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ARTICLE



Generic Use Abroad Does Not Mean Generic Use in US

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This article examines the *Deckers Outdoor Corp. v. Australian Leather Pty., Ltd.* case, in which the US District Court in Illinois addressed the issue of whether a term found to be generic in Australia should also be found to be generic in the US. It also takes a closer look at whether the doctrine of foreign equivalents should apply to a term used in another English-speaking country.

Deckers, the owner of the UGG brand, filed a complaint against Australian Leather asserting claims for trademark infringement, among other things, based on Australian Leather's sale of boots it called "ugg boots." Australian Leather responded by claiming that "ugg" was a generic term for a kind of sheepskin boot, which was popularized by Australian surfers in the 1970s. They requested that Deckers' trademark registration for the UGG mark be cancelled and the company barred from preventing third parties from calling their boots "uggs." Australian Leather also argued that the term "ugg" is generic in Australia and should be treated as such in the US pursuant to the doctrine of foreign equivalents. The court held that even if Australian Leather could establish that the term "ugg" was generic in Australia, it was not able to link that finding to consumer perceptions in the US. The court also determined that the application of the doctrine of foreign equivalents suggested by Australian Leather was not correct. Ultimately, a court in the US will look to the US marketplace and US consumer perception as determinative.

Read "Generic Use Abroad Does Not Mean Generic Use in US" in its entirety.

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