

# Louis vuitton malletier vs dooney and bourke inc

[Business](#), [Company](#)



In this famous case known as the “ Battle of the Handbags” Louis Vuitton (LV) sues Dooney & Burke (D&B) for trademark infringement of its multicolore line. The Plaintiff, Louis Vuitton Malletier , is a French fashion house founded in 1854 by Louis Vuitton. The famous label is well known for its LV monogram, which is featured on most of its products. Louis Vuitton is considered as one of the world’s most valuable and prestigious brands. The LV monogram was created in 1896 by Louis’ son Georges Vuitton who invented the symbol and the letters represent his father’s initials.

The logo is a Japanese-inspired flower motif which initially was created as a way to prevent counterfeiting. This memorable logo is now synonymous with luxury, brilliance and indulgence. It is the world's 29th most valuable brand and is estimated to be worth over \$19 billion USD. Unfortunately, Louis Vuitton is one of the most counterfeited brands in the fashion world due to its image as a status symbol. The company takes counterfeiting seriously, and uses all its possible resources to fight counterfeiting. The Defendant, Dooney & Bourke, is an American company founded in 1975 by Peter Dooney and Frederic Bourke.

The company specializes in fashion accessories and is best known for its high quality handbags, accessories, and travel luggage. Their Signature and Mini Signature handbags consist of the " DB" initials interlocking in a repeating pattern. The founders of the company started off with two introductory products: surcingle belts and suspenders for men. Their products became very popular due to their unique design and color. Now Dooney & Bourke is a well-known brand in America and has a good reputation for making quality

products. The defining look of Dooney & Bourke is elegant and sophisticated, but above all, it is timeless.

Its classic designs make these handbags the perfect accessory for any outfit due to the superior quality and unique form. In 2002, the designer Marc Jacobs invited the Japanese artist Takashi Murakami to come up with a fresh take on the Louis Vuitton "toile monogram" famous entwined LV logo intermixed with flower shapes for a new line of bags. This led to the creation of the Monogram Multicolore design, in 33 colors, displayed on handbags in a repeating pattern against a white or black background. The bags made their debut on Paris runways in October 2002 and were then presented in prestige retail outlets in March 003, where they sold for up to \$3, 950. Previously LV registered its famous LV monogram design pattern and the individual unique shapes as trademarks with the United States Patent and Trademark Office. In July 2003 D in collaboration with Teen Vogue developed a new line of handbags for teenagers. It was launched as the " It Bag" collection. The pattern on the purses consisted of the entwined " DB" initials printed in contrasting colors on variety of colored backgrounds and white and black background. D released handbag line looked similar to Louis Vuitton's trendy model, but the price was significantly lower.

Considering the fact that Louis Vuitton fights counterfeiting very aggressively, not surprisingly, the matter ended up in the courts. LV immediately viewed the " It Bag" as a copy of their design. When Louis Vuitton gathered with legal counsel on their options to file suit against Dooney and Bourke, they became aware of the alternatives that were

available to them in order to move forward. For designers and manufacturers in the American Fashion industry, there are four possible avenues to explore:

1. Copyright protection,
2. Patent protection,
3. Trade Dress protection
4. Trademark protection.

Copyright protection covers a range of categories including literary, musical, dramatic, choreographic, pictorial and architectural works. Within this range, the only one that is applicable to fashion designs is pictorial, as it shields two- and three- dimensional works. Patent protection shields any “ new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof”. Since the design in the fashion industry rarely creates a new process, machine or manufactures, they have a separate statute specifically for them for new, original and ornamental design for an article of manufacture.

Trade dress protection is addressed under the Lanham Act to defend 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. Colors have also been addressed under the Trade dress protection in which the United States Supreme Court has stated that the color and designs of a product are only protected under the Lanham Act if a secondary meaning has been demonstrated.

Color and design must be associated by the customer for that particular product over time. In 2004, the legal team decided to advance with option 4:

Trademark protection. They claimed trademark infringement, trademark dilution, as well as unfair competition and false designation. Trademark infringement harbors a manufacturer or seller's product to include a word, slogan or symbol. For instance, Apple is an example of a word that cannot be used in relationship with software or computers as it will cause confusion from a consumer's perspective.

Nike holds the trademark of the slogan "Just Do It" that is associated with its product and McDonald's hold trademark of the golden arches symbol. In some instances this protection can extend to other properties such as its color or even its packaging. For trademark dilution claims, the distinctive quality of a mark must be diluted by blurring or tarnishment. However, the likelihood of confusion is not necessary. Unfair competition and false designation is characterized as likely to cause confusion, mistake or deceive the consumer.

Section 43(a) states " any person who on or in connection with any goods or services, or any container goods, used in commerce any word, term, name or symbol, or device, or any combination therefore, 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 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. " In addition under sections 32 and 43(a) of the Lanham Act, trademark protection extends above the registered trademarks to the unregistered trademarks from misuse or reproduction in commerce. Once a trademark is established as fundamentally distinctive or to have developed secondary meaning, as well as protection under the Lanham Act, one can then address the likelihood of confusion under trademark infringement.

Statutes require a sense of clear case situation as well as a specific element of which the claim can be proven as a violation of the law. This means that sequential evidence is needed, as this poses the validity of the claim and further makes the justification of the case. Without this evidence, the case could be deemed as void, as there is no possible evidence that can prove the claim. Statutes also require the clarity of the case, which means the details of the case or the violation should be given in chronological order so that the justifications set for the claim as well as the laws that could be used to make it more justified could be legally provided.

There is actually a varied definition on how violations of laws happen. There are times when a crime committed may not be a violation of the law, or the violation of the law is not a crime. This happens when the crime being claimed is not part of the scope of the statute, or there is no existing law for such crime. Therefore this results in deliberating on whether the action indeed is a crime or a violation of the law. Situations such as this often arise from actions where the defendant is ignorant of the law which he has

violated. In addition, the claimant can be the one who is ignorant of the law when he laid evidence on the ' crime' allegedly committed by the defendant.

Now that we have a thorough understanding of the applicable laws, the rules that govern those laws and what are required by the statutes to prove a violation of law we can examine how the case unfolded. As previously stated, Vuitton filed suit against D&B in April of 2004 in the United States District court for the Southern District of New York, claiming trademark infringement, unfair competition and false designation, and trademark dilution. Vuitton moved for a preliminary injunction against D&B which would have stopped sales of the " it bag" until the case was resolved. The District court ruled in favor of D&B and Vuitton was not granted the injunction. In determining trademark infringement the court applied the two prong test required of Section 43 of the Lanham Act.

First the test looks to whether or not the mark merits protection by determining if the unregistered trademark is distinctive or has achieved secondary meaning. In this case the district court did find that Vuitton's design was distinctive and had garnered secondary meaning in the market place. The second part of the test involves deciding whether the defendant's use of the mark is likely to cause consumers confusion as to the origin or sponsorship of the defendant's goods. Accordingly the court then examined the eight factors weighed in determining likelihood of confusion:

1. the strength of the mark
2. the similarity between the marks
3. the proximity of the roducts

4. the likelihood that the plaintiff will bridge the gap between the markets of the two marks
5. actual confusion
6. the defendants good faith in using his or her mark
7. the quality of the defendant's product
8. the sophistication of the customers.

The district court ruled that there was no likelihood of confusion based on its evaluation of the 8 factors and thus denied the injunction. In addition, the district court found that Vuitton was unable to prove trademark dilution. LV appealed the injunction denial to the Second Circuit Court of Appeals hoping to force the court into making a more broad judgment with regard " design piracy". Unfortunately for Vuitton the court was not in the mood to make a statement in favor of protecting designers.

Rather than make its' own ruling on the case, based on the facts laid out before the court, the Second Circuit instead focused on a mistake by the district court in its application of the standard of likelihood of confusion. The Second Circuit had previously held in *Louis Vuitton Malletier v. Burlington Coat Factory* that courts must use a sequential market place comparison rather than a side by side comparison when applying the standard of likelihood of confusion. The district court had used a side by side comparison that the Second Circuit deemed improper. In addition, the Second Circuit agreed with the district court that LV was not able to prove trademark dilution at the federal level.

In order to prove trademark dilution the plaintiff must demonstrate the following; " its mark is famous, the defendant is making commercial use of

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the mark in commerce, the defendants use began after the mark became famous, the defendants use of the mark dilutes the quality of the mark by diminishing the capacity of the mark to identify and distinguish goods and services". Vuitton was able to prove the first three requirements but was unable to prove actual dilution. While the court did agree that LV could not prove actual dilution (the federal requirement) they vacated the injunction at the state level due to the fact that it only requires LV to show likelihood of dilution.

The Second Circuit decided to remand the similarity of the marks factor back to the district court for reconsideration. This meant that the district court would use the sequential market place comparison when examining the similarity of the marks and hold onto all other previous analysis of the likelihood of confusion factors. Even if the market place comparison had an effect on that one factor it was very unlikely to affect the outcome of the district court's ruling because the similarity of the marks was just one of eight weighted factors. The Second Circuit was essentially making a statement with its handling of this case that it was not prepared to make a precedent setting ruling on the lack of protection for " design piracy" in the fashion industry.

Even if they desired to address the topic, strictly following the established law would have prevented them from coming up with a different result. The court may have felt that any perceived or real injustice plaguing the fashion industry should be handled through the adoption of written law rather than legislated from the bench. Ultimately in May of 2008 the district court granted summary judgment to D&B on all claims. The court found that Louis

Vuitton did not have adequate evidence to present with regards to the trademark infringement or dilution claims. While the outcome of the case disappointed many people because D&B did copy the design, the court based its decision on the interpretation of the law.

Another example of a trademark infringement case that could have implications is European Trademark vGoogle. Originally LV sued Google in France claiming trademark infringement from Google's AdWords program and the French court ruled in LV's favor. The court held that Google was committing trademark infringement and diluting the trademark when it decided to sell the LV name to other companies in order for their site to pop up upon a search. Unfortunately for LV the European Court of Justice later ruled that Google in fact was not guilty of trademark infringement. There is a silver lining for LV. The court stated that advertisers using a trademark as a keyword can be held liable for infringement.

The court specifically stated that "such use of a trademark by the advertiser adversely affects the source-indicating function of the trademark if the advertisement does not enable normally informed and reasonably attentive internet users to ascertain whether goods or services referred to by the ad originate from the proprietor of the trademark or, on the contrary, originate from a third party". Thus, a company like Louis Vuitton does have legal recourse if it finds misleading advertisements from searches of its brand. In addition, Google can be held accountable if it was aware of the improper use of the trademark and did not take the ad or content down.

The ruling could have impacted a case like Louis Vuitton Malletier v Dooney & Bourke Inc. , but instead has gone farther towards protecting companies in <https://assignbuster.com/louis-vuitton-malletier-vs-dooney-bourke-inc/>

the fairly unregulated internet market place. In closing, companies like LV will have to continue to be extremely aggressive through the use of lawsuits in order to protect their brand. Once more laws are applied to specific industry, such as the fashion industry, it will become easier to convey. The courts can only interpret the law, not create laws to safeguard these specific industries. The courts, as well as the citizens, have to trust that the legislative branch will step up and address these complex issues.