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Trademark Office Denies Louboutin's Request to Broaden Trade Dress in Red Sole Shoes

By Jocelyn M. Belloni, Susan E. Hollander

See our previous alert, "Louboutin's Red Sole Shoe Mark: Trademark Protection for Single Colors in the Fashion Industry," available [here](#).

The red hot dispute continues between Christian Louboutin and Yves Saint Laurent ("YSL") over Louboutin's red sole shoe trademark. On January 16, 2013, the U.S. Patent and Trademark Office rejected Louboutin's request to broaden its protection in its red sole shoe mark.

The USPTO's recent decision is rooted in a September 2012 Second Circuit ruling, which held that Louboutin's red sole shoe trademark was valid, but that the USPTO should modify the trademark registration to limit it to protect only red soles that contrast with the rest of the shoe. The Second Circuit found that the trade dress was sufficiently distinctive to merit protection only where the red sole contrasts with the color of the rest of the shoe. Thus, the Court found that YSL's monochrome red shoes with red soles did not infringe Louboutin's trademark. *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 2012 U.S. App. LEXIS 18663 (2d Cir. Sept. 5, 2012).

In an attempt to follow the Second Circuit's mandate, in December 2012, the USPTO proposed revising the description of Louboutin's mark to cover a red sole "that contrasts with the color of the adjoining remaining portion of the shoe (known as the 'upper')." On January 4, Louboutin argued that instead the description should cover a red sole "that contrasts with the color of **any visible portions** of the shoe" (emphasis added). On January 8, YSL argued that Louboutin's proposed amendment was not the intention of the Second Circuit because it would mean that a red shoe with a red sole and, for example, "a black heel cap or a gold buckle fastened on the toe," would infringe the red sole mark.

The USPTO advised in its January 18 letter that it does not believe it has the authority to enter Louboutin's proposed amendment absent a new order from the Second Circuit. The USPTO advised that it would postpone its decision until February 4, 2013 in order to allow the parties to request the Second Circuit to clarify its mandate as to the modification of the red sole mark registration. We will continue to monitor this case and provide updates.

Trademark owners, like Louboutin, frequently attempt to broadly register and enforce trade dress. However, the USPTO and/or courts can limit the scope of trade dress protection. We regularly assist clients with obtaining trade dress registrations that are broad enough to protect the trademark owner, yet specific enough to be registrable and enforceable. If you would like assistance in developing strategies for protecting trade dress, including the protection of color trade dress, please contact one of our attorneys.

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