

Doc Martens Gives the Boot to Likelihood of Confusion Expert in Trade Dress Dust-Up

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We've discussed a number of cases lately where flimsy consumer surveys were tossed out as unreliable under *Daubert*. This latest installment presents a slightly different twist. It discusses a recent case where the Defendant's expert opined on the issue of secondary meaning and consumer confusion without a survey at all. As it turns out, Plaintiff's expert successfully booted this proffered evidence. Read on so that you don't end up kicking yourself when faced with a similar situation.

Today's case involves Doc Martens, the British footwear brand known for its chunky-soled combat boots that are routinely sported by the likes of Kendall Jenner, Gigi and Bella Hadid, and other Hollywood denizens. Doc Martens owns a number of U.S. trade dress registrations for its boots, and it was none too happy when a company by the name of ITX allegedly sauntered into the marketplace with its own clunky-looking imposters. Doc Martens sued for trade dress infringement, ITX lobbed counterclaims of trade dress invalidity, and the parties were officially off to the races.

ITX retained a footwear industry expert to rebut Doc Martens' infringement claims. Specifically, ITX's expert offered an opinion that the Doc Martens at issue lacked secondary meaning and that consumers were not likely to be confused by ITX's boots in any event.

In opining on the lack of secondary meaning, ITX's expert asserted that the Doc Martens footwear designs "are so common in the footwear industry that no one manufacturer has the exclusive right to use the elements." As the Court noted, though, secondary meaning is based on a number of factors, including exclusivity, length of use, sales, consumer recognition, and other factors. ITX's expert only offered an opinion on "exclusivity" and was, therefore, based on "mere conjecture."

In opining that consumers would not be confused, ITX's expert cobbled together a "side-by-side" comparison of the various boots and pointed out the differences among them. The Court rightfully observed that "a side-by-side comparison is improper if that is not the way consumers encounter the product in the market." Because there was no evidence that these dueling boots were encountered together by consumers in the real marketplace, ITX's expert opinion got the boot on this issue as well.

The moral of this saga is this: if you are attempting to offer evidence of secondary meaning, make sure you consider all the legal elements associated with that endeavor. Moreover, if you are trying to establish a lack of confusion in the marketplace, run—don't walk—to a competent consumer survey expert for a proper assessment. Fail to heed either of these and you may be kicking yourself.