

European Licensee Lacked Sufficient Rights to Enforce Trademark Claim Against Kardashian Sisters

April 11, 2019 – The TMCA
by Margeaux Serrano



Can a licensee sue for trademark infringement under Section 43(a) of the Lanham Act? On April 1, 2019, the Eleventh Circuit issued its decision in *Kroma Makeup EU, LLC v. Boldface Licensing + Branding, Inc. et al.*, and held that the answer to this question depends on the language of the licensing agreement. In Kroma Makeup EU's case, it had contracted away any right to enforce the KROMA trademark.

KROMA is a federally registered trademark. Kroma Makeup EU obtained the exclusive license to

import, sell, and distribute KROMA products in Europe through a licensing agreement with By Lee Tillett, Inc. – the owner and registrant of the KROMA trademark in the United States.

The dispute between Kroma Makeup EU and the Kardashians involved the use of “Khroma” in cosmetic manufacturer (and co-defendant) Boldface Licensing + Branding’s new cosmetic line “Khroma Beauty.” The Kardashian sisters, Kim, Kourtney, and Khloe, endorsed Khroma Beauty, and given the sisters’ popularity, this endorsement concerned Kroma Makeup EU. Kroma Makeup EU was worried that the similarity in names between the products would cause consumer confusion. Ultimately, in a lawsuit between By Lee Tillett and Boldface, a California federal district court enjoined Boldface from using Khroma Beauty and Boldface rebranded the line as “Kardashian Beauty.” Kroma Makeup EU was not involved in the California lawsuit and did not receive any of the settlement money that resulted from the case.

Related Capabilities

- Trademark, Copyright + Advertising
- Intellectual Property Litigation

Kroma Makeup EU filed an action in a Florida federal district court to enforce its rights under the Lanham Act against the Kardashian sisters and Boldface. Kroma Makeup EU also named By Lee Tillett as a defendant and is pursuing separate breach of contract claim against By Lee Tillett. In response to the lawsuit, By Lee Tillett invoked a mandatory arbitration clause from the license agreement and currently the federal case against By Lee Tillett is stayed pending the arbitration.

The Kardashians moved to dismiss the case and alleged Kroma Makeup EU lacked standing. The district court held that the licensing agreement between Kroma Makeup EU and By Lee Tillett only provided By Lee Tillett with the right to enforce the KROMA mark. Kroma Makeup EU appealed the decision. The Eleventh Circuit concluded that the plain language of the licensing agreement expressed the intention that By Lee Tillett would retain all ownership and enforcement rights of the KROMA mark and affirmed the decision. At last, the Kardashian sisters can breathe a sigh of relief.