

Yeshiva University, Cardozo School of Law

LARC @ Cardozo Law

AEIJ Blog

Journal Blogs

3-13-2019

The Red Sole Reflection

Jolie Schenerman

Cardozo Arts & Entertainment Law Journal

Follow this and additional works at: <https://larc.cardozo.yu.edu/aelj-blog>



Part of the [Law Commons](#)

Recommended Citation

Schenerman, Jolie, "The Red Sole Reflection" (2019). *AEIJ Blog*. 195.

<https://larc.cardozo.yu.edu/aelj-blog/195>

This Article is brought to you for free and open access by the Journal Blogs at LARC @ Cardozo Law. It has been accepted for inclusion in AEIJ Blog by an authorized administrator of LARC @ Cardozo Law. For more information, please contact christine.george@yu.edu, ingrid.mattson@yu.edu.

The Red Sole Reflection

BY [JOLIE SCHENERMAN](#) / ON MARCH 13, 2019



Christian Louboutin is continuously disputing what the color on the bottom of their shoes means. Louboutin is recognized by the red soles on their women's shoes, worn by stars such as Kate Winslet, Victoria Beckham and Margot Robbie,[\[1\]](#) and even featured in a Cardi B song. In the most recent controversy, decided by Court of Justice of the European Union, Louboutin prevailed on the trademark protection of their red-soled shoes.[\[2\]](#) However, the red sole is now in peril: a cancellation proceeding with The European Union Intellectual Property Office arose as a result of this litigation.[\[3\]](#) Historically, the red sole has been controversial both with its trademark registration, and Louboutin being the singular user of red on the bottom of shoes.

Christian Louboutin first began selling his shoes on the market in 1992 and was granted trademark protection in the United States—on a third attempt—[\[4\]](#) for the “Red Sole Mark” in 2008.[\[5\]](#) A trademark is “any word, name, symbol, or device” that is used “to identify and distinguish” goods, “and to indicate the source of the goods, even if that source is unknown.”[\[6\]](#) In *Qualitex Co. v. Jacobson Prods. Co. Inc.*, The Supreme Court held that color, when it has acquired source identification status, may be used as a trademark.[\[7\]](#) The color red on the bottom of a shoe has come to signify different things, notably luxury and high status.[\[8\]](#) While the red sole is protectable in theory, in practice this protection may lead to more costs and risks than rewards.

In 2008, Louboutin sought to enforce the use of their mark against Zara when Zara used red on the bottom of their shoes. There, the French Court of Appeal held that the registration for the mark was “unenforceable because the mark sought to be protected was not ‘clear, precise, self-contained, easily accessible, intelligible, durable and objective.’”[\[9\]](#) Since then, Louboutin refiled its registration with a specific Pantone color.[\[10\]](#) This is just one example of the costs associated with color mark registration and enforcement; however, it is important to weigh these costs against the potential loss of revenue if there was no registration.

In the Netherlands, Louboutin was victorious. That case centered around the “European trademark law that forbids the registration of shapes where they add substantial value to goods.”[\[11\]](#) However, the court found that Louboutin was only seeking to protect the application of the color rather than the shape.[\[12\]](#) Louboutin was ultimately successful in its infringement claim; the company that lost, Van Haren, initiated cancellation proceedings against the red sole trademark registration in the European Union.[\[13\]](#) These proceedings have not arrived at any conclusions at this time. While there was a small success in finding infringement, there is a much larger risk with the possibility of having the mark cancelled. Does the price of enforcing a trademark outweigh the possibility of having the trademark cancelled?

Louboutin once again was pseudo-successful in a United States action. In 2011, Yves Saint Laurent made monochrome shoes in different colors, one of which was red. Louboutin filed a motion to enjoin Yves Saint Laurent from marketing the red shoes. Yves Saint Laurent responded by commencing cancellation proceedings for the mark based on its supposed functionality. In the end, the Second Circuit actually lessened the protection that Louboutins

enjoy in the United States to “only to the use of a lacquered red out-sole that contrasts with the adjoining portion of the shoe”^[14] While Louboutin retained its red soles, it is now only protected in the United States if the sole contrasts from the rest of the shoe. Before commencing the suit, Louboutin had broader protections than it ended up with.

One outright loss for the shoe giant lies just outside of the European Union. Louboutin was unsuccessful in obtaining a trademark registration for the red sole in Switzerland.^[15] The Federal Supreme Court of Switzerland found that consumers would “perceive a red out-sole on a shoe as a decorative element rather than a trade mark.”^[16] Further, the Court acknowledged the red sole registration in many other jurisdictions such as the European Union and China; however, it made it clear that they were not legally bound by these decisions.^[17] This is one country that Louboutin will have to manage without protections. It will be an interesting study in the costs and benefits that registration for the bottom of the shoe entails; will the lack of registration hurt the company’s bottom line?

With all of the time, money, and publicity that comes with enforcing its signature red-bottomed shoes, Louboutin has placed its trademark in dangerous territory. There have been numerous cancellation attempts on the trademark in response to litigation commenced by Louboutin; further, courts around the world have modified the registrations, consequently narrowing protection. Something to consider is whether the cost of all of this litigation and push back against foreign registrations really make up for the gains that would be associated with the protection of the red sole.

Jolie Schenerman is a second-year law student at Benjamin N. Cardozo School of Law and a Staff Editor of the Cardozo Arts & Entertainment Law Journal. She is an active member of the Cardozo Fashion Law Society and she hopes to establish a career in the fashion industry. She is also an avid lover of shoes.

^[1] Julia Kollewe, *Christian Louboutin Faces Setback in Fight to Trademark Red Sole*, The Guardian (Feb. 6, 2018), <https://www.theguardian.com/business/2018/feb/06/christian-louboutin-faces-setback-in-fight-to-trademark-red-sole>.

^[2] *Christian Louboutin Lands Victory in Long-Running Dutch Red Sole Shoe Case*, The Fashion Law (Feb. 6, 2019), <http://www.thefashionlaw.com/home/louboutin-lands-victory-in-long-running-dutch-red-sole-shoe-case>.

[3] *Id.*

[4] Driush Adli, *EP's Louboutin Decision Opens the Door for U.S. Businesses to Protect Their Color/Shape Brands in Europe*, IP Watchdog (Sept. 4, 2018), <https://www.ipwatchdog.com/2018/09/04/eps-louboutin-decision-opens-door-for-color-shape-brands-europe/id=100692/>.

[5] *Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012).

[6] 15 U.S.C § 1127.

[7] *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

[8] Raquel Laneri, *Christian Louboutin, YSL and What's so Special About Red-Soled Shoes*, Forbes (Aug. 17, 2011), <https://www.forbes.com/sites/raquellaneri/2011/08/17/christian-louboutin-ysl-and-whats-so-special-about-red-soled-shoes/#4f4430da3fe6>.

[9] Aldi, *supra* note 4.

[10] Dhani Mau, *Zara Defeats Louboutin in Trademark Case, Does This Open the Door for More Red Sole Imitators?*, Fashionista (Jun. 11, 2012), <https://fashionista.com/2012/06/zara-defeats-louboutin-in-trademark-case-does-this-open-the-door-for-more-red-sole-imitators>.

[11] <https://www.theguardian.com/business/2018/jun/12/christian-louboutin-ecj-ruling-red-soled-shoes>.

[12] *Id.*

[13] *Christian Louboutin Lands Victory in Long-Running Dutch Red Sole Shoe Case*, *supra* note 2.

[14] *Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012).

[15] *Louboutin Loses Latest Fight to Register Red Sole Trademark in Switzerland*, The fashion Law (Mar. 28, 2017), <http://www.thefashionlaw.com/home/louboutin-loses-latest-quest-to-register-red-sole-trademark-in-switzerland>; Robert Williams, *Louboutin & the Law: Switzerland Turns Down Red Soles Trademark Request*, women's wear daily (Feb. 27, 2017), <https://wwd.com/fashion-news/fashion-scoops/louboutin-the-law-switzerland-turns-down-red-soles-trademark-request-10823528/>.

[16] John MacKenzie, *Seeing Red: Swiss Court Rules Louboutin's Soles Mere Decoration*, Shepherd + Wedderburn (May 27, 2016), <https://shepwedd.com/knowledge/seeing-red-swiss-court-rules-louboutin-s-soles-mere-decoration>.

[17] *Id.*