

Trademark Law

Case 18:
Catalog
Fight

Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters

Trademark Infringement and Trade Dress Protections

OBJECTIVE

To understand the basics of trademark infringement in the area of "trade dress" between two high profile competitors in business.

TOPICS COVERED

- Intentional Tort
- Trademark
- Trademark Infringement
- Trade Dress

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Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters

Trademark Infringement and Trade Dress Protections

BACKGROUND

- The following case focuses on two very well-known clothiers: Abercrombie & Fitch and American Eagle. Abercrombie & Fitch is an old established company stemming back over 100 years, and American Eagle is a relatively new company that began doing business in 1994.
- Abercrombie & Fitch claimed that American Eagle intentionally infringed on its trademark by copying, among other things, its designs of certain articles of clothing, in-store advertising displays, and its catalog. We will be focusing on the catalog portion of this case—which will be known as trade dress.
- Abercrombie & Fitch believed that American Eagle was trying to take advantage of its long-standing name and advertising dollars to confuse consumers into purchasing American Eagle products over Abercrombie & Fitch products.

BEFORE YOU BEGIN

What is an intentional tort?

An intentional tort describes a civil action resulting from an intentional and wrongful act on the part of the Defendant against another, such as intentionally stealing another person's or company's trademark.

What is a trademark?

A trademark is a unique word, phrase, or symbol that distinguishes a company. The essential function of a trademark is to exclusively identify the commercial source or origin of products—in other words, the manufacturer—like the Nike “swoosh” symbol.

What is trademark infringement?

Trademark infringement occurs when a party uses another's trademark without the authorization of the owner. If the respective marks or products are not identical, the courts will assess the similarity based upon the “likelihood of confusion” by consumers as to the origination (owner) of the products or services.

What is trade dress?

Trade dress refers to characteristics of the visual appearance of a product or its packaging that may be registered and protected from being used by competitors in the manner of a trademark. These characteristics involve the total image of a product and may include features such as size, shape, color combinations, textures, graphics, or even a particular sales technique.

ISSUE BEFORE THE COURT

Whether the two catalogs by major clothing companies are sufficiently distinct from each other so that a reasonably prudent consumer can differentiate between the two companies depicted in each catalog?

THE FACTS

This case pits an old hand against the new kid on the block: Abercrombie & Fitch sued American Eagle claiming that American Eagle infringed on what Abercrombie & Fitch describes as its unregistered “trade dress.”

Abercrombie & Fitch was founded in 1892 and is a retailer of casual clothing and accessories appealing to college-age consumers. In 1988, The Limited, Inc. acquired Abercrombie & Fitch and rejuvenated the brand, selling billions of dollars in merchandise and spending over \$26 million on marketing, including advertisements in national and fashion magazines. Abercrombie & Fitch products are sold nationwide through 157 retail stores and a mail order catalog under the registered trademarks and service marks ABERCROMBIE & FITCH, A & F CO, A & F, and variations thereof.

American Eagle Outfitters sells essentially the same variety of clothing and products in its 300 stores nationwide under the trademarks and service marks AMERICAN EAGLE OUTFITTERS and AE, generating approximately \$300 million in annual sales. American Eagle has been a retailer since at least 1994, although many of its products describe the company’s vintage as 1977.

Abercrombie & Fitch accused American Eagle of selling similar products and marketing them in a similar way, which confused the consumer as to which products belonged to each company.

Specifically, Abercrombie & Fitch asserted that American Eagle copied its premiere issue of *The Quarterly*, an Abercrombie & Fitch catalog that advertises Abercrombie & Fitch products in a way to depict a certain lifestyle. First, Abercrombie & Fitch alleged that American Eagle’s catalog featured the same products, colors, designs, fabrics, and names (i.e., “vintage” sweatshirts and “field jerseys”) as *The Quarterly*.

Second, Abercrombie & Fitch claimed that the paper, page layouts, lifestyle editorial content, manner of displaying merchandise, and typeface in American Eagle’s catalog were identical or confusingly

Revenue for
Abercrombie &
Fitch in 2009 was
\$3,540,000,000.

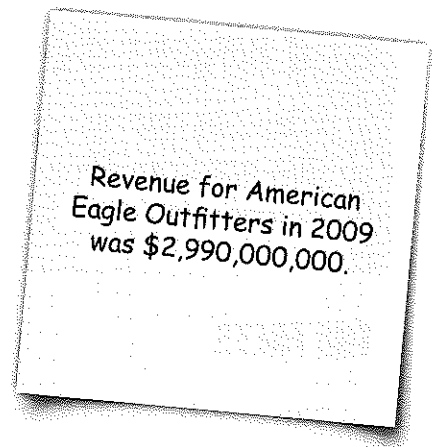
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similar to *The Quarterly*.

To support its contention, Abercrombie & Fitch introduced evidence of an American Eagle directive to its marketing executives that stated: “Attention store managers - we need you to tell us what Abercrombie & Fitch is marketing!!!” American Eagle managers were instructed to inspect the windows, lead table, and signs in Abercrombie & Fitch stores every week and report on Abercrombie & Fitch’s presentation.

When comparing *The Quarterly* with American Eagle’s catalogs of the same year, the following facts were revealed:

- 1) **FORMAT:** Like Abercrombie & Fitch, American Eagle used the clothesline (or cutout) format to display its goods—the garments appeared on the page as if hanging from a clothesline, not on a model.
- 2) **DISPLAY:** American Eagle used colorbars and design bars underneath almost all its garments, while Abercrombie & Fitch did so only occasionally.
- 3) **PHOTOGRAPHS:** Throughout *The Quarterly*, Abercrombie & Fitch made extensive use of grainy photographs depicting apparently in-shape college-aged models in often romantic poses. American Eagle’s photographs were clear and presented a “wholesome image,” with models of various ages in non-suggestive, often family-oriented situations.
- 4) **ARTICLE CONTENT:** American Eagle concentrated on family subjects with slogans such as “After all the gifts are opened and the decorations packed away, there is really one thing that lasts through the holidays—the spirit of giving.” Abercrombie & Fitch articles included titles like “I’ll have a brew Christmas,” “7 ways to survive a holiday gathering with your relatives,” “Drinking 101” which included recipes and a device for playing drinking games.
- 5) **TRADEMARK:** Abercrombie & Fitch displayed its trademarks throughout *The Quarterly* on nearly every page. The American Eagle catalog also prominently displayed their marks. While both companies liberally using their trademarks throughout their catalogs was a similarity, the court found that it was also a difference, because each used its own trademark and trademarks as an indication of a product’s origin.



Sources

The case briefing above contains excerpts and direct extractions from the sources noted below that have been combined with the author’s own expert legal input. The case has been condensed and formatted from its original content for purposes of this workbook.

[Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.](#), 280 F.3d 619 (6th Cir. 2002). United States Court of Appeals, Sixth Circuit February 15, 2002. Opinion written by the Honorable Justice Danny Julian Boggs.

NAME

DATE

Review the Case

After reading Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, answer the following:

1. Identify the Plaintiff(s) in the case.

2. Identify the Defendant(s) in the case.

3. What was one of Abercrombie & Fitch's main claims against American Eagle?

4. When did Abercrombie & Fitch start its business?

5. When did American Eagle start its business?

6. What specific actions by American Eagle does Abercrombie & Fitch argue violate its trademark rights?

7. What did American Eagle instruct its employees to do regarding the Abercrombie & Fitch brand?

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Review the Case (continued)

8. What is the "clothesline method" of displaying clothes in a catalog? Did American Eagle and/or Abercrombie & Fitch use this method?

9. Each company used the photographs to portray a certain image of its products. Explain the content of the photographs for Abercrombie & Fitch and American Eagle and the message each portrayed to consumers. Are the messages different?

10. List the "editorial comments" in the two magazines. Compare the way lifestyle is portrayed in the two magazines.

11. Does the Abercrombie & Fitch logo appear in its catalog? Does American Eagle use its logo in its catalog? Does the court regard the printing of the logos by American Eagle as a similarity between the two catalogs or a difference?

NAME _____

DATE _____

Make the Argument

In order for the judge or jury to render a decision, the following are some of the questions that must be considered:

1. Can the Abercrombie & Fitch catalog and its design within the catalog be considered "trade dress" as defined herein? Explain.

2. Is the catalog sufficiently distinct from the Abercrombie & Fitch catalog in its design?

3. Is the American Eagle catalog so similar to Abercrombie & Fitch's, *The Quarterly*, that the catalogs will cause confusion among members of the general public as to which products belong to which company? In other words, are the catalogs confusingly similar? Explain.

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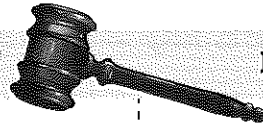
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You Be the Judge

Having reviewed the case and considered the questions involved, decide the case for either the **Plaintiff** or the **Defendant**:

Decision for the Plaintiff



Decision for the Defendant

Abercrombie & Fitch Stores, Inc.

American Eagle Outfitters

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