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The Red Soles March On

Christian Louboutin, the eponymous French fashion house known primarily for its towering stilettos, scored a victory in June in its pursuit of global trademark protection for the iconic red sole on its high heels. The Court of Justice of the European Union in Luxembourg (the ECJ) held, in [Christian Louboutin and Christian Louboutin SAS v. Van Haren Schoenen BV](#), that Louboutin's red sole may function as a trademark. However, the question of whether a single color can serve as a trademark remains unsettled in both the U.S. and the EU.

Louboutin sued the Dutch retailer Van Haren in the Rechtbank Den Haag (Hague District Court) over its sale of red soled high-heeled shoes, which Louboutin alleged infringed its Benelux registration of the mark for its high-heeled shoes.

In the application for registration, the Louboutin mark was described as follows: "The mark consists of the colour red (Pantone 18-1663TP) applied to the sole of a shoe as shown (the contour of the shoe is not part of the trade mark but is intended to show the positioning of the mark)."

Louboutin obtained a default judgment against Van Haren, which Van Haren challenged on the basis that Louboutin's red colored sole cannot function as a trademark under the [Benelux Convention on Intellectual Property \(Benelux Convention\)](#). Under the Benelux Convention, marks "consisting solely of a shape which results from the nature of the goods,

which gives a substantial value to the goods or which is necessary to obtain a technical result" are not protectable. Van Haren argued that Louboutin's mark consisted of "a two-dimensional figurative mark that consists of a red coloured surface," which was not protectable. The Hague District Court referred to the ECJ the limited question of whether the concept of "shape" under applicable law was limited to three-dimensional properties or whether it could include properties such as color.

Drawing upon the European Commission's prior guidance that "the concept of 'shape' is usually understood as a set of lines or contours that outline the product concerned," and noting that Louboutin's registration specifically did not seek to protect the contour of the sole of the shoe to which the red color was applied, the ECJ found that "the main element" of Louboutin's mark was "a specific colour designated by an internationally recognised identification code." Accordingly, Louboutin's mark did not consist "exclusively" of a shape, and was protectable.

As a result of this ruling, it is likely that the Hague District Court will uphold the validity of Louboutin's Benelux registration of its red outsole and the prior judgment of infringement against Van Haren. Louboutin's recent victory comes on the heels of a less favorable decision last year by the Swiss Supreme Court rejecting the red sole trademark as inherently non-distinctive. Although the Swiss

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Supreme Court decision in *Christian Louboutin v. Swiss Federal Institute of Intellectual Property* was reached on different grounds than the ECJ decision, it highlights the fact that trademark protection for various fashion elements is fragmented across jurisdictions within the EU. Nevertheless, the ECJ decision opens the door for other fashion houses and brands to seek protection for single color source-identifying marks in the European Union.

Louboutin has been pushing the boundaries of U.S. trademark law as well. In 2012, Louboutin sued Yves Saint Laurent (YSL) for trademark infringement based upon YSL's introduction of a line of monochromatic shoes, which included red shoes with red soles. After an unfavorable decision at the district court level, holding that there is a per se rule against registration of single color marks in the fashion industry, Louboutin prevailed in an appeal to the Second Circuit. Partially reversing the lower court's holding, the Second Circuit explained that, to the extent the color mark had gained secondary meaning, and didn't significantly undermine competitors' ability to compete in the relevant market, a single color mark could be eligible for federal trademark protection and would not be held to be aesthetically functional. The Second Circuit drew the somewhat arbitrary line that the Louboutin red outsole was source-identifying only in shoes with contrasting upper colors (distinguished from the YSL monochromatic red shoe at issue), yet found that Louboutin's U.S. registration was valid with a modified description making that distinction.

Louboutin is not the only – nor the first – luxury brand to obtain federal trademark protection in the U.S. for the color red as used on outsoles. Since 2004, Prada has owned a U.S. federal trademark registration for a red stripe on the sole of its footwear.

Tiffany has also surmounted the dual hurdles of secondary meaning and non-functionality to obtain federal trademark protection for its famous robin's-egg

blue color (now a unique Pantone named 1837 Blue, in honor of the year Tiffany was founded), including as represented on its jewelry bags and gift boxes.

Perhaps this Fashion Week will see the birth of a new single color icon.

Are you thinking about applying to register a single color mark? Keep these tips in mind:

- Consider specifying that shape is not an element of the mark to avoid running afoul of EU prohibitions against protecting shapes.
- Gather all the press mentions and other indicators of acquired secondary meaning in your color mark, to have ammunition against a functionality refusal. Has the mark been in use less than five years? Keep building more secondary meaning to increase your chances of obtaining registration.
- Be consistent with use of the color on all, or as many as possible, of your goods to build a clear association in the public's mind between that color and your brand. As with Louboutin's red soled heels, you want consumers to see your color and immediately think of your brand.

Related Professionals

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