

IP Buzz

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Louboutin Gets the Boot: S.D.N.Y. Judge Denies Motion for Preliminary Injunction in Trademark Dispute Over Signature Red Soles

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Designer Christian Louboutin got the idea for his iconic, red-soled shoes when, believing that a pair of sky-high black pumps “lacked energy,” he applied red nail polish to the bottom. The overall effect was considered such a success that the shiny, red-lacquered sole became a permanent fixture of Louboutin’s footwear designs. Since then, Louboutin’s signature heels have been beloved by fashionable people the world over. So much so, that the Louboutin brand is under constant attack from fake and knock-off designs. In the last few years, the company has served hundreds of DMCA notices on Google to remove sites selling fake goods from their search results. It has also set up a separate website to protect the brand by identifying hundreds of websites that sell fake luxury goods and summarizing legal actions taken against the most egregious counterfeiters.

This past summer, however, one particular entity was thrust into the spotlight as the object of Louboutin’s legal efforts. Yves Saint Laurent America, Inc.—itself a designer of much-coveted, high-end heels—was sued by Louboutin over a pair of red-soled, red suede pumps, which Louboutin claimed were virtually identical to its own, signature red-soled shoes. Yet, Yves Saint Laurent claimed that it has been manufacturing red-soled shoes like the pair at issue long before Christian Louboutin popularized them. In any event, it argued, no fashion designer should be permitted to monopolize any color.

In the end, U.S. District Judge Victor Marrero sided with Yves Saint Laurent, rejecting Louboutin’s request for a preliminary injunction and holding that the Lanham Act does not permit designers to corner the market on a color—even if that color has gained enough public recognition to have acquired secondary meaning. Much to Louboutin’s dismay, Judge Marrero distinguished the present case from earlier, similar cases in which trademark registrations were upheld in colors *and patterns* in fashion. In such cases, the colors and/or patterns were wholly or partially intended to embed a uniquely identifiable mark in the goods, whereas here, the red color is merely an “indispensable medium” that is functional or aesthetically pleasing, rather than an indicator of origin.

Judge Marrero even indicated a willingness to convert the record to a partial summary judgment motion canceling the trademark. Louboutin is now preparing its appeal.