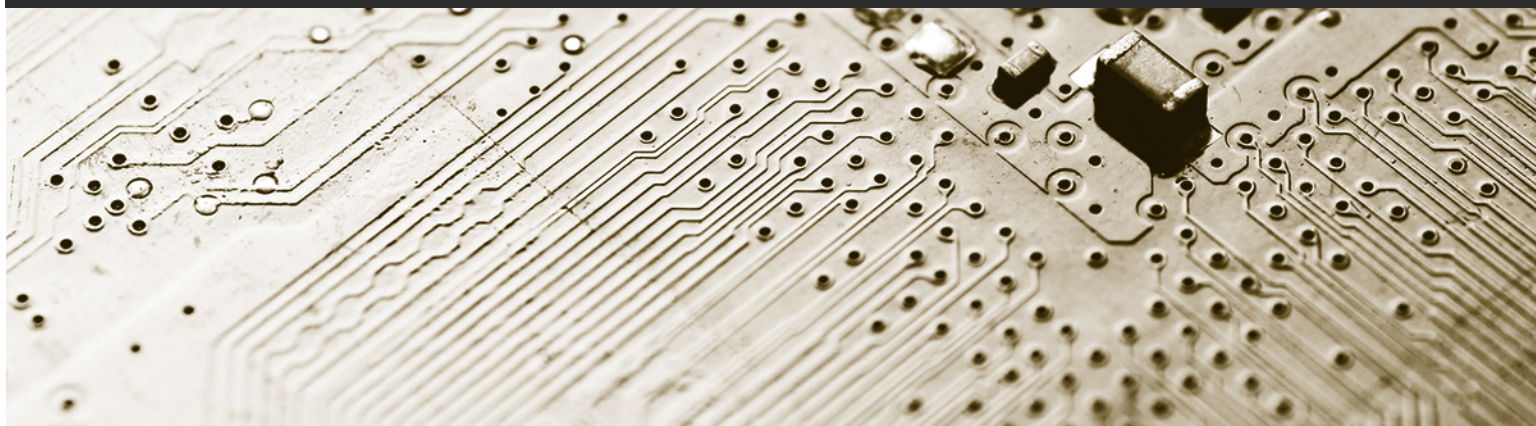


Alert | Intellectual Property Litigation



June 2018

The *Christian Louboutin* Decision – E.U. Court Says Red Soles Are Capable of Trademark Protection

On June 12, 2018, the Court of Justice of the European Union in Luxembourg – in *Christian Louboutin and Christian Louboutin SAS v. Van Haren Schoenen BV* - opened the door for fashion brands to register colors as a trademark as part of their designs in the European Union.

French shoe designer Christian Louboutin – known for his luxurious high-heeled shoes with red soles – has been trying to obtain global trademark recognition for his signature red shoe soles for over a decade. It has not been an easy task. After a long legal battle with Yves Saint Laurent, the U.S. Court of Appeals for the Second Circuit, in 2013, recognized that a single-color mark in the specific context of the fashion industry could acquire secondary meaning and serve as a brand source identifier. This decision confirmed that Christian Louboutin’s signature red shoe sole was a “distinctive symbol” that had come to represent the brand and deserved trademark protection (provided the shoe wasn’t monochromatic red). And although Louboutin was similarly successful in acquiring trademark rights in China, Russia, and Australia, Christian Louboutin’s iconic red-soled shoes were not extended the same trademark protection in Europe.

In an effort to protect his brand globally, Christian Louboutin filed a lawsuit in the Netherlands in 2012 against Van Haren, a Dutch company whose retail stores were selling more affordably priced high-heeled shoes with red soles. The case centered on the technicalities of European trademark law, notably whether a trademark that consists of a color applied to the sole of a shoe consists exclusively of a shape - which is not entitled to protection, or whether it is a position mark, capable of trademark protection. In *Van*

Haren, the lower Dutch court ruled against Louboutin on grounds that the red soles were not separate from the shape of the high-heeled shoes. However, the Court of Justice of the European Union reversed that opinion, deciding that the law governing shape trademarks does not apply because the red sole mark is a position mark, and thus acknowledging that Louboutin's red soles are capable of protection under E.U. trademark law.

What Does This Mean?

This is a landmark case for brands who use distinctive colors as part of their trademarks. While fashion is often considered a form of artistic expression, there are limited legal protections for fashion designs because fashion is inherently functional – regardless of how fancy or expensive a garment is, its function is to keep you warm and clothed. Nevertheless, this decision by the European Union's highest court may encourage fashion brands to use colors, placement of color, and possibly combinations of colors to distinguish themselves from the competition, while simultaneously limiting the ability for signature elements of their designs to be copied by competitors. It is worth noting that courts in other jurisdictions, including the Federal Supreme Court of Switzerland, are still reluctant to consider the red sole as deserving of intellectual property protection, finding the coloring of the sole to be purely aesthetic.

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