

UNITED STATES: Vans ‘Skools’ Walmart

Published: July 13, 2022



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On March 31, 2022, Vans, Inc. and VF Outdoor, LLC (collectively Vans) successfully obtained a preliminary injunction against Walmart prohibiting it from selling shoes under Walmart’s private brands, TIME AND TRU, NO BOUNDARIES, and WONDER NATION. ***Vans, Inc. v. Walmart, Inc.***, 2022 U.S. Dist. LEXIS 95244 (C.D. Cal. Mar. 31, 2022). Vans alleged that these brands are confusingly similar in the post-sale context to Vans’ registered Side Stripe Mark and Stitching Mark and protectable trade dress in Vans’ distinctive OLD SKOOL trade dress, OLD SKOOL TODDLER trade dress, and SK8-HI” trade dress, all applied to sneakers.





Rejecting Walmart's argument to the contrary, the court found Vans' combination of elements claimed as trade dress protectable. The registered Side Stripe Mark and Stitching Mark were both valid and enforceable trademarks. Vans was likely to succeed in showing that the OLD SKOOL, OLD SKOOL TODDLER, and SK8-HI trade dresses have acquired secondary meaning based on extensive and longstanding use of the designs, significant expenditures to advertise the shoes, significant media and third-party recognition, and considerable sales and revenues of the shoes, exceeding US \$16 billion. In addition, expert survey evidence showing that purchasers associate the OLD SKOOL and SK8-HI designs with Vans, further supported a finding of secondary meaning.

Applying the Ninth Circuit's *Sleekcraft* factors for assessing a likelihood of confusion, the court found the parties' marks are similar, the goods are related, Vans' marks are strong, purchasers of athletic shoes are unlikely to exercise a high degree of care in their selection, Walmart's intent does not reflect good faith, survey evidence demonstrated actual confusion, and Walmart's product expansion all favored finding a likelihood of confusion. The marketing channels used are irrelevant because Vans argued only post-sale confusion.

Because seven of the eight ***Sleekcraft*** factors favored Vans, the court found that Vans was likely to establish that Walmart’s marks are likely to cause confusion. The court applied the rebuttable presumption of irreparable harm, adopted as part of the Trademark Modernization Act of 2020.

The court found that Vans is likely to suffer irreparable harm absent injunctive relief. The balance of hardships favored Vans, which demonstrated that the public interest would be served by issuance of a preliminary injunction because the public has the right not to be deceived or confused.

The court granted the preliminary injunction and enjoined Walmart from advertising, marketing, importing, manufacturing, promoting, offering for sale, distributing, or selling 28 different styles of sneakers or any other color combinations of the same shoe designs.

The court imposed a US \$50,000 bond proposed by Vans, which Vans posted in early April 2022.

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