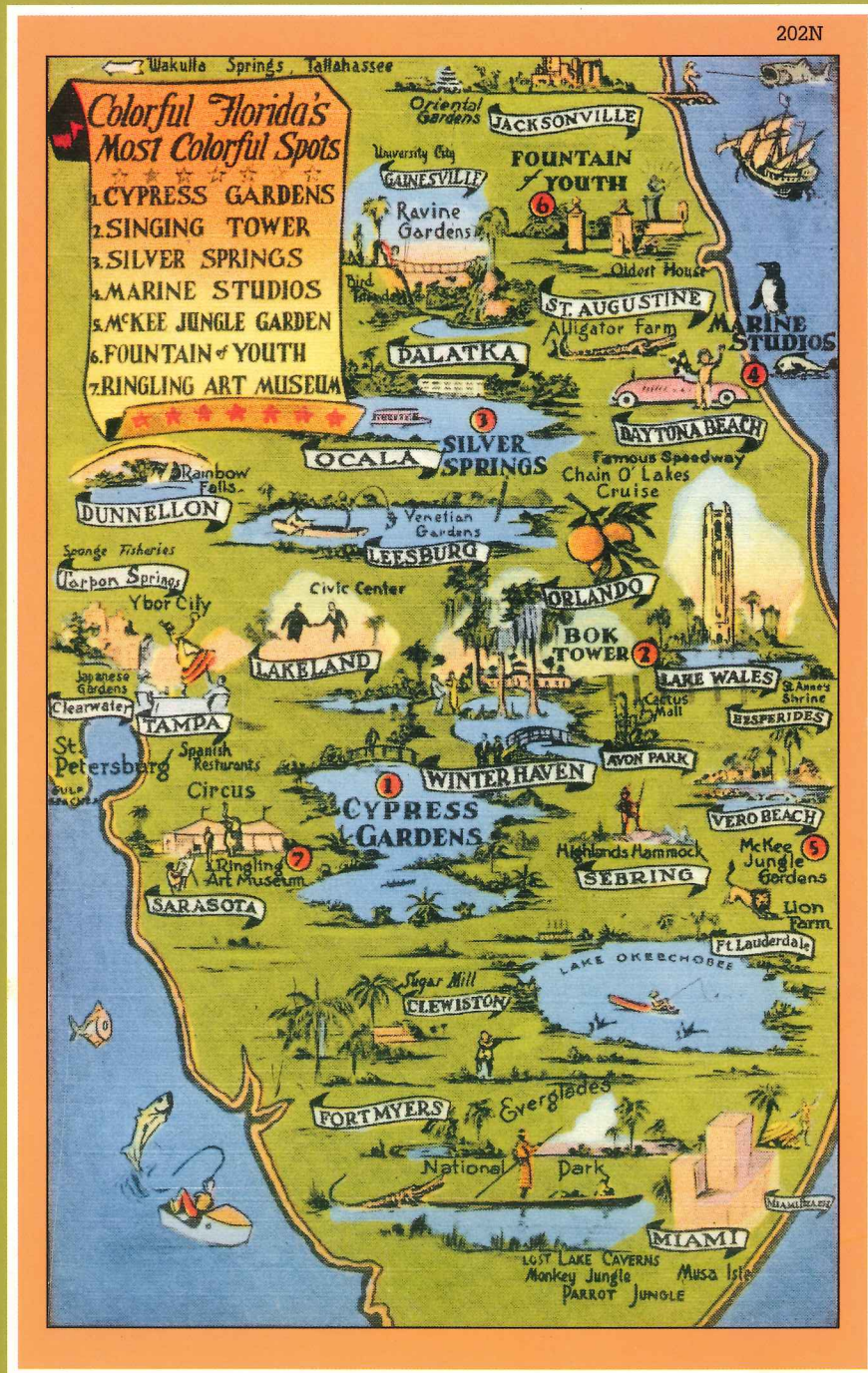


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THE HILLSBOROUGH COUNTY BAR ASSOCIATION
TAMPA, FLORIDA | NOVEMBER 2012 | VOL. 23, NO. 2



FLASH OF A RED SOLE: HIGH STAKES FOR HIGH HEELS

Intellectual Property Section

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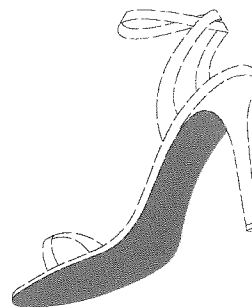


In a much anticipated decision for intellectual property practitioners and fashionistas alike, the Second Circuit has upheld Christian Louboutin's trademark for the use of the color red on the outsoles of Louboutin's high end, "instantly recognizable" high heels.¹ This appeal stems from a decision out of the Southern District of New York, where the District Court denied Louboutin's request for a preliminary injunction stating that "a single color can never serve as a trademark in the fashion industry."²

Since 1992, French designer Christian Louboutin has painted the "outsoles" of his women's shoes with a high-gloss red lacquer. In 2008, Louboutin registered the red lacquered outsole trademark in the United States Patent and Trademark Office. In 2011,

American designer Yves Saint Laurent began to market a line of monochromatic shoes in purple, green, yellow, and red. Yves Saint Laurent's shoes featured the same color on the entire shoe. Louboutin sued Yves Saint Laurent for trademark infringement and counterfeiting, false designation of origin and unfair competition, trademark dilution, and various state law claims based on Yves Saint Laurent's monochromatic red shoe. The District Court denied the injunction and Louboutin quickly appealed.

The Second Circuit reversed the District Court's conclusion that a single color can never serve as a



A court is willing to extend basic intellectual protections to the fashion industry and uphold a color trademark that signifies Christian Louboutin's handiwork.

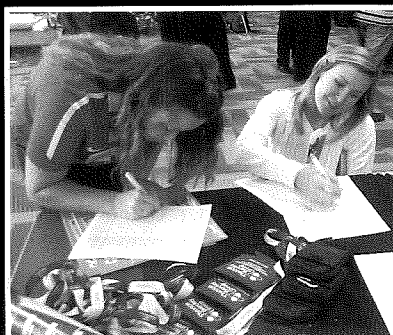
trademark in the fashion industry, stating that the holding is inconsistent with the United States Supreme Court's decision in *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 162 (1995). Consequently, Louboutin's trademark was held valid and enforceable. However, the Second Circuit limited Louboutin's trademark rights by directing the Director of the Patent and Trademark Office to limit the registration of

the Louboutin's red sole mark to only a red lacquered outsole that contrasts with the color of the adjoining "upper." In essence, the Second Circuit split the baby, and

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COOLEY LAW SCHOOL INFORMATION FAIR

Thomas M. Cooley Law School students learned about the benefits of joining the HCBA at a school information fair on September 18, 2012.



Lupe Mitcham, director of Lawyer Referral and Information Services, assists Cooley Law students.

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upheld Louboutin's contrasting red outer sole trademark as valid and enforceable, while at the same time holding that Yves Saint Laurent's monochrome shoe does not infringe Louboutin's red outer sole trademark.

In 1995, the Supreme Court resolved the issue of whether a color could meet the requirements for use as a trademark.³ The Supreme Court held that "color alone, at least sometimes, can meet the basic legal requirements for use as a trademark. It can act as a symbol that distinguishes a firm's goods and identifies their source, without serving any other significant function."⁴ So why would the District Court in New York possibly rule

that Louboutin's trademark was not valid and not enforceable? There is one basic answer: This case involves the fashion industry. Historically, the fashion industry has been immune from the basic intellectual property protections afforded to every other industry. As the Second Circuit acknowledges, "the fashion industry, like other industries, has special concerns in the operation of trademark law; it has been argued forcefully that the United States law does not protect fashion design adequately."⁵ The Second Circuit presented an academic summary on the issues of whether color is a functional aspect of the fashion industry and outlined the basic tenants of the aesthetic functionality doctrine. At the end of the day, a court is willing to

extend basic intellectual protections to the fashion industry and uphold a color trademark that signifies Christian Louboutin's handiwork.

¹ See *Christian Louboutin S.A. v. Yves Saint Laurent*, 2012 WL 3832285 (C.A.2. (NY)).

² See *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445 451, 457 (S.D.N.Y. 2011).

³ See *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 160-61 (1995).

⁴ *Id.* at 166.

⁵ See *Christian Louboutin S.A.*, 2012 WL 3832285 *11.



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