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## Louboutin's Challenge: Can One Fashion Designer 'Sole-ly' Trademark a Color for Well-Heeled Shoes?

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The exclusive claim of a single color as a trademark is one of the more controversial areas of trademark law. The debate surrounding when it is appropriate to allow one entity exclusive rights to a single color in connection with a particular product or service is not entirely new. In 1995, the Supreme Court attempted to address this issue in *Qualitex Co. v. Jacobson Products Co.*, holding that if the use of a color is functional, then it should not be accorded trademark protection. A color is functional "if it is essential to the purpose of the article." If, on the other hand, color is not a necessary element of the product but an indication of origin only, then trademark protection may be appropriate, as with UPS's trademark rights in the color brown, Tiffany's claim to robin's-egg blue, and Owens Corning's rights in pink for fiberglass insulation.

A recent dispute between shoe designer Christian Louboutin and fashion empire Yves Saint Laurent highlights the difficulty in applying the *Qualitex* holding to the fashion industry – a domain in which unfettered access to forms of expression is essential to product innovation.

In 2008, Louboutin was granted a U.S. federal trademark registration for the color red as used on shoe soles based on the acquired distinctiveness Louboutin had gained through sales of the designer's famous, high-fashion footwear since 1992. However, last year, when Louboutin attempted to enforce these rights in response to a line of shoes produced by Yves Saint Laurent that also featured red soles, U.S. District Court for the Southern District of New York Judge Victor Marrero denied Louboutin's request for injunctive relief and granted Yves Saint Laurent's motion for summary judgment. Unmoved by Louboutin's trademark registration for red-soled shoes, the district judge was persuaded instead by Yves Saint Laurent's arguments that permitting a color to be trademarked in the fashion industry unfairly impacted competition from an artistic perspective. Judge Marrero expressed concern about the possibility of "cramping what other designers could do while allowing Louboutin to paint with a full palette." In Judge Marrero's opinion, the purpose of color in fashion is "not to identify and advertise a commercial source," but to please the eye.

While that may be true, no one, not even Yves Saint Laurent, disputes that Louboutin's lacquered red soles have garnered widespread consumer recognition and acquired distinctiveness. One wonders, however, whether Louboutin shot himself in the proverbial foot when he argued that he chose this particular shade of red to make his footwear designs "sexy" and "engaging" and that the color imparted "energy" to his high-priced footwear.

The issue arises because functionality actually has two meanings under trademark law – a feature such as color is functional if it has a utilitarian function (for example, bright orange to indicate hazardous materials), but the *aesthetic* functionality cannot be ignored. A color is aesthetically functional if it gives a competitive advantage because of its aesthetic appeal to consumers. Judge Marrero's decision clearly suggests that the color red as used by Louboutin

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on shoe soles is aesthetically functional and therefore not entitled to trademark protection. Such a "one size fits all" interpretation of the aesthetic functionality standard implies the standard would effectively apply to all uses of color in the fashion industry. Judge Marrero's opinion would seem to contradict the Supreme Court's *Qualitex* decision, as well as decades of trademark and trade dress precedent – not to mention according little weight to the significant consumer recognition and acquired distinctiveness Louboutin's signature red soles have acquired.

Earlier this year, Louboutin appealed to the U.S. Court of Appeals for the Second Circuit in Manhattan, arguing to a three-judge panel that the lower court's decision should be reversed.

Whatever the outcome, the Second Circuit's decision will likely be a seminal trademark case and will certainly be of interest to the fashion industry and beyond. If Judge Marrero's decision is upheld, it could effectively preclude the fashion industry from the ability, enjoyed by all other industries, to trademark color under U.S. law. This is a trademark case to watch, and one we will closely monitor as it proceeds.

*For more information related to this alert, please contact the authors or any attorney in Lowenstein Sandler's [Trademark Law group](#).*

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