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INTA Seeks to Aid in Protection of Color Trademark

December 16, 2011 by Tiffany Blofield

The International Trademark Association (“INTA”), formerly known as the United States Trademark Association (USTA), has been around since 1878—longer than the color trademark and high-end designer shoes. It is a not-for-profit organization dedicated to the support and advancement of trademarks and related intellectual property concepts as essential elements of trade and commerce. This important organization has over 5,700 members. When INTA speaks, people listen. Christian Louboutin hopes that the Second Circuit will listen.

You may recall a prior DuetsBlog post regarding the trademark battle in the Southern District of New York between two famous designers. The Christian Louboutin companies sued competitor Yves Saint Laurent companies based on its federally registered trademark for “a lacquered red sole on footwear.” In connection with this lawsuit, Christian Louboutin brought a motion for preliminary injunction. In denying the motion, the District Court found that granting trademark rights to this use of red would “significantly hinder competition,” that is, “permit one competitor (or a group) to interfere with legitimate (nontrademark-related) competition through actual or potential exclusive use of an important product ingredient.” *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 454 (S.D.N.Y. 2011). In declining to find a likelihood of success to enjoin Yves Saint Laurent, the District Court explained that it “c[ould] not conceive that the Lanham Act could serve as the source of the broad spectrum of absurdities that would follow recognition of a trademark for the use of a single color for fashion items.” *Id.* at 457.

Christian Louboutin has now appealed this decision to the Second Circuit. As you likely read in Catlan McCurdy’s blog post, Tiffany & Co. submitted an amicus curiae brief on behalf of Christian Louboutin. As any company associated with the fashion industry knows, color is often crucial to the company’s brand. Tiffany & Co.’s robin egg blue is the subject of numerous trademark registrations for items such as jewelry, fragrances and handbags (Reg. Nos. 2184128, 2416795, 2416794). Tiffany & Co. wants to keep the protection courts have afforded single color marks.

INTA also has submitted an amicus curiae brief in support of Christian Louboutin. Specifically, INTA alleges that the District Court erred in rejecting the presumption of validity attendant to Christian



Louboutin's federal trademark where the narrower claim actually defined in the registration, namely a "lacquered red sole on footwear." Further, INTA alleges that the color red on soles of shoes was not aesthetically functional. Such errors if left to stand would "upend key aspects of trademark and unfair competition law, making it easier for third parties to use the brands of others."

The importance of the appeal to the Second Circuit is highlighted by the amicus curiae briefs filed by Tiffany & Co. and INTA. Color trademarks are an important form of intellectual property protection for fashion brands. It will be interesting to see if Christian Louboutin, with the help of Tiffany & Co. and INTA, can convince the Second Circuit to protect its red-soled footwear.

