



## Some Respondents Prohibited from “Treading” on Converse Trademarks by the ITC

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This investigation stemmed from a complaint filed by Converse on October 14, 2014, in which it alleged violation of Section 337 in the importation into the United States and sale of certain footwear products that infringe the ‘103 and ‘960 trademarks, as well as U.S. Trademark Registration No. 4,398,753 (the ‘753 trademark) (for the midsole of the shoe). Converse also alleged violation of Section 337 based upon unfair competition/false designation of origin, common law trademark infringement and unfair competition, and trademark dilution. While most of the named respondents were subsequently either found in default or terminated from the investigation based on good cause or settlement and/or consent order stipulation, certain respondents remained (Wal-Mart Stores, Inc.; Skechers U.S.A.; Inc.; Highline United LLC d/b/a Ash Footwear USA and New Balance Athletic Shoe, Inc.).

Chief ALJ Charles E. Bullock, in his initial determination on November 17, 2015, found all three trademarks valid and infringed by certain accused products. In addition to finding that Converse satisfied both the economic and technical prongs of the domestic industry requirement with respect to all asserted trademarks, the ALJ found no dilution of the ‘753 trademark. However, in its June 23, 2016 notice, the ITC affirmed-in-part, reversed-in-part and vacated certain portions of the ALJ’s Initial Determination. Specifically, the ITC adopted the ALJ’s finding that Converse holds two valid trademarks on the outsole layout of the famous canvas sneaker (the ‘103 and ‘960 trademarks). But, the ITC struck down the ‘753 trademark as invalid based on lack of secondary meaning. It was that mark that Walmart, Skechers and New Balance were accused of infringing.

The notice resulted in a mixed-bag victory for Converse. While Converse lost on the ‘753 trademark covering the midsole—a rubber “bumper” running around the front of the shoe, a

toe cap above the bumper and stripes running around the sides—it was victorious in its assertion that two other trademarks covering the distinctive outsole with its diamond-shaped pattern are valid. As a result, companies beyond those involved in this dispute are now barred from importing shoes that violate Converse’s trademarks for its outsole design. Further, the order applies not only to any company that may currently be selling shoes with that sole pattern, but also to any future knockoff attempts.

*In the Matter of Certain Footwear Products*, Inv. No. 337-TA-936 (ITC).

## Categories

International Trade Commission

Infringement

ITC Section 337 Investigations

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