

# Trademark Review

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## The Last Chapter in the Louboutin Red Soled Shoe Story

In what is likely the final ruling in the continuing story of Christian Louboutin's fight to protect its red lacquer shoe soles, the Second Circuit Court of Appeals rejected Louboutin's request that the Court amend its prior order to broaden the scope of Louboutin's trademark protection.

In September, the appeals court ruled that Louboutin has trademark rights in its lacquered red sole on footwear but only if the red sole contrasts with the color of the remainder of the shoe. The court directed the U.S. Patent and Trademark Office to make an appropriate limitation to Louboutin's registration.

Louboutin sought a modification of the appeal court's mandate because the PTO indicated it would amend Louboutin's registration by adopting the language of the court's mandate word for word. The court held Louboutin made no showing of the "exceptional circumstances" required to grant a request for modification of the court's order. The opinion does not indicate what modification Louboutin was seeking.

*Christian Louboutin SA et al v. Yves Saint Laurent America Holding Inc.*, (Case No. 11-3303, (2nd Cir. March 8, 2013)).

## Applicants for U.S. Trademark Registrations Must Have a Bona Fide Intent to Use the Mark for All Listed Goods and Services

Sandro Andy is a French company that designs, manufactures and sells clothing in many countries around the world under the mark SANDRO. Sandro had an International Registration for its SANDRO mark (issued by the World Intellectual Property Organization) and obtained a U.S. registration by extending protection of that International Registration to the U.S. pursuant to §66(a) of the Trademark Act. Sandro's U.S. registration identifies over 250 items ranging from laundry detergent to clothing to perfumes to animal leashes. Sandro later started using the SANDRO mark in the U.S. on clothing.

Sandro filed an infringement lawsuit against Light Inc. alleging infringement of its registered SANDRO mark. Light filed a counterclaim seeking to cancel Sandro's registration on the basis that Sandro lacked a bona fide intent to use the registered mark on all the goods and services listed in the registration. Sandro filed a motion to dismiss Light's counterclaim.

The owner of an International Registration seeking to extend protection of that mark to the U.S. does not need to actually use the

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mark in commerce in the U.S. prior to obtaining the registration here, but the application *must include* a declaration of bona fide intention to use the mark in commerce. This is true whether the application is filed based on a foreign application (§44(d)), a foreign registration (§44(e)) or by extension of an International Registration (§66(a)).

Sandro argued that a party may petition to cancel a registration on grounds that the registration was obtained fraudulently, but that Light's counterclaim does not meet the pleading requirements for a fraud claim. Because Sandro was required to have a bona fide intent to use the *mark*, the court held that Light's counterclaim to cancel the registration stated a valid claim. Sandro also argued that it was only required to declare an intent to use the mark, and the intent did not have to be specific to the goods. The court rejected this argument also.

Sandro conceded that the mark was in use only in connection with apparel in Class 25 and indicated it was willing to delete all unused classes from its International Registration. Light sought to have the entire registration deemed void ab initio because Sandro did not possess the necessary bona fide intent to use the mark for each and every good listed on the International Registration. The court found, however, that absent fraud, a lack of bona fide intent to use the mark for some but not all of the goods "is not necessarily a reason to deem the entire registration void ab initio." Rather, the court directed Sandro to amend its registration to delete the unused goods and classes.

*Sandro Andy S.A. v. Light, Inc.*, Civil Action No. 12 Civ 2392 (HB) (SDNY Dec 27, 2012).\*

\*Although this decision was issued in December, it is an important reminder to foreign companies seeking registration in the U.S.

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