

**IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK**

Swoosh Shoes,

Plaintiff,

v.

Holy Shoes, Inc.,

Defendant.

Civil Action No. 2021-cv-042921

**JURY INSTRUCTIONS**

**1. GENERAL INSTRUCTIONS**

**1.1 INTRODUCTION**

Members of the jury, now it is time for me to instruct you about the law that you must follow in deciding this case. I will start by explaining your duties and the general rules that apply in every civil case. I will explain some rules that you must use in evaluating particular testimony and evidence. I will explain the positions of the parties and the law you will apply in this case. Last, I will explain the rules that you must follow during your deliberations. Please listen very carefully to everything I say.

You will have a copy of these instructions with you for your reference during your deliberations. You will also have a verdict form, which will list the questions that you must answer to decide this case.

**1.2 JUROR'S DUTIES**

You have two main duties as jurors. The first one is to decide what the facts are from the evidence that you saw and heard here in court and nothing else.

Your second duty is to take the law that I give you, apply it to the facts, and decide which party should prevail on the issues presented.

Perform these duties fairly. Do not let any bias, sympathy or prejudice that you may feel toward one side or the other influence your decision in any way.

### **1.3 CONSIDERATION OF EVIDENCE**

You should use your common sense in weighing the evidence. Consider it in light of your everyday experience with people and events, and give it whatever weight you believe it deserves. If your experience tells you that certain evidence reasonably leads to a conclusion, you are free to reach that conclusion.

### **1.4 STATEMENT OF COUNSEL**

A further word about statements and arguments of counsel. The attorney's statements and arguments are not evidence. Instead, their statements and arguments are intended to help you review the evidence presented. If you remember the evidence differently from the attorneys, you should rely on your own recollection.

## **2. THE PARTIES AND THEIR CONTENTIONS**

### **2.1 THE PARTIES**

I will now review for you the parties in this action and the positions of the parties that you will have to consider in reaching your verdict. Plaintiff is Swoosh Shoes ("Swoosh") an athletic shoe store. Defendant is Holy Shoes, Inc. ("Holy Shoes") a custom shoe store that buys branded athletic shoes and then customizes those shoes for their customers.

Plaintiff Swoosh owns the famous swoosh design  (“SWOOSH”) trademark.

Reg. No.	Trademark	Reg. Date	Goods
977,190		Jan. 22, 1974	Athletic shoes with or without spikes
1,264,529		Jan. 17, 1984	Retail footwear and apparel store services
1,323,343		Mar. 5, 1985	Footwear
1,323,342		Mar. 5, 1985	Footwear
1,238,853		May 17, 1983	Retail footwear and apparel store services

Swoosh contends that Holy Shoes has infringed its trademark and has filed this lawsuit to maintain control of its brand, to protect its intellectual property, and to clear the confusion and dilution in the marketplace. Swoosh has not and does not approve or authorize Holy Shoe’s customized shoes. As an innovative brand that strives to push the envelope and do the right thing, Swoosh believes that decisions about what products to put the SWOOSH on belong to Swoosh, not to third parties like Holy Shoes. Swoosh requests that the Court immediately and permanently stop Holy Shoes from fulfilling all orders for its unauthorized custom shoes.

Defendant Holy Shoes bought normal pairs of Swoosh’s Air Max 97 sneakers at market value for about \$160 and redesigned the shoe. Holy Shoes added a golden Jesus on a crucifix as a shoelace charm. Holy Shoes also sourced holy water from the Jordan River, which was blessed by a priest and added it to the soles of the redesigned sneakers.



**Swoosh Air Max 97 Sneaker**



**Holy Shoes Sneaker**

Holy Shoes sold its redesigned sneakers for \$1,425. Holy shoes believes that its shoes are custom works of art and that it is entitled to sell its shoes based on the fact that it has made significant modifications to the shoes first sale doctrine and because it has materially changed Swoosh's Air Max 97 sneakers. It argues that its artists have made their own creative modifications to the shoes before selling them and that its customers are not confused about source of its sneakers.

I will explain what is required for trademark infringement.

You will be asked to determine the issues of:

- (1) whether Holy Shoes has infringed Swoosh's trademarks; and
- (2) whether Holy Shoes' sale of its customized redesigned Air Max 97 shoes has caused dilution of Swoosh's trademarks; by following instructions, I will give you in a moment.

## **2.2 BURDENS OF PROOF**

In any legal action, facts must be proven by a required standard of evidence, known as the "burden of proof."

Swoosh must prove its claims for trademark infringement by preponderance of the evidence. When a party has the burden of proof by a preponderance of the evidence, it means that you must be persuaded that what the party seeks to prove is more probably true than not true.

Those of you who are familiar with criminal cases will have heard the term "proof beyond a reasonable doubt." That burden does not apply in a civil case like this one and you, therefore, should put it out of your mind.

## **2.3 SUMMARY OF THE ISSUES**

I will now summarize the issues you that must decide and for which I will provide instructions to guide your deliberations. You must decide the following issues:

1. Whether Swoosh has proven by a preponderance of the evidence that Holy Shoes has infringed Swoosh's trademarks.
2. Whether Swoosh has proven by a preponderance of the evidence that Holy Shoes' sale of its customized redesigned Air Max 97 shoes has caused dilution of Swoosh's trademarks.

## **3. THE LAW GOVERNING THE CLAIMS AT ISSUE**

Plaintiff Swoosh alleges two claims against Defendant Holy Shoes: (1) trademark infringement in violation of 15 U.S.C. §1114; and (2) dilution by blurring of its asserted trademarks in violation of 15 U.S.C. § 1125(c).

### **3.1 TRADEMARK INFRINGEMENT**

I will now instruct you on the specific rules you must follow when deciding whether Swoosh has proven that Holy Shoes has infringed the SWOOSH trademarks.

A trademark is a word, symbol, or combination of words or symbols used by a person to identify a product, to distinguish that product from those manufactured or sold by others, and to indicate the source of his product. The trademark laws balance three goals: (1) protecting the public from being misled about the nature and source of goods and services, so that the consumer is not confused or misled; (2) protecting the rights of a business to identify itself to the public and its reputation in offering goods and services to the public; and (3) protecting the public interest in fair competition in the market.

The first sale doctrine is a defense that can be raised to a claim of trademark infringement. Pursuant to the first sale doctrine, it is legal for an individual to resell a trademarked item after it has been sold by the trademark owner in an authorized sale, even if the resale is without the trademark owner's consent.

### **3.2 DILUTION**

Dilution by blurring occurs when the distinctiveness of a famous trademark is impaired or harmed by association with the use of another similar trademark. The owner of a famous trademark is entitled to stop another entity that uses a trademark or in commerce that is likely to cause dilution of the famous mark regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

To prevail on a dilution claim, Swoosh must show that (1) its asserted trademarks are famous, (2) the defendant used the trademark in commerce without the company's consent, and (3) Defendants' use of the trademark weakens the consumer's perception that the famous mark is connected only to the plaintiff's goods or services.

## **4. DELIBERATIONS AND VERDICT**

Once you adjourn to deliberate as a jury, the first thing I recommend you do is select a foreperson.

How you conduct your deliberations is up to you. But however you conduct those deliberations, please remember that your verdict must represent the considered judgment of each juror.

It is your duty, as jurors, to consult with one another and to deliberate with a view towards reaching an agreement, if you can do so without sacrificing your individual judgment.

Each of you must decide the case for yourself, but do so only after consideration of the evidence with your fellow jurors. In the course of your deliberations, do not hesitate to reexamine your own views and change your opinion if believe that your original position was wrong, but do not surrender your honest beliefs as to the weight or effect of evidence solely because of the opinion of your fellow jurors, or for the purpose of returning a verdict. In order for you as a jury to return a verdict, it is necessary that each juror agree to the verdict. Your verdict must be unanimous.

You may not use any electronic device or media, such as telephone, cell phone, smart phone, iPhone, Blackberry or computer, the Internet, Internet service, or any text or instant messaging service, or any Internet chat room, blog, or social networking website such as Twitter, Facebook, MySpace, LinkedIn, YouTube, Instagram, or Snapchat, to communicate to anyone any information about this case or to conduct any research about this case until I accept your verdict.

A form of verdict has been prepared for you. When you have reached unanimous agreement as to your verdict let us know.

You must decide the case yourselves based on the evidence presented.