

LEGAL AND PRIVACY

Hublot finds itself back in trademark battle over terminology

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Hublot timepiece described as "red gold"

By SARAH JONES

A renewed legal battle between Hublot and another jeweler raises the question of what language is generic and what can be owned.

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In 2011, Solid 21 filed 15 lawsuits against luxury watchmakers, including Hublot, Bulgari, Breitling, Swatch and Rolex, claiming that the jewelry houses had violated its intellectual property by using its trademarked term "red gold." After winning a summary judgment in a district court in 2015, Hublot of America is now finding itself having to defend itself again.

"Solid 21 prevailing would, in our view, be a net negative for luxury brands," said Milton Springut, partner at [Springut Law PC](#), New York.

"We see little upside," he said. "Luxury brands generally use trademarks that are well-established and distinctive they don't need to protect weak marks.

"And there is significant downside. What you have here is someone trying to protect a borderline protectable mark, likely descriptive or generic.

"Protecting such a mark makes it harder for brands to truthfully describe their goods. The copper-goldish color has been popular lately. What is a design house like Hublot supposed to do to describe that color for one of its watches?"

Mr. Springut is not affiliated with Hublot or Solid 21, but agreed to comment as an industry expert. [Hublot](#) was reached for comment.

Seeing red gold

The Nevada-based Solid 21 trademarked "red gold" in 2003, claiming ownership of the term in connection to an alloy of gold used in fine jewelry and watch production. The trademark also extends to marketing and advertising.

According to a release put out by the company in connection to the suits in 2013, Solid 21's president and designer Chris Aire has spent "millions of dollars to brand the mark and create demand for it in the marketplace via

tastemakers and other celebrities."



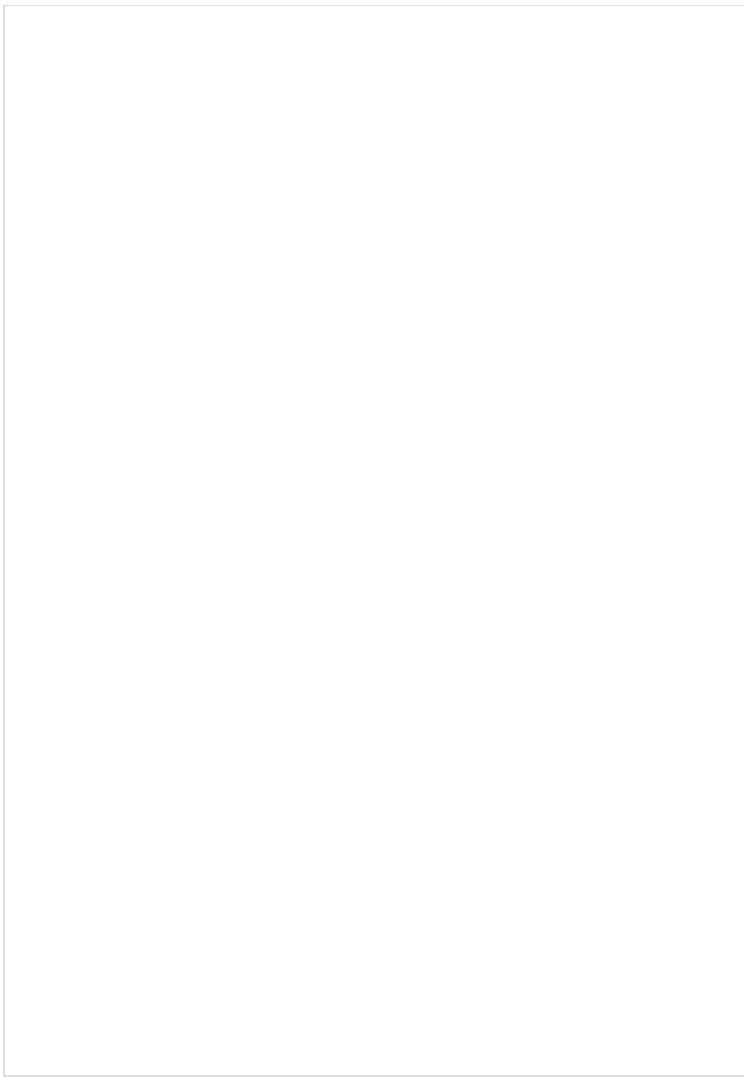
Red gold bracelet from Chris Aire

The suit claims that the jewelers in question only began using the term "red gold" in connection with their products after 2003. According to the plaintiff, the use of the term in marketing of Hublot watches violates its trademark and also dilutes its mark.

Hublot and LVMH counterclaimed, looking to invalidate and cancel Solid 21's trademark, arguing that the term "red gold" is generic rather than specific to the jeweler. Included in their motion to dismiss the case were examples of "red gold" being used in patent claims as early as 1919 and

After an ongoing legal battle for five years, Hublot and parent company LVMH were granted a summary judgment in 2015. At the time, Solid 21 promised to appeal the decision, wanting to put the case in front of a jury.

On March 24, the United States Court of Appeals for the Ninth Circuit granted Solid 21 its appeal. The court found that the earlier ruling disregarded elements of Solid 21's declaration, including the opinions within a linguist's testimony and consumer witnesses.



Breitling Superocean Heritage 46 with red gold ring

Like Hublot, Breitling USA's case saw a lower court dismiss the suit, while the Ninth Circuit reversed the decision, sending them back to trial in 2013.

Naming rights

Luxury brands are often the plaintiffs in trademark cases, as they work to fight against copycats. These efforts have seen mixed results for them in court.

U.S. jeweler Tiffany & Co. won a trademark infringement lawsuit against wholesale club Costco in a New York court.

In 2013, Tiffany claimed Costco was using its name as a generic term to describe an engagement ring setting that has become a signature design for the jewelry brand. Costco filed a counterclaim disagreeing with the jeweler, saying that the term is in fact generic and can be used in its store promotions, but on Sept. 8, 2015, a U.S. District Court for the Southern District of New York granted Tiffany's motion for summary judgement ([see story](#)).

French footwear and accessories label Christian Louboutin's attempt to protect its red soles by registering them as a protected brand was turned down.

The Swiss Federal Administrative Court ruled in a statement published May 12, 2016 that the red soles are merely a decoration, rather than a brand, making them ineligible for a trademark. Christian Louboutin has been seeking sole ownership of its red soles, protecting itself legally from any copycat attempts ([see story](#)).

"The main takeaway is to choose a distinctive trademark, not one that is descriptive," Mr. Springut said. "For luxury brands, we trust that their lawyers did a trademark search and realized someone has a registration for 'red gold' before using it. And if they did, then they should have taken steps to avoid confusion.

"Realize also that the genericness issue is only half the battle," he said. "Even if Solid 21 proves it has trademark rights in red gold, it still has to show that the defendants are using it in a way likely to cause confusion.

"There is an easy way for the luxury brands to avoid this use their own house marks in a way to make clear that is the

source of the goods, and use red gold in a way that is clearly descriptive."

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