



UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

OFFICE OF THE SOLICITOR

January 16, 2013

VIA UPS & EMAIL

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Re: ***Christian Louboutin S.A. v. Yves Saint Laurent Am. Inc.***, No. 11-3303-cv (2d Cir.),
No. 11-cv-2381 (VM) (S.D.N.Y.);
U.S. Trademark Reg. No. 3,361,597

Dear Counsel,

The United States Patent and Trademark Office (USPTO) has considered the comments received from counsel for Christian Louboutin S.A. (Louboutin) on January 4, 2013, from Yves Saint Laurent America, Inc., Yves Saint Laurent Holding, Inc., and Yves Saint Laurent S.A.S. collectively (YSL) on January 8, 2013, and again from Louboutin on January 14, 2013. The comments concerned the USPTO's proposal to give effect to the Judgment/Mandate of the U.S. Court of Appeals for the Second Circuit (Doc. 126), issued on September 27, 2012, in the above-referenced appeals, by amending the description of the mark in Registration No. 3,361,597 as follows (changes are to the current mark description and are underscored):

The color(s) red is/are claimed as a feature of the mark. The mark consists of a lacquered red outsole on footwear that contrasts with the color of the adjoining remaining portion of the shoe (known as the "upper"). The dotted lines are not part of the mark but are intended only to show placement of the mark.

YSL agrees with the USPTO's proposal. Louboutin disagrees and urges the USPTO to instead enter the following amendment to the registration:

The color(s) red is/are claimed as a feature of the mark. The mark consists of a lacquered red outsole on footwear that contrasts with the

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color of any visible portions of the shoe. The dotted lines are not part of the mark but are intended only to show placement of the mark.

Although appellate mandates are typically directed to the originating district court, section 37 of the Lanham Act, 15 U.S.C. § 1119 (“section 1119”), authorizes courts to issue orders with respect to a party’s trademark registration and specifies that the USPTO Director “shall make appropriate entry upon the records of the [USPTO], and shall be controlled thereby.” The Judgment/Mandate in this case was directed to the USPTO pursuant to section 1119. While the USPTO appreciates that a court’s underlying decision may provide insight into the meaning of terms the court uses in an order issued pursuant to section 1119, the USPTO does not have discretion to deviate from the terms of a court’s section 1119 order in any significant or substantive respect. *Cf. Briggs v. Penn. R.R. Co.*, 334 U.S. 304, 306 (1948) (“an inferior court has no power or authority to deviate from the mandate issued by an appellate court”); *In re Ivan F. Boesky Sec. Litig.*, 957 F.2d 65, 69 (2d Cir. 1992) (“Indeed, because the district court has no discretion in carrying out the mandate, the appellate court retains the authority to determine whether the terms of the mandate have been ‘scrupulously and fully carried out.’”) (citation omitted). If a party has concerns about the language a court uses in a section 1119 order, the appropriate course of action is for the party to seek a modified order from the court that issued the order.

Here, the Second Circuit’s mandate specified in relevant part as follows (emphasis added in underlining):

Pursuant to 15 U.S.C. § 1119 the Director of the United States Patent and Trade Office shall make appropriate entry upon that Office’s records to reflect that U.S. Trademark Registration No. 3,361,597, held by Christian Louboutin and dated January 1, 2008, is limited to a red lacquered outsole on footwear that contrasts with the color of the adjoining (“upper”) portion of the shoe.

The USPTO must give effect to this language. The USPTO has concluded that its proposed amendment most appropriately does so. The USPTO does not believe that it has the authority to enter the amendment Louboutin urges absent a new order from the Second Circuit so directing because Louboutin’s preferred wording deviates substantially from the mandate’s language quoted above.

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Given the above, the USPTO normally would proceed to enter its proposed amendment to the registration. However, on January 10, 2013, Louboutin's counsel informed the USPTO that the Second Circuit granted the parties' request to extend until February 1, 2013, the deadline for the parties to restore jurisdiction to the Second Circuit to consider whatever arguments remain or arise relating to the case, in particular the USPTO's pending amendment to the registration.

Under the circumstances, and because any amendment to the registration is being made at the direction of the Second Circuit pursuant to the court's authority under section 1119, the USPTO believes it is appropriate to postpone entry of the proposed amendment to the registration until February 4, 2013. Postponing entry of the amendment until February 4, 2013, will provide any party wanting clarification of the language the Second Circuit used in its mandate sufficient time to make such request to the Second Circuit and inform the USPTO of its request. Any party making such a request to the Second Circuit should notify the USPTO in writing on or before February 1, 2013, by sending a copy of the request to the undersigned via email. If the USPTO receives timely notification of such a request to the Second Circuit, the USPTO will stay entry of the proposed amendment until after the Second Circuit rules on the request.

Respectfully,

UNITED STATES PATENT AND TRADEMARK OFFICE

**Thomas L.
Casagrande**

Digitally signed by Thomas L. Casagrande
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