

The Katten Kattwalk®

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Katten

Katten Muchin Rosenman LLP

Letter From the Editor



Welcome to the Winter 2018 issue of *Kattwalk*.

In this issue, we are pleased to introduce you to City University of New York School of Law student Theodora Fleurant and the interesting work she is doing for underserved business communities in partnership with Volunteers of Legal Services' Microenterprise Project and Katten. We also talk to our own Corporate partner David Kravitz, as he shares insights into his work with fashion clients, trends in this sector and more.

Also in this issue, we examine the recent TTAB decision regarding the likelihood of confusion between trademarks that share a common surname for complementary fashion products. We also look at whether a term found to be generic abroad should compel the same conclusion in the US.

We hope you enjoy this edition and will check back in with us in the spring for more.

Karen Artz Ash

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Through the Lens



Theodora Fleurant



-----[passion]-----

Tell us a little about yourself

Originally from Brooklyn, I am currently a 3L at the CUNY School of Law. I am the daughter of Haitian parents, who worked hard to provide and create a great life for me and my two siblings. During my time at Hunter College, I worked as a legislative intern for Gale Brewer through a public scholar program. After graduating from Hunter, I went on to the New York Public Library, where I worked for five years, primarily doing community outreach and technology training. I was driven to attend law school and focus on public interest law by what I saw as an inequality in the distribution of educational resources in New York.





Through the Lens: Q&A With Theodora Fleurant

-----[inspiration]-----

◉ ◉ ◉ What got you interested in the externship through Volunteers of Legal Services?

At CUNY, I have been fortunate to be able to participate in the Community & Economic Development (CED) Clinic's Economic Democracy practice. This program provides transactional legal services to worker-owned cooperatives and small businesses. Through my work with the CED Clinic, I saw a need for IP services and became motivated to find an external placement where I could gain practical IP experience. I was introduced to the Volunteers of Legal Services' (VOLS) Microenterprise Project, which helps small business owners and microentrepreneurs gain access to free legal services through its network of pro bono partners, including Katten.

-----[motivation]-----

What generated your interest in intellectual property?

While in law school, I worked on a research project that involved trademark law, and the IP bug never left. I was also moved by the book *My Beloved World*, by Justice Sonia Sotomayor, in which she discusses her work as an IP attorney and going after counterfeit goods. As I thought about how to better serve under-resourced businesses and communities, I realized that IP is often a missing component of community economic development services.

-----[lifestyle]-----

What about fashion?

While initially my interest was in IP generally, my time at Katten has sparked a particular interest in the fashion industry. My first client during my externship was a fashion designer, and it was rewarding to help her recognize and defend her IP rights. I have a desire to continue to help current and future designers—especially those that lack access to high-quality and fundamental legal services—protect their creations and get one step closer to their goals.



-----[vision]-----

What were your expectations for the externship?

In addition to gaining real-world IP experience, I want to help fill what I see as a knowledge gap within the business communities I've worked with. So many business owners lack the knowledge to properly protect their IP. Through the VOLS program and with help from my mentors at Katten, I am developing curriculum for an IP workshop that will give small businesses a basic understanding of their rights. I am also revising our intake questionnaire to make sure it includes questions about trademarks and copyrights, as these are things every entrepreneur should be thinking about.



-----[experience]-----

What skills have you gained from this experience?

In addition to gaining hands-on IP experience, including how to conduct trademark clearance searches, perform trademark prosecution analyses and the importance of due diligence, this experience has really helped me sharpen my interpersonal and communication skills. I've learned how to take complex issues and present them in a simplified way that my clients can understand.

-----[insight]-----

What did you learn during the externship that surprised you?

One interesting and unexpected aspect has been how interwoven IP is to other areas of law. What could initially be a question about a trademark can lead to other issues, including those involving business, tax and employment law.





David Kravitz

Corporate Partner

Katten Muchin Rosenman LLP

-----[passion]-----

Tell us about your background

I am a transactional lawyer, with a focus on middle-market mergers and acquisitions and related financings, including a substantial amount of private equity work. I frequently represent buyers and sellers in a variety of transactions, including buyouts, minority investments and joint ventures. I began my law career at Katten more than 13 years ago, during which time I have worked across a number of industries, including numerous transactions in the fashion and retail sector.

-----[inspiration]-----

What are some noteworthy matters you've worked on, and what is your current focus?

Early in my career, I worked on the \$6 billion sale of a public company, as well as other billion-dollar public transactions. Throughout my career, I have worked on various kinds of corporate transactions, including purchases and sales of companies, initial public offerings, and equity and debt financings. My practice is now focused on the middle market, with \$100-\$500 million transactions being our customary deal size.

-----[challenge]-----

What do you find interesting about working with fashion and branded retail clients?

I particularly enjoy working with brands because a wide variety of legal disciplines come into play, whether we are advising a startup or a large, established company. In particular, brand positioning and presentation are critically important factors when working with fashion and retail clients. Our clients are very protective of how they will be perceived in the market and are intent on maintaining their brand perception and authenticity.

-----[vision]-----

What's the most rewarding aspect of your work?

I find it incredibly enjoyable to work with creative people with vision—in particular those in the fashion industry—who tend to bring a fresh perspective to deals and to see terms differently than bankers or lawyers who handle transactions on a full-time basis. These types of experiences help to expand my own perspective as counsel, and I've used those lessons in the work I do for clients both in and out of the fashion and retail space. Additionally, it is rewarding to work side-by-side with founders and entrepreneurs to help them develop, grow and, in some cases, sell their businesses.

-----[experience]-----

What are some of the firm's strongest areas at the moment?

One of Katten's greatest strengths is our ability to harness the talents of a wide variety of legal disciplines and bring them to bear in a focused way to solve problems for our clients. Fashion and retail are great examples. We bring our extensive M&A experience together with our IP, tax, real estate and other teams, allowing us to advise clients in a powerful, holistic way. Given the breadth of our practice, we can handle virtually any matter that a brand may encounter,

from leases, litigation, Americans With Disabilities Act compliance and other areas that are critical to those in the fashion and retail sector.

-----[innovation]-----

What are some of the legal trends you are seeing in the fashion sector?

Fashion and branded apparel M&A is very active right now. Deal activity has picked up substantially in the last few years, which has been driven by sophisticated investors' desire to invest in high-quality brands. We, fortunately, have long-standing relationships with many of these brands and have been able to help with all aspects of the investments. We pride ourselves on having a deep understanding of our clients' businesses, which helps us to advise on complex transactions.

-----[insight]-----

What do you do for fun when not working?

I like to exercise, travel and watch sports. I'm originally from Cleveland and, unfortunately, suffer through losing seasons year after year as a Cleveland sports fan. Somehow, they keep me coming back for more.



Karen Artz Ash Honored at New York Law School Gala

National co-chair of Katten's Intellectual Property department **Karen Artz Ash** was recognized as an influential leader in IP and in the fashion industry at the New York Law School's (NYLS) annual gala on November 15. NYLS also honored Karen for her deep commitment to pro bono work, including her role as board chair of Volunteers of Legal Service, as well as her contributions to NYLS, where she is a dedicated adjunct professor, mentor and trusted advisor to the School's Innovation Center for Law and Technology.

The gala raised more than \$900,000 for student scholarships, academic programs and faculty research. Anthony Crowell, dean and president of NYLS, said, "Each and every day, everyone at NYLS works very hard to build on [Karen's] accomplishments, as we graduate the next generation of lawyers to lead our profession."

Generic Use Abroad Does Not Mean Generic Use in US

by **Karen Artz Ash** and **Bret J. Danow**

In *Deckers Outdoor Corp. vs. Australian Leather Pty. Ltd.*, the US District Court in Illinois addressed the issue of whether a term found to be generic in Australia should compel the conclusion that such term is generic in the US, and whether the doctrine of foreign equivalents should apply to a term used in another English-speaking country.

Deckers, the owner of the UGG brand, had filed a complaint against Australian Leather, asserting claims for trademark infringement, among other things, based on Australian Leather's sale of boots which it called "ugg boots." In response, Australian Leather claimed that "ugg" was a generic term for a kind of sheepskin boot which had been popularized by Australian surfers in the 1970s and, therefore, Deckers' trademark registrations for the UGG mark should be cancelled and Deckers barred from preventing third parties from calling their boots "uggs." Each of the parties filed cross-motions for summary judgment.

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The crux of Australian Leather's argument was that the term "ugg" is generic in Australia and should be treated as generic in the US pursuant to the doctrine of foreign equivalents.

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The court, however, 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 which, in the case at hand, was the relevant public. The court noted that "although evidence of how Australians use the term 'ugg' could be relevant to consumer perception in the US, generic usage is not enough on its own to infer generic meaning in the US." Even if the court were to assume that the term "ugg" was generic in Australia, there was no evidence that it was generic in the US.

Australian Leather further asserted that the term "ugg" was generic among American surfers in the 1970s. In response, the court held that such a claim was not supported by any evidence and, even if it were, there was no reason to construe the relevant public so narrowly, since "sheepskin boots are not a specialized technology that appeals only to some limited consumer base."

The court held that the application of the doctrine of foreign equivalents suggested by Australian Leather was not correct. The court indicated that the doctrine of foreign equivalents provides that "a word commonly used in another language as the generic name of a product cannot be imported into the US and be transformed into a valid trademark." Firstly, the court held that the doctrine is used to analyze the use of non-English terms in the marketplace and not a term from another English-speaking country. Secondly, the doctrine serves as a prohibition on allowing a trademark to monopolize a generic term, and Australian Leather was not able to provide evidence that either Americans are familiar with the Australian usage of the term "ugg" or that Australian visitors to the US "would be misled into thinking that there is only one brand of ugg-style sheepskin boots available in this country."

Ultimately, a court in the US will look to the US marketplace and US consumer perception as determinative.

TTAB Rules No Likelihood of Confusion Between Designer Surnames

by **Karen Artz Ash** and **Bret J. Danow**

In *Royal Chain, Inc. vs. Mansur Gavriel LLC*, the Trademark Trial and Appeal Board (TTAB) evaluated whether a likelihood of confusion existed between marks sharing a common surname for complementary fashion products.

Royal Chain had filed a notice of opposition against Mansur Gavriel's trademark application for the mark MANSUR GAVRIEL (consisting of the two surnames of its founders) covering "handbags; tote bags; purses; wallets," claiming that the MANSUR GAVRIEL mark resembled its registered PHILLIP GAVRIEL mark covering jewelry and was, therefore, likely to cause confusion.

During the proceeding, Royal Chain's pleaded registration for the PHILLIP GAVRIEL mark was cancelled due to its failure to carry out the necessary maintenance filing in a timely manner. As a result, the Board held that Royal Chain was not entitled to rely on any of the statutory presumptions conferred by the ownership of a trademark registration, and the issue of priority was determined based on Royal Chain's common law use of the PHILLIP GAVRIEL mark rather than the presumptions accorded to its registration. Royal Chain was not able to meet its burden of proving priority of use by

a preponderance of the evidence, and the Board dismissed the opposition. For purposes of completeness, however, the Board did address the issue of a likelihood of confusion between the marks.

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In assessing whether a likelihood of confusion existed between the PHILLIP GAVRIEL mark for jewelry, on the one hand, and the MANSUR GAVRIEL mark for handbags, on the other, the Board found that evidence existed to show that jewelry and handbags are accessories to a women's fashion ensemble and, as such, they are complementary products, and consumers encountering such products under similar marks are likely to believe that they emanate from a single source.

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Although the Board found the products to be complementary and potentially offered through the same channels of trade to the same classes of consumers, based on the evidence, the Board ultimately determined that there was no likelihood of confusion between the marks.

The Board was not persuaded by Royal Chain's proffered evidence of actual confusion. Though Royal Chain asserted that various tradeshow attendees and buyers inquired as to whether there was an affiliation or relationship between

Continued on next page.

Katten Sponsors the WWD Apparel & Retail CEO Summit

Katten was a proud sponsor of the 14th annual WWD Apparel & Retail CEO Summit that was held at The Plaza in New York City. The event brought together more than 200 global top retailers, brand executives, dealmakers and thought leaders to speak on topics such as how technology, the economic environment and today's social mores, priorities and life-styles affect consumers.



Generic Use Abroad Does Not Mean Generic Use in US

Continued from previous page.

PHILLIP GAVRIEL and MANSUR GAVRIEL, the Board held that “inquiries as to corporate affiliations is not evidence of actual confusion because, without more, they indicate that these persons were aware that the companies at issue were two different entities.” This absence of actual confusion over the approximately five years that the marks were both in use did, in the opinion of the Board, “suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.”

Mansur Gavriel submitted evidence to show the coexistence of companies using common surnames for clothing and accessories. The Board drew several inferences from this evidence, namely:

1. There is no per se rule that marks consisting of identical surnames and different given names are likely to cause confusion;
2. The USPTO has registered marks with identical surnames and different given names in the field of clothing and clothing accessories; and

3. A number of different trademark owners have accepted, over a long period of time, that various marks with identical surnames and different common names can be used and registered side-by-side without causing confusion provided that there are differences between the marks and goods in the field of clothing and clothing accessories.

Accordingly, the Board found that there was no likelihood of confusion between the marks. This decision is particularly instructive for companies in the fashion industry, which often use and seek to register a designer’s name or a combination of designers’ names as a trademark.

Katten Muchin Rosenman LLP represented Mansur Gavriel in this proceeding.

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