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Barrett Block^[1]

You have probably seen it—a traditional Japanese bamboo purse popularized most recently by Cult Gaia, carried by the likes of Rihanna and Beyoncé.^[2] In an attempt to claim exclusive rights to the Japanese design for itself, Cult Gaia’s founder, Jasmin Larian, has filed with the United States Patent and Trademark Office (“USPTO”) an application to register the design of its Cult Gaia Ark bag, shown below^[3]:



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On October 5, 2017, the USPTO issued an office action initially refusing registration on the basis that the Cult Gaia Ark bag design is merely functional and consists of a nondistinctive product design.^[5] The USPTO stated: “Consumers are aware of Japanese bamboo half-moon shaped carrying-bags.^[6] Applicant’s mark is merely an iteration or appropriation of a style of bag from the Japanese culture. The design is a classic shape and style of carrying bag for personal use.”^[7]

Despite the USPTO’s refusal to register the design, Cult Gaia proceeded to send Madden a letter on February 18 demanding that Madden “[i]mmediately and permanently cease and desist from any further sale, distribution, promotion, and/or advertisement of any item that infringes upon the Ark trade dress” and “destroy all infringing items and confirm destruction of the same.”^[8] Since, Madden has filed a declaratory action against Larian, and Larian has counterclaimed.^[9]

Larian is not alone in capitalizing on the reproduction of the Classic Japanese Design for fashion purposes, as multiple third parties have sold these identical bags in the United States since at least as early as the 1960’s through today.^[10]

Larian’s infringement claim must overcome several hurdles. First, an owner of asserted trade dress must specifically define the list of elements that comprise the trade dress.^[11] This is necessary for the court and the accused to “determine whether the trade dress is valid and if what the accused is doing is infringement.”^[12]

Second, for an overall product configuration to be protectable, “the entire design must be arbitrary or non de jure functional.”^[13] “A product feature need only have *some* utilitarian advantage to be considered functional.”^[14] That is, “[t]o establish non functionality the party with the burden must demonstrate that the product feature serves *no purpose* other than identification.”^[15] Only artificial embellishment has trademark significance; a design that is simply the assemblage of functional parts is not protectable.^[16]

Moreover, a product design is only protectable if it has acquired secondary meaning in the non-functional features of the design.^[17] “To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature . . . is to identify [a single] source of the product rather than the product itself.”^[18] Litigation will determine whether Jasmin Larian is capable of proving any of this .

But another question lingers: whether a product design otherwise in the public domain should acquire protection, so long as it actually develops secondary meaning as a mark. I argue no. Expanding the scope of trade dress protection to include designs in the public domain is improper because it frustrates the purpose of design patent law .

Although expanding the definition of trade dress to include elements of product design is not expressly prohibited by the language of the Lanham Act, doing so clearly interferes with the Constitutional and congressional objectives of the federal design patent laws. The Supreme Court has recognized that “the ultimate goal of the patent system is to bring new designs and technologies into the public domain through disclosure.”^[19] With this goal in mind, the Court noted that “at the heart of *Sears* and *Compco* is the conclusion that the efficient operation of the federal patent system depends upon substantially free trade in publicly known, unpatented design and utilitarian conceptions.”^[20] By extending trade dress protection to designs in the public domain, the efficient operation of the federal patent system is compromised, and Congress’ balance of the costs and benefits of patent protection is upset.

Furthermore, the Constitution expressly mandates that the protection granted to inventors be “for limited times.”^[21] This is the concern expressed by the Second Circuit in stating that “since trademark protection extends for an unlimited period, expansive trade dress protection for the design of products would prevent some functional products from enriching the public domain.”^[22]

Therefore, because Cult Gaia seeks not to prevent a design from entering the public domain, but rather to appropriate a design from the public domain for itself, its claim for trade dress infringement ought to fail.

^[1] Staff Editor, *Kentucky Law Journal*, Volume 107; J.D. Candidate, The University of Kentucky College of Law (2020); B.S., University of Pennsylvania Wharton School of Business (2016).

^[2] Whitney Bauck, *Cult Gaia is Suing Steve Madden for \$15 Million*, FASHIONISTA (May 16, 2018), <https://fashionista.com/2018/05/cult-gaia-ark-bag-steve-madden-copyright-lawsuit>.

^[3] *Steve Madden Responds to Cult Gaia's Lawsuit Threat: Your Bag is a "Slavish Copy"*, THE FASHION LAW (Mar. 12, 2018), <http://www.thefashionlaw.com/home/steve-madden-responds-to-cult-gaias-lawsuit-threats-your-bag-is-a-slavish-copy>.

^[4] Cultgaia, INSTAGRAM, <https://www.instagram.com/cultgaia/?hl=en> (last visited Sept. 3, 2018); *Gaia's Ark – Natural*, CULT GAIA, <https://cultgaia.com/collections/ark/products/gaias-ark-natural#slide-2620673458286> (last visited Sept. 3, 2018); *Acrylic Ark – Amber Multi*, CULT GAIA, <https://cultgaia.com/collections/ark/products/acrylic-ark-amber-multi> (last visited Sept. 3, 2018); *Acrylic Ark – Citrine*, CULT GAIA, <https://cultgaia.com/collections/ark/products/acrylic-ark-citrine> (last visited Sept. 3, 2018).

^[5] Complaint at 6, *Steven Madden, Ltd. v. Jasmin Larian, LLC*, No. 1:18-cv-02043 (S.D.N.Y. Mar. 06, 2018).

^[6] Bauck, *supra* note 2.

^[7] Complaint, *supra* note 5, at 3.

^[8] THE FASHION LAW, *supra* note 3.

^[9] *See generally* Answer to Complaint Counterclaim, *Steven Madden, Ltd. v. Jasmin Larian, LLC*, No. 1:18-cv-02043.

^[10] Complaint, *supra* note 5, at 4.

^[11] *Homeland Housewares, LLC v. Europro Operating, LLC*, No. CV 14-03954, 2014 WL 6892141, at *3 (C.D. Cal. Nov. 5, 2014).

^[12] *Id.*

^[13] *Secalt S.A. v. Wuxi Shenxi Const. Mach. Co., Ltd.*, 668 F.3d 677, 683 (9th Cir. 2012).

^[14] *Id.* at 686, citing *Disc Golf Assn. v. Champion Discs, Inc.* 158 F.3d 1002, 1007 (9th Cir. 1998) (emphasis in original).

^[15] *Apple Inc. v. Samsung Electronics Co., Ltd.*, 786 F.3d 983, 992 (Fed. Cir. 2015), citing *Disc Golf*, 158 F.3d at 1007.

^[16] *See Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 785 (9th Cir. 2002) (“Where the plaintiff only offers evidence that ‘the whole is nothing other than the assemblage of functional parts,’ our court has already foreclosed this argument, holding that ‘it is semantic trickery to say that there is still some sort of separate ‘overall appearance’ which is non-functional.”).

^[17] *TraFFix Devices v. Mktg. Displays*, 532 U.S. 23, 28–34 (2001); *First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378, 1383 (9th Cir. 1987); *Straumann Co. v. Lifecore Biomedical Inc.*, 278 F. Supp. 2d 130, 136–37 (D. Mass. 2003) (discussing the issue of whether the non-functional features acquired secondary meaning.).

^[18] *Inwood Labs. v. Ives Labs.*, 456 U.S. 844, 851 n. 11 (1982). “In the case of a product configuration . . . which has utilitarian as well as trademark purposes, the public must be cognizant of the design’s trademark purpose in order for the design to be protectable.” *Chrysler Corp. v. Vanzant*, 44 F. Supp. 2d 1062, 1073 (C.D. Cal. 1999).

^[19] *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151, 9 U.S.P.Q.2d (BNA) 1847, 1855 (1989).

^[20] *Id.* at 156, 9 U.S.P.Q.2d (BNA) at 1854.

^[21] U.S. CONST. art. I, § 8, cl. 8.

^[22] *Stormy Clime Ltd. v. Progroup, Inc.*, 809 F.2d 971, 978, 1 U.S.P.Q.2d (BNA) 2026, 2031 (2d Cir. 1987).

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