolore "trademark" as "a design plus color, that is, the traditional Vuitton Toile pattern design—entwined LV initials with the three already described motifs—displayed in the 33 Murakami colors and printed on a white or black background." *Dooney & Bourke*, 454 F.3d at 115; see Brief of Plaintiff-Appellant at 7, *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108 (2d Cir. 2006) (No. 04-4941-cv). "Like the Toile Monogram, these [Multicolore] marks similarly featured a repeating diagonal pattern of intertwined initials and shapes. This pattern was now colorized with thirty-three specially-chosen and contrasting Murakami colors. In addition, the patterns were placed on either a white background or a black one, instead of the original brown, creating an electric, pop-art effect." *Id.*

6. Vuitton's original Toile Monogram is a registered trademark. *Dooney & Bourke*, 454 F.3d at 112.

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existing trademark are elements of that trademark and entitled to the same protection.⁷ Vuitton chose to pursue trademark protection because the protection offered under copyright, patent, and trade dress laws is significantly limited.⁸

The Second Circuit, however, refused to consider these fashion-specific concerns, and instead focused on an error by the district court concerning how to evaluate similar marks under the likelihood of confusion doctrine.⁹ The court also declined to address whether newly incorporated colors may be considered as part of a preexisting trademark in order to receive the same protection. The Second Circuit then remanded the issue of trademark infringement to a district court that clearly disfavors Vuitton, and ultimately ignored the possibility of expanding trademark protection in the American fashion industry.

The Second Circuit's decision leaves the American fashion industry in a precarious position as the current statutes for copyright, patent, trade dress, and trademark fail to protect fashion designs. Both the fashion industry and its designers desperately need an effective way to protect their creations through the court system because legislative laws provide minimal, if any, protection for their costly and time-consuming designs. An expansion of trademark law to allow for the protection of colors incorporated into an existing trademark, as Vuitton requested, is a small and fair adjustment that would have helped the American fashion industry. The Second Circuit failed the industry by choosing to ignore this significant problem for fashion designs.

I. THE CASE

Vuitton and Dooney & Bourke, Inc. ("D & B") design and manufacture handbags sold in the United States.¹⁰ Vuitton is a French firm best known for its Toile Monogram that consists of the entwined "LV" initials set against one of three motifs.¹¹ Vuitton registered this design pattern and the individual unique shapes as trademarks with the United States Patent and Trademark Office,¹² and these trademarks are now incontestable.¹³ Vuitton updated its Toile Monogram in October 2002 by printing the entwined "LV" initials in thirty-three bright colors on either a white or a black background.¹⁴ Vuitton named this new design the Louis Vuitton Toile Monogram Multicolore,¹⁵ and it received significant attention from both the media and

7. *Id.* at 115; see *supra* note 5 (discussing Vuitton's unique colors).

8. See *infra* Part IV.B (discussing limitations of protection in fashion industry).

9. *Dooney & Bourke*, 454 F.3d at 116-18.

10. *Id.* at 112-13.

11. *Id.* at 112. Louis Vuitton uses three different motifs with its Toile Monogram, including "a curved diamond with a four-point star, its negative, and a circle with a four-leafed flower inset." *Id.*

12. *Id.*

13. *Id.* Registered trademarks used continuously for five consecutive years from registration are incontestable. 15 U.S.C. § 1065 (2000).

14. *Dooney & Bourke*, 454 F.3d at 112.

15. *Id.*

celebrities.¹⁶ By April 2004, Vuitton sold close to 70,000 Multicolore handbags and accessories in the United States generating a net revenue of \$40 million.¹⁷ Vuitton's Multicolore design is not a registered trademark.¹⁸

D & B is an American company best known for its Signature and Mini Signature handbags that consist of the "DB" initials interlocking in a repeating pattern.¹⁹ D & B partnered with *Teen Vogue* in March 2002 to develop a new line of handbags for teenagers.²⁰ In July 2003, D & B began manufacturing its "It-Bag" collection, which consists of the entwined "DB" initials printed in contrasting colors on a variety of colored backgrounds.²¹

Vuitton filed suit against D & B in the United States District Court for the Southern District of New York on April 19, 2004 not long after the "It-Bag" introduction, claiming trademark infringement, unfair competition and false designation, and trademark dilution under federal and New York state law.²²

Vuitton filed this lawsuit against D & B to address the issue of "design piracy" in the world of fashion. "Design piracy" is a term used by the fashion industry to refer to companies or individuals who copy and reproduce someone else's designs.²³ Design piracy destroys a designer's motivation to be innovative by allowing a designer's creation to be immediately copied, and by then causing a loss of revenue that lessens the designer's incentive to spend the money, time, and effort needed to be creative.²⁴ The ultimate result is that both well-established and up-and-coming designers suffer. The fashion giants, like Vuitton, lose the millions of dollars in-

16. *Id.*; see Rebecca Voight, *The Message Is All in the Bag*, INT'L HERALD TRIB., Oct. 8, 2003, at 19; see also Marcelle S. Fischler, *Post-Waldbaum's, A Rival to Rodeo Drive*, N.Y. TIMES, Sept. 14, 2003, §14LI, at 4.

17. *Dooney & Bourke*, 454 F.3d at 112-13.

18. *Id.* at 116. If a trademark is unregistered, it may only receive protection under the Lanham Act if it meets certain qualifications specified by that Act. See *infra* notes 65-72 and accompanying text.

19. *Dooney & Bourke*, 454 F.3d at 113. D & B's Signature and Mini Signature collection is a registered trademark. *Id.*

20. *Id.* *Teen Vogue* magazine, partnering with D & B, chose a group of female teenagers to travel to Italy and develop a new line for D & B. *Id.* This group was called the "It Team," and during this trip to Italy, the team was photographed looking at Vuitton's Multicolore handbags at a Vuitton store. *Id.*

21. *Id.* Both Vuitton's Multicolore Monogram and D & B's It-Bag use intertwining initials displayed in bright colors set on similar colored fabrics. *Id.*

22. *Id.* Vuitton also sent a cease-and-desist letter to D & B on April 16, 2004. *Id.*

23. S. Priya Bharathi, Comment, *There is More Than One Way to Skin a Copycat: The Emergence of Trade Dress to Combat Design Piracy of Fashion Works*, 27 TEX. TECH L. REV. 1667, 1667 (1996).

24. *Id.* at 1670.

Design piracy, or 'knocking off,' is a way of life in the fashion industry. . . . To designers, however, knocking off is simply highway robbery. Designers invest vast amounts of time and money in design development, only to have their designs copied by other manufacturers. . . . [D]esign piracy is entirely legal under present law.

Id. at 1667. This sentiment is similar to Locke's Labor Theory of Property, which states:

The labor of [a man's] body, and the work of his hands . . . are properly his. Whatsoever then he removes out of the state that nature has provided, and left it in, he has mixed his labor with, and joined to it something that is his own, and thereby makes it his property.

JESSE DUKEMINER & JAMES E. KRIER, PROPERTY 15 (5th ed. 2002); see also *The Design Piracy Prohibition Act*, *supra* note 4, at 11.

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vested into the innovative process and advertising,²⁵ while “design piracy [wipes] out young careers in a single season.”²⁶

Despite design piracy’s detrimental effects, it is constantly used in the fashion industry.²⁷ Because most design piracy is legal under current United States law, cases like this one are often brought to the courts in the hope of receiving judicial protection.²⁸

Design piracy, and more importantly, the lack of design protection in this country were the driving forces behind the *Dooney & Bourke* litigation. Vuitton specifically claimed trademark infringement because it knew the other forms of design protection were inadequate to shield its new Monogram Multicolore mark.²⁹ Vuitton filed this lawsuit in the hopes of expanding trademark protection into a doctrine that could safeguard both designs and fashion industry investments.³⁰

Vuitton ultimately moved for a preliminary injunction against D & B on April 28, 2004.³¹ The district court found that Vuitton’s Multicolore design “was an inherently distinctive mark that had achieved secondary meaning in the marketplace,”³² but “there was no likelihood of confusion between [D & B’s] It-Bag pattern and [Vuitton’s] Multicolore mark.”³³ Accordingly, the district court denied Vuitton’s preliminary injunction.³⁴ Vuitton appealed this judgment to the United States Court of Appeals for the Second Circuit.³⁵

II. LEGAL BACKGROUND

Designers and manufacturers in the American fashion industry have four possible avenues of protection to prevent infringement or copying of their creations: copy-

25. See *Dooney & Bourke*, 454 F.3d at 112. “Plaintiff states that it spent over \$4 million in 2003–2004 advertising and promoting the Multicolore mark and associated handbags.” *Id.*; see also Brief of Plaintiff-Appellant, *supra* note 5, at 9. “Louis Vuitton spent almost \$6 million to ensure that its new source-identifiers were firmly planted in the public mind.” *Id.*

26. See *The Design Piracy Prohibition Act*, *supra* note 4, at 10–13.

So once a designer spends the thousands and thousands and gets to that runway show and then reveals a new and original design – it can be stolen before the applause has faded thanks to digital imagery and the internet The famous designer with an established and substantial business might be able to withstand that assault, but it can absolutely derail the career of a young designer.

Id. at 12.

27. Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1689 (2006).

28. *Id.*

29. *Id.* at 115.

30. *Id.*

31. *Id.*

32. *Id.* (quoting *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 340 F. Supp. 2d 415, 438–39 (S.D.N.Y. 2004), *aff’d in part, vacated in part*, 454 F.3d 108 (2d Cir. 2006)).

33. *Dooney & Bourke*, 454 F.3d at 113.

34. *Id.*

35. *Id.* at 111.

right protection,³⁶ patent protection,³⁷ trade dress protection,³⁸ and trademark protection.³⁹

A. *Copyright Protection*

General copyright protection is available under 17 U.S.C. § 102 for the following categories of work: “(1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works.”⁴⁰ Of these categories, the only one applicable to fashion designs is “pictorial, graphic, and sculptural works,” which are statutorily defined to include:

*two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.*⁴¹

A “useful article” is statutorily defined as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”⁴² In the case of clothing, as an example, § 102 copyright protection is elusive because it is difficult to separate the utilitarian aspect (to protect a person’s skin and body) from the “pictorial, graphic, or sculptural work” (the colors or design of a specific piece of clothing referred to as the “expressive” component).⁴³

36. See *infra* Part II.A.

37. See *infra* Part II.B.

38. See *infra* Part II.C.

39. See *infra* Part II.D.

40. 17 U.S.C.A. § 102 (West 2007).

41. *Id.* § 101 (emphasis added).

42. *Id.*

43. Raustiala & Sprigman, *supra* note 27, at 1699. As a further example of copyright protection limits, consider the following:

[A] two-dimensional sketch of a fashion design is protected by copyright as a pictorial work. The three-dimensional garment produced from that sketch, however, is ordinarily not separately protected, and copying that uses the garment as a model typically escapes copyright liability. Why? The doctrinal answer is that the garment is a useful article, and copyright law applies only when the article’s expressive component is “separable” from its useful function.

Id.

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In other words, the design and/or colors of a dress, for instance, may not be protected under § 102 copyright law unless these designs and colors are separable from any utilitarian function the dress may serve.⁴⁴

Copyright laws also provide protection for “original designs” under 17 U.S.C. §§ 1301–02.⁴⁵ An “original design” is statutorily defined as a design that “is the result of the designer’s creative endeavor that provides a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source.”⁴⁶ These forms of copyright-protected designs do not include any designs that are:

- (1) *not original;*
- (2) *staple or commonplace, such as a standard geometric figure, a familiar symbol, an emblem, or a motif, or another shape, pattern, or configuration which has become standard, common, prevalent, or ordinary;*
- (3) *different from a design excluded by paragraph (2) only in insignificant details or in elements which are variants commonly used in the relevant trades;*
- (4) *dictated solely by a utilitarian function of the article that embodies it; or*
- (5) *embodied in a useful article that was made public by the designer or owner in the United States or a foreign country more than 2 years before the date of the application for registration under this chapter.*⁴⁷

B. Patent Protection

Patent protection is generally available for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof” under 35 U.S.C. § 101.⁴⁸ A design in the fashion industry, however, rarely constitutes a process,⁴⁹ machine, manufacture,⁵⁰ or composition of mat-

44. An example of when an expressive component is separable from the utilitarian component, and as such protected under copyright law, is “a jeweled appliqué stitched onto a sweater . . . because the appliqué is physically separable from the garment . . .” *Id.* at 1699–1700.

45. 17 U.S.C.S. §§ 1301–02 (LexisNexis 2004). “(a) Designs protected. (1) In general. The designer or other owner of an original design of a useful article which makes the article attractive or distinctive in appearance to the purchasing or using public may secure the protection provided by this chapter upon complying with and subject to this chapter.” *Id.* § 1301.

46. *Id.* § 1301.

47. *Id.* § 1302.

48. 35 U.S.C.A. § 101 (West 2007).

49. A process is statutorily defined to mean a “process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.” *Id.* § 100. An example is the process for making a specific chemical compound or drug—one would get patent protection for the steps taken to make that compound or drug, but not for the actual compound or drug itself.

50. A machine or a manufacture deals with an invention that is structural in nature. DONALD S. CHISUM ET AL., *PRINCIPLES OF PATENT LAW* 775 (3d ed. 2004). A machine usually has a moving part involved, like a toaster for example, while a manufacture has a unique type of insulation to keep beverages warm or cold, like a coffee mug. *Id.*

ter.⁵¹ Instead, patents for designs are available under a separate statute for “any new, original and ornamental design for an article of manufacture.”⁵² A design patent, however, “provides protection only for the ornamental features of an article of manufacture . . . and case law makes clear that features dictated by function cannot be protected by a design patent.”⁵³ As one source further notes, “design patents [do] not extend to designs that are merely reworkings of previously existing designs.”⁵⁴

C. Trade Dress Protection under the Lanham Act

The Lanham Act, specifically section 43(a),⁵⁵ provides trade dress protection to safeguard “the design and appearance of the product as well as that of the container and all elements making up the total visual image by which the product is presented to customers.”⁵⁶ It should be noted, however, that in a suit “for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.”⁵⁷ The United States Supreme Court clarified this requirement by holding that “a product feature is functional . . . if it . . . affects the cost or quality of the article, that is, if exclusive use of the feature would put competitors at a significant disadvantage.”⁵⁸ As one scholar explains, “courts have adopted a market-based definition of functionality. According to this view, a product or feature is deemed functional if it is something that would be difficult for competitors to do without.”⁵⁹

51. A composition of matter deals with an invention or a discovery that is chemical in nature. *Id.* at 775. “A composition of matter may be a new compound . . . or a new combination of existing and/or new compounds.” *Id.*

52. 35 U.S.C.A. § 171.

53. CHISUM ET AL., *supra* note 50, at 225.

54. Raustiala & Sprigman, *supra* note 27, at 1704–05.

55. 15 U.S.C.A. § 1125(a) (West 2007).

56. *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1005 (2d Cir. 1995). An example of trade dress protection is when the United States Supreme Court protected a Mexican restaurant’s claimed trade dress, which consisted of:

[A] festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals. The patio includes interior and exterior areas with the interior patio capable of being sealed off from the outside patio by overhead garage doors. The stepped exterior of the building is a festive and vivid color scheme using top border paint and neon stripes. Bright awnings and umbrellas continue the theme.

Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 765 (1992) (quoting *Taco Cabana Int’l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1117 (5th Cir. 1991), *aff’d*, 505 U.S. 763 (1992)).

57. 15 U.S.C.A. § 1125(a)(3). The phrase, “trade dress not registered on the principal register,” refers to an unregistered trade dress like Vuitton’s Multicolor Monogram handbags, which have not been officially registered with the United States Patent and Trademark Office. *Id.*; *see infra* note 64 and accompanying text (discussing the Principal Register of the United States Patent and Trademark Office).

58. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995).

59. James E. Stewart & J. Michael Huget, *Trade Dress: Protecting a Valuable Asset*, 74 MICH. B.J. 56, 57 (1995).

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In addition, the United States Supreme Court has stated that the colors and designs of a product, which constitute aspects of trade dress, are only protected under the Lanham Act upon a showing of secondary meaning.⁶⁰ Secondary meaning requires that customers come to associate that specific color or design with the source of a particular product over time.⁶¹

D. Trademark Protection under the Lanham Act

A trademark is statutorily defined as

any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

*(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.*⁶²

Trademark protection is available under sections 32 and 43(a) of the Lanham Act. Together, these sections protect both registered and unregistered trademarks from misuse or reproduction in commerce.⁶³ Section 32 protects those trademarks that are registered on the Principal Register with the United States Patent and Trademark Office.⁶⁴ Section 43(a) protects qualifying unregistered trademarks by providing that an entity's

us[e] in commerce [of] any word, term, name, symbol, or device, or any combination thereof . . . which is likely to cause confusion, or to cause mistake, or to deceive as to . . . origin, sponsorship, or approval of his or her goods, services,

60. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212, 216 (2000). "We hold that, in an action for infringement of unregistered trade dress under § 43(a) of the Lanham Act, a product's design is distinctive, and therefore protectible, only upon a showing of secondary meaning." *Id.*

61. *Knitwaves, Inc.*, 71 F.3d at 1008; *see infra* notes 69–72 and accompanying text.

62. 15 U.S.C.A. § 1127.

63. *Id.* §§ 1114, 1125(a).

64. Section 32 states that:

(1) Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . . shall be liable in a civil action by the registrant for the remedies hereinafter provided.

15 U.S.C.A. § 1114. *See generally* United States Patent and Trademark Office: Trademarks, <http://www.uspto.gov/main/trademarks.htm> (last visited Sept. 21, 2007).

*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.*⁶⁵

To determine whether an unregistered trademark qualifies for protection under this provision of the Lanham Act, the United States Supreme Court held “that the general principles qualifying a mark for registration under §2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under §43(a).”⁶⁶ Section 2 of the Lanham Act states: “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it” falls under one of six exceptions listed within that statute.⁶⁷

According to the United States Supreme Court, this means that the unregistered trademark must be either inherently distinctive or possess secondary meaning in order to receive protection under Section 43(a) of the Lanham Act.⁶⁸ The Second Circuit elaborated on this requirement in *Star Industries, Inc. v. Barcardi & Co.*, by stating

65. 15 U.S.C.A. § 1125(a).

66. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

67. 15 U.S.C.A. § 1052. The six statutory exceptions are as follows:

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof;

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow;

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional;

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. . . .

Id.

68. *Two Pesos, Inc.*, 505 U.S. at 768.

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*a mark must be sufficiently “distinctive” to distinguish the registrant’s goods from those of others. Such distinctiveness may be demonstrated in either of two ways. The mark may be “inherently distinctive” if its intrinsic nature serves to identify its particular source. Alternatively . . . the mark may be distinctive by virtue of having acquired a “secondary meaning” in the minds of consumers.*⁶⁹

A trademark, as noted above, is inherently distinctive when its nature, usually either words or specific packaging of a product, immediately identify its particular source. As an example, “marks that are ‘arbitrary’ (‘Camel’ cigarettes), ‘fanciful’ (‘Kodak’ film), or ‘suggestive’ (‘Tide’ laundry detergent) are held to be inherently distinctive.”⁷⁰ A trademark acquires secondary meaning, on the other hand, “when, ‘in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.’”⁷¹ Examples of items that often need to acquire secondary meaning for protection under section 43(a) of the Lanham Act include colors or designs of the item to be trademarked.⁷²

Once a trademark is found either to be inherently distinctive or to have acquired secondary meaning, and as such protected under the Lanham Act, the issue of trademark infringement is then addressed under the standard of likelihood of confusion.⁷³ While there is no ruling from the United States Supreme Court on how to determine whether there is a likelihood of confusion, the individual circuits each created their own list of factors for making this determination.⁷⁴ In the Second Circuit, a series of non-exclusive factors, known as the *Polaroid* factors,⁷⁵ comprise the likelihood of confusion test for trademark infringement.⁷⁶ These factors include (1) the strength of the mark, (2) the similarity between the marks, (3) the proximity of the products, (4) the likelihood that the plaintiff will bridge the gap between

69. 412 F.3d 373, 381 (2d Cir. 2005), *cert. denied*, 547 U.S. 1019 (2006).

70. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210–11 (2000).

71. *Id.* at 211 (quoting to *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982)); *see supra* notes 60–61 and accompanying text (discussing secondary meaning).

72. *Wal-Mart*, 529 U.S. at 212.

73. The test to determine whether a trademark is protected from trademark infringement under the Lanham Act is a two-part analysis: “The plaintiff must provide factual proof that: (1) either secondary meaning or inherent distinctiveness has been acquired by the trade dress [or trademark]; and (2) that the defendant’s product is ‘confusingly similar’ to the plaintiff’s product.” *Gruner + Jahr USA Publ’g v. Meredith Corp.*, 991 F.2d 1072, 1074 (2d Cir. 1993).

74. *See generally* *Carefirst of Md., Inc. v. First Care, P.C.*, 434 F.3d 263, 267 (4th Cir. 2006); *Freedom Card, Inc. v. JPMorgan Chase & Co.*, 432 F.3d 463, 470–71 (3d Cir. 2005); *Davis v. Walt Disney Co.*, 430 F.3d 901, 903 (8th Cir. 2005), *cert. denied*, 126 S. Ct. 2303 (2006); *Scott Fetzer Co. v. House of Vacuums Inc.*, 381 F.3d 477, 484–85 (5th Cir. 2004); *Sullivan v. CBS Corp.*, 385 F.3d 772, 776 (7th Cir. 2004); *Sally Beauty Co. v. Beautyco, Inc.*, 304 F.3d 964, 972 (10th Cir. 2002); *Int’l Assoc. of Machinists & Aerospace Workers v. Winship Green Nursing Ctr.*, 103 F.3d 196, 201 (1st Cir. 1996); *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1186 (6th Cir. 1988); *Ambrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1538 (11th Cir. 1986), *cert. denied*, 481 U.S. 1041 (1987).

75. *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961), *cert. denied*, 368 U.S. 891 (1961).

76. *See id.* “Even [the] extensive catalogue does not exhaust the possibilities—the court may have to take still other variables into account.” *Id.*

the markets of the two marks, (5) actual confusion, (6) the defendant's good faith in using his or her mark, (7) the quality of the defendant's product, and (8) the sophistication of the consumers.⁷⁷

The second factor, the similarity of the two trademarks, is especially important to any likelihood of confusion analysis,⁷⁸ and is evaluated in most Circuits through a sequential, marketplace comparison.⁷⁹ For the Second Circuit, this comparison developed through a series of cases,⁸⁰ which includes a 2000 holding that the fact finder must "appraise the overall impression created by . . . the context in which [the marks] are found and consider the totality of factors that could cause confusion among prospective purchasers" in evaluating the similarities between two trademarks.⁸¹ The court affirmed this rationale in 2004, holding that "[b]ecause the ultimate issue is the likelihood of confusion, analysis focuses on the particular industry where the marks compete."⁸²

Then, in a 2005 decision by the Second Circuit, *Malletier v. Burlington Coat Factory*,⁸³ the court once again addressed how lower courts must evaluate the similarity of trademarks when determining likelihood of confusion.⁸⁴ In that case, Louis Vuitton Malletier sued Burlington Coat Factory claiming trademark infringement by Burlington of its Louis Vuitton Monogram Multicolore Design.⁸⁵ The Second Circuit explicitly held that "courts must analyze the mark's overall impression on a consumer, considering the context in which the marks are displayed and 'the total-

77. *Id.*; see *Nabisco, Inc. v. Warner-Lambert Co.*, 220 F.3d 43, 46 (2d Cir. 2000) ("[T]he issue is whether, on balance, the factors establish a likelihood of confusion."); see also *Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 390–91 (2d Cir. 2005) (balancing the *Polaroid* factors), *cert. denied*, 547 U.S. 1019 (2006).

78. *Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 537 (2d Cir. 2005).

79. All federal circuit courts of appeal appear to use a sequential, marketplace comparison to determine a similarity of marks in a likelihood of confusion determination. See, e.g., *Davis*, 430 F.3d at 904 (noting that while marks were identical, they were used in very different manners and in very different markets); *Scott Fetzer*, 381 F.3d at 485 ("[W]e must 'consider the marks in the context that a customer perceives them in the marketplace, which includes their presentation in advertisements.'"); *Dippin' Dots, Inc. v. Frosty Bites Distrib., LLC*, 369 F.3d 1197, 1208 (11th Cir. 2004) (quoting *Ambrit*, 812 F.2d at 1541) ("[A] court may not view [a mark] in a vacuum. Rather, a court must consider how the [mark] would function in the actual market place."), *cert. denied*, 543 U.S. 1054 (2005); *Winship Green*, 103 F.3d at 20 (stating that "any meaningful inquiry into the likelihood of confusion necessarily must replicate the circumstances in which the ordinary consumer actually confronts . . . the conflicting mark").

80. *Lang v. Ret. Living Publ'g Co.*, 949 F.2d 576, 581 (2d Cir. 1991). "In making this determination, a court should look at the general impression created by the marks, taking into account all factors that potential purchasers will likely perceive and remember." *Id.*; see also *Gruner + Jahr USA Publ'g v. Meredith Corp.*, 991 F.2d 1072, 1078 (2d Cir. 1993). "In assessing similarity, courts look to the overall impression created by the logos and the context in which they are found and consider the totality of factors that could cause confusion among prospective purchasers." *Id.*

81. *Nabisco*, 220 F.3d at 47 (quoting *Streetwise Maps, Inc. v. Vandam, Inc.*, 159 F.3d 739, 744 (2d Cir. 1998)).

82. *Brennan's, Inc. v. Brennan's Rest., LLC*, 360 F.3d 125, 133 (2d Cir. 2004).

83. 426 F.3d 532 (2d Cir. 2005).

84. *Id.* at 534.

85. *Id.* at 534, 536. It should be noted that this is the same Vuitton trademark in question in the case at hand. See *supra* note 22 and accompanying text.

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ity of factors that could cause confusion among prospective purchasers.’⁸⁶ As the court in that case noted, “[t]hough two products may be readily differentiated when carefully viewed simultaneously, those same products may still be confusingly similar in the eyes of ordinary consumers encountering the products individually under typical purchasing conditions”⁸⁷ Thus, there is an established Second Circuit legal precedent for the evaluation of likelihood of confusion in relation to trademark infringement, as well as the similarity of marks factor in determining likelihood of confusion.

III. THE COURT’S REASONING

Circuit Judge Cardamone wrote for the United States Court of Appeals for the Second Circuit⁸⁸ in *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, establishing four separate holdings⁸⁹ that addressed (1) the proper burden for a preliminary injunction;⁹⁰ (2) the type of trademark entitled to protection;⁹¹ (3) the proper test for determining the likelihood of confusion;⁹² and (4) the burden that must be met for a trademark dilution claim.⁹³ The Second Circuit agreed with the district court that Vuitton’s Multicolore mark deserved protection,⁹⁴ but vacated the district court’s decision to utilize a side-by-side comparison to determine similarity of the marks.⁹⁵ The Second Circuit also vacated the district court’s decision concerning the proper burden for a preliminary injunction,⁹⁶ but agreed with the district court that Vuitton failed to prove trademark dilution.⁹⁷

86. *Burlington Coat Factory*, 426 F.3d at 537 (quoting *Gruner + Jahr USA Publ’g v. Meredith Corp.*, 991 F.2d 1072, 1078 (2d Cir. 1993)).

87. *Id.* at 539.

88. *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 111 (2d Cir. 2006). Circuit Judge Richard J. Cardamone was joined on the panel by Judge Joseph M. McLaughlin and Judge Rosemary S. Pooler.

89. *Id.* at 112.

90. *Id.* at 114.

91. *Id.* at 116.

92. *Id.* at 118.

93. *Id.* at 119.

94. *Id.* at 116; *see supra* notes 60–61, 68–72 and accompanying text (discussing secondary meaning and inherent distinctiveness). The Second Circuit agreed with the district court, and found that Vuitton’s Multicolore trademark was inherently distinctive and consumers acquired a secondary meaning for this trademark. *Dooney & Bourke*, 454 F.3d at 116. As such, Vuitton’s Multicolore mark deserved protection under section 43(a) of the Lanham Act. *Id.*

95. *Dooney & Bourke*, 454 F.3d at 118.

96. *Id.* at 114.

97. *Id.* at 119. The Second Circuit explained that to establish a dilution claim under the Federal Trademark Dilution Act, 15 U.S.C.A. §1125(c) (West 2000), Vuitton must demonstrate that: “(1) its mark is famous; (2) the defendant is making commercial use of the mark in commerce; (3) the defendant’s use began after the mark became famous; and (4) the defendant’s use of the mark dilutes the quality of the mark by diminishing the capacity of the mark to identify and distinguish goods and services.” *Dooney & Bourke*, 454 F.3d at 118 (quoting *Savin Corp. v. Savin Group*, 391 F.3d 439, 448–49 (2d Cir. 2004), *cert. denied*, 546 U.S. 822 (2005)). There also must be a demonstration of actual dilution, in addition to the above four factors, not just a likelihood of dilution. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 422, 434 (2003). While the panel assumed

Of the four holdings in this case, the Second Circuit focused its opinion on the proper standard to determine whether the similarity between the parties' marks amounted to likelihood of confusion.⁹⁸ The court, relying on its holding in *Burlington Coat Factory*,⁹⁹ stated that "courts must analyze the mark's overall impression on a consumer, considering the context in which the marks are displayed and the totality of factors that could cause confusion among prospective purchasers" to determine similarity of the marks for likelihood of confusion.¹⁰⁰ The court found that the district court improperly relied on a side-by-side comparison¹⁰¹ to determine the similarity of Vuitton's and D & B's trademarks, rather than using a sequential, marketplace comparison,¹⁰² and remanded the issue to the district court.¹⁰³

Importantly, the Second Circuit remanded only the similarity of the marks factor¹⁰⁴ for reconsideration by the district court.¹⁰⁵ The court held that while the district court erred in determining this likelihood of confusion factor, by utilizing a side-by-side comparison,¹⁰⁶ the district court had not "clearly erred with respect to the other *Polaroid* factors."¹⁰⁷ As a result, the Second Circuit only compelled the district court to reanalyze the similarity of Vuitton's and D & B's marks under the sequential, marketplace comparison, and to then rebalance all of the *Polaroid* factors relevant to this case.¹⁰⁸

IV. ANALYSIS

The Second Circuit used *Dooney & Bourke* to make a subtle but powerful statement about protection for fashion designs, including colors, under the Lanham Act. While the court devoted much of its opinion to a sequential, marketplace comparison for determining similarity of marks,¹⁰⁹ as though this was a novel con-

Vuitton would be able to show the first three factors, the Second Circuit agreed with the district court that "Vuitton has not offered any evidence of actual dilution." *Dooney & Bourke*, 454 F.3d at 119.

98. *Id.*

99. *Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532 (2d Cir. 2005).

100. *Dooney & Bourke*, 454 F.3d at 117.

101. *Id.* The Court re-emphasized, as it had in *Burlington Coat Factory*, that a side-by-side comparison can be a useful tool to determine the similarities and differences between two trademarks, as long as the focus continues to remain on "likelihood of confusion" in the marketplace. *Id.* (discussing *Burlington Coat Factory*, 426 F.3d at 538).

102. *Id.*

103. *Id.* at 118.

104. *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961), *cert. denied*, 368 U.S. 820 (1961). "Where the products are different, the prior owner's chance of success is a function of many variables . . . [including] the degree of similarity between the two marks . . ." *Id.*

105. *Dooney & Bourke*, 454 F.3d at 117-18.

106. *Id.* at 117.

107. *Id.* at 118.

108. *Id.*

109. *Id.* at 116-18.

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cept,¹¹⁰ the court's true holding was an implicit refusal to expand trademark protection in the American fashion industry.¹¹¹ The Second Circuit's refusal is evident through its failure to address Vuitton's fashion industry concerns¹¹² and its decision to remand only one factor in the trademark infringement calculus to an already predisposed district court.¹¹³ Unfortunately for Vuitton and other fashion designers, the Second Circuit is unwilling to offer the necessary trademark protection for fashion designs, despite the unavailability of protection from other sources.

A. *The Court Implicitly Refused to Expand Trademark Protection in the American Fashion Industry by Overly Focusing on a Legally Established Comparison for a Likelihood of Confusion Factor.*

While the Second Circuit dutifully performed its job by once again affirming a sequential, marketplace comparison as the proper standard for evaluating similarity of marks for a likelihood of confusion determination,¹¹⁴ the court missed a golden opportunity to assist designers and manufacturers in the American fashion industry. One would think the Second Circuit's likelihood of confusion holding in this case was innovative, as the court devoted almost half of its nearly ten-page opinion to this topic.¹¹⁵ The truth, however, is the court could have easily dispatched this issue, as there is established legal precedent for it, and then used the bulk of its opinion to address the important concerns of Vuitton and the fashion industry.¹¹⁶

The Second Circuit's avoidance of Vuitton's fashion industry concerns is further evidenced by the fact that a few months before this case, the Second Circuit heard arguments on the same issue of likelihood of confusion from Vuitton and Burlington Coat Factory.¹¹⁷ As such, the Second Circuit's overly focused opinion in *Dooney & Bourke* on this matter was duplicative and unnecessary. The disappointing reality of *Dooney & Bourke* is that the Second Circuit's concentration on the proper standard for evaluating similarity of marks in a likelihood of confusion determination merely masked the court's deliberate evasion of the fashion-specific issues raised by Vuitton and the need to address a hole in design-protection legislation.

110. The Second Circuit and most other circuits already have held that a sequential, marketplace comparison is the proper standard for evaluating the similarity of marks for likelihood of confusion. See *supra* notes 79–87 and accompanying text.

111. See *infra* Part IV.A.

112. See *infra* Part IV.B.

113. See *infra* Part IV.C; see also *Dooney & Bourke*, 454 F.3d at 118.

114. See *supra* notes 80–87 and accompanying text (discussing the Second Circuit's prior decisions on similarity of marks for a likelihood of confusion determination).

115. *Dooney & Bourke*, 454 F.3d at 111–20.

116. See *infra* Part IV.B.

117. *Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532 (2d Cir. 2005). *Burlington Coat Factory* was argued on March 2, 2005, and decided on October 12, 2005. *Id.* *Dooney & Bourke* was argued on September 9, 2005, and decided on June 30, 2006. 454 F.3d 108; see also *Burlington Coat Factory*, 426 F.3d at 534, 538–39 (discussing the proper standard for evaluation of similarity of mark in a likelihood of confusion determination).

B. The Court Implicitly Refused to Expand Trademark Protection in the American Fashion Industry by Declining to Expressly Address Vuitton's Purpose for Filing this Lawsuit.

Vuitton filed this lawsuit against D & B to address the issue of “design piracy” in the world of fashion.¹¹⁸ Copyright, patent, and trade dress law do not provide protection from design piracy. However, protection from design piracy may be available under trademark law. By failing to address the possibility of trademark protection from design piracy, the court implicitly refused to expand protection for the fashion industry and declined to expressly address Vuitton’s purpose for filing this lawsuit.

Copyright law provides no design protection to Vuitton or other fashion designers under either 17 U.S.C. § 102 or §§ 1301–02. The general protection offered by 17 U.S.C. § 102 to a pictorial, graphic, or sculptural work is only extended to a design whose “pictorial, graphic, or sculptural features . . . can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”¹¹⁹ In fashion, it is almost always impossible to separate the expressive components (which may be copyrighted) from the utilitarian components (which may not be copyrighted) as required by this statute.¹²⁰ In Vuitton’s case, there is no method to separate the unique colors incorporated into Vuitton’s preexisting Toile Monogram trademark¹²¹ from the rest of the handbag. The colored “LV” initials entwined on the surface of the handbag also are entwined with the other aspects of the handbag, including the sturdy material used to allow the article to functionally hold personal items.

As for copyright protection offered under 17 U.S.C. §§ 1301–02, the “originality” requirement is problematic because it excludes all standard, familiar, or commonplace figures, emblems, symbols, and motifs, along with all designs that differ “only in insignificant details or elements which are variants commonly used in the relevant trades.”¹²² Vuitton’s Monogram Multicolore design consists of letters in different colors on either a white or a black background.¹²³ While Vuitton would argue otherwise, a copyright examiner could conclude that the colored letters are standard symbols or figures, or insignificant variations within the fashion industry. Thus, copyright protection, if ever available to fashion designers, is difficult to obtain and available in a very limited manner.

Patent law, likewise, offers no protection for Vuitton’s Monogram Multicolore design. Even without specifically examining Vuitton’s design, the patent process is

118. See *supra* Part I.

119. 17 U.S.C.A. § 101 (West 2007).

120. See *supra* notes 43–44 and accompanying text (discussing how it is difficult under copyright law to protect clothing).

121. See *supra* note 5 and accompanying text (discussing Vuitton’s unique colors).

122. 17 U.S.C.S. § 1302 (LexisNexis 2004).

123. *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 115 (2d Cir. 2006).

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insufficient for fashion for two central reasons. First, patents are only issued to “new, original, and ornamental” designs, which do not include re-workings or the slight variations in design that the fashion industry considers to be new.¹²⁴ Here, like with copyright law, Vuitton’s colored letters may not be seen as original, but rather as a re-working of the prior use of initials in handbag design. The second reason is that the patent process simply takes too long for the fashion industry.¹²⁵ Vuitton released its Monogram Multicolore design in October 2002, and by July 2003, less than a year later, D & B had released its allegedly infringing “It-Bag” collection.¹²⁶ There was simply no time to seek patent law protection.

Trade dress protection, likewise, provides no refuge to Vuitton’s Monogram Multicolore design. While Vuitton amazingly established secondary meaning for its design in the minds of its consumers,¹²⁷ which is a fairly significant challenge in the fashion industry,¹²⁸ it would still not pass the “not functional” prerequisite required under the Lanham Act.¹²⁹

For example, the use of a color to make a product more desirable to a consumer is a functional use of that color, and that color would not be entitled to trade dress protection.¹³⁰ Vuitton arguably used its unique colors to make its handbags more desirable to its consumers, which indicates that the colors incorporated into its original Toile Monogram trademark are probably functional. Moreover, protecting the trade dress use of these thirty-three colors against a white or black background could be perceived as hindering competition in the relevant market by preventing other competitors from using multicolored symbols on either a white or black background. As such, this would cause Vuitton’s Monogram Multicolore mark to fall under the definition of “functionality.”¹³¹

124. 35 U.S.C.A. § 171 (West 2000); see Raustiala & Sprigman, *supra* note 27, at 1704 (noting that “design patents . . . [do] not extend to designs that are merely reworkings of previously existing designs. . . . [b]ecause so many apparel designs are reworkings and are not ‘new’ in the sense that the patent law requires, most will not qualify for design patent protection”).

125. Raustiala & Sprigman, *supra* note 27, at 1704. “[T]he waiting period [is] lengthy (more than eighteen months, on average, for design patents), and the prospects of protection uncertain” *Id.*

126. *Dooney & Bourke*, 454 F.3d at 112–13.

127. See *id.* at 116 (holding that Vuitton’s Multicolore design possessed both secondary meaning and inherent distinctiveness); see also *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 340 F. Supp. 2d 415, 440 (S.D.N.Y. 2004) (holding that Vuitton’s Multicolore design possessed both secondary meaning and inherent distinctiveness), *aff’d in part, vacated in part*, 454 F.3d 108 (2d Cir. 2006).

128. Bharathi, *supra* note 23, at 1691. “Since the ‘style life’ of a garment is usually not more than three months, secondary meaning is difficult to prove. . . . In a rapidly changing industry, where trends arise almost every season, the length of time required to establish secondary meaning is unlikely to be met.” *Id.*

129. 15 U.S.C.A. § 1125(a)(3) (West 2007).

130. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995).

131. The lower court in this case was concerned that allowing Vuitton to prevail on its trademark claims “would grant Louis Vuitton monopoly rights over a ‘look’—a multicolored monogram against a white or black background.” *Louis Vuitton Malletier*, 340 F. Supp. 2d at 420–21. The underlying problem is that a success for Vuitton would mean that other competing handbag designers would be unable to colorize their own trademarked logos and place these logos on a white or black background. Moreover, a decision for Vuitton would give exclusive rights over this “design” to a manufacturer with a substantial amount of market share in the

In the fashion industry, however, this worry is misplaced and unfounded due in part to trade dress legislation's failure to consider the nature of fashion trends. Fashion designs and trends change seasonally, and what is in high demand by consumers one month changes drastically throughout a single fiscal year.¹³² Thus, while allowing Vuitton to protect its unique colors under trade dress law may give them a slight edge temporarily, the edge will not last long in the world of fashion. Regardless of this truth, trade dress protection provides no shelter for Vuitton's newest creation.

Without the protection of copyright, patent, or trade dress laws, Vuitton pursued this lawsuit under trademark law in the hope of convincing the Second Circuit that the newly incorporated colors were an element of its already protected Toile Monogram trademark.¹³³ As the Second Circuit noted, "Vuitton does not seek to protect the overall look of its handbags, that is, its trade dress, but rather the narrower trademark it has established in its colored pattern."¹³⁴ Vuitton's intent was to

*visibly integrate a trademark to an extent that the mark becomes an element of the design. Burberry's distinctive plaid is trademarked, for example, and many of Burberry's garments and accessories incorporate this plaid into the design. . . . For these goods, the logo is part of the design, and thus trademark provides significant protection against design copying.*¹³⁵

The Second Circuit, however, refused to expressly hold whether Vuitton's Monogram Multicolore design qualified to receive protection as a trademark. Furthermore, the court failed to address or discuss the fashion industry and the lack of protection for fashion designs, even though these issues were motivating factors

higher-end handbag industry. This may also raise antitrust issues under section 2 of the Sherman Act, which prohibits entities from "monopoliz[ing], or attempt[ing] to monopolize, or combin[ing] or conspir[ing] with any other person or persons, to monopolize any part of the trade or commerce among the several States, or with foreign nations . . ." 15 U.S.C.A. § 2.

132. See Raustiala & Sprigman, *supra* note 27, at 1705 (noting that "[g]iven the short shelf-life of many fashion designs, the design patent is simply too slow and uncertain to be relevant"); see also Lennie Bennett, *Lukewarm Coco*, ST. PETERSBURG TIMES, June 5, 2005, at 8E ("A point the exhibition makes—and that all dealing with fashion make—is its fleeting nature."); Melissa Maynard, *The Fast-Moving Fashion World Leaves Little Time for Signature Style*, CHICAGO TRIB., Jan. 12, 2005, at 4 ("Fashion's fleeting nature barely gives us time to find a current style we want . . .").

133. *Louis Vuitton Malletier*, 340 F. Supp. 2d at 420. This is supported by Vuitton's motion for a preliminary injunction, which requested the district court to enjoin Dooney & Bourke from "using in any way any of the Louis Vuitton Trademarks, including the Louis Vuitton Toile Monogram Multicolore Trademarks, [or] any designation or design so similar as to be likely to cause confusion, mistake or deception with . . . the Louis Vuitton Trademarks." *Id.* (emphasis added).

134. *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 115 (2d Cir. 2006). "Like the Toile Monogram, these [Multicolore] marks similarly featured a repeating diagonal pattern of intertwined initials and shapes. This pattern was now colorized with thirty-three specially-chosen and contrasting Murakami colors. In addition, the patterns were placed on either a white background or a black one, instead of the original brown, creating an electric, pop-art effect." See Brief of Plaintiff-Appellant, *supra* note 5, at 7.

135. Raustiala & Sprigman, *supra* note 27, at 1701.

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behind this lawsuit.¹³⁶ Instead, the Second Circuit remanded the issue of trademark infringement to the district court, and unlike the lower court,¹³⁷ failed to mention the fashion industry background of this case¹³⁸ or the hardships facing fashion designers in protecting their creations.

C. The Court Implicitly Refused to Expand Trademark Protection in the American Fashion Industry by Remanding the Trademark Infringement Issue to a District Court Disinclined to Favor Vuitton.

The Second Circuit remanded the issue of trademark infringement with knowledge that the district court was likely to find against Vuitton. Specifically, the court knew from the record that the district court found a majority of the *Polaroid* factors in favor of D & B.¹³⁹ The Second Circuit also knew that the district court believed that a balancing of the *Polaroid* factors did not support a finding of likelihood of confusion.¹⁴⁰ Finally, the court knew that the district court believed that “[i]f Louis Vuitton succeed[ed], then it [would] have used the law to achieve an unwarranted anticompetitive result”¹⁴¹ and “it would grant Louis Vuitton monopoly rights over a ‘look’—a multicolored monogram against a white or black background.”¹⁴²

Thus, the Second Circuit’s decision to remand the issue of trademark infringement to the district court appears to be an implicit refusal by the court to expand trademark protection in the American fashion industry. After all, the court re-

136. While the lower court in this case did not favor Vuitton’s request for fashion design protection, the district court at least addressed the fashion industry setting of this case. In fact, district Judge Scheindlin opened the case by stating that “[t]his case involves the Court in the world of haute couture, where Louis Vuitton Malletier, armed with state and federal trademark law, seeks to prevent Dooney & Bourke, Inc.—and all others—from trespassing in what it perceives as its fashion ‘territory.’” *Louis Vuitton Malletier*, 340 F. Supp. 2d at 419–20. The district court then spent the following two pages discussing the general facts of this case against the background of the fashion industry. *Id.* at 420–22.

137. See *supra* Part IV.B (discussing the Second Circuit’s failure to directly address Vuitton’s fashion-specific concerns).

138. *Dooney & Bourke*, 454 F.3d at 118. “We do not believe the district court clearly erred with respect to the other *Polaroid* factors.” *Id.* (emphasis added).

139. *Louis Vuitton Malletier*, 340 F. Supp. 2d at 441–47. Specifically, the district court found there was no evidence of actual confusion (Factor 5: Existence of Actual Confusion), that customers who shop for [expensive] products in high-end department stores are usually discriminating customers (Factor 6: Sophistication of Consumers), that there was no proof that Dooney & Bourke acted with bad faith (Factor 7: Bad Faith), and that the quality of the defendant’s product was neutral (Factor 8: Quality of Product). *Id.* It is also reasonable to believe that, even after a reanalysis of the “similarity of the marks” factor under the sequential, marketplace comparison, the district court still will maintain that there is not a sufficient degree of similarity between the marks. This is especially possible as the district court believes the consumers of these bags to be sophisticated enough to differentiate between the “LV” initials on Vuitton’s bags and the “DB” initials on Dooney & Bourke’s bags. *Id.* at 446.

140. *Id.* at 447. “According each of the factors its proper weight, it is quite clear that Louis Vuitton has not demonstrated that there is a likelihood of confusion . . . among consumers as to the source, authorization, or affiliation of Dooney & Bourke’s handbags.” *Id.*

141. *Id.* at 420.

142. *Id.* at 421; see *supra* note 132 and accompanying text (explaining why the district court’s arguments are arguably incorrect).

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manded this issue to a district court it knows disfavors Vuitton. The Second Circuit, moreover, only criticized the district court's initial finding concerning how the similarity of two marks was to be determined. As such, it is reasonable and logical to believe that Vuitton will lose its trademark infringement claim upon remand, as there is only one likelihood of confusion factor to reconsider, and thus federal courts will continue to limit trademark protection in ways detrimental to fashion innovation.

V. CONCLUSION

The decision by the Second Circuit in *Louis Vuitton Malletier v. Dooney & Bourke, Inc.* represents a refusal to offer necessary protection to designs in the American fashion industry. Vuitton, unable to shield its Monogram Multicolore design under copyright, patent, or trade dress protection, attempted to convince the Second Circuit that its newest design was an element of its original Toile Monogram trademark so that it could receive protection under trademark laws. The court in this case, however, implicitly refused to expand trademark protection to include the use of colors and background colors as elements of Vuitton's trademark, and the fashion industry is once again left with minimal protection for its designs.