

Black & Decker Wins \$54M In DeWalt Trade Dress Battle

By **Bill Donahue**

Law360, New York (October 5, 2015, 8:34 PM ET) -- An Illinois federal jury handed down a \$54 million verdict Monday that said toolmaker Positec USA Inc. infringed the yellow and black trade dress of Black & Decker's DeWalt brand of power tools.



Black & Decker sued Positec in 2011, claiming the smaller company's Rockwell line had infringed both patents — four different patents for lawncare products — as well as its DeWalt trademarks and trade dress. (Credit: AP)

Following a one-week trial that capped off more than four years of litigation, an eight-member jury found that consumers would likely be confused by Positec's use of a similar color scheme on its Rockwell brand of tools. DeWalt has used the colors since it launched in 1992.

“We’re thrilled the jury recognized not just the longstanding goodwill of DeWalt’s iconic yellow and black color scheme, but the important economic value of that trade dress,” Raymond P. Niro Jr. of Niro McAndrews, counsel for Black & Decker, said in a statement announcing the verdict.

A verdict form or judgment was not immediately available, and an attorney for Positec did not immediately return a request for comment on the news.

Black & Decker sued Positec in 2011, claiming the smaller company's Rockwell line had infringed both patents — four different patents for lawncare products — as well as its DeWalt trademarks and trade dress.

The patent claims were all either dismissed or dropped over the course of the litigation, but a jury trial

kicked off on Sept. 28 to determine whether Positec's use of yellow and black on its tools constituted trade dress infringement.

According to Niro, he presented survey evidence showing that 100 percent of professional tradespeople and 85 percent of “serious do-it-yourselfers” could identify DeWalt by name upon seeing a black and yellow power tool, as well as evidence that Black & Decker spent more than \$100 million promoting DeWalt's branding.

Black & Decker also had a helpful precedent to which it could point: In 1998, a Virginia federal judge ruled that Black & Decker's “aggressive marketing” meant that it was “beyond debate” that the “DeWalt colors currently enjoy secondary meaning.” The old ruling said the scheme had achieved consumer recognition among professional power tool users comparable to McDonald's golden arches.

Positec argued that Black & Decker failed to show that the trade dress itself was protectable, and that its use of what it called “sunburst” on its tools wouldn't infringe it anyhow.

Niro said Black & Decker immediately plans to seek a permanent injunction barring the continued use of the colors on Positec's Rockwell line.

The two companies are also involved in a separate patent case, which is sitting before the Federal Circuit on appeal from a decision by the U.S. Patent and Trademark Office's Patent Trial and Appeal Board.

Black & Decker is represented by Raymond P. Niro, Jr. and Matthew G. McAndrews of Niro McAndrews.

Positec is represented by Robert J. Theuerkauf, Brian Patrick McGraw, Dennis D. Murrell, Henry Spencer Alford and Scot A. Duvall of Middleton Reutlinger, and John Aron Carnahan of Husch Blackwell LLP.

The case is *The Black & Decker Corp. et al v. Positec USA Inc.*, case number 1:11-cv-05426, in the U.S. District Court for the Northern District of Illinois.

--Editing by Aaron Pelc.