



## **ARE Trademark Law Alert:**

# **Trade Dress Allegation For Shoes Containing Description Of “Laundry List” Of Elements, Functional Features And Ornamental Features For Enhancement Of The Aesthetic Appeal Insufficient To Survive Motion To Dismiss**

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On February 22, 2018, the Federal Court for the Eastern District of New York affirmed the magistrate judge’s report and recommendation to dismiss a trade dress complaint regarding shoes in *Eliya, Inc. v. Steven Madden, Ltd.*—in which Amster, Rothstein & Ebenstein LLP successfully represented defendant Madden.

In *Eliya*, the plaintiff alleged that several of Madden’s shoes infringed its trade dress. Madden moved to dismiss the complaint on the grounds that (1) the trade dress allegations failed to sufficiently describe the character and nature of the trade dress; (2) the alleged trade dress was functional; and (3) there was no likelihood of confusion between the alleged trade dress and the Madden shoes. The magistrate recommended dismissing the Complaint on all three grounds, and this recommendation was upheld by Judge Hurley of district court for the Eastern District of New York.

The decision is important because it makes clear that simply making broad non-detailed statements alleging trade dress infringement are insufficient to survive a motion to dismiss. In *Eliya*, the Court found that the Complaint’s description of elements such as a “distinctive alternating pattern with ¼ inch multi-color or multi-shaded wide straps” merely set forth a “laundry list” of features and failed “to explain the scope or character of the pattern or specify what colors or shades are covered.” The Complaint also set forth generic categories of the shoe insufficient to make a trade dress allegation, such as being “closed or open toe,” “flat heel,” and “vertical” or “horizontal grooves on the sole” without describing, for example, precise descriptions of the shape of the heel or how the grooves on the sole are distinctive.

The decision also reinforces the necessity of overcoming the presumption that elements are functional to maintain a trade dress allegation. Here, the Court found that a strap, that helps the user put on and keep on the shoe, and “grooved soles,” that “provide traction for the wearer,” did not overcome this presumption of functionality and accordingly cannot set forth a claim for trade dress. Further, certain ornamental features may not warrant trade dress protection—even when they may be non-functional—when those features don’t serve to identify their source. Addressing the ornamental multi-colored or multi-shaded nature of the shoe



straps, the Court found these features “serve to enhance the aesthetic appeal of the shoes” and not identify their source, and thus they also cannot be used to maintain a trade dress allegation.

Lastly, the decision reinforces the importance of providing a written description in the Complaint when alleging a likelihood of confusion. In that regard, the Court found that photographs submitted by plaintiff to allege confusion were insufficient to support its allegation and noted that a written description alleging a likelihood of confusion of the accused shoes or their resemblance to the plaintiff’s shoes was “conspicuously absent.”

\*Doug Miro and Holly Pekowsky are Partners at Amster, Rothstein & Ebenstein LLP. Their practice specializes in intellectual property issues, including trademark prosecution, enforcement and counseling. In this matter, Mr. Miro and Ms. Pekowsky represented defendant Steven Madden, Ltd. Mr. Miro and Ms. Pekowsky may be reached at [dmiro@arelaw.com](mailto:dmiro@arelaw.com) and [hpekowsky@arelaw.com](mailto:hpekowsky@arelaw.com) respectively.