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Sole Ownership? Louboutin Loses Appeal in French Court in Trademark Dispute with Zara Over Signature Soles on Shoes

IP Buzz

Last May, high-end French footwear designer Christian Louboutin suffered yet another loss in its ongoing legal battle over its iconic red-soled shoes. On May 30, 2012, the Cour de Cassation—the highest French court of appeals—determined there was no risk of consumer confusion between a red peep-toe platform heel with red soles sold by Spanish fashion retailer Zara and Louboutin’s own “Yo Yo” design, a nude peep-toe platform heel with his signature red soles. In denying Louboutin’s claims, the court found its French trademark specifications (the description of the mark) to be too vague, noting the absence of a specific Pantone color reference in Louboutin’s trademark. And, in ruling against Louboutin, the court ordered him to pay approximately \$3,600 in litigation costs to Zara France, pursuant to Article 700 of the Noveau Code de Procedure Civile.

Designer Christian Louboutin has testified that he came up with the idea for his red soles after he applied bright red nail polish to a pair of sky-high pumps he felt “lacked energy.” The effect was such a success that it became a permanent feature of Louboutin’s footwear designs. As a result, at least one court has found the color red on the soles served a function, and was not primarily a source identifier. Unfortunately, the red soles have become a permanent feature of other parties’ shoe designs as well, causing the company to spend millions of dollars each year seeking to protect its designs. Louboutin has served hundreds of Digital Millennium Copyright Act notices on Google to remove from its search results photos of Louboutin shoes on websites allegedly selling counterfeits. Louboutin has also set up a website dedicated to identifying the mounting number of fakes.

This most recent decision comes nearly a year after Louboutin suffered a similar loss in the Southern District of New York against designer Yves Saint Laurent (YSL). In that case, District Judge Victor Marrero denied Louboutin’s motion for a preliminary injunction seeking to enjoin YSL’s sales of four designs of red shoes with red soles and held that Louboutin was not legally entitled to corner the market on a color—notwithstanding the high-level of public recognition the red-soled shoes have gained. In his ruling, Judge Marrero distinguished earlier trademark disputes, wherein colors and/or patterns were wholly or partially intended to act as a source identifier; by contrast, the red color of Louboutin’s soles, by his own testimony, served a functional purpose, i.e. provided “energy.” Judge Marrero went even further, indicating a willingness to convert Louboutin’s motion for a preliminary injunction to a partial summary judgment motion canceling Louboutin’s trademark.

Yet, these two losses have not minimized Louboutin’s desire to protect the red soles. The Southern District of New York decision is currently on appeal to the Second Circuit Court of Appeals, and, since the original decision in French court, Louboutin has re-filed his French trademark to include a highly specific shade of red—Pantone 18-1663TP. Thus, Louboutin’s quest for protection continues.

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