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## **Louboutin Red-Sole & Surrounding Contrast: An Implied Trademark Limitation**

By Steve Baird on February 15th, 2012

The Louboutin [lacquered red sole trademark](#) is the subject of great debate in the [trademark world](#), [fashion industry](#), [popular news media](#), and among [law school academics](#) and [friends of the court](#).

I'm just not seeing it. I really don't see a viable trademark claim here for Louboutin. Not for the reasons found by the district court — I believe Louboutin's mark is distinctive and valid. Instead, I fail to see a valid claim, in part, because the presence of a red-sole on a monochrome red shoe is simply not a trademark use because it [blends into the background of an all-red pair of shoes](#).

Equally important to explaining why there is no valid trademark claim, is what I believe to be an inherent or implied limitation in [Louboutin's red-sole single-color trademark registration](#): The critical need for visual contrast between the red-sole and the surrounding portions of the shoe.



Louboutin Red-Sole Shoes

Yves Saint Laurent Monochrome Red Shoes

Let's not forget that Louboutin's specimen – [found in the USPTO file history for the federal trademark registration](#) — shows use of the red-sole with a contrasting color bordering the red-sole portion of the shoe (as you can see from the link, the specimen appears to show the contrasting color as lavender, not black, but a contrasting color no less). Had Louboutin relied on an all-red color shoe (with no contrasting color) in its specimen of use, registration would have been denied.

So, the answer to Louboutin's overreaching, in my view, is not to invalidate the Louboutin red-sole trademark — as many have suggested — or discard the single-color non-traditional trademark law that has developed since the groundbreaking [Owens Corning decision in 1985](#) and the Supreme Court's endorsement of single-color trademarks in the [1995 Qualitex decision](#).

Moreover, it is not the answer to carve out the fashion industry from color trademark law or treat it somehow differently – as some have suggested – or prevent that industry from enjoying the benefits of single-color trademark rights when the claimed rights, in fact, meet the definition of a trademark by identifying, distinguishing, and indicating the source of the goods in question, as I believe the Louboutin red-sole mark, actually does.

No, at least to me, the answer to Louboutin's overreaching in the Yves Saint Laurent case is to deny the requested relief because there is no trademark use of the red-sole on a monochrome red shoe and because it is fair use to make an entirely red-colored shoe.

Those who understand the nuances of the trademark field will appreciate that obtaining a single-color trademark that is limited by where the color is placed on a portion of an object is a much narrower and more limited right than claiming that same color as applied across the entire surface of the object. It is my sense that many of those who react negatively to Louboutin's claim may do so because there is something offensive about obtaining a narrow right and using it as a club to stop conduct that is far beyond the narrow obtained right. It's the classic concern about the tail wagging the dog.

Let's explore a few other real-world examples to test my approach.

Gillette owns federally-registered rights in not only [THE COPPERTOP BATTERY](#) word mark, but also the trade dress [depicting a band of copper-tinted color across the top of their batteries](#). Does that right extend to batteries or battery covers having a copper color across the entire surface of the article? I don't think so. Apple apparently agrees.



What about the [GOLDTOE](#) sock brand? Does owning a federally-registered color/placement mark provide rights broad enough to reach use of that color across the entire surface of the article in question? Despite the [federal trademark registration covering the color gold as applied to the toe portion of the sock](#), the marketplace tells us that anyone can sell solid gold colored socks:



GoldToe Brand Socks

And, what about [Adidas famous three stripe design trademark](#)? Does that permit Adidas to prevent use of stripes that cover the entirety of shoes? These examples suggest not: (1) [Raben striped shoes](#); (2) [Toms striped shoes](#); (3) [Keds striped tennis shoes](#); and (4) these cool-looking striped Nike soccer shoes (interesting story on their design [here](#)):



What about Ked's blue rectangle trademark device that appears on the heel of tennis shoes? Does that limited non-traditional trademark right extend protection to every shoe that also has the color blue covering the same portion of the shoe? [Nike apparently did not think it needed to carve the blue out of that portion](#). Neither did [America with its solid blue shoes](#).



The Supreme Court in *Qualitex* discussed the possibility of industrial [bolts with red heads](#) serving as non-traditional trademarks. Would such a color/placement trademark forbid another from making and selling totally-red colored bolts? [These guys wouldn't think so.](#)

Finally, Casella Wines, owner of the Yellow Tail brand, also owns a federally-registered non-traditional trademark in the "[placement and combination of the color pink as placed on the top and the front of a wine bottle,](#)" as shown in the middle bottle displayed below:



Should [Susan G. Kommen](#) be concerned about sponsoring an all-pink wine bottle in connection with fundraising for breast cancer? I'm thinking Casella Wines is not a problem, what do you think?

In the end, permitting a single-color/limited placement trademark to bar the use of that same color across the entire surface of an article, as a common form of ornamentation, would allow the (yellow) tail to wag the dog (or kangaroo), wouldn't it?

Where do you come down on these issues?

