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Alison Frankel's **ON THE CASE**

Shoes and herrings are red in 2d Cir. Louboutin argument

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The shoe on the counsel's table was the last straw.

During Tuesday's inconclusive oral argument over [Christian Louboutin's red-sole trademark case](#) at the U.S. Court of Appeals for the Second Circuit, Louboutin's lawyer, **Harley Lewin of McCarter & English**, noticed that Yves Saint Laurent's lawyer from **Debevoise & Plimpton** had displayed one of YSL's monochromatic red shoes on the table in front of him. Clearly irritated, Lewin complained that he had not been informed that YSL planned to introduce the shoe as evidence. Senior Judge **Chester Straub**, showing a rare flash of humor from the bench, suggested that perhaps someone in the audience might volunteer a Louboutin pump as a demonstrative. (Straub soon thereafter asked Debevoise to take the shoe off the table, saying, "Frankly, I find it distracting.")

The shoe, of course, was intended to add a kick to YSL's argument that U.S. District Judge **Victor Marrero** of Manhattan federal court ruled correctly when he [denied Louboutin a preliminary injunction](#) barring the sale of YSL's shoes. In that decision, issued in August, Marrero stepped beyond the issue of the injunction to conclude that Louboutin should not have been awarded a trademark on the Chinese red-lacquered soles that have become the world-renowned symbol of Louboutin's pricey pumps. The judge said that in fashion, color is not merely a brand identifier, but serves an aesthetic purpose. So under the U.S. Supreme Court's 1995 ruling in [Qualitex v. Jacobson Products](#), Louboutin's red soles can't be trademarked.

Louboutin's appeal challenged Marrero's ruling on the trademarkability of colors as "legally erroneous." Marrero, according to the Louboutin side, ignored arguments that Louboutin's red soles are a powerful brand identifier -- and didn't even consider evidence that competition in the high-end women's shoe business hasn't suffered as a result of Louboutin's 20-year-old trademark.

The glamour quotient was (relatively) high when Second Circuit judges Straub, **Jose Cabranes**, and **Debra Livingston** heard arguments Tuesday afternoon. Louboutin himself was in attendance, looking lawyerly in a charcoal-grey pinstriped suit. (A small, neat man, he bears a slight resemblance to YSL's lead lawyer, David Bernstein of Debevoise.) The shoe designer was accompanied by Diane von Furstenberg, in a sparkly black top and sunglasses she left on indoors. The audience was uncommonly well-shod for a Second Circuit argument; on the elevator up to the ninth-floor courtroom, Becker noted that there was "lots of red flashing" from the bottoms of shoes waiting on the security line. Lots of French accents, too.


But the Second Circuit panel seemed fully aware of the underlying significance of the question the case presents: Can colors be trademarked in the context of fashion design?

Bernstein led off his argument by agreeing that colors can be trademarked when they serve solely as brand identifiers (a la Tiffany's blue boxes, or Owen-Corning's pink fiberglass), but drawing a distinction between color that serves no purpose beyond identification and color in fashion, where all choices are aesthetic. Straub threw that argument back at him. "You're saying that no evidentiary showing is necessary because it's fashion?" the judge said. "At bottom, your position is that in the fashion industry, there [can be] no protective mechanisms." Louboutin, Straub said, is "only trying to protect one little portion" of the shoe.

Of the three judges, Straub appeared to be the most troubled by Marrero's preliminary injunction opinion. He pressed Bernstein to explain the trial court's factual basis for calling color an aesthetic choice in fashion, asserting that he didn't see the findings that dictated that ruling. (Bernstein pointed to Marrero's comparison of shoe designers to artists. "Artists need a full color palette," he said.)

Livingston was friendlier to YSL's argument that Louboutin's trademark isn't in line with the Supreme Court's *Qualitex* ruling. She told Lewin she was "stumbling" over the "significant function" served by Louboutin's red soles. "Doesn't it hinder competition if can't make monochromatic shoes?" she asked. (Lewin sidestepped the question,

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calling YSL's protests about its long tradition of monochromatic high heels "a red herring.")

Cabranes, meanwhile, seemed faintly amused by the crowd that came to hear the argument, which went on for 45 minutes. He asked Lewin why Louboutin had appealed the preliminary injunction, rather than waiting until Marrero issued a summary judgment ruling on the validity of Louboutin's trademark. Lewin suggested that Marrero's statements left little doubt about how he'd rule on summary judgment. His decision "was way out of bounds," Lewin said.

"What do you want from us?" Cabranes then asked. Lewin said he wanted the Second Circuit to enjoin sales of YSL's all-red shoes. "You can't expect us to do that!" Cabranes said.

Lewin then said he wanted the court to order additional discovery to take place before Marrero -- which is a request YSL has already made in its appellate filings. I'll be very surprised if that's not the path the Second Circuit decides to walk, sending the case back to the district court for discovery and a summary judgment ruling. Then we'll get to do the same thing all over again at the Second Circuit, since whichever side loses before Marrero will surely appeal.

Finally, here's a sad coda to all the high-heeled, shiny patent glory at the Second Circuit: I wore my vintage YSL peep-toe pumps to court (bought 'em used for \$25 because I loved the orange insole). As I hustled back to the subway to get to the office and write this post, I tripped and fell in the street. Now I have ripped tights and a bloody knee to remind me of the perils of covering the fashion industry.

(Reporting by Alison Frankel)

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