

## Picture My Bag

Law360, New York (April 12, 2011) -- For the woman with a great sense of style and a not-so-great budget, how can she get a famous Hermes Birkin bag? The iconic and sought-after Birkin is a special piece. It has been a must-have item for decades. Many consumers would love to hold — and be seen carrying — the distinctive, handcrafted fashion accessory that has been featured in Allure, Vogue, Vanity Fair, Style and People magazines and has appeared in episodes of "Sex and the City," "Will and Grace" and "Gossip Girl."

Faced with prices starting at \$6,000 and subject to a waiting list over a year long, what's a shopper to do? Thursday Friday Inc. had an idea.

The "Together bag," available for purchase through the Thursday Friday Inc. website, is a screen-printed, cotton tote bag featuring on each of its five surfaces corresponding images of what appears to be a genuine Birkin (back, front, bottom and sides). Thursday Friday calls its product an "extra bag to supplement our 'real' bags" for carrying groceries or gym clothes, describing it as a "surreal design that references luxury" and contending that the Together bag comments on the Birkin.

Priced at only \$35 and available in blue, red or brown, this "lo-fi carryall" allows almost any shopper to be seen with the coveted status symbol (or at least an image of it) on her person. It is a bag on a bag. The Together bag's popularity has taken off, with write-ups in The New York Times, Glamour and Elle — and now has its own three-month waitlist. Hermes is not amused. It's not easy being Hermes orange.

### The Lawsuit

On Jan. 28, Hermes filed a five-count complaint against Thursday Friday in the Southern District of New York, alleging violations of federal and state laws for trademark infringement, unfair competition, false designation of origin and dilution by tarnishment. Hermes apparently believes Thursday Friday's Together bag takes advantage of the French company's famous image and reputation without its permission, perhaps even implying its endorsement. And Hermès wants it to stop.

The Birkin design itself is protected under U.S. trademark law. The registration covers the strapped and padlocked closure. The registration has become an incontestable U.S. trademark, meaning it is immune from a challenge regarding its descriptiveness.[1]

Hermes — known for keeping a keen eye out for rip-offs of its famous designs and for vigorously protecting its mark — has waged and prevailed in past legal battles in New York over knock-offs of the Birkin, based on the bag's recognizable shape.[2]

When it comes to knock-offs, infringement of a registered trademark design or trade dress is a relatively straightforward issue on a very basic level — especially when the rights holder has successfully protected its design against copycats in past legal actions. It is generally a question of consumer confusion: Will people at point of sale or post-sale be confused, and thus believe that its origin is the same as the original? Is the intent of the defendant to intentionally copy the design and sell knock-offs of the originals, deliberately trading off the name and products of the plaintiff?

The question in this case, however, may be somewhat different. Is it actually accurate to call the Together bag a knock-off? Though it is an over-the-shoulder bag like the Birkin, is the rectangular canvas tote actually likely or intended to promote customer confusion? Will people think the Together bag is part of the Birkin line or that it is made or licensed by the same company? Is that the intention of its creators? It is not entirely clear. The Together bag is not what one typically would call a knock-off or a counterfeit.

Given the quality and style of the Together bag, the key legal issue is perhaps more properly framed as whether an image of a product (uncopyrightable as a useful article) can be protected via trademark or trade dress theory when placed on another product.

If that is the issue, is putting a picture of an Hermes Birkin bag on a non-Hermes bag any different than putting such an image on a t-shirt without permission? Hermes' greatest fear seems to be that consumers will be duped into thinking that Hermes has granted approval to use the Birkin design or has been involved in some kind of sponsorship of the Together bag, "giv[ing] into the temptation to license its famous trademark for mass market goods." [3]

The story and mission of the Together bag, according to Thursday Friday, might be viewed more in a light of commentary than copycatting. Thursday Friday says on its website, "Yeah, we're inspired by consumerism, class and iconography, but that doesn't mean we're putting out precious, abstract concepts."

Rather, the company prefers to think of its product as an "anti-status status symbol." [4] It sounds like the Together bag may be an attempt to say something about the Birkin bag, rather than an attempt to be a Birkin. Except in cases involving obscenity, the Second Circuit has a history of being generous toward unauthorized use if it is legitimate trade dress parody. [5]

If making such a claim, perhaps the most significant example for Thursday Friday to reference is the Cliffs Notes case. [6] In that case, the popular study-guide series Cliffs Notes sued over a parody, "Spy Notes," which had an extremely similar cover.

The Second Circuit invoked a balancing test, weighing public interest in free expression against consumer confusion when an expressive work (like a parody) is alleged. The court specified that "the expressive element of parodies requires more protection than the labeling of ordinary commercial products," and held in favor of the creator of Spy Notes. The channels of commerce for each of the products in the Birkin bag case are likely to be very different. One would find it difficult to find anything at an Hermès shop priced at \$35 or less.

In this case involving much more than accusations of a “knock-off,” the outcome remains to be seen. The Together bag appears to make a statement about the Birkin bag and the status surrounding it. But is it homage, parody or just a rip-off? Either way, is it likely there would be a three-month waiting list for this cotton tote if it did not have the Birkin bag images on it?

As a practical matter, if someone decides to reproduce an image of another’s valuable product without permission, do not expect the originator of the product to be pleased. A lawsuit should not be a surprise. For trademark owners, registering distinctive product designs can be of great help when the designs are used, even in unexpected contexts.

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[1] U.S. Trademark Registration No. 1,806, 107.

[2] *Hermes International et al. v. Lederer de Paris, Inc. and Pelle Via Roma, Inc.*, 98 Civ. 2820 (SAS).

[3] *Hermes Complaint*.

[4] <http://www.thufri.com/pages/about-us>.

[5] See, e.g., *Cliffs Notes Inc. v. Bantam Doubleday Dell Publishing Group Inc.*, 886 F.2d 490 (2d Cir. 1989); *Hormel Foods Corp. v. Jim Henson Productions Inc.*, 73 F.3d 497 (2d Cir. 1996).

[6] *Cliffs Notes Inc. v. Bantam Doubleday Dell Publishing Group Inc.*, 886 F.2d 490 (2d Cir. 1989).

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