

## **Louboutin sees red: signature red sole shoes not protected against copyright and trade mark infringement**

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Nowadays, it seems common to see women of all ages strutting around the city with red soled shoes. For some people, seeing red soled shoes means nothing. However, the fashion savvy will be quick to recognise that the owner has probably paid a small fortune for their shoes, produced by exclusive French designer, Christian Louboutin.

Louboutin's shoes are so famous that they even inspired a song by Jennifer Lopez called *Louboutins*.

Louboutin obtained a trade mark in the United States for a lacquered red sole on footwear in 2008 (Trade Mark). Colour trade mark applications have also become quite common in Australia, though colour combination trade marks seem to be granted more readily than single colour trade marks.

Earlier this year, Louboutin brought a copyright and trade mark infringement action in the Federal District Court in Manhattan, New York against iconic fashion house Yves Saint Laurent (YSL), over four shoe designs that were featured in the YSL Cruise 2011 collection. YSL's Tribute, Taboo, Palais and Woodstock shoe models featured red soles similar to those protected by Louboutin's Trade Mark.

YSL argued in its defence, that no fashion brand or brand should have a "monopoly on a colour".

Judge Victor Marrero ruled that Louboutin's Trade Mark was "overly broad" and most likely not protectable. He implied that the trade mark should be cancelled despite the fact that he described Louboutin's shoes as "a product visually so eccentric and striking that it is easily perceived and remembered". He went on to say:

*"Because in the fashion industry colour serves ornamental and aesthetic functions vital to robust competition...the court finds that Louboutin is unlikely to be able to prove that its red outsole brand is entitled to trade mark protection, even if it has gained enough protection in the market to have secondary meaning".*

Judge Marrero made reference to the fact that the famous jewellery store Tiffanys has a trade mark for the very precise shade of blue used on its packaging but acknowledged that owning a whole colour category when applied to the sole of a shoe was a different proposition that would more than likely dampen other designers' creativity.

Judge Marrero declined to grant a preliminary injunction to Louboutin against YSL. Louboutin intends to appeal Judge Marrero's judgments in a bid to block YSL from producing red soled shoes in its 2011 Cruise collection.

As a result of the decision, YSL has, for the time being, been able to continue producing its red soled shoes and has also inspired many other shoe designers and manufacturers to add a touch of red to their shoe soles.

In Australia, it is likely that a judge would agree with Marrero's reasoning. Several decisions in respect of colour trade marks indicate that whilst colours can certainly be protected as trade marks in Australia,



there is a very strong onus on the registrant to show how the colour is used as a means of distinguishing a company's brand. Colour trade mark applications are more likely to succeed if they can be connected to a distinctive shape of goods or the layout and design of a particular product, and if colour combinations are used.

If you would like more information about registering your trade mark in Australia and internationally, please contact Alexia Marinos, Registered Trade Marks Attorney and Senior Associate at **Gadens Lawyers**.