

Nike on a Mission for More Trademark Protection

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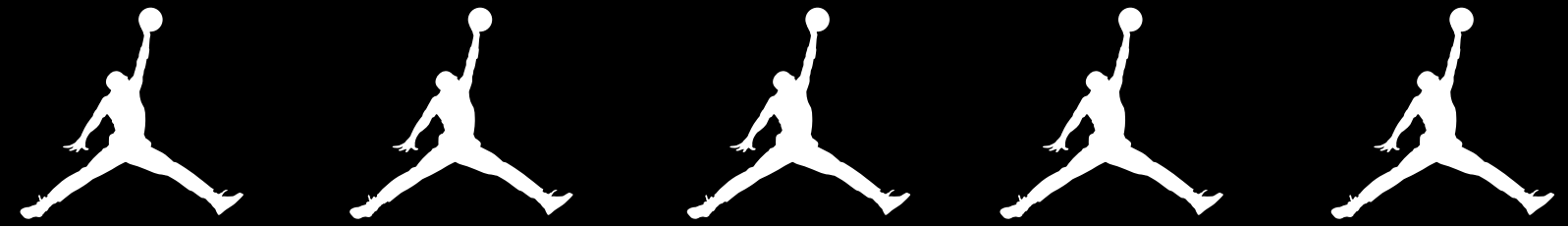
As a follow up to the previous blog post entitled Trademark Infringement Only When Customer Confusion is Not Beneficial, Nike has continued to take large strides in preventing customizers and creatives from recreating its shoes. On June 1, 2021, Nike, was granted a trademark for the trade dress of the Air Jordan 1, Michael Jordan's first sneaker, which was first sold in 1985. (Reg. NO. 6,368,694). Despite first selling the sneaker over thirty-six years ago, Nike just sought protection of its design with the United States Patent and Trademark Office ("USPTO") in July of 2020.

Nike's trademark rights in the Air Jordan 1 protects only the silhouette, and remarkably, without the infamous Nike Swoosh. Before registering its trademark rights, the only protection Nike had for the Air Jordan 1 was for its trade dress. Trade dress protects an item that have become so iconic consumers can identify it without seeing any brand marks. Trade dress can be protected under common law or the Lanham Act as it can be registered with the USPTO. A product's trade dress is protected under the Lanham Act, irrespective of being registered, if it is not functional and there is a likelihood of confusion between the claimant's product and a competing product. In the Second Circuit, a trade dress infringement claim must allege: (1) a precise expression of the character and scope of the claimed trade dress; (2) the trade dress is not functional; (3) the trade dress has acquired secondary meaning; and (4) the infringing feature is likely to cause confusion. However, proving consumer confusion is quite difficult under the theory of trade dress. As such, Nike will likely look to its trademark rights to assert infringement claims as it means to provide greater protection for Nike against recreations of the Air Jordan 1.

In addition to Nike's suit against MSCHF for its Satan Shoes, Nike previously filed suit against Warren Lotas ("Lotas") over his creation that he classified as a "reinterpretation" of the Nike SB Dunk, the Pigeon, which was a Nike collaboration with Jeff Staple that originally released in 2005. Lotas teamed up with Jeff Staple to recreate the Nike SB Dunk, the Pigeon. Nike had trademarked the trade dress for the Dunk before suing Lotas. In the suit for trademark infringement, false designation of origin, unfair competition, and trademark dilution, Nike asserted claims against Lotas' Nike SB Dunk, The Pigeon and other recreations. Similarly as against MSCHF, the court awarded Nike's motion for preliminary injunction preventing Lotas from fulfilling orders for the allegedly infringing footwear. Eventually, the case also settled, in which Lotas was barred from "manufacturing, transporting, promoting, importing, advertising, publicizing, distributing, offering for sale, or selling any products" that infringe upon Nike's trademarks and trade dress.

While these cases were not fully litigated to bear precedential effect, we do know that Nike is now aggressively trying to protect its products from recreation. Nike has been busy filing an array of trademark applications to register with the USPTO in the past couple of months for its Air Max 90, Jordan 3 Retro, Jordan 4 Retro, Jordan 5 Retro, Jordan 11 Retro, and Nike Air Foamposite One. All of these pending applications and the newly-issued registration for the Air Jordan 1 are devoid of the Nike Swoosh. Nike has never produced a shoe without its Swoosh.

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Therefore, there is a question of whether the registration was properly awarded as it omits a significant element. We can imagine that this approach by Nike is intentional to claim broader protection against creatives and small business owners than if the Swoosh were included, as variations of the silhouettes of the shoe alone could result in possible infringement.

Due to its popularity, Nike's shoes already benefit from the trademark protections as discussed above, however, these trademark registrations enable Nike to benefit from additional and heightened remedies. If Nike acquires additional trademark registration, we would expect Nike to attempt to enforce its rights against creatives. The attorneys in RMF's Intellectual Property & Technology practice group have the unique expertise of representing trademark holders in trademark and patent infringement litigation and in proceedings before the Trademark Trial and Appeal Board, as well as defending those alleged of trademark and patent infringement. Additionally, our practice group has expertise in prosecuting trademark applications in the U.S. Patent and Trademark Office on behalf of foreign and domestic clients. Our dual-perspective of prosecuting and defending clients' trademark related issues is invaluable to creatives and small businesses who are in the reselling and customization market.

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