

SDNY Allows Skechers to Walk Away from Trademark Claims

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After Skechers began selling open-back women's shoes under the name "Commute Time" in August 2018, Easy Spirit, owner of the mark TRAVELTIME for similar shoes, sued Skechers in April 2019 for trademark and trade dress infringement under the Lanham Act and New York law. In January 2021, the U.S. District Court for the Southern District of New York granted summary judgment on the trade dress claims for Skechers, and the remaining trademark infringement claims—trademark infringement under 15 U.S.C. § 1114(a), false designation of origin under 15 U.S.C. § 1125(a), and common law trademark infringement under New York state law, proceeded to trial. Following a twelve-day bench trial, the district court dismissed the trademark infringement claims, finding no likelihood of confusion existed between the marks.

As the opinion recounted, to succeed on a claim for trademark infringement under 15 U.S.C. § 1114(a), Easy Spirit needed to prove the validity of its mark (which Skechers did not contest) and a likelihood of confusion between the marks. Analyzing likelihood of confusion, the court assessed the eight factors used by the Second Circuit: (1) strength of the prior owner's mark; (2) similarity between the marks; (3) competitive proximity of the products; (4) likelihood that the prior user will bridge the gap; (5) actual confusion; (6) defendant's good faith; (7) quality of the defendant's product; and (8) buyer sophistication.

First, in analyzing the strength of Easy Spirit's TRAVELTIME mark, the court examined its inherent distinctiveness and acquired distinctiveness in the marketplace. Regarding inherent distinctiveness, the court found that TRAVELTIME was "modestly" inherently distinctive because it was plainly suggestive. In other words, the mark required some imagination for a purchaser to "go from 'travel time' to the idea of movement, then to what one might need when moving, and finally to the product, an open-back comfort shoe."

As to acquired distinctiveness, which the court explained referred to the recognition that the mark earned in the marketplace as a designator of Easy Spirit's goods, the opinion analyzed six factors used by the Second Circuit: (1) advertising expenditures; (2) consumer studies linking the mark to a source; (3) unsolicited media coverage of the product; (4) sales success; (5) attempts to plagiarize the mark; and (6) length and exclusivity of the mark's use.

Here, the court noted that Easy Spirit did not provide advertising expenditures or other evidence

showing how many consumers its TRAVELTIME-specific advertising reached, as opposed to Easy Spirit advertising generally. Regarding unsolicited media coverage, the court stated that Easy Spirit presented only one piece of evidence from before 2018, so it was unclear if the mark acquired secondary meaning before Skechers started selling its Commute Time shoe that year.

The sales success factor favored Easy Spirit however, as the court cited evidence that the TRAVELTIME shoe became the number-one-selling shoe in U.S. department stores in 2016 and amassed \$26.3 million in sales between July 2017 and March 2019. The court also determined that length and exclusivity moderately weighed in Easy Spirit's favor because while Easy Spirit had sold TRAVELTIME shoes continuously since 2004, other shoe companies routinely used marks containing the words "time" or "travel"—including Easy Spirit for its other products.

Thus, the court concluded that Easy Spirit had not provided strong evidence that TRAVELTIME acquired secondary meaning before Skechers began using the Commute Time mark, and accordingly the strength of the mark factor weighed "only moderately" in favor of a likelihood of confusion.

Second, the court held that the marks were not similar based on their overall impression on consumers. It found several differences in their appearance, including that: (1) TRAVELTIME is one word while Commute Time is two; (2) TRAVELTIME generally appears in all capital letters but Commute Time does not; and (3) TRAVELTIME is written on one line yet Commute Time generally appears on separate lines. The court also found that TRAVELTIME appeared on a minimalist beige box with simple orange lettering alone, while Commute Time appeared on a jewel-toned patterned box with various shapes, accents, and other Skechers marks. And the opinion noted that "travel" and "commute" neither sounded the same nor were synonymous.

Third, the court found no evidence of actual confusion. It pointed out that Easy Spirit did not submit any consumer survey showing confusion, and while Easy Spirit did not need to, the absence of a survey was evidence actual confusion could not be shown. The opinion also emphasized Skechers' survey showing 0% confusion, which Easy Spirit failed to adequately rebut or discredit. Specifically, the court rejected Easy Spirit's concern as to the universe of participants, that the survey showed participants the parties' websites and not those of third-party retailers, and incentives given to participants. It held that the survey properly targeted consumers beyond women 55-years-and-older because prospective customers should be counted, any marketplace could be replicated given the parties sold their shoes on multiple platforms, and incentives are commonly accepted for surveys.

Fourth, the court examined whether Skechers acted in bad faith or with an intent to deceive consumers about the source of its product. It determined that evidence showing Skechers based some measurements of its shoe on TRAVELTIME but included several aesthetic and functional differences demonstrated an intent to compete rather than to deceive. The court noted that companies in the shoe industry commonly incorporate features of other products in order to compete.

Fifth, the court determined that the customer sophistication factor also weighed in Skechers' favor. As neither party presented direct evidence of consumer sophistication, the court stated it could rely solely on indirect indications of sophistication, such as nature of the products or their price. The court rejected Easy Spirit's argument that because its customers were older women they were not sophisticated consumers of women's shoes, finding it borderline "offensive" and contrary to common sense. It also found the price points of the shoes sufficiently high to indicate thoughtful purchases.

Finally, while Skechers did not contest that the proximity of the goods factor weighed in favor of a likelihood of confusion, the court independently found this factor weighed in Easy Spirit's favor because the Commute Time shoe was sold to the same class of purchasers, through the same marketing channels, and for approximately the same price as the TRAVELTIME shoe. It did not assess the remaining two factors—bridging the gap and disparity of goods—because the parties agreed they did not apply.

In closing, the court held that no likelihood of confusion existed given the absence of any direct evidence that customers were actually confused or survey evidence of actual confusion. Accordingly, it dismissed the federal trademark infringement claim. And because the federal false designation of origin and common law trademark infringement claims also required a likelihood of confusion, the court dismissed those remaining claims too.

The case is *Easy Spirit, LLC v. Skechers U.S.A., Inc.*, No. 19-cv-3299 (JSR), __ F. Supp. 3d __, 2021 WL 5312647 (S.D.N.Y. Nov. 16, 2021).

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