DIAMONDS ARE FOREVER, AS ARE TRADEMARKS: ARTICULATING THE TWISTS OF SECTION 43(A) TRADE DRESS PROTECTION FOR JEWELRY DESIGNS THROUGH THE FACTS OF *DAVID YURMAN V. MEJURI*

Daphne Singer*

Cite as: Daphne Singer, *Diamonds Are Forever, As Are Trademarks: Articulating The Twists Of Section 43(A) Trade Dress Protection For Jewelry Designs Through The Facts Of David Yurman v. Mejuri*, 32 RICH. J.L. & TECH. 114 (2026).

* J.D. Candidate, American University Washington College of Law, Class of 2026. B.A., Sarah Lawrence College, Class of 2021. Ms. Singer has contributed legal commentary to *The New York Times*, *The IPKat*, the *AIPLA Speaker Showcase*, and *Innovate Magazine*. She would like to thank Professor Christine Farley for her mentorship and the *Richmond Journal of Law & Technology* team for their support of this Article.

Table of Contents

I. INTRODUCTION

[1] Jewelry is adornment—adornment that has "spawned cultural movements, launched political dynasties, and even started wars."[1] This Article will analyze the application of Section 43(a) of the Lanham Act,[2] which covers trade dress, to jewelry design. Trade dress law is a powerful tool for designers because it regulates the protection of designs rather than words.[3] Despite this strength, trade dress has not been analyzed in the context of the jewelry industry because legal academics have dismissed jewelry as an accessory to fashion law.[4] Luxury jewelry and watches are often used to convey status via "recognizable, distinguished designs that consumers associate with the particular brand" to indicate "craftsmanship and quality;" the designs themselves, which are subject to trade dress law, are one of the "key ingredients" in creating and selling jewels.[5]

[2] Trade dress protection establishes the distinctiveness of a particular garment, but obtaining this trade dress protection is often difficult due to

[1] AJA RADEN, STONED: JEWELRY, OBSESSION, AND HOW DESIRE SHAPES THE WORLD xi (2015).

[2] Lanham Act, 15 U.S.C. § 1125(a).

[3] Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 215 (2000).

[4] *See e.g.*, Paige Holton, *Intellectual Property Laws for Fashion Designers Need No Embellishments: They Are Already in Style*, 39 J. CORP. L. 415, 419 (2014) (failing to focus on jewelry as a distinct area of the law); Symposium, *The Global Contours of IP Protection for Trade Dress, Industrial Design, Applied Art, and Product Configuration*, 20 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 783 (2010) (mentioning jewelry as an aside in a discussion of trade dress and fashion law).

[5] Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 221–22 (S.D.N.Y. 2004) (stating that jewels refer to both cut gemstones and assembled pieces or sets of jewelry); *see generally* RADEN, *supra* note 1, at 6.

the fast-paced nature of the clothing industry.[6] In contrast, as the great sculptor and jeweler Elsa Peretti asserted, "[j]ewelry is not fashion . . . [i]t does not have to be discharged as soon as something new comes along."[7] Just as trademarks can last as long as they are in use, jewels are wearable sculptures that can last for thousands of years.[8] Further, while most jewelry serves no utilitarian purpose, clothing designs "almost invariably serves purposes other than source identification"[9] such as to clothe the wearer.[10] Treating clothing and jewelry as equivalent products under the law ignores the fact that most jewelry, unlike most clothing, is non-functional, and thereby jewelry designers have access to greater intellectual property protections for their creations than clothing designers.[11]

---

[6] Holton, *supra* note 4, at 419 (explaining that distinctiveness is an essential element for a valid trademark and requires that a trademark can serve as a source identifier for a business); *see* Lanham Act, 15 U.S.C. § 1127.

[7] Nancy MacDonnell, *How Elsa Peretti Transformed Tiffany & Co. in Her Own Fabulous Image*, W MAG. (Oct. 14, 2024), https://www.wmagazine.com/fashion/elsa-peretti-tiffany-jewelry-50th-anniversary-collection [https://perma.cc/Z85C-XV8Z].

[8] RADEN, *supra* note 1, at 108 (stating that humans have made and worn jewelry for hundreds of thousands of years– "the invention of jewelry may have marked the beginning of modern human thought and behavior."); MacDonnell, *supra* note 7.

[9] Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 213 (2000).

[10] *See* RADEN, *supra* note 1, at 37 (describing jewelry as "an item that serves no purpose except as a status symbol, to be compared (hopefully favorably) with the same item belonging to others."). However, patents protect some aesthetic technological developments. *E.g.,* Michelle Graff, *Independent Brand Ox Sues H&M for Allegedly Knocking Off Its 'Ourglass'*, NAT'L JEWELER (Jan. 11, 2024), https://nationaljeweler.com/articles/12576-independent-brand-ox-sues-h-m-for-allegedly-knocking-off-its-ourglass [https://perma.cc/9PGX-L9EW] (explaining that patents protect some aesthetic technological developments by describing a tennis bracelet protected by utility and design patents for a design that allows the diamonds to rotate 180 degrees).

[11] Charlene A. Azema, *The Crown Jewels: How to Protect Your Jewelry Designs*, KNOBBE MARTENS (Jan. 16, 2019), https://www.knobbe.com/blog/crown-jewels-how-protect-your-jewelry-designs/ [https://perma.cc/EA5Z-PPWQ].

[3] To clarify the current state of federal trade dress law as applied to the jewelry industry, this Article applies approximately twenty federal court interpretations of Section 43(a) in jewelry design litigation, in particular the tests for secondary meaning, functionality, and likelihood of confusion to the merits of the arguments in *David Yurman Enters. LLC v. Mejuri, Inc*.[12] *David Yurman v. Mejuri* was a trade dress infringement suit between two major jewelry designers, which the parties settled in 2023.[13] While the parties in *David Yurman v. Mejuri* settled, other jewelers are manufacturing the design at issue, including the direct-to-consumer brand Quince.[14] Additionally, Mejuri just launched a similar design to the alleged infringing trade dress.[15] Both of these situations make new litigation over the same or similar facts likely to occur.[16] Thus, the circumstances underlying the litigation in *David Yurman v. Mejuri* provide facts that will guide this Article's analysis applying trade dress law to jewelry design.

[12] Complaint, David Yurman Enters. LLC v. Mejuri, Inc., No. 1:21-cv-10821 (S.D.N.Y. Dec. 17, 2021).

[13] Answer, Affirmative Defenses and Counterclaims, David Yurman Enters. LLC v. Mejuri, Inc., No. 1:21-cv-10821 (S.D.N.Y. Mar. 4, 2022); Order, David Yurman Enters. LLC v. Mejuri, Inc., No. 1:21-cv-10821 (S.D.N.Y. Apr. 11, 2023) (details of the settlement were not publicly disclosed, however while Mejuri initially continued to sell the allegedly infringing designs, Mejuri no longer stocks these specific designs); *see also David Yurman, Mejuri Settle "Copying" Suit, Shed Light on ESG Marketing Risk,* FASHION L. (Apr. 12, 2023), https://www.thefashionlaw.com/david-yurman-mejuri-settle-copying-suit-shed-light-on-esg-marketing-risk [https://perma.cc/ZPV8-5GNK]; Lenore Fedow, *David Yurman, Mejuri Settle Dueling Lawsuits*, NAT'L JEWELER (Apr. 14, 2023), https://nationaljeweler.com/articles/11861-david-yurman-mejuri-settle-dueling-lawsuits [https://perma.cc/9UGN-7V9P].

[14] *See Croissant Ring*, QUINCE, https://www.quince.com/women/crossiant-ring?srsltid=AfmBOooS09_eBBPLHbLfbqiojPCD9cWXajN63W4XvKU4kTruIPgI_v6m [https://perma.cc/7W54-PB8K]; *Croissant Hoops* (last visited Nov. 17, 2025), QUINCE, https://www.quince.com/women/croissant-hoop-earrings?color=gold-vermeil [https://perma.cc/82FT-CSJU] (last visited Nov. 17, 2025).

[15] *Brioche Hoops*, MEJURI, https://mejuri.com/products/brioche-hoops [https://perma.cc/2AWM-HKDY].

[16] *See supra* notes 14–15.

[4] Part II.A. establishes how federal courts apply trade dress case law to jewelry designs for a prima facie case of trade dress protection.[17] Part I.B. likewise establishes the rules for a likelihood of confusion analysis under current trade dress case law.[18] Part II.C. provides background about the uncertain application of trade dress law to jewelry design before *Two Pesos, Inc. v. Taco Cabana, Inc.,*[19] and *Wal-Mart Stores, Inc. v. Samara Bros.*,[20] as well as the major challenge and advantage with seeking trade dress rights for jewelry design.[21] Part II.D. of this Article introduces the facts and litigation history of *David Yurman v. Mejuri*.[22] Part III.A. narrows the analysis to assessing how federal courts' interpretations of the three major tests in a trade dress claim: secondary meaning/distinctiveness, functionality, and likelihood of confusion, should be applied to the facts in *David Yurman v. Mejuri*.[23] Part III.B. synthesizes the case law discussed earlier to illustrate the boundaries of trade dress protections for future jewelry design trade dress litigants.[24] Finally, in Part IV, this Article will conclude that David Yurman failed to establish all three elements at issue necessary to assert trade dress rights and thus succeed in a likelihood of confusion infringement claim against Mejuri.[25]

[17] *See infra* Part II.A.

[18] *See infra* Part II.B.

[19] Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992).

[20] Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205 (2000).

[21] *See infra* Part II.C.

[22] *See infra* Part II.D.

[23] *See infra* Part III.A.

[24] *See infra* Part III.B.

[25] *See infra* Part IV.

II. BACKGROUND

[5] Understanding the modern state of jewelry designs under trade dress law requires understanding how federal courts approach Section 43(a) jewelry design claims as well as the statutory and judicial developments in trademark law over the past few decades.[26] For a plaintiff to assert a successful prima facie Section 43(a) trade dress claim over a jewelry design, a plaintiff must accomplish three main tasks. The plaintiff must state the elements of their trade dress, establish that the jewelry design is distinctive via secondary meaning through balancing factors (advertising expenditures, unsolicited media coverage, consumer surveys, sales success, plagiarism, length and exclusivity of use), and demonstrate that the jewelry design is non-functional.[27] For a plaintiff to succeed on a likelihood of confusion claim, the jewelry design must prevail on seven factors: the strength of the trade dress, the similarity of the plaintiff's and defendant's marks, the proximity of the products, the likelihood that the gap between the plaintiff and defendant's markets will be bridged, consumer sophistication, jewelry quality, and evidence of defendants' good or bad faith.[28] Additionally, it

[26] *See generally* Lanham Act, 15 U.S.C. § 1125(a). The Lanham Act Section 43(a) governs trade dress, or designs, smells, business plans, etc. rather than word and logo trademarks that are not registered with the USPTO. This includes unregistered jewelry designs because jewels are designs rather than words or logos. Section 43(a) trade dress is divided between product designs, including jewelry designs, and product packaging; product designs are only able to show distinctiveness with secondary meaning. Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 215 (2000) (noting that trade dress is divided between product designs, jewelry designs, and product packaging; product designs are only able to show distinctiveness with secondary meaning).

[27] *See infra* Part II.A. Functionality is a barrier to a design being able to serve as a trademark. Designs that are aesthetically functional, or have elements that a plaintiff's to exclusive use would harm competitors' interests, cannot serve as trademarks. *See also* Audemars Piguet Holding S.A. v. Swiss Watch Int'l Inc., 46 F. Supp. 3d 255, 270 (S.D.N.Y. 2014) (supporting the fact that trademark law bars a design from trade dress protection under the doctrine of utilitarian functionality of which the design has an element essential to its use or purpose.); *see also* Neiman Marcus Grp., Inc. v. A'Lor Int'l, Ltd., 22 F. App'x 60, 62–63 (2d. Cir. 2001).

[28] *See infra* Part II.B.

requires setting up the backdrop for our frame case, *David Yurman v. Mejuri*.

A. Elements of a Prima Facie Section 43(a) Trade Dress Claim

[6] To achieve trademark protection, a design must serve as a source identifier to distinguish the goods of one business from another.[29] Courts recognize that the jewelry industry's strengths in mass-production and strong marketing help jewelry designs build consumer recognition over a period of at least five years and thus meet the requirements to establish distinctiveness via secondary meaning.[30] The designs of luxury jewelry themselves are often intended to convey the high status of the brand and thus its consumers. [31] However, this advantage for jewelry designers has limits, because achieving trademark protection for jewelry designs can be difficult due to the decorative, as opposed to descriptive, nature of rings, bracelets, or watches compared to word marks or logos.[32] Jewelry designers

---

[29] *See* HARRISON GODDARD FOOTE, FASHIONABLY IP: EXPLAINING FASHION IP LAW VIA A PIECE OF JEWELRY, at 03:08 (Fashionably IP, June 14, 2024).

[30] Ingrida Karins Berzins, *The Emerging Circuit Split Over Secondary Meaning in Trade Dress Law*, 152 U. PA. L. REV. 1661, 1691–93 (2004) (referencing *Cartier, Inc. v. Four Star Jewelry Creations, Inc.*, 348 F. Supp 2d 217 (S.D.N.Y. 2004)); Judith B. Prowda, *Application of Copyright and Trademark Law in the Protection of Style in the Visual Arts*, 19 COLUM.-VLA J. L. & ARTS 269, 298 (1995).

[31] *Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 221–22 (arguing that "[m]ost luxury watches are also 'status' watches . . . [a]s a result, the purchaser and wearer of a luxury watch aligns him or herself with the elite status of the watch.").

[32] *See* Ashley M. Marshall, *Free Fashion*, 17 MARQ. INTELL. PROP. L. REV., 123, 127 (2013) (arguing that trademark law offers stronger protection for logos than designs themselves); Harrison Goddard Foote, Fashionably IP: Explaining Fashion IP law Via a Piece of Jewelry at 04:40 (Fashionably IP, June 14, 2024). Lee Curtis, a British trademark attorney argues that jewelry has limits as a badge of trade origin due to it being a decorative object, in part due to the United Kingdom Trademarks Act of 1994 and the European Union Trade Regulation. *But see* Holger Gauss et al., *Red Soles Aren't Made for Walking: A Comparative Study of European Fashion Laws*, 5 LANDSLIDE 19, 26 (2013).

will have an easier time obtaining trademark protection for word marks and logo-stamped packaging in the jewelry industry than for jewelry designs themselves.[33]

[7] Diamonds are forever—as are trademarks. So long as a mark is in use, trademark protection exists, while patent and copyright protection have finite lifetimes.[34] This potentially perpetual monopoly has led to concerns about the anti-competitive risks of trade dress protection for product designs.[35] The court placed restrictions on product design trade dress protection in *Samara Brothers* to weigh the broad, perpetual interests of rightsholders "against a strong federal policy in favor of vigorously competitive markets."[36] Courts have reiterated this concern in jewelry design trade dress cases.[37]

[8] For a trademark to be valid, it must be used "to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods."[38] Trademarks can be inherently distinctive, acquire distinctiveness via

[33] *See* Holton *supra* note 4, at 422 (arguing that protecting the logos and word marks of fashion brands is easier than protecting the products themselves); Graham M. Pitman, *Are Diamonds Forever? Tiffany & Co.'s Fight to Protect Its Name*, 22 WAKE FOREST J. BUS. & INTELL. PROP. L. 81, 88–89 (2021) (mentioning Richard Posner used Tiffany and Co. as a Platonic ideal of a famous mark).

[34] *See* Berzins *supra* note 30, at 1670–71.

[35] *See* Symposium, *The Global Contours of IP Protection for Trade Dress, Industrial Design, Applied Art, and Product Configuration,* 20 FORDHAM INTELL. PROP., MEDIA & ENT. L.J. 783 (2010).

[36] Kennedy K. Luvai, *Score One for Competition: A Look at the Rational Limits of Trade Dress Protection for Unregistered Product Designs*, 56 ADVOCATE 32, 32 (2013).

[37] *See e.g.*, Yurman Design, Inc. v. PAJ, Inc., 262 F.3d 101, 114, 177 (2d Cir. 2001).

[38] Lanham Act, 15 U.S.C. § 1127.

secondary meaning, or be insufficiently distinctive and thus generic.[39] Finally, marks can fail to be distinctive at all and can be established that product design trade dress cannot be inherently distinctive, for a jewelry design to be distinctive under the Lanham Act, it must acquire secondary meaning.[40] Establishing distinctiveness through secondary meaning in jewelry product designs is simpler compared to clothing product designs, since jewelry is advertised to consumers for longer.[41] As technological advancements in craftsmanship and artificial stone development continue, it will likely become more difficult for designers to establish secondary meaning with certain jewelry designs, such as those that incorporate lab-grown, rather than natural, diamonds.[42]

[9] The secondary meaning distinctiveness balancing factors for jewelry designs include advertising expenditures, consumer studies, unsolicited media coverage, sales success, plagiarism, and the length and exclusivity of the plaintiff's use of the design.[43] The first factor in a

[39] *Id.* Inherently distinctive trademarks are trademarks or product packaging that can clearly identify the source of the goods or services to customers without external knowledge due to the unique nature of the mark. Chrome Hearts LLC v. Controse Inc., No. 21-cv-6858 (LJL), 2023 WL 5049198, at *16 (S.D.N.Y. Aug. 8, 2023). Additionally, marks can acquire distinctiveness by developing secondary meaning in the marketplace for at least five years if the mark itself is less unique and merely descriptive of the goods or services and the mark becomes associated with the goods or services to consumers. Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 276 (S.D.N.Y. 2014). Finally, marks can fail to be distinctive at all and can be generic, in which case the mark can never serve as a trademark or assert any trademark claims. *See* Sunrise Jewelry Mfg. Corp. v. Fred S.A., 175 F.3d 1322, 1325–26 (Fed. Cir. 1999).

[40] Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 211 (2000); Azema, *supra* note 11 (stating that securing jewelry designs trademark protection requires establishing secondary meaning).

[41] Holton, *supra* note 4, at 419; MacDonnell, *supra* note 7.

[42] Barton Beebe, *Intellectual Property Law and the Sumptuary Code*, 123 HARV. L. REV. 809, 823 (2010).

[43] Jeffrey L. Michelman & Kay R. Sherman, "*Protecting Your Client's Good Looks"–Trade Dress Protection*, 37 ST. LOUIS BUS. J. 12, 16 (1990).

secondary meaning analysis is advertising. Plaintiffs must be able to separate out a jewelry design or design line from the plaintiff's broader advertising budget for courts to be able to consider advertising expenditures as a factor in a secondary meaning analysis.[44] Courts also look favorably on plaintiffs whose annual or semi-annual advertising expenditures are in the high six figures, if not millions—a low barrier for international luxury jewelry brands like Audemars Piguet and Cartier.[45] Audemars Piguet spent $881,787 on advertising expenditures for its Royal Oak watch over a two-year period, and a court found that this was sufficient to satisfy the first secondary meaning factor.[46] Cartier spent between half a million and three million dollars annually advertising different watch model lines, which the court held "were considerable expenditure[s] of resources in advertising."[47] However, the expenditure threshold smaller jewelers need to meet to satisfy a finding of distinctiveness on the advertising factor is unclear and more prone to jurisdictional variance. In *Cosmos Jewelry Ltd. v. Po Sun Hon Co.*,[48] which was decided in the Central District of California, the court held that a million dollars in advertising expenditures over a thirteen-year period was sufficient to establish secondary meaning.[49] Meanwhile, the Southern District of New York held in *Diamond Direct, LLC v. Star Diamond Grp.*,

---

[44] Yurman Design, Inc. v. Golden Treasure Imports, Inc., 275 F. Supp. 2d 506, 513 (S.D.N.Y. 2003); Cartier, Inc. v. Sardell Jewelry, Inc., 294 F. App'x 615, 618 (2d Cir. 2008).

[45] *See* Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 277 (S.D.N.Y. 2014); Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 226–27 (S.D.N.Y. 2004).

[46] *Audemars Piguet Holding S.A.*, 46 F. Supp. 3d at 277.

[47] *Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 226–27 (stating that in addition to the sheer numbers of spending, the court was swayed by Cartier's use of "actual panthers in its stores").

[48] Cosmos Jewelry Ltd. v. Po Sun Hon Co., 470 F. Supp. 2d 1072 (C.D. Cal. 2006).

[49] *Id.* at 1077, 1086.

Inc.[50] that spending $135,000 on a year's ad campaign for a diamond ring was "hardly overwhelming."[51]

[10] Courts look favorably on plaintiffs who advertise widely in mass media, like the New York Times or airline brochures.[52] When advertisements focus on the design itself, with the design taking up at least 80% of the page, courts are more likely to view the ad as evidence of secondary meaning.[53] However, if these advertisements focus on words unconnected to the trade dress, such as vague superlative words without any ties to the claimed trade dress jewelry design in the advertisement, this factor will not favor the plaintiff.[54] Sponsorship of events, such as award shows, cocktail parties, or trade shows, can contribute to a finding of secondary meaning.[55] However, trade show participation alone is unlikely to be strong evidence for secondary meaning because trade shows have limited consumer exposure.[56] In addition to paid advertising, the second factor in a secondary meaning analysis is unsolicited media coverage. This includes all unsolicited media coverage and celebrity endorsements of the claimed trade dress jewelry design, even if the media coverage is only a

[50] Diamond Direct, LLC v. Star Diamond Grp., Inc., 116 F. Supp. 2d 525 (S.D.N.Y. 2000).

[51] *Id.* at 532.

[52] Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 277 (S.D.N.Y. 2014); *Cosmos Jewelry Ltd*., 470 F. Supp. 2d at 1086.

[53] Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 226 (S.D.N.Y. 2004).

[54] *See* Berg v. Symons, 393 F. Supp. 2d 525, 553–54 (S.D. Tex. 2005).

[55] *Audemars Piguet Holding S.A*., 46 F. Supp. 3d at 271; Cosmos Jewelry Ltd. v. Po Sun Hon Co., 470 F. Supp. 2d 1077 (C.D. Cal. 2006); *Four Star Jewelry Creations, Inc*., 348 F. Supp. 2d at 241–42.

[56] *See* Diamond Direct, LLC v. Star Diamond Grp., Inc., 116 F. Supp. 2d 525, 532 (S.D.N.Y. 2000).

single appearance in a niche magazine targeted at the jeweler's customer base.[57]

[11] The third factor in a secondary meaning analysis is consumer studies that poll consumers to determine if they associate a jewelry design with a single source.[58] The surveys must target the item's specific consumer base, which for luxury jewelry items is often customers who shop at upscale malls or specialty jewelry or watch stores.[59] Courts encourage surveys to be narrowed geographically to luxury jewelers that sell and advertise the product in question and demographically to buyers in a specific financial bracket.[60] Consumer studies establish secondary meaning when polls show a majority of consumers recognize that a jewelry design came from one source or recognize that distinct elements in an allegedly infringing design originated from the plaintiff's jewelry design, even if the recognition rates are low (between 8 and 23%).[61] Consumer studies provide strong evidence for plaintiffs in trade dress litigation, but can be prohibitively expensive—even the biggest jewelers in the world reuse surveys in subsequent trade dress litigation.[62] However, while the costs of conducting a consumer survey are high, the cost of failing to conduct a study can be even higher, as

[57] *See Audemars Piguet Holding S.A*., 46 F. Supp. 3d at 271; *Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 227–28; *see also Berg*, 393 F. Supp. 2d at 552 (holding that an article about a western style jeweler in a western magazine positively contributed to a potential finding of secondary meaning).

[58] *See* Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 242 (S.D.N.Y. 2004).

[59] *See id.* at 229–31.

[60] *See id.*; Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 272–73, 277 (S.D.N.Y. 2014).

[61] *Four Star Jewelry Creations, Inc*., 348 F. Supp. 2d at 242.; *Audemars Piguet Holding S.A*., 46 F. Supp. 3d at 277.

[62] *See, e.g.*, Cartier, Inc. v. Sardell Jewelry, Inc., 294 F. App'x 615, 618 (2d Cir. 2008).

courts note when plaintiffs fail to present evidence of consumer surveys.[63] The fourth element in a secondary meaning analysis for a jewelry design is the sales success of that design, which considers the profits and quantity of the plaintiff's designs sold. Fine jewelry is typically sold in low volumes at high prices.[64] Thus, plaintiffs seeking to establish secondary meaning for their jewelry designs will have an easier time establishing sales via profits, but a harder time establishing sales via quantity.[65] Plaintiffs often need to sell tens of thousands of units and generate millions in profits to establish sales that show substantial evidence that a jewelry design has obtained secondary meaning.[66] If only one of these sales elements, profits or quantity, favors the plaintiff, the two elements may cancel each other out, rendering the entire factor moot.[67]

[12] The fifth element in a secondary meaning analysis is plagiarism which can occur when defendants falsely compare their products to the

[63] *See, e.g.*, Berg v. Symons, 393 F. Supp. 2d 525, 553 (S.D. Tex. 2005); Diamond Direct, LLC, v. Star Daimond Grp., Inc., 116 F. Supp. 2d 525, 531–32 (S.D.N.Y. 2000).

[64] *See, e.g.*, *Audemars Piguet Holding S.A*., 46 F. Supp. 3d at 270 (showing watches between $15,000 to over one million); *Berg*, 393 F. Supp. 2d at 552 (showing belt buckles between $1,000 and $2,750); *Four Star Jewelry Creations, Inc*., 348 F. Supp. 2d at 227 (showing watches between $2,450 to $208,000).

[65] *Audemars Piguet Holding S.A*., 46 F. Supp. 3d at 270–71, 277 (holding that while Audemars Piguet had high revenue, and the Royal Oak design constituted a majority of it, the low volume of units sold made the sales factor neutral when determining whether secondary meaning existed).

[66] *See, e.g.*, Nola Spice Designs, L.L.C. v. Haydel Enters., Inc., 783 F.3d 527, 544 (5th Cir. 2015) (holding that 380 related items sold and $30,500 in income was insufficient to show secondary meaning); *Diamond Direct, L.L.C.*, 116 F. Supp. 2d at 532 (holding that 2,624 units sold was insufficient to show secondary meaning); *Berg*, 393 F. Supp. 2d at 552, 554 (holding that 100 units sold and $1.3 million in sales in a single year were insufficient to show secondary meaning); Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 227 (S.D.N.Y. 2004) (holding that 14,225 units and $102 million in sales was sufficient to show secondary meaning).

[67] *Audemars Piguet Holding S.A.*, 46 F. Supp. 3d at 277.

plaintiffs' designs.[68] Plagiarism also occurs when courts find that the plaintiff's designs are so unique that similarities between the two jewelry designs must be the result of plagiarism, excluding any similarities that are a result of general industry standards.[69] Direct evidence of plagiarism can include proof that a defendant copied a plaintiff's jewelry designs, such as an oral confession or use of a jewelry design's unique commercial name in the infringing product's description.[70]

[13] The final factor for determining whether a jewelry design has achieved secondary meaning considers the length and exclusivity of use of the combination of the stated elements of the trade dress. Unregistered trade dress claims do not have a presumption against genericism.[71] Generic marks are unprotectable as they are elements that are so common in business that they would not function as a source identifier for a single business.[72] While the exclusivity of use is more important than the length of use, the court in *Cartier, Inc. v. Four Star Jewelry Creations, Inc.*[73] held that comparing the length of use by a prospective plaintiff to the lengths of use of similar luxury jewelry contributed to a finding of secondary meaning, as the length of use gave context to the exclusivity of use.[74]

[68] Berg v. Symons, 393 F. Supp. 2d 525, 554 (S.D. Tex. 2005).

[69] *Id.*

[70] *Four Star Jewelry Creations, Inc*., 348 F. Supp. 2d at 243; Cartier, Inc. v. Sardell Jewelry, Inc., 294 F. App'x 615, 618 (2d Cir. 2008).

[71] Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 277, 284 (S.D.N.Y. 2014); Chrome Hearts L.L.C. v. Controse Inc., No. 21-cv-6858 (LJL), 2023 WL 5049198, at *6 (S.D.N.Y. Aug. 8, 2023).

[72] Lanham Act, 15 U.S.C. § 1127.

[73] Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 217 (S.D.N.Y. 2004).

[74] *Id.* at 244 (holding that eight years of use was a sufficient length of time for secondary meaning when compared to the length of use of comparable luxury watches); *see also* Audemars Piguet Holding S.A., 46 F. Supp. 3d at 278 (holding that thirty years of use is a sufficient length of time for secondary meaning).

[14] Jewelry designs are more likely to fail to establish exclusivity of use when the design is based on elements commonly used throughout the jewelry industry, such as nautical rope motifs, granulation, or vine scrollwork.[75] Because these elements are commonly used by jewelry designers rather than exclusively used by the designer asserting a trade dress claim, these elements are generic.[76] The prominence of generic elements may suggest that the resulting design is generic, and thus has not been exclusively used by the designer.[77] This will bar a finding of exclusive use unless the combination of the elements functions as an indicator of source for the jewelry designer.[78]

[15] However, establishing exclusive use of a resulting design while relying on industry standard elements is difficult. An expert witness in *Judith Ripka Designs, Ltd. v. Preville*[79] stated the plaintiff's claimed trade dress jewelry designs, which used ancient-inspired jewelry elements, "have been around forever[.]"[80] Evidence affecting the length and exclusivity of use of an asserted trade dress can include testimony from jewelry company

[75] Sunrise Jewelry Mfg. Corp. v. Fred S.A., 175 F.3d 1322, 1326–27 (Fed. Cir. 1999); Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 242 (S.D.N.Y. 1996); Berg v. Symons, 393 F. Supp. 2d 525, 553 (S.D. Tex. 2005).

[76] *Berg*, 393 F. Supp. 2d at 553.

[77] R.F.M.A.S., Inc. v. Mimi So, 619 F. Supp. 2d 39, 83 (S.D.N.Y. 2009); Yurman Design, Inc. v. PAJ, Inc., 262 F.3d 101, 118 (2d Cir. 2001).

[78] *R.F.M.A.S., Inc.*, 619 F. Supp. 2d at 83 (S.D.N.Y. 2009).

[79] *Judith Ripka Designs, Ltd.*, 935 F. Supp. at 243–44.

[80] *Id.* at 244.

executives, other craftsmen, and collectors,[81] images,[82] and expert historical analysis.[83]

[16] To establish a prima facie trade dress claim, a design must be non-functional.[84] Functional marks are not protectable under trademark law because protecting functional marks would grant a monopoly over a useful design, thereby harming competition.[85] The doctrine of functionality has two prongs: utilitarian functionality and aesthetic functionality.[86] Utilitarian functionality asks whether a design element is essential to the use or purpose

[81] *Compare* Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 231–32 (S.D.N.Y. 2004) (holding that testimony from executives contributed to secondary meaning), *with* Berg v. Symons, 393 F. Supp. 2d 525, 533, 551 (S.D. Tex. 2005) (holding that testimony from two collectors and letters from silversmiths were acceptable evidence but insufficient to establish exclusivity of use).

[82] *Compare* Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 271, 277 (S.D.N.Y. 2014) (holding that images of other, similar designs affect a finding of exclusive use); *with* Chrome Hearts LLC v. Controse Inc., No. 21-cv-6858 (LJL), 2023 WL 5049198 at *7 (S.D.N.Y. Aug. 8, 2023) (holding that an unverified screenshot of a Google Images search for gothic crosses was not sufficient evidence to find a design is generic).

[83] *See* Solid 21, Inc. v. Hublot of Am., 109 F. Supp. 3d 1313, 1318 (C.D. Cal. 2015) (holding that jeweler Anthony Lent may testify as an expert on the history of the use of red gold in jewelry as he "base[d] his opinions on … trade dictionaries, books, encyclopedias, the popular press, and textbooks") *rev'd*, 685 F. App'x 530 (9th Cir. 2017) (reversed for failure to include part of a different expert's testimony). *But see* Beebe, *supra* note 42, at 809 (arguing that "[i]ntellectual property law begins where history ends.").

[84] Lanham Act, 15 U.S.C. § 1125(a).

[85] Yurman Design, Inc. v. Golden Tresure Imps., 275 F. Supp. 2d 506, 512 (S.D.N.Y. 2003).

[86] *Audemars Piguet Holding S.A.*, 46 F. Supp. 3d at 282; *see also*, A. Samuel Oddi, *The Functions of "Functionality" in Trademark Law*, 76 TRADEMARK REP. 308, 323 (1986) ("The sole balance against the right to copy is not the likelihood of confusion. Of equal and independent importance is the doctrine of 'functionality', which is designed to avoid serious anti-competitive inroads into the right to copy.").

of the item as a whole, or if the design affects the cost or quality of the article.[87] While these are separate inquiries, utilitarian functionality has a minor role in jewelry design trade dress analysis as often jewelry's only utility is telling time or serving as a status symbol.[88] Clasps, chains, and other elements that contribute to the wearability or production of the design are most likely to be functional under the utilitarian functionality doctrine.[89] Jewelry designs previously protected by design or utility patents have a rebuttable presumption of functionality.[90] However, if a jewelry design uses a functional element like twisted wire for a non-functional purpose, the design can be non-functional and thus protectable under trade dress law.[91] This can be achieved by combining the functional element with other design elements, as it is "improper… to break the trade dress down into specific elements and call them functional."[92] Nor can jewelry design elements be aesthetically functional, or harm competitors' commercial interests by

[87] *See* Berg v. Symons, 393 F. Supp. 2d 525, 525, 556 (S.D. Tex. 2005); Neiman Marcus Grp., Inc. v. A'Lor Int'l, Ltd, 22 F. App'x 60, 62 (2d Cir. 2001).

[88] *See* RADEN, *supra* note 1, at 37 (stating that jewels have only one purpose as status symbols); Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 221 (S.D.N.Y. 2004) (holding that luxury Watches tell time but are primarily used as status symbols).

[89] Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 242 (S.D.N.Y. 1996).

[90] Yurman Design, Inc. v. Golden Treasure Imps., Inc., 275 F. Supp. 2d 506, 512 (S.D.N.Y. 2003).

[91] *Neiman Marcus Grp. Inc*., 22 F. App'x at 62.

[92] Cartier, Inc. v. Sardell Jewelry, Inc., 294 F. App'x 615, 620–21 (2d Cir. 2008). *Compare* Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 282 (S.D.N.Y. 2014) (holding that an octagonal watch design was protectible because the design encompassed not only the octagon shape but the combination of the shape with eight screws around the bezel), *with in re* Audemars Piguet Holding SA, 2025 WL 21318 (T.T.A.B. 2025) (denying trademark application to Royal Oak that did not exclude "everything except the octagonal bezel and the eight hexagonal screwheads within the bezel.").

putting them at a non-reputationally related disadvantage.[93] Jewelry designs are more likely to be aesthetically functional when they use industry standard techniques such as matte finishing or other "common elements" of a particular subgenre of jewelry.[94] When combinations of common elements in the jewelry trade—such as a diamond ring made up of baguette and marquise diamonds—limit other jewelers' abilities to produce similar designs, these combinations can be barred for functionality.[95] Courts scrutinize attempts to protect the use of color in trade dress claims under the aesthetic functionality doctrine. [96] This is especially true in the jewelry industry, where a limited number of colors can be produced via alloys (mixes of metal), such as rose gold or green gold, and exclusive use of basic colors like gold and black is antithetical to competitive interests.[97]

---

[93] *Audemars Piguet Holdings S.A.*, 46 F. Supp. 3d at 280. *But see* Symposium, *The Global Contours of IP Protection for Trade Dress, Industrial Design, Applied Art, and Product Configuration*, 20 FORDHAM INTELL. PROP. MEDIA & ENT. L J. 783, 791–93 (2010) (arguing that the aesthetic functionality doctrine treats all aesthetics as a function as aesthetics justify consumers' decisions to shop).

[94] Berg v. Symons, 393 F. Supp. 2d 525, 525, 557 (S.D. Tex. 2005) (holding that a jeweler's use of floral motifs, colors and scrollwork were aesthetically functional); *see* Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 242, 257 (S.D.N.Y. 1996) (holding that the use of common elements of ancient inspired jewelry, such as "the use of 18 karat green colored gold, matte finishes, beading, granulation, rope twists, fluting, cabochon stones, columnar designs, pyramid designs and art deco design" are aesthetically functional). *But see* Cosmos Jewelry Ltd. v. Po Sun Hon Co., 470 F. Supp. 2d 1072, 1085 (C.D. Cal. 2006) (holding that a plumeria flower design using industry standard techniques were not aesthetically functional).

[95] DBC of New York, Inc. v. Merit Diamond Corp., 768 F. Supp. 414, 415, 418 (S.D.N.Y. 1991); Cartier, Inc., v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 224-25 (S.D.N.Y. 2004).

[96] *See* Marshall, *supra* note 32, at 128 (arguing that fashion designers need access to colors without restrictions).

[97] *See* Solid 21, Inc. v. Breitling U.S.A., Inc., 96 F.4th 265, 277–78 (2d Cir. 2024) (arguing that the phrase "red gold" cannot be protected as a mark because red gold describes a gold-copper alloy.); *Judith Ripka Designs, Ltd.*, 935 F. Supp. at 243, 248 (determining that "green gold is generally used by designers in the ancient-inspired genre" and thus is functional.); *Berg*, 393 F. Supp. 2d at 556–57 (arguing that the color

[17] In addition to distinctiveness via secondary meaning and non-functionality, the plaintiff must state each element of the claim for a court to consider whether a jewelry design has a valid Section 43(a) claim.[98] Concerns over granting expansive trademark protection to unregistered designs led the Second Circuit in *Yurman Design, Inc. v. PAJ, Inc.*[99] to dismiss the plaintiff's trade dress claims for failing to "articulate the design elements that compose the trade dress."[100] Plaintiffs must articulate the distinctive elements they are claiming as part of their trade dress with words, rather than images.[101] The court in *PAJ* itself acknowledged that "[t]he trade dress of works that are decorative or artistic may be harder to capture in words, and may need descriptions more broadly framed, or may need drawings."[102]

[18] However, since the Second Circuit stated this requirement, jewelry designers have consistently met this standard by including numerically

black is aesthetically function due to its ability to match other pigments being one of the "few nonmetallic colors that is compatible with the general format of western jewelry" while gold is aesthetically functional as a signifier of opulence, and thus exclusive use of either color would "hinder market competition.").

[98] Yurman Design, Inc. v. PAJ, Inc., 262 F.3d 101, 116 (2d Cir. 2001); Berzins, *supra* note 30, at 1672.

[99] *Yurman Design, Inc*., 262 F.3d at 101.

[100] *Id.*; *PAJ, Inc.*, 262 F.3d at 116–17 (holding that a lack of stated claims would grant the plaintiff a monopolistic claim on jewelry design elements.); R.F.M.A.S., Inc. v. Mimi So, 619 F. Supp. 2d 39, 78 (S.D.N.Y. 2009) (stating defendant's concerns over the defendant's inability to know if the defendant was infringing the plaintiff's designs without stated claims.).

[101] Sara Designs, Inc. v. A Classic Time Watch Co., 234 F. Supp. 3d 548, 555 (S.D.N.Y. 2017); *see R.F.M.A.S. Inc.*, 619 F. Supp. 2d at 77.

[102] *PAJ, Inc.*, 262 F.3d at 117.

listed specific descriptions of each listed element accompanied by images to illustrate written descriptions.[103]

B. Elements of A Section 43(a) Trade Dress Infringement Claim

[19] Once a plaintiff has established a prima facie case for a valid trade dress, courts can determine if there was a Section 43(a) infringement. Section 43(a) infringement can occur due to a likelihood of confusion between the plaintiff and defendant's products.[104] Courts determine the likelihood of confusion by weighing the factors from *Polaroid Corp. v. Polarad Elecs. Corp.*[105] These factors include: 1) the strength of the trade dress; 2) the similarity of the plaintiff's and defendant's designs; 3) the proximity of the products; 4) the likelihood that the original owner will bridge the gap between their product's commercial stream and the latter owner's; 5) the sophistication of the consumers; 6) the quality of the product; and 7) any evidence of good or bad faith by the defendant.[106]

[20] The first likelihood of confusion factor considers the strength of the plaintiff's trade dress product design.[107] A jewelry design is strong when it serves as an indicator of the jewelry designer's brand, as evident through

[103] *See, e.g.,* Yurman Design, Inc. v. Golden Treasure Imps., Inc., 275 F. Supp. 2d 506, 510 (S.D.N.Y. 2003); Compl., *supra* note 12, at 11–15; Montblanc-Simplo GmbH v. Colibri Corp., 692 F. Supp. 2d 245, 250 (E.D.N.Y. 2010); Berg v. Symons, 393 F. Supp. 2d 525, 532 (S.D. Tex. 2005).

[104] Lanham Act, 15 U.S.C. § 1125(a); Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492, 495 (2d Cir. 1961).

[105] Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492, 495 (2d Cir. 1961).

[106] *Id.*

[107] *Id.*

survey results, advertising evidence, press statements, and revenue.[108] Jewelry designs that are purely ornamental or common in the jewelry industry are less likely to be strong marks in a likelihood of confusion analysis.[109] This factor's analysis often overlaps with the aesthetic functionality analysis because phrases and logos are poor indicators of source if consumers see the jewelry's designs as decorative rather than source identifying.[110]

[21] The second likelihood of confusion factor considers the similarity of the marks themselves. Courts analyze similarity of the marks by considering whether overlapping details between the plaintiff's and defendant's asserted trade dress product designs are likely to confuse

[108] *See* Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 271, 279 (S.D.N.Y. 2014) (holding that the strength of the mark factor in a likelihood of confusion analysis measures the ability of a distinctive design to serve as an indicator of source); Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 245 (S.D.N.Y. 2004) (holding that advertising evidence and sales evidence of a jewelry design was sufficient proof that Cartier's designs were strong). *But see* Chrome Hearts LLC v. Controse Inc., No. 21-cv-6858 (LJL), 2023 WL 5049198 at *16–17 (S.D.N.Y. Aug. 8, 2023) (holding that the strength of the mark is presumed when a designer has a registered trade dress jewelry design, and will not be overcome if a defendant fails to show that a design commonplace in the jewelry industry).

[109] *See Chrome Hearts LLC*, 2023 WL 5049198 at *16 (holding that jewelry designs must not be "commonplace" but rather "unique or unusual in the relevant market."); Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 258 (S.D.N.Y. 1996) (holding that a plaintiff who failed to present clear evidence why ancient jewelry designs were source indicators rather than ornamental choices failed to show the strength of her marks); Luvai, *supra* note 36, at 33 ("The mere fact that a product design is or was "one of a kind" "cool' "unique" and/or "innovative" does not necessarily provide a defensible basis for trade dress protection.").

[110] Oddi, *supra* note 86, at 956–57.

consumers.[111] When considering the similarity of the two designs, courts analyze designs in person or via photographs side by side to determine if the differences would be minor (favorable to plaintiff) or significant (favorable to defendant).[112] However, courts are cognizant of the fact that most shoppers will not notice minor differences, because most consumers do not compare designs side by side when they are purchasing jewelry.[113] Courts additionally weigh whether the plaintiff's design's features are unique to the plaintiff or "common in the trade and not identifiable with a particular source."[114]

[22] The third likelihood of confusion factor considers the proximity of the plaintiff's and defendant's jewelry designs based on the proximity of the functions, prices, and retail venues of the parties' jewelry. While close prices increase the possibility of confusion, a difference of multiples in price between a plaintiff and defendant's jewelry reduces the likelihood of consumer confusion.[115] Even jewelry sold at different retailers can be proximate.[116] The fourth likelihood of confusion factor, bridging the gap, considers the possibility that a plaintiff's and defendant's marks will enter the same market.[117] Bridging the gap is not a factor in jewelry design trade

[111] Audemars Piguet Holding S.A., 46 F. Supp. 3d at 279; Yurman Studio, Inc. v. Castaneda, 591 F. Supp. 2d 471, 499 (S.D.N.Y. 2008).

[112] *Chrome Hearts LLC*, 2023 WL 5049198 at *18.

[113] Cartier, Inc., v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 245 (S.D.N.Y. 2004).

[114] Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 258 (S.D.N.Y. 1996).

[115] Castaneda, 591 F. Supp. 2d at 500; Wolstenholme v. Hirst, 271 F. Supp. 3d 625, 644 (S.D.N.Y. 2017); Four Star Jewelry Creations, Inc., 348 F. Supp. 2d at 246.

[116] Cartier, Inc. v. Sardell Jewelry, Inc., 294 F. App'x 615, 619 (2d Cir. 2008).

[117] Four Star Jewelry Creations, Inc., 348 F. Supp. 2d at 246; Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 279–80 (S.D.N.Y. 2014).

dress infringement claims because jewelry is a single market with no gap to be bridged.[118]

[23] The fifth likelihood of confusion factor measures consumer sophistication. When consumer sophistication is high, consumers are presumed to be less likely to be confused by similarities between the plaintiff's and defendant's designs at the time of purchase, which is referred to in trademark law as point-of-sale confusion.[119] Consumer sophistication is higher when the products sold are expensive because consumers are more likely to research these purchases, and thus less likely to be confused at the point of sale.[120] Because jewels are non-essential and cost thousands of dollars, this factor is likely to be advantageous to a defendant arguing against point-of-sale confusion.[121] However, this advantage reverses in cases of post-sale confusion (confusion after the sale), because sophisticated

[118] Four Star Jewelry Creations, Inc., 348 F. Supp. 2d at 246; Audemars Piguet Holding S.A., 46 F. Supp. 3d at 280.

[119] Cartier, Inc., v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 246 (S.D.N.Y. 2004) (holding that "[c]onsumers of expensive goods" like Cartier jewelry and watches "may be held to a high standard of purchasing care", and thus the sophistication of the consumer "would presumably weight against a finding of a likelihood of confusion."). *But see id.* at 246 ("the general assumption that sophisticated consumers are less likely to be confused is not absolute.").

[120] *See* Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 244 (S.D.N.Y. 1996) ("Prospective purchasers of jewelry scrutinize pieces of high-end jewelry they are considering buying carefully.").

[121] *See* Audemars Piguet Holding S.A., 46 F. Supp. 3d at 281–82 (holding that there is a presumption of sophistication for consumers of expensive goods like jewelry against confusion); Judith Ripka Designs, Ltd., 935 F. Supp. at 243, 258 (holding that when jewelry costs thousands of dollars, the expensive price of the item lessens the likelihood of confusion).

buyers are more likely to choose the infringer's product to take advantage of the social value of the plaintiff's design.[122]

[24] The sixth likelihood of confusion factor considers whether the differences in quality between a plaintiff's and defendant's jewelry design make confusion likely to occur.[123] Plaintiff jewelers are often concerned customers will confuse the defendant's poor quality infringing designs for their own, thus damaging their brand's goodwill.[124] As technology develops, plaintiff jewelers may likewise fear high quality replacements will replace the plaintiffs' market share.[125] Defendants often object to the quality of their jewels being deemed worse than plaintiffs' jewels.[126] However, because the likelihood of confusion decreases as differences in quality increase, a difference in quality ultimately assists defendants in a likelihood of confusion analysis.[127]

[25] Plaintiffs must present sufficient evidence of a difference in the quality of the jewelry or watches for courts to consider this factor in a

[122] Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 281 (S.D.N.Y. 2014); Chrome Hearts LLC v. Controse Inc., No. 21-cv-6858 (LJL), 2023 WL 5049198 at *62 (S.D.N.Y. Aug. 8, 2023).

[123] Audemars Piguet Holding S.A., 46 F. Supp. 3d at 281.

[124] *Four Star Jewelry Creations, Inc.,* 348 F. Supp. 2d at 247; FRANCESCA CARTIER BRICKELL, THE CARTIERS, 527 (2019) (stating concern that Cartier New York's decision to sell gold-plated watches would risk "devaluing the Cartier name.").

[125] *But see* Beebe, *supra* note 42, at 809, 815, 833 (arguing that advances in laboratory diamond production threaten to "dilute the rarity and thus the distinctiveness" of natural diamonds, which "[t]he mined diamond industry is as concerned now [about] as the natural pearl industry was a century ago.").

[126] Cartier, Inc. v. Sardell Jewelry, Inc., 294 F. App'x 615, 620 (2d Cir. 2008).

[127] *Id.*

likelihood of confusion analysis.[128] In the fine jewelry industry, quality is primarily affected by the materials, especially metals, used to produce a jewel.[129] Confusion about metal composition itself is unlikely to occur, as federal law requires jewelers to use hallmarks, stamps in the metal indicating the composition of the material the jewel is made of.[130] Hallmarks inform customers whether a jewel is gold-plated (thinly coated gold over cheap base metal), gold vermeil (gold-plating over sterling silver), sterling silver (marked 925 for 92.5% silver), or a percentage in 'karats' of gold.[131] Gold vermeil is hallmarked as silver and thus is marked with 925.[132] In addition, many jewelers opt to stamp their jewelry with their own branded hallmark, further lowering potential consumer confusion.[133] Hallmarking

[128] *See* Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 281 (S.D.N.Y. 2014) (explaining that Plaintiff presented no quality evidence with respect to Defendant's product and factor of quality was found to be neutral); Cartier, Inc., v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 247 (S.D.N.Y. 2004).

[129] *See* Chrome Hearts LLC v. Controse Inc., No. 21-cv-6858 (LJL), 2023 WL 5049198 at *61 (S.D.N.Y. Aug. 8, 2023*)* (holding that the difference in quality between sterling silver jewelry and stainless-steel jewelry increased a finding of likelihood of confusion in a post-sale confusion analysis, which is the opposite result of a point-of-sale analysis).

[130] 15 U.S.C. § 297.

[131] RADEN, *supra* note 1, at 22.

[132] VICTORIA FINLAY, JEWELS: A SECRET HISTORY 406 n.18 (2006).

[133] *See* Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 259 (S.D.N.Y. 1996) (holding that because the defendant complied with federal hallmarking laws and used his brand hallmark, quality-based confusion was unlikely to occur); *David Yurman Bracelets: How to Tell Real From Faux*, THEREALREAL (Nov. 19, 2020), https://realstyle.therealreal.com/david-yurman-bracelets-jewelry-how-to-tell-real-thing [https://perma.cc/G8C3-FJ5U] (depicting David Yurman's brand hallmark); Chloe Wen, *Biggest Mejuri Haul Yet - SO Many New Arrivals & Mejuri Influencer Discount Code* (June 11, 2024) https://bychloewen.com/all-topics/mejuri-jewelry-new-arrivals-

has spread to the diamond industry, where concerns over so-called "lab diamonds" diluting the natural diamond market have led dealers to use laser marks to authenticate stones.[134]

[26] Actual confusion is a strong factor unlikely to ultimately affect a likelihood of confusion analysis due to parties' difficulties acquiring evidence via surveys or reported instances of confusion.[135] Survey evidence only requires at least 15% of surveyed parties misidentifying defendants' designs for plaintiffs' designs.[136] Because consumer surveys are often prohibitively expensive, most jewelers present no evidence of actual confusion or insufficient evidence of actual confusion, making this a factor unlikely to affect a finding of likelihood of confusion.[137]

influencer-discount-code-10-percent-off [https://perma.cc/PV4G-Z6ZR] (depicting Mejuri's brand hallmark).

[134] *But see* Beebe, *supra* note 42, at 830, 833.

[135] Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 280 (S.D.N.Y. 2014).

[136] *Id.*

[137] *See e.g.*, Cartier, Inc., v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 247 (S.D.N.Y. 2004) (no evidence presented); Chrome Hearts LLC v. Controse Inc., No. 21-cv-6858 (LJL), 2023 WL 5049198 at *14 (S.D.N.Y. Aug. 8, 2023) (no evidence presented); Judith Ripka Designs, 935 F. Supp. at 237 (1996) (holding that an affidavit of a single consumer refusing to purchase the plaintiff's jewelry because the defendant sold it for cheaper was insufficient evidence for a finding of likelihood of confusion). Courts did not explain the importance of actual confusion in the Section 43(a) jewelry design cases examined in this Article, even when the plaintiff attempted to present evidence of actual confusion in Ripka. *Id.*

[27] The final likelihood of confusion factor considers the defendant's good or bad faith.[138] Plaintiffs do not always present evidence of good or bad faith, and an absence of evidence will not necessarily prevent a finding of a likelihood of confusion.[139] Examples of bad faith include recorded admissions of a defendant copying or seeing the plaintiff's designs, the defendant branding its product with the plaintiff's marks, or a substantial length of time between the plaintiff's and defendant's product launches allowing the defendant time to copy the plaintiff's product jewelry design.[140] A plaintiff's tendency to instigate repeated trade dress litigation actions does not constitute bad faith.[141]

[138] Audemars Piguet Holding S.A., 46 F. Supp. 3d at 280; *Chrome Hearts LLC*, 2023 WL 5049198 at *19.

[139] *See Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 248–49 (holding that likelihood of confusion could be established absent evidence of bad faith). *But see* Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 259 (S.D.N.Y. 1996) (holding that likelihood of confusion was unable to be established absent evidence of good faith).

[140] *See e.g.*, *Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 248 (holding that a plaintiff hiring a private detective to record confessions of copying was acceptable evidence); Cosmos Jewelry Ltd. v. Po Sun Hon Co., 470 F. Supp. 2d 1072, 1078 (C.D. Cal. 2006) (arguing that defendant admitted to seeing the plaintiff's plumeria jewelry designs in marketing materials before developing defendant's own jewelry design was bad faith); Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 280 (S.D.N.Y. 2014) (holding that twenty year gap between plaintiff's launch and defendant's launch was sufficient to show bad faith).

[141] Yurman Design, Inc. v. Golden Treasure Imps., Inc., 275 F. Supp. 2d 506, 518 (S.D.N.Y. 2003).

C. The Status of Modern Trade Dress Law Under The Lanham Act

[28] Unlike copyright and patent law, which are protected under the Intellectual Property Clause of the Constitution,[142] American trademark law comes from the Commerce Clause, as trademarks are ultimately source identifiers of businesses.[143] That being said, trademarks are not all work and no play—trade dress, which includes designs, is a valuable tool to assert rights to artistic designs.[144] This is particularly true for jewelers, due to the ease of achieving source association for mass-produced jewelry designs compared to other creative disciplines and the perpetuity advantage that exists in trademark law versus copyright and patent law.[145]

[29] In the United States, trademark law has both common law origins in unfair competition tort law, as well as statutory law origins in the Lanham Act, which expanded protections to unregistered trademarks in 1988 with the addition of Section 43(a).[146] Section 43(a) broadened and clarified

[142] U.S. CONST. art. I, § 8, cl. 3.

[143] *See generally* U.S. CONST. art. I, § 8, cl. 8. (authorizing Congress to grant exclusive rights to authors and inventors to promote the sciences and useful arts).

[144] *See* Marshall, *supra* note 32, at 126 (arguing that trademark law is the most "notable form of protection offered to fashion design").

[145] *See* Marshall, *supra* note 32, at 126. Trademark's perpetuity advantage allows trademarks to hold a monopoly over an area of intellectual property in perpetuity so long as the trademark remains valid; *see generally* Luvai, *supra* note 36, at 32 (noting that the exclusivity of trade dress protection was potentially broad and perpetual in consideration of the federal policy for competitive markets).

[146] *See generally* Lanham Act, 15 U.S.C. § 1125(a) (stating the legal framework for trademark protection); Jeff Resnick, *Trade Dress Law: The Conflicts Between Prod. Design and Prod. Packaging*, 24 WHITTIER L. REV. 253, 257, 259 (2002) (referencing Sanforth's Case, one of the earliest examples of trademark infringement involving alleged copying of fabric markings).

trademark protection to include the "shape, design or configuration of a tangible product[,]"[147] providing a legal framework for the protection of product design.[148] Before the 1988 modification of the Lanham Act and the Court's clarifications of the necessary tests for a prima facie trade dress claim and trade dress infringement claim in *Two Pesos* and *Samara Brothers*, federal courts struggled to determine which tests were necessary to apply in jewelry design trade dress claims, and how the different extant tests connected to one another.[149]

[30] The lack of clarity in the Lanham Act led to circuit splits and frequent denials of trade dress claims for jewelry designs under "a broad assessment considering aesthetic functionality and mere ornamentation."[150] The Ninth Circuit conducted a functionality analysis, arguing that registered designs could be aesthetically functional and thus unable to function as a trademark.[151] The Fifth Circuit ignored a functionality analysis altogether,

---

[147] Luvai, *supra* note 36, at 32.

[148] *See generally* Luvai, *supra* note 36, at 32 (arguing that the adoption of the new trade dress law in the 1980s expanded trademark law).

[149] *See* Anthony L. Fletcher, *The Defense of "Functional" Trademark Use: If What is Functional Cannot be a Trademark, How can a Trademark be Functional?*, 75 TRADEMARK REP. 249, 258 (1985) (asserting that trade dress functionality analysis in the 1980s was "unnecessary and unsound" because the analysis "appears to recognize some connection between likelihood of confusion and functionality without explaining what that apparently inverse relationship may be").

[150] *See* Oddi, *supra* note 86, at 955 (arguing that aesthetic functionality has historically been a major barrier "to deny trademark protection to jewelry and related products").

[151] Oddi, *supra* note 86, at 956 (citing Int'l Ord. of Job's Daughters v. Lindeburg & Co., 633 F.2d 912, 918 (9th Cir. 1980)).

only assessing claims under a likelihood of confusion analysis.[152] Courts in the Second Circuit dismissed jewelry designers' claims when the jewelry designs were primarily decorative rather than source-identifying, rather than testing both distinctiveness and functionality to determine if there was a valid unregistered trade dress infringement claim under the Lanham Act.[153] Ultimately, in the pre-*Two Pesos* legal landscape, "if the jewelry [was] bought only because of its attractive appearance, registration would be denied."[154]

[31] *Two Pesos* and *Samara Brothers* marked a transition in how courts interpreted Section 43(a) of the Lanham Act, clarifying that Section 43(a) protects unregistered trade dress so long as the party asserting the mark can establish that the mark is distinctive, non-functional, and that competing use is likely to cause confusion in the minds of the relevant consumers.[155] The Court rooted its decision in *Samara Brothers* in trademark law's common law unfair competition origins, determining that all three tests were necessary "to discourage product design trade dress litigation as part of an apparent conscious effort to restore a healthy competitive balance between established market players and new entrants."[156]

D. The Facts of David Yurman v. Mejuri

[32] A useful lens for analyzing the application of unregistered trade dress law in jewelry design cases is the facts raised by the parties in *David Yurman v. Mejuri*. David Yurman is a globally renowned jewelry designer

[152] Oddi, *supra* note 86, at 956–957 (citing Supreme Assembly, Ord. of Rainbow for Girls v. J. H. Ray Jewelry Co., 676 F.2d 1079, 1082 (5th Cir. 1982)).

[153] Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 257 (S.D.N.Y. 1996).

[154] Oddi, *supra* note 86, at 955.

[155] Resnick, *supra* note 146, at 267.

[156] Luvai, *supra* note 36, at 33.

with a noted history of asserting trade dress rights via litigation.[157] Mejuri is a direct-to-consumer jewelry brand popular with Millennial and Gen Z women.[158] In December 2021, David Yurman filed a Complaint against Mejuri for alleged infringement of its asserted trade dress under Section 43(a) of the Lanham Act.[159] The trade dress asserted by Yurman consisted of two lines of jewelry designs—a puffed, twisted rope design known as the Pure Form line and a smooth, rounded design, both of which were executed in rings, bracelets, and earrings.[160]

[33] At the core of David Yurman's Complaint was an assertion that Mejuri's Croissant line of twisted-rope inspired jewelry infringed Yurman's Pure Form line of jewelry.[161] David Yurman is famous for the brand's twisted cable designs inspired by ancient jewelry and the cables on the Brooklyn Bridge.[162] While Yurman's "core" design has federal trademark registration, Yurman's Pure Form line does not, and thus is subject to

[157] *Yurman Design, Inc.*, 275 F. Supp. 2d at 518 (accusing that Yurman acted in bad faith for "raising allegedly frivolous and unfounded trade dress infringement claims in this and other lawsuits.").

[158] Complaint, *supra* note 12, at 42.

[159] *Id.*

[160] *Id.* at 8, 11, 13–15.

[161] *Id.* at 6.

[162] Sophie Dweck, *T&C Tried & True: Why the David Yurman Cable Flex Bracelet Belongs on Every Woman's Wrist*, TOWN & COUNTRY (Apr. 28, 2025), https://www.townandcountrymag.com/style/jewelry-and-watches/a61142964/david-yurman-cable-flex-bracelet-review/ [https://perma.cc/PR4E-2AD2]; ARTISTS AND JEWELLERS—SYBIL AND DAVID YURMAN, *If Jewels Could Talk with Carol Woolton*, at 40:10 (Dec. 12, 2024) (available on Apple Podcasts).

Section 43(a) of the Lanham Act.[163] Mejuri responded, characterizing Yurman's suit as a "baseless attack"[164] by a larger jeweler against a newer player in the industry and an attempt to monopolize a jewelry design that has been in use for thousands of years via trademark law.[165]

[34] Mejuri and David Yurman settled before the court could determine the merits of the facts of the trade dress dispute.[166] Immediately after the settlement, Mejuri continued selling the Croissant line of jewelry; as of January 2024, Mejuri no longer stocks its Croissant design at the core of Yurman's Complaint—a typical result in jewelry trade dress cases, where alleged infringers often have "sell-down" periods to sell off the last of their stock.[167] Despite this, other retailers sell identical twisted-rope designs with the "Croissant" name, and Mejuri launched a similar twisted-rope jewelry line under the similarly yeasty name "Brioche."[168] Given these

[163] *See* Azema, *supra* note 11 ("David Yurman owns trade dress registrations for its 'twisted-cable' bracelet designs").

[164] Lenore Fedow, *David Yurman Sues Mejuri Over Alleged IP Theft*, NAT'L JEWELER (Dec. 20, 2021), https://nationaljeweler.com/articles/10465-david-yurman-sues-mejuri-over-alleged-ip-theft [https://perma.cc/EEC2-EY4Z].

[165] *See* Answer, *supra* note 13, at 2 (asserting that David Yurman's Complaint "is an improper attempt to suppress an innovative competitor and to claim ownership of well-known, common motifs—like twist designs—that have been used in jewelry since at least the Roman Empire."); Tiffany Hu, *Mejuri Says Jewelry Copying Case Shows Yurman Is a 'Bully'*, LAW360 (Mar. 7, 2022, at 21:50 ET), https://www.law360.com/articles/1471377 [https://perma.cc/4VB4-JK9B].

[166] *Order*, David Yurman Enters. LLC v. Mejuri, Inc., No. 1:21-cv-10821 (RA) (S.D.N.Y. Apr. 11, 2023).

[167] Fedow, *supra* note 13, at 2–3.

[168] *Croissant Ring*, *supra* note 14; *Croissant Hoops*, *supra* note 14; *Brioche Hoops*, *supra* note 15.

developments and the historic nature of both Yurman's litigation and the use of twisted-rope designs in the jewelry industry, litigation over similar facts is likely to occur in the future.

III. ANALYSIS

[35] Under Part III.A. this Article will explore the merits of *David Yurman v. Mejuri*.[169] Under Part III.B. this Article will move beyond the facts of *David Yurman v. Mejuri* to assess which jewelry design elements are currently protectable and which elements are more vulnerable to litigation under modern trade dress case law.[170]

A. Application of Trade Dress Case Law to *David Yurman v. Mejuri*

[36] Section III.A.i. argues that David Yurman would ultimately have been able to show that David Yurman's Pure Form line of jewelry obtained distinctiveness through secondary meaning.[171] Section III.A.ii. weighs the functionality doctrine, determining that the aesthetic functionality of the twisted cable motif disadvantages other competitors, favoring Mejuri.[172] Section III.A.iii. states that even if David Yurman were able to assert a prima facie case of trade dress, Yurman would have been unlikely to establish a likelihood of confusion with Mejuri's Croissant jewelry designs.[173]

[169] *See infra* Part III.A.

[170] *See infra* Part III.B.

[171] *See infra* Section III.A.i.

[172] *See infra* Section III.A.ii.

[173] *See infra* Section III.A.iii.

i. David Yurman's Pure Form Line has a Slight Ability to Show Distinctiveness

[37] For Yurman to succeed in a trade dress infringement claim against Mejuri, Quince, or any other potential alleged infringers of Yurman's twisted rope designs, Yurman would have to establish that its designs are distinctive via secondary meaning.[174] This is not a bright line test, but involves balancing several factors, the most common of which are Yurman's advertising expenditures for its Pure Form line of jewelry, the existence and results of consumer studies, unsolicited media coverage of the Pure Form jewelry, sales success of the Pure Form jewelry, evidence of plagiarism by Mejuri of Yurman's jewelry designs, and Yurman's length and exclusivity of use of the Pure Form line of jewelry.[175]

[38] David Yurman's extensive advertising expenditures would likely support a finding that Yurman's Pure Form line of jewelry obtained distinctiveness through secondary meaning. In analyzing this factor, courts primarily look at the total amount of money spent on marketing that specific line of jewelry, with the avenues of advertising spend providing ancillary evidence of secondary meaning.[176] Federal courts have found that $881,787 spent over a two-year period and $500,000 in annual marketing spending on single jewelry design lines were sufficient marketing expenditures to support secondary meaning.[177] As David Yurman spent over $5 million on

[174] Lanham Act, 15 U.S.C. § 1127; Wal-Mart Stores v. Samara Bros., 529 U.S. 205, 215 (2000).

[175] *See* Michelman & Sherman, *supra* note 43, at 16.

[176] *See* Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 277 (S.D.N.Y. 2014); Cartier, Inc., v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 241 (S.D.N.Y. 2004); Yurman Design, Inc. v. Golden Treasure Imports, Inc., 275 F. Supp. 2d 506, 513 (S.D.N.Y. 2003).

[177] *Four Star Jewelry Creations, Inc.*, 348 F.Supp.2d at 226–27, 241–42; *Audemars Piguet Holdings S.A.*, 46 F. Supp. 3d at 271.

the Pure Form line since 2016, and $1.5 million on the launch alone, the amount spent on advertising is likely sufficient to support a finding of secondary meaning.[178] In addition, David Yurman advertises in "nationally recognized magazines and newspapers such as… The New York Times," on billboards, in stores, and makes appearances at trade shows.[179] While trade show appearances are less likely to aid a finding of secondary meaning through advertising efforts, courts look favorably on jewelers who advertise in major outlets like The New York Times.[180] Thus, this evidence is likely to support a finding of secondary meaning through advertising.

[39] David Yurman's failure to include consumer studies in its Complaint would at best be a neutral factor in its case and at worst favor Mejuri in a secondary meaning analysis.[181] Surveys measuring prospective consumers' ability to recognize that a jewelry design originates from a single source provide strong evidence of trade dress having developed secondary meaning.[182] David Yurman's lack of consumer studies is not unusual, given the costs of producing surveys; however, courts have held plaintiffs' failure to present consumer surveys as a factor against plaintiffs,

[178] Complaint, *supra* note 12, at 9–10.

[179] Complaint, *supra* note 12, at 7.

[180] Cosmos Jewelry Ltd. v. Po Sun Hon Co., 470 F. Supp. 2d 1072, 1086 (C.D. Cal. 2006); *Audemars Piguet Holdings S.A.*, 46 F. Supp. 3d at 272; Diamond Direct, LLC. v. Star Diamond Grp., Inc., 116 F. Supp. 2d 525, 532 (S.D.N.Y 2000).

[181] Complaint, *supra* note 12, at 33, 39.

[182] *Audemars Piguet Holding S.A.*, 46 F. Supp. 3d at 273; *Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 242.

and thus this factor may weigh marginally against a finding of secondary meaning.[183]

[40] Substantial unsolicited media coverage of David Yurman's jewelry is likely to favor a finding of secondary meaning. In David Yurman's Complaint, David Yurman asserted far more unsolicited media coverage than a single, industry-specific magazine, citing that its jewelry designs have been worn on the cover of Vogue and by former First Ladies, with national magazines calling Yurman's Cable design "instantly recognizable" and "unique."[184] Mejuri did not refute Yurman's assertions, nor recognize that Yurman's assertions focused on a separate registered line of jewelry, instead mentioning its own media profiles in high-profile publications like Vogue and Forbes.[185] While unsolicited media coverage about a jewelry brand itself can contribute to the secondary meaning analysis of that brand's designs, it is unlikely the same would be true for praise for separate trademarks owned by the same brand.[186]

[41] The fourth secondary meaning factor, sales success, is likely to favor Yurman based on the jeweler's large volume of sales and profits. *Four Star* found that eight to nine-figure sales are sufficient to show secondary meaning via profit, whereas in *Berg*, a million dollars in sales was insufficient to support a finding of secondary meaning via sales success.[187]

---

[183] *See* Cartier, Inc. v. Sardell Jewelry, Inc., 294 F. App'x 615, 618 (2d Cir. 2008); Berg v. Symons, 393 F. Supp. 2d 535, 553 (S.D. Tex. 2005); *Diamond Direct, LLC*, 116 F. Supp. 2d at 531.

[184] Complaint, *supra* note 12, at 1, 6–7.

[185] Answer, *supra* note 13, at 8.

[186] Complaint, *supra* note 12, at 1, 6–7.

[187] *Berg*, 393 F. Supp. 2d at 554 (holding that 100 units and $1.3 million were insufficient for secondary meaning); *Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 227 (holding 14,225 units and $102 million was sufficient for a finding of secondary meaning).

Yurman's profits of $35 million for the Pure Form line and $200 million for the Sculpted Cable collection are more in line with the findings of *Four Star*.[188] Mejuri's own sales success is irrelevant, as the analysis only considers the plaintiff's sales.[189] However, in addition to profits, the sales success factor also measures volume of sales, and courts have found narrow ranges to be acceptable, as 9,350 units were insufficient in one case while 14,225 units were sufficient in another.[190] While Yurman did not individually list units sold in its Complaint, with profits of $35 million and $200 million respectively and retail prices between $800 and $6,500, David Yurman could have sold 5,384 units in eighteen karat gold or 43,750 units in sterling silver.[191] Thus, Yurman's sales are likely sufficient to support a finding of secondary meaning via sales success.

[42] Neither party presented facts for or against a finding of the fifth factor, plagiarism. Because direct evidence of plagiarism is difficult to obtain, the absence of plagiarism evidence would neither help nor harm a claim of distinctiveness.[192] However, under the sixth factor, David Yurman is unlikely to establish secondary meaning via the length and exclusivity of use of its Pure Form line of twisted rope-inspired jewelry. The length of use is a litmus test for courts to determine when jewelry consumers develop

---

[188] Complaint, *supra* note 12, at 10; *Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 227 (S.D.N.Y. 2004).

[189] *See* Answer, supra note 13, at 7.

[190] Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 270, 277 (S.D.N.Y. 2014); *Four Star Jewelry Creations, Inc*., 348 F. Supp. 2d at 227, 232.

[191] *See* Complaint, *supra* note 12, at 10; *see generally* Complaint *supra* note 12; Answer, *supra* note 13, at 44.

[192] Complaint, *supra* note 12; Answer, *supra* note 13; *see* Berg v. Symons, 393 F. Supp. 2d 525, 554 (S.D. Tex. 2005); *Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 243; Cartier, Inc. v. Sardell Jewelry, Inc., 294 F. App'x 615, 618 (2d Cir. 2008).

secondary meaning, with eight years on the market being the shortest accepted length of time for secondary meaning.[193] While David Yurman began designing cable jewelry in 1980, Mejuri's Croissant design launched in 2016, below the known eight-year threshold for length of use as of Yurman's 2021 Complaint.[194] Thus, it is unclear whether the length of time that Yurman's asserted trade dress had been available on the market would be sufficient to support a finding of secondary meaning.

[43] David Yurman's lack of exclusive use of the twisted-rope motif in its claimed trade dress is unlikely to support a finding of secondary meaning.[195] Unlike Yurman's registered trade dress jewelry designs that combine elements such as twisted cables, end caps, and cabochons, the Pure Form and Sculpted Cable designs are minimalist designs where the twist is the main characteristic of the design.[196] When the key element of a jewelry design is common in the jewelry industry, such as the twist in the Pure Form and Sculpted Cable designs, the trade dress cannot establish secondary meaning via exclusivity of use because the key motif is generic, and generic elements cannot serve as an indicator of source.[197]

---

[193] *Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 243–44.

[194] Complaint, *supra* note 12, at 6, 9; *Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 244.

[195] *See* Lanham Act, 15 U.S.C. § 1127.

[196] Complaint, *supra* note 12, at 1, 6 (asserting that David Yurman's brand is best known for its helix cable); Answer, *supra* note 13, at 18; *see* R.F.M.A.S., Inc. v. Mimi So, 619 F. Supp. 2d 39, 77, 83 (S.D.N.Y. 2009); Yurman Design, Inc. v. PAJ, Inc., 262 F.3d 101, 107, 118 (2d Cir. 2001).

[197] *See Berg*, 393 F. Supp. 2d at 553; R.F.M.A.S., Inc., 619 F. Supp. 2d 39, 77, 83; *PAJ, Inc*., 262 F.3d at 101, 107, 118; Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 242, 244 (S.D.N.Y. 1996).

[44] Mejuri presented photographic images of twisted cable jewelry that resembled both David Yurman's Pure Form and Sculpted Cable and Mejuri's Croissant jewelry from other jewelers, countries, and centuries.[198] These compilations provided concrete evidence that the twisted-rope motif is a common design that has been "used extensively in jewelry designs for millennia," including the "Roman Empire."[199] While David Yurman's attorneys dismissed this argument as a "weak attempt to excuse [Mejuri's] conduct by citing the Roman Empire,"[200] Mr. Yurman himself stated that the Metropolitan Museum of Art's collection of ancient jewelry inspired his twisted cable designs.[201] Elements of trade dress do not need to be historic to be generic, nor is novelty a requirement for trademark protection.[202] However, older, foundational techniques are more likely to be common motifs in jewelry designs by other craftsmen.[203]

---

[198] *See* Answer, *supra* note 13, at 16, 18–21, 25, 34 (featuring images of twisted jewelry from Native American silversmiths, Kay Jewelers, Tiffany and Co, Cartier, and the collection of the British Museum).

[199] *See* Answer, *supra* note 13, at 22–24 (citing *7000 Years of Jewelry* 50, 56, 93, 139 (Hugh Tait ed., 2008), including images of torc-style jewelry from between 1200 B.C. and the thirteenth century A.D. found in England, Iran, Egypt, and Spain). *Id*.

[200] *See* Hu, *supra* note 165.

[201] *See* ARTISTS AND JEWELLERS—SYBIL AND DAVID YURMAN*, If Jewels Could Talk with Carol Woolton*, at 41:37 (Dec. 12, 2024) (available on Apple Podcasts).

[202] *See David Yurman, Mejury Settle "Copying" Suit, Shed Light on ESG Marketing Risk,* FASHION L. (Apr. 12, 2023) https://www.thefashionlaw.com/david-yurman-mejuri-settle-copying-suit-shed-light-on-esg-marketing-risk [https://perma.cc/KV45-EB97] ("[w]hile elements of Yurman's designs are not earth-shatteringly novel. . . . [u]nlike the novelty/originality pre-requisites to design patent and copyright protection, trade dress law does not have an equivalent requirement, and instead, rights are awarded based largely on whether consumers associate the combination of non-functional elements at issue with a single source.").

[203] *See* Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 257 (S.D.N.Y. 1996).

[45] David Yurman would likely be able to establish distinctiveness via secondary meaning by a narrow margin. David Yurman's Pure Form and Cable Classic lines would struggle in asserting distinctiveness, as the twisted rope motif that is a claimed element in its asserted trade dress is a generic element common in the jewelry industry that Yurman does not exclusively use.[204] Yurman's failure to present evidence of plagiarism or consumer surveys would serve as neutral or mildly harmful evidence.[205]

ii. A Functionality Analysis Likely Favors Mejuri

[46] A distinctive jewelry design, such as David Yurman's twisted-rope design in *Yurman v. Mejuri*, can only assert claims against a potential infringer of its trade dress if the jewelry design is non-functional. Under a functionality analysis, there are two prongs that courts would need to consider Yurman's designs under—utilitarian functionality and aesthetic functionality.[206]

[47] David Yurman's twisted rope designs are not functional under the utilitarian prong of the functionality analysis because they were "neither essential to the use or purpose of the jewelry, nor do they affect the cost or quality of the jewelry."[207] David Yurman patented (both utility and design)

---

[204] *See* Berg v. Symons, 393 F. Supp. 2d 525, 553 (S.D. Tex. 2005)

[205] *See* Complaint*, supra* note 12; Answer, supra note 13; see Berg v. Symons, 393 F. Supp. 2d 525, 554 (S.D. Tex. 2005); Four Star Jewelry Creations, Inc., 348 F. Supp. 2d at 243; Cartier, Inc. v. Sardell Jewelry, Inc., 294 F. App'x 615, 618 (2d Cir. 2008).

[206] Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 282 (S.D.N.Y. 2014).

[207] Complaint, *supra* note 12, at 11, 13–14; Neiman Marcus Grp., Inc. v. A'Lor Int'l, Ltd., 22 Fed. Appx. 60, 62 (2d Cir. 2001).

and advertised other cable-inspired jewels for their lightweight, strong nature, creating a presumption of functionality.[208] However, this presumption does not apply when a functional jewelry feature is used in a non-functional way.[209] Because the Pure Form and Sculpted Cable jewels are not made of the functional "helix" cable but of cast metal, the Yurman designs have no utilitarian functionality.[210]

[48] Yurman claimed that the Pure Form line was aesthetically non-functional because there were "near-countless" alternative designs for other jewelers to produce.[211] As Yurman argued, when elements of a jewelry design are not common to the genre but are arbitrarily chosen among an array of alternative designs, the trade dress is less likely to be aesthetically functional.[212] However, Yurman's use of industry standard techniques and ancient-inspired motifs is likely to be aesthetically functional and thus harms competitive interests.[213]

---

[208] *See generally* Yurman Design, Inc. v. Golden Treasure Imps., Inc., 275 F. Supp. 2d 506, 512 (S.D.N.Y. 2003); If Jewels Could Talk with Carol Woolton, *Articles and Jewellers - Sybil and David Yurman*, at 41:05 (Dec. 12, 2024) (downloaded using Apple Podcasts) (quoting Mr. Yurman's statement that David Yurman has developed 120 different kinds of flexible, thin cable that is 50% harder than other jeweler's cable).

[209] Neiman Marcus Grp., Inc. v. A'Lor Int'l, Ltd., 22 Fed. Appx. 60, 62 (2d Cir. 2001).

[210] *See* Complaint, *supra* note 12, at 8.

[211] Complaint, *supra* note 12, at 16.

[212] Cartier, Inc. v. Sardell Jewelry, Inc., 294 Fed. Appx. 615, 621 (2d Cir. 2008); Complaint, *supra* note 12, at 12, 14, 16 (stating that the asserted trade dress "reflect a series of artistic, arbitrary design choices that create a distinctive and unique commercial impression.").

[213] *See* Oddi, *supra* note 86, at 938 (1985) ("The sole balance against the right to copy is not the likelihood of confusion. Of equal and independent importance is the doctrine of "functionality," which is designed to avoid serious anti-competitive inroads into the right to copy.").

[49] When rights-holders claim standard techniques or common design elements in a subgenre of jewelry as elements of a trade dress, the resulting design is more likely to be aesthetically functional.[214] This is because exclusive use of these elements in perpetuity would harm competition.[215] Unlike a jeweler's personal interpretation of a real plumeria flower,[216] Yurman's asserted designs centered on a single element—a puffed, twisted-rope motif, which is a standard design in the jewelry trade akin to common diamond cuts.[217] Mejuri presented evidence of the common industry usage of this motif in its Answer using images of other twisted-rope rings, earrings, and bracelets at other retailers and in museum collections.[218] Thus, exclusive protection of Yurman's design would likely harm competitive interests under the aesthetic functionality doctrine.

---

[214] *See* Berg v. Symons, 393 F. Supp. 2d 525, 556 (S.D. Tex. 2005); Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 256–259 (S.D.N.Y. 1996); DBC of New York, Inc. v. Merit Diamond Corp., 768 F. Supp. 414, 415, 418 (S.D.N.Y. 1991); Cartier, Inc., v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 224–25 (S.D.N.Y. 2004). *But see* Cosmos Jewelry Ltd. v. Po Sun Hon Co., 470 F. Supp. 2d 1072, 1085 (C.D. Cal. 2006).

[215] *See Berg*, 393 F. Supp. 2d at 556; *Judith Ripka Designs, Ltd*., 935 F. Supp. at 256–259; *Merit Diamond Corp.*, 768 F. Supp. at 415, 418; *Four Star Jewelry Creations, Inc*., 348 F. Supp. 2d at 224–25; *see also* Answer, *supra* note 13, at 40–41. But see Cosmos Jewelry Ltd. v. Po Sun Hon Co., 470 F. Supp. 2d 1072, 1085 (C.D. Cal. 2006).

[216] *See* Berg, 393 F. Supp. 2d at 556; Judith Ripka Designs, Ltd., 935 F. Supp. at 256–259; Merit Diamond Corp., 768 F. Supp. at 415, 418; Four Star Jewelry Creations, Inc., 348 F. Supp. 2d at 224–25; *see also* Answer, supra note 13, at 40–41. *But see* Cosmos Jewelry Ltd. v. Po Sun Hon Co., 470 F. Supp. 2d 1072, 1085 (C.D. Cal. 2006).

[217] *See* Complaint, *supra* note 12, at 7–9.

[218] Answer, *supra* note 13, at 16, 18–21, 25, 34.

iii. Likelihood of Confusion Likely Favors Mejuri

[50] The first likelihood of confusion factor, the strength of the trade dress, is likely to favor Mejuri. This factor favors plaintiffs when there is evidence that the trade dress jewelry design comes from a single source via survey results, advertising evidence, press statements, or revenue.[219] However, jewelry designs are unlikely to be strong indicators of source when their elements are purely ornamental or commonplace in the jewelry industry.[220] While Yurman presented evidence of significant advertising expenditures and revenue comparable to the millions of dollars spent by Cartier in Four Star, this alone would not support a finding of a strong trade dress.[221] Like the plaintiff in *Ripka v. Preville*, whose ancient-inspired jewelry was ornamental rather than a source identifier, Yurman would be unlikely to show the strength of its trade dress, because Yurman's ancient twisted rope designs are similar to those sold by competitors and displayed in museums.[222]

[51] David Yurman would be unlikely to succeed under the second factor, similarity of the marks. Under a similarity of the marks analysis, courts compare jewelry designs solely based on the appearance of the jewels via photographs or samples to determine how similar, and thus likely to

[219] *See* Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 271–278 (2014).

[220] Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 258 (S.D.N.Y. 1996).

[221] *See* Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 245 (2004); *see also* Chrome Hearts LLC v. Controse Inc., No. 21-cv-6858 (LJL), 2023 WL 5049198 at *16–17 (S.D.N.Y. Aug. 8, 2023).

[222] *Judith Ripka Designs, Ltd*., 935 F. Supp. at 258; Answer, *supra* note 13, at 18, 20–22, 25, 33–34.

confuse consumers, the two jewels are.[223] Courts have noted minor differences distinguishing jewelry designs, though these distinctions will not overcome a finding of similar marks alone because courts are aware that customers are not comparing images of products while shopping.[224] Significant differences, such as entirely different chains for pendants, are necessary for courts to consider two adjacent designs dissimilar, and the differences between David Yurman's trade dress and Mejuri's trade dress are unlikely to rise to this level of difference.[225] Yurman and Mejuri's designs are characterized by twisted-rope motifs, with the sole notable differences being the tapered, open design of Mejuri's Croissant Cuff Bracelet versus the uniformly wide and closed design of David Yurman's Pure Form Bracelet.[226] Yet, while the majority of the designs in *Mejuri* are similar, they are also elements common to the jewelry industry, which cannot be used to find a similarity between the plaintiff's and defendant's marks. [227] Thus, Yurman would be unable to succeed on a likelihood of confusion factor due to the similarity of the jewelry designs.

---

[223] Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 279 (S.D.N.Y. 2014); Yurman Studio, Inc. v. Castaneda, 591 F. Supp. 2d 471, 499 (S.D.N.Y. 2008).

[224] *See* Cosmos Jewelry Ltd. v. Po Sun Hon Co., 470 F. Supp. 2d 1072, 1078–79 (C.D. Cal. 2006) (holding that images of two plumeria flower pendants showed differences, such as the petals on two plumeria pendants having slightly concave versus convex petals; however, this factor was not ultimately used in the final likelihood of confusion analysis).

[225] *See, e.g.*, Chrome Hearts LLC v. Controse Inc., No. 21-cv-6858, 2023 WL 5049198, at *18 (S.D.N.Y. Aug. 8, 2023).

[226] Answer, *supra* note 13, at 42; Complaint, *supra* note 12 at 23, 27.

[227] *See* Answer, *supra* note 13, at 42; Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 258 (S.D.N.Y. 1996) (holding that when the similarities are common elements like "beading, fluting, rope twists, green gold, semi-precious and precious stones, mystery clasps, and toggle bar and ring closures" there is no similarity of the marks).

[52] David Yurman would be marginally favored by the third likelihood of confusion factor. This factor measures the proximity of the venues, functions, and prices of the parties' jewelry.[228] Federal courts consider jewelry sold to the same consumer market, including through separate stores and direct-to-consumer websites, proximate as all jewelry serves the same purpose for consumers: adornment.[229] David Yurman's jewelry pieces are primarily sold directly to consumers or via luxury third-party retail outlets like Saks Fifth Avenue, Nordstrom, or Neiman Marcus.[230] Mejuri primarily sells via its own direct-to-consumer website and retail stores.[231] However, because both Mejuri and David Yurman target the same core consumer market—women interested in sterling silver jewelry—the similar functions of their products render their venues proximate.[232]

[53] Proximity also measures the prices of products, as jewelry that does not intersect in price point is less proximate.[233] The differences in price

[228] Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 224–25, 231 (S.D.N.Y. 2004); Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 280 (S.D.N.Y. 2014).

[229] *Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 224–25, 231; *Audemars Piguet Holding S.A.*, 46 F. Supp. 3d at 280.

[230] Complaint, *supra* note 12, at 17.

[231] Complaint, *supra* note 12, at 20; Answer, *supra* note 13, at 45.

[232] Complaint, *supra* note 12, at 51–52. *But see* Answer, *supra* note 13, at 45, 50 (arguing that Mejuri and Yurman have separate markets because Mejuri caters to a modern, younger generation of self-purchasing jewelry customers while Yurman's customers are older men purchasing for their female partners).

[233] Yurman Studio, Inc. v. Castaneda, 591 F. Supp. 2d 471, 500 (S.D.N.Y. 2008); Wolstenholme v. Hirst, 271 F. Supp. 3d 625, 644 (S.D.N.Y. 2017); *Four Star Jewelry Creations Inc.*, 348 F. Supp. 2d at 246.

between Mejuri and Yurman's disputed jewelry lines range from $65 and $300 at the low end to $150 and $6,500 at the high end.[234] Thus, while the venues and function of the jewelry are likely to favor a finding of close proximity in favor of David Yurman, the large price gaps between Mejuri and David Yurman's jewelry pieces may dampen the effect of this factor, if not neutralize it altogether. Likewise, the fourth likelihood of confusion factor, bridging the gap, would favor David Yurman, as there is no gap to be bridged when both parties are fine jewelers.[235]

[54] The fifth likelihood of confusion factor, which looks at the level of sophistication of a product's average consumer, weighs heavily in favor of jewelry design defendants like Mejuri.[236] Both David Yurman and Mejuri describe their core customer bases as women who research and purchase their own jewelry.[237] In point-of-sale infringement analyses, the likelihood of confusion is lower when consumer sophistication is higher.[238] Because David Yurman and Mejuri sell jewelry that costs hundreds of dollars, both

[234] Answer, *supra* note 13, at 44; Complaint, *supra* note 12, at 51–52.

[235] *Four Star Jewelry*, 348 F. Supp. 2d at 224, 231, 246; Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 279–280 (S.D.N.Y. 2014).

[236] Polaroid Corp. v. Polarad Elecs. Corp., 297 F.2d 492, 295 (2d Cir. 1961).

[237] *See* Complaint, *supra* note 12, at 1–2 (stating that David Yurman's customers are "women who would purchase jewelry for themselves instead of traditionally receiving it as a gift."); Answer, *supra* note 13, at 45 (stating that Mejuri's consumers are "intentional about the design of their jewelry purchases and deliberative in which companies they choose to buy from").

[238] *See Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 246 (holding that "[c]onsumers of expensive goods" like Cartier jewelry and watches "may be held to a high standard of purchasing care", and thus the sophistication of the consumer "would presumably weight against a finding of a likelihood of confusion.").

brands' clients would be expected to conduct research before purchasing jewelry and thus be sophisticated customers.[239]

[55] The sixth likelihood of confusion factor considers the quality of the product, which would be unlikely to confuse customers due to material differences between vermeil and eighteen karat gold and federal hallmarking laws.[240] David Yurman characterizes Mejuri's vermeil as a gold-plating over a "cheaper base metal" while Mejuri describes its fabrication as "18k gold vermeil."[241] Vermeil can tarnish as it is gold-plated silver, and thus is lower quality than solid gold.[242] However, federal hallmarking requirements make consumer confusion unlikely.[243] Additionally, while both brands manufacture pieces in sterling silver, both brands' use of brand hallmarks would mitigate potential quality-based confusion.[244] Both David Yurman and Mejuri noted that while David Yurman's pieces are solid, the undersides of Mejuri's respective pieces are hollow, leading to a lighter jewel with less metal compared to a similarly

[239] *See* Complaint, *supra* note 12, at 51–52.

[240] *See Audemars Piguet Holding S.A.*, 46 F. Supp. 3d at 281; *see* Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 224–25, 247 (S.D.N.Y. 2004).

[241] Complaint, *supra* note 12, at 30.

[242] Complaint, *supra* note 12, at 3, 30–33 (arguing that Mejuri's products tarnish and are of lesser quality with images of alleged samples found in store and on Yelp).

[243] *See* 15 U.S.C. § 297.

[244] *See* Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 259 (S.D.N.Y. 1996); *David Yurman Bracelets: How To Tell Real From Faux*, THE REALREAL (Nov. 19, 2020), https://realstyle.therealreal.com/david-yurman-bracelets-jewelry-how-to-tell-real-thing/ [https://perma.cc/S2NG-2G75]; Chloe Wen, Biggest Mejuri Haul Yet - SO Many New Arrivals & Mejuri Influencer Discount Code (June 11, 2024) https://bychloewen.com/all-topics/mejuri-jewelry-new-arrivals-influencer-discount-code-10-percent-off [https://perma.cc/C5LV-J7W4] (depicting Merjuri's brand hallmark).

sized item from David Yurman.[245] While Mejuri characterizes this lightness as an advantage to the wearability of its pieces, Mejuri's pieces likely are lower quality because the resulting piece would have less value tied to the weight of the precious metal.[246] Thus, the difference in quality makes customer confusion unlikely.

[56] Neither David Yurman nor Mejuri made assertions of actual confusion.[247] As actual confusion is difficult to prove, it is unlikely to affect a likelihood of confusion analysis.[248] The final likelihood of confusion factor, bad faith, is unlikely to support David Yurman. This factor measures whether the defendant was acting in bad faith to capitalize on the plaintiff's goodwill and instigate confusion between the competing jewelry designs.[249] While Mejuri launched its Croissant line in 2019, three years after David Yurman's 2016 launch, this fact does not meet the current bad faith standard requiring clear, recorded evidence.[250] While Mejuri denied acting in bad faith to associate its brand with David Yurman, evidence of Mejuri's good faith consisted of unconvincing imagery, including undated screenshots of Google Images searches of croissants and undated images of computer-animated designs of the Croissant jewelry.[251] These images were

[245] *See* Complaint, *supra* note 12, at 34–35; Answer, *supra* note 13, at 44.

[246] *See* Answer, *supra* note 13, at 44.

[247] Answer, *supra* note 13, at 42; Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 280 (S.D.N.Y. 2014).

[248] *Audemars Piguet Holding S.A.*, 46 F. Supp. 3d at 280.

[249] *Id.*; *see also* Chrome Hearts LLC v. Controse Inc., No. 21-cv-6858 (LJL), 2023 WL 5049198 at *14, *68 (S.D.N.Y. Aug. 8, 2023).

[250] Complaint, *supra* note 12, at 13; Answer, *supra* note 13, at 3, 9–11, 46; *see* Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 248 (S.D.N.Y. 2004); Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 259 (S.D.N.Y. 1996).

[251] Answer, *supra* note 13, at 9.

supposedly supported by Mejuri's artistic director, who stated that "when [Mejuri's creative team] were looking for design inspiration, images of croissants and Paris kept appearing."[252] Federal courts have found undated screenshots unconvincing evidence for or against trade dress infringement claims.[253] While this evidence would be insufficient to establish that Mejuri acted in good faith, without sufficient evidence of bad faith, the bad faith factor would not impact a likelihood of confusion analysis.[254]

[57] By applying the likelihood of confusion factors and current federal case law in jewelry trade dress infringement cases, David Yurman would be unlikely to succeed in a likelihood of confusion claim. First, the twisted-rope motif in David Yurman's asserted trade dress is not a strong mark as it is predominantly ornamental and common in the industry.[255] Second, the similarities of the marks cannot support a likelihood of confusion finding as David Yurman's designs are based on industry standard motifs.[256] David Yurman would be marginally favored by the third and fourth factors, proximity of the goods and bridging the gap, as all fine jewelry operates in the same consumer market.[257] The fifth factor, sophistication of the consumer, would favor Mejuri as consumers of expensive luxury goods like jewelry are assumed to carefully research their purchases.[258] Mejuri would

---

[252] Answer, *supra* note 13, at 11.

[253] *Chrome Hearts LLC*, 2023 WL 5049198, at *7.

[254] *See* Answer, *supra* note 13, at 85–86.

[255] *See* Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 258 (S.D.N.Y. 1996).

[256] *See Chrome Hearts LLC*, No. 21-cv-6858 (LJL), 2023 WL 5049198 at *18.

[257] *See* Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 279–80 (S.D.N.Y. 2014).

[258] *See* Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492, 495 (2d Cir. 1961); *see also Audemars Piguet Holding S.A.*, 46 F. Supp. 3d at 281.

succeed on the sixth factor, quality, as differences in the metal weight and hallmarking would differentiate Mejuri's and David Yurman's jewelry.[259] The seventh and eighth factors, actual confusion and bad faith, would not apply to this analysis due to a lack of substantial evidence.[260] Thus, David Yurman would be unlikely to succeed on a likelihood of confusion claim.

B. Current State of Trade Dress Protection for Jewelry Designs

[58] For a plaintiff to succeed on a Section 43(a) claim, the plaintiff must prove secondary meaning, functionality, and likelihood of confusion. Part II.B. of this Article will synthesize these three tests along with the analysis from *David Yurman v. Mejuri* down to two broad requirements to improve a jewelry design's chances to obtain trade dress protection and succeed on a likelihood of confusion infringement claim. First, that the jewelry design has financial success and fame, and second, that the jewelry design is unique in the jewelry industry.

i. Financial Success and Fame Make Jewelry Designs Stronger Marks

[59] Financial success and fame are not explicit requirements for a jewelry design to serve as a successful product design trademark. However, they are strong indicators that a design can achieve secondary meaning, as five of the six distinctiveness factors are directly connected to the fame and financial success of a plaintiff's jewelry design.[261] For smaller jewelry designers, factors connected to financial success and fame often pose barriers to successfully asserting a prima facie trade dress claim. For

---

[259] *See* Complaint, *supra* note 12, at 31 (arguing that Mejuri's products tarnish and are of lesser quality with images of alleged samples found in store and on Yelp).

[260] *See Audemars Piguet Holding S.A.*, 46 F. Supp. 3d at 280.

[261] *See* Michelman & Sherman, *supra* note 43, at 16.

example, while participating in trade shows is often one of the only financially viable ways for smaller jewelers to advertise their brands, it is unlikely to be strong evidence for secondary meaning.[262] Additionally, federal courts have yet to reach a consensus on the low end of the threshold smaller jewelers need to meet to satisfy the advertising expenditure factor for secondary meaning.[263] The Central District of California held that a million dollars over thirteen years was sufficient, while the Southern District of New York disagreed, holding that $135,000 over a single year was insufficient.[264] While the Southern District of New York's ruling has no binding precedential value, because many fashion and jewelry companies go through litigation in the Southern District of New York, this Article recommends giving this court's perspective greater weight.[265] However, even a niche magazine feature targeting a smaller jeweler's audience can qualify as an unsolicited media appearance on par with a Vogue mention.[266]

[60] Small jewelers will also have a difficult time establishing secondary meaning via quantity of sales, given that fine jewelry operates under a model of higher prices and lower volumes.[267] Trade dress law's sales factor

[262] Diamond Direct, LLC v. Star Diamond Grp., Inc., 116 F. Supp. 2d 525, 532 (S.D.N.Y. 2000).

[263] *See Diamond Direct, LLC*, 116 F. Supp. 2d at 532; *see also* Cosmos Jewelry Ltd. v. Po Sun Hon Co., 470 F. Supp. 2d 1072, 1086 (C.D. Cal. 2006).

[264] *See Diamond Direct, LLC*, 116 F. Supp. 2d at 532; *see also Cosmos Jewelry Ltd*, 470 F. Supp. 2d at 1077.

[265] *See, e.g.*, Complaint, *supra* note 12; R.F.M.A.S., Inc. v. Mimi So, 619 F. Supp. 2d 39 (S.D.N.Y. 2009); Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217 (S.D.N.Y. 2004); Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237 (S.D.N.Y. 1996).

[266] Berg v. Symons, 393 F. Supp. 2d 525, 552 (S.D. Tex. 2005).

[267] *See Berg*, 393 F. Supp. 2d at 554.

balances both units and profit in a manner counterintuitive to the fine jewelry industry's business model.[268] Even Audemars Piguet, one of the biggest watchmakers in the world, struggled to establish secondary meaning via sales success due to the high prices but low volume units of the brand's luxury watches.[269] However, if a smaller jeweler has weak unit sales but strong profits, these elements will cancel each other out, leaving the overall sales factor neutral rather than harmful in the overall analysis.[270]

[61] Major jewelry brands are less likely to experience issues with factors associated with financial success and fame, as they have the resources to invest in marketing and production to ensure customers perceive brands' jewelry designs as indicators of source.[271] Major jewelry brands are likely to satisfy the primary element for advertising, expenditures on a specific trade dress in the high six figures to low seven figures, and have the marketing expertise to know to keep advertisements focused on the designs themselves to establish secondary meaning.[272] Due to their pre-existing fame, major jewelers are more likely to receive unsolicited media coverage and celebrity endorsements, earn greater sales profits, and sell larger numbers of units on new designs.[273] However, if major jewelers do not use

---

[268] *See id.*

[269] *See* Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 277 (S.D.N.Y. 2014).

[270] *Id.* at 271, 277.

[271] Lanham Act, 15 U.S.C. § 1125(a); Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492, 495 (2d Cir. 1961).

[272] *See* Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 226 (S.D.N.Y. 2004); *see also Audemars Piguet Holding*, 46 F. Supp. 3d at 277.

[273] *See* Complaint, *supra* note 12, at 6; *see also* Answer, *supra* note 13, at 39; *Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 232 (stating that Cartier's expensive watch

all the resources at their disposal, they may fail to avail themselves of potential product design rights and protections.

[62] Major jewelry brands looking to assert trade dress protection for jewelry designs should invest in consumer surveys, as surveys serve as excellent evidence for establishing prospective consumers' recognition of major jewelry brands' trade dress.[274] These surveys can be narrowly tailored only to include participants who are demographically and geographically relevant to the brand's consumer base.[275] Consumer surveys are expensive to produce and thus only accessible to major companies; however, jewelers can reuse consumer studies in future litigation, increasing the survey's investment value.[276] Further, the cost of not commissioning a consumer survey could be consequential, as courts have noted when plaintiffs failed to present consumer survey evidence.[277] While this may be less of an issue for a smaller jeweler, as a court would note a small business would not have the funds for such an undertaking, the same would not necessarily be true for a major business.[278]

launches achieved secondary meaning in periods of 3-4 years due to Cartier's media recognition).

[274] *See Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 240, 242.

[275] *See Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 230; *see also Audemars Piguet Holding*, 46 F. Supp. 3d at 272–73, 277.

[276] Cartier, Inc. v. Sardell Jewelry, Inc., 294 F. App'x 615, 618 (2d Cir. 2008).

[277] Berg v. Symons, 393 F. Supp. 2d 525, 553 (S.D. Tex. 2005); Diamond Direct, LLC v. Star Diamond Grp., Inc., 116 F. Supp. 2d 525, 531 (S.D.N.Y. 2000).

[278] *See Berg*, 393 F. Supp. 2d at 553; *see also Diamond Direct, LLC*, 116 F. Supp. 2d at 531.

ii. Jewelry Designs that are Unique Within the Jewelry Industry are Stronger Marks

[63] While creativity and novelty are not official requirements for trade dress, for a jewelry design to serve as a successful indicator of source, the jewel must be visually distinct from other designs without relying purely on industry standard techniques and cannot be functional.[279] Due to the probability that design elements common in the jewelry industry make a product design less distinctive, aesthetically functional, and potentially reduce the likelihood of confusion, jeweler plaintiffs who rely on these elements in jewelry design product design litigation are particularly vulnerable to fail.[280] This is due to the heavy weight both tests place on jewelry designs being unique within the industry and not relying on techniques and motifs common to the trade, as trademark law is rooted in unfair competition law.[281] Courts look less favorably on plaintiffs' claims of trade dress when the jewelry designs' stated elements are common in the jewelry trade, such as matte finishing, gold alloys, ancient jewelry techniques, or well-known cuts of diamonds.[282] Evidence that a plaintiff's

[279] Lanham Act, 15 U.S.C. § 1127.

[280] DBC of New York, Inc. v. Merit Diamond Corp., 768 F. Supp. 414, 415, 418 (S.D.N.Y. 1991).

[281] *See* Resnick, *supra* note 146, at 257, 259 (describing the origins of trade dress law in unfair competition law).

[282] *See Berg*, 393 F. Supp. 2d at 556–57 (arguing that the color black is aesthetically functional due to its ability to match other pigments being one of the "few nonmetallic colors that is compatible with the general format of western jewelry" while gold is aesthetically functional as a signifier of opulence, and thus exclusive use of either color would "hinder market competition"); Solid 21, Inc. v. Breitling U.S.A., Inc., 96 F.4th 265, 277–78 (2d Cir. 2024) (arguing that the phrase "red gold" cannot be protected as a mark because red gold describes a gold-copper alloy); *see generally* Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237 (S.D.N.Y. 1996) (holding that the use of common elements of ancient-inspired jewelry, such as "the use of 18 karat green colored

stated element is common in the jewelry industry can come from images of competitors' products, images of museum collections, and testimony.[283]

[64] Courts are more favorable to jewelers who create original pieces of jewelry, such as a plumeria flower inspired by a photograph of a plumeria, or use functional objects in non-functional ways—designers who think outside the box and do not rely on industry techniques for their trade dress claims.[284] Additionally, ornamentality itself is not enough, as designers must be able to show how that ornamentality serves as a source identifier.[285]

[65] With recent technological innovations in lab-diamond manufacturing, gold-alloying, and new gemstone cutting designs, the boundaries of what courts consider to be "industry standard" techniques will expand, and jewelers will face difficulties justifying their exclusive use of certain methodologies.[286] Techniques that were once considered unusual or that a single jewelry designer popularized can become common elements in the jewelry trade and thus generic under trademark law.[287] Additionally, as

gold, matte finishes, beading, granulation, rope twists, fluting, cabochon stones, columnar designs, pyramid designs and art deco design" are aesthetically functional).

[283] Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 231–32 (S.D.N.Y. 2004) (holding that testimony from executives contributed to secondary meaning); Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 271, 277 (S.D.N.Y. 2014) (holding that images of other, similar designs affect a finding of exclusive use).

[284] *Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d at 245; *see also* Cosmos Jewelry Ltd. v. Po Sun Hon Co., 470 F. Supp. 2d 1072, 1085 (C.D. Cal. 2006) (holding that a plumeria flower design using industry standard techniques were not aesthetically functional).

[285] *Judith Ripka Designs, Ltd.*, 935 F. Supp. at 258.

[286] *See* Beebe, *supra* note 42, at 830–32.

[287] Berg v. Symons, 393 F. Supp. 2d 525, 551 (S.D. Tex. 2005).

technology progresses, jewelry designers should be aware of the possibility that their designs are barred from trade dress protections under the doctrine of utilitarian functionality.[288] Innovations that aid in the wearing of the jewelry piece, such as clasps, chains, or end caps, or that make the jewel more affordable to produce, are the most vulnerable to a finding of utilitarian functionality, especially if that innovative element is also protected by a patent or advertised as having a functional feature.[289]

[66] Jewelers interested in asserting trade dress over new designs should prepare arguments against potential aesthetic functionality claims by emphasizing that the entire design, rather than individual elements, cannot be aesthetically functional.[290] Jewelers should also argue that even if a targeted element is generic, the arbitrary combination of the element with other elements may not necessarily be generic.[291] However, even an assertion of a specific combination of several distinct elements may not be enough when these elements all fall within a specific subgenre of jewelry.[292] Ultimately, a jewelry design must identify a specific brand, not an era or an aesthetic; if a jewelry design fails to serve as a source identifier, it will fail as a trademark.

---

[288] *See* Graff, *supra* note 10 (describing a trade dress infringement claim by a jeweler who possesses utility and design patents for a tennis bracelet that diamonds to rotate 180 degrees).

[289] Neiman Marcus Grp., Inc. v. A'Lor Int'l, Ltd., 22 F. App'x 60, 62 (2d Cir. 2001); Yurman Design, Inc. v. Golden Treasure Imps., Inc., 275 F. Supp. 2d 506, 511–12 (S.D.N.Y. 2003).

[290] R.F.M.A.S., Inc. v. So, 619 F. Supp. 2d 39, 83 (S.D.N.Y. 2009); Golden Treasure Imps., Inc., 275 F. Supp. 2d at 512.

[291] *R.F.M.A.S.*, *Inc.*, 619 F. Supp. 2d at 83; Golden Treasure Imps., Inc., 275 F. Supp. 2d at 512.

[292] *R.F.M.A.S., Inc.*, 619 F. Supp. 2d at 83.

IV. CONCLUSION

[67] Narrowly tailoring product design trade dress analysis in jewelry design cases to other Section 43(a) jewelry cases clarifies how the factors and tests for distinctiveness via secondary meaning, functionality, and likelihood of confusion apply to the jewelry industry. Further, other industries can replicate this framework, as this model only requires concentrating the trade dress analysis to industry-specific cases to produce industry-specific results. Legal academics have treated jewelry as an accessory to fashion law for years.[293] However, this Article provides a demonstration in building a legal framework from all Section 43(a) cases in a specific industry, jewelry,[294] before applying that framework to the fact pattern from *David Yurman v. Mejuri*.[295] While David Yurman would be able to establish distinctiveness via secondary meaning, David Yurman would likely fail to establish Section 43(a) trade dress rights due to aesthetic functionality. David Yurman would likewise fail to establish a likelihood of confusion claim against Mejuri.[296]

[68] *David Yurman v. Mejuri* settled,[297] yet the application of the facts in this Article's framework provides an industry specific trade dress assessment for potential jewelry design litigants. Jewelry designs present unique, consistent fact patterns, such as high prices and low unit volumes, industry specific jewelry motifs, and federal hallmarking laws.[298] Thus,

[293] Holton, *supra* note 4, at 419; *see also* Symposium, *supra* note 4, at 783.

[294] *See supra* Parts II.A–B.

[295] *See supra* Part II.D.

[296] *See supra* Part III.A.

[297] Order, *supra* note 13.

[298] Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 46 F. Supp. 3d 255, 270 (S.D.N.Y. 2014); Berg v. Symons, 393 F. Supp. 2d 535, 532, 552–553 (S.D. Tex. 2005);

potential plaintiffs and defendants should consider how the facts of their potential Section 43(a) cases align with courts' current interpretations of jewelry design trade dress law and tailor their litigation, and design, strategies accordingly.

Cartier, Inc. v. Four Star Jewelry Creations, Inc., 348 F. Supp. 2d 217, 227–28 (S.D.N.Y. 2004); Sunrise Jewelry Mfg. Corp. v. Fred S.A., 175 F.3d 1322, 1326–27 (Fed. Cir. 1999); Judith Ripka Designs, Ltd. v. Preville, 935 F. Supp. 237, 256–259 (S.D.N.Y. 1996); Yurman Design, Inc. v. Golden Treasure Imps., Inc., 275 F. Supp. 2d 506, 510 (S.D.N.Y. 2003); Montblanc-Simplo GmbH v. Colibri Corp., 692 F. Supp. 2d 245, 250 (E.D.N.Y. 2010); Complaint, *supra* note 12, at 11–15.