

Fashion Law



Christian Louboutin v. YSL

In 1992, parisian-born designer Christian Louboutin started coloring the outsoles of his high fashion women's shoes with a bright red in order to make the shoes more "engaging, flirtatious, memorable, and...sexy." Even though the designer does not use print advertisements to promote his creations – preferring red carpets and celebrities endorsement - the red soles became so synonymous with Christian Louboutin among the fashion lovers that the U.S. Patent and Trademark Office ("USPTO") awarded a registered trademark for the "lacquered red soles" in 2008. Yves Saint Laurent ("YSL") is a world famous French fashion house founded in 1962 that produces ready-to-wear collections, including footwear. Since the 1970s, YSL's collections have even included the occasional red outsole shoes. In January 2011, Louboutin filed suit against YSL because their 2011 Cruise collection included four shoes (Tribute, Tribtoo, Palais, and Woodstock) with red outsoles. Louboutin claimed that YSL infringed their trademark and requested an injunction against YSL.

The issue brought before the court was whether trademark protection should not have been granted to that registration, even though Louboutin was acknowledged as innovative and was highly associated with the red outsoles. The challenge was to determine when the use of color is a design element and when it is a trademark.

Louboutin asserted several claims under the Lanham Act (which deals with

trademark law in the U.S.): trademark infringement and counterfeiting, false designation of origin and unfair competition, and trademark dilutions. They also filed claims under state law for: trademark infringement, trademark dilution, unfair competition, and



unlawful deceptive acts and practices. Basically, Louboutin believes that allowing others to use the red soles, will create irreparable harm to the brand because of the potential "copycats." YSL counterclaimed seeking: cancellation of the Red Sole Mark on the grounds that it is not distinctive, ornamental, functional, and was secured by fraud on the PTO. They also sought damages for tortious interference with business relations and unfair competition. Essentially, YSL

believes that fashion designers should not be able to monopolize a color.

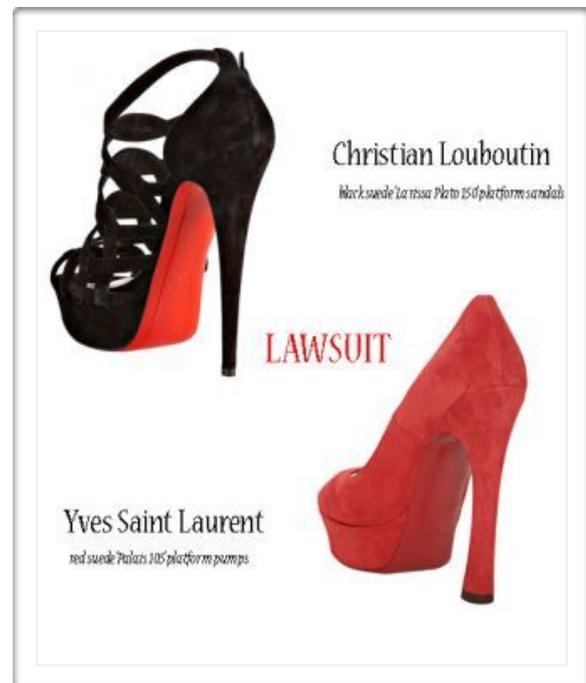
On August 10, 2011, District Court Judge Victor Marrero, denied the injunction requested by Louboutin. Judge Marrero explains that color serves ornamental and aesthetic functions in the fashion industry. Therefore, the court finds that Louboutin is not likely to be able to prove that the red outsole brand is entitled to trademark protection, even if it has gained enough public recognition in the market to have acquired secondary meaning. In delivering the opinion, Judge Marrero did acknowledge that it is possible for color to be trademarked in the fashion industry; however, he explained that the difference was that this was possible only for distinct patterns or combinations of shades like the Louis Vuitton logo or Burberry check pattern.

On Monday, October 17, 2011, Louboutin filed their appeal. Louboutin is arguing that the red sole is too vital to the brand's identity; therefore, allowing others to use it would be harmful to Louboutin. Louboutin reiterates their main points, but also goes further to say that the judge made "errors of law in determining that Louboutin's red outsole mark was likely invalid." Louboutin's counsel also claimed that YSL's shoe caused "consumer confusion," which is a critical component to determining if a trademark has been violated.

According to the brief Louboutin's "trademark status has been conferred upon it by the consuming public...only public recognition can breathe life into another mark, whether it be a single color, several colors or another design element."

On October 24, 2011, Tiffany & Co. filed an amicus brief in support of Louboutin. Tiffany's is known for their "little blue box" and has a registered color trademark which we fondly know as "Tiffany Blue." Although there is a distinction between Louboutin's mark and Tiffany's mark — one is for "product packaging," the other for "product

configuration"- the eventual cancellation of Louboutin's red sole trademark would "weaken color trademarks across the world of fashion," as noted by Susan Scafidi, director of Fordham University's



Fashion Law Institute.

The entrance of Tiffany clearly underlines how the whole case is not just about Louboutin's sexy pumps anymore, but the entire world of fashion. If Louboutin would lose his "monopoly", other world-known fashion houses are in serious problems. Just think about the "red-Valentino", Versace's "neo classical baroque prints" or Missoni's signature crocheted knits.

This is a real Fashion Law Emergency.

