

The Other Shoe Drops: Court Boots Doc Martens' Legal Expert in Trade Dress Donnybrook

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We previously blogged about *Airwair Int'l v. Pull & Bear* and how Doc Martens successfully challenged Defendant's expert who opined on secondary meaning and likelihood of confusion. Now, the shoe is on the other foot. Doc Martens' expert found himself in the hot seat for offering improper legal conclusions regarding Doc Martens' trade dress rights. Take a load off and read on so you don't find yourself getting cold feet the next time you are considering using experts in a trade dress dispute.

Doc Martens is the purveyor of the wildly popular clunky-soled combat boots and shoes with yellow stitching simply known as "Docs." As Rolling Stone magazine recently commented, those who have sported Docs over the years "runs the gamut from Eddie Vedder and Morrissey, to Rancid and Rihanna." Doc Martens owns several trade dress registrations and sued Pull & Bear Espana SA for allegedly selling several styles of footwear that infringe on Doc Martens' trade dress. Pull & Bear countersued, claiming that Doc Martens' trade dress rights were invalid. Between the two sides, they retained a small squadron of experts for the purposes of opining, rebutting, and excluding.

Doc Martens offered rebuttal expert testimony from a distinguished law professor who, among other things, opined that Doc Martens' "registered trade dress is unambiguous, valid, and protectable." He also opined that the registrations "comport with" certain requirements mandated by the USPTO.

The Court excluded this rebuttal opinion because an "expert cannot testify to a matter amounting to a legal conclusion." Whether a given trade dress is "presumptively valid" or "enforceable" are ultimately calls for the court to make, not for an expert witness. Similarly, whether a registration comports with USPTO requirements is also a legal conclusion and not appropriate for expert testimony.

In walking a mile in Doc Martens' shoes, we can see where it was possibly headed with this proffered testimony. *Federal Rule of Evidence* 704 tells us that "[a]n opinion is not objectionable just because it embraces an ultimate issue." After all, whether a given trade dress is valid and enforceable is certainly one of the "ultimate issues" in any trade dress infringement case. Thus, we could see how trial counsel could find it alluring to have a well-regarded law professor provide a rebuttal opinion on this important issue. Trial counsel must remember, though, that *Federal Rule of Evidence* 702 mandates that an expert's testimony is only admissible in the first instance if it will "help the trier of fact to *understand the evidence* or to determine a *fact* in issue." When an expert ventures into the realm of explaining what the law is or renders a legal opinion, that's going to be a bridge too far. Just as it was here.