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YSL Has a Friend in Its Battle with Christian Louboutin

January 18, 2012 by [Tiffany Blofield](#)

We have previously blogged about the battle over Christian Louboutin's ("Louboutin's") trademark registration for lacquered red soled shoes that is taking place in New York and is now before the Second Circuit. Friends of the Court (the Latin meaning of the phrase *amici curiae*) that have weighed in on Louboutin's side include both [Tiffany & Co.](#) and [The International Trademark Association \("INTA"\)](#). Now friends weigh in on behalf of Yves Saint Laurent ("YSL").

By way of background, Louboutin urged the Second Circuit to reverse the District Court's order denying it a preliminary injunction on the grounds that Louboutin could not demonstrate that it was likely to succeed on its trademark infringement and unfair competition claims. In support of Louboutin and a reversal, Tiffany & Co. argued that the District Court's opinion in this case had "adopted a sweeping and unprecedented per se rule against granting trademark protection to any single color that is used on any 'fashion item,' even where the color has achieved 'secondary meaning' and is associated with a single brand." INTA also weighed in alleging that the color red on soles of shoes was not aesthetically functional and that if left to stand the decision would "upend key aspects of trademark and unfair competition law, making it easier for third parties to use the brands of others."

YSL's friends are professors of law who teach in the area of trademark and related fields (including a professor from my alma mater the University of Minnesota Law School). They argue that "functionality channels the grant of legal monopolies over product features away from trademark to utility . . ." They believe that the District Court appropriately recognized the importance of color to consumers in fashion markets. Aesthetic functionality of a trademark occurs where the consumer's preferences for attractive product designs drive purchases. These professors further believe that competitors would be harmed if trademarks, such as Louboutin's red soled mark, were allowed to monopolize certain colors. After discussing design patents, the law professors assert that there is a need to bolster the doctrine of aesthetic functionality to not only protect trademarks, but also design patent applications.

Finally, the law professors dismiss Tiffany & Co.'s concerns for its own trademark because its rights are based on color marks for nonfunctional product packaging (i.e., the well-recognized robin's egg blue). [This same argument was also expressed in a comment to my prior post on INTA's amicus curiae brief.](#)



In their brief, the law professors claim that “it is far from clear how Louboutin would be harmed if a woman mistakenly believes another woman’s monochromatic red shoes to be Louboutin.” I disagree. I have always wanted a pair (unfortunately, they were not under the Christmas tree this year), but would be less inclined to buy a pair if I saw another woman wearing poorly designed red sole shoes that I mistook for Louboutin’s shoes. Maybe, it is just me, but there are likely others who would have a similar reaction.

The Second Circuit has its work cut out for it. This is a very important battle for color trademarks (and especially those trademark owners in the fashion industry that rely so heavily on color). Will Louboutin and its friends INTA and Tiffany & Co. prevail or will YSL and the law professors prevail?

