

## The Fight for Red: Fashion Statement or Protected Trademark?

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### *Louboutin v. YSL*

Christian Louboutin (“Louboutin”), the designer of the famous red bottom shoes, filed a trademark infringement lawsuit against fashion house Yves Saint Laurent (YSL) claiming YSL infringed on its red sole trademark (the “Red Sole Mark”) by selling a monochrome dress shoe that was entirely red, including a red insole, heel, upper, and outsole. YSL counterclaimed seeking to invalidate Louboutin’s Red Sole Mark arguing it was ornamental and not distinctive and purely functional.

After investing considerable time, money, and effort building a brand based on recognizable red soles in women’s high fashion footwear, Louboutin sought and obtained a federal trademark registration for its red outsole, which became indicative of Louboutin shoes. The Red Sole Mark consists of a lacquered red sole on footwear. Several years later, YSL launched a new line of monochrome shoes in various colors including red. The monochrome shoes featured the same color on the entire shoe. Unhappy with the competitor’s use of a “red sole,” Louboutin filed suit against YSL in United States District Court for the Southern District of New York and sought a preliminary injunction. In denying the injunction request, the District Court found that Louboutin was unlikely to succeed on its infringement claim because its Red Sole Mark was unenforceable due to single-color marks in fashion being inherently functional. The court held that a single color can never serve as a trademark in the fashion industry. Such a *per se* rule was rejected by the Second Circuit appellate court, which held that a single color may be entitled to trademark protection if it acquires secondary meaning and consumers come to recognize that color, as used on the goods or packaging, as identifying the source or producer of the products. As the Supreme Court put it:

over time, customers may come to treat a particular color on a product or its packaging (say, a color that in context seems unusual, such as pink on a firm’s insulating material or red on the head of a large industrial bolt) as signifying a brand. And, if so, that color would have come to identify and distinguish the goods—*i.e.*, “to indicate” their “source”—much in the way that descriptive words on a product . . . can come to indicate a product’s origin.

[*Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163 (1995).]

According to *Qualitex*, a case involving a claim for trade dress protection for the color of a dry-

cleaning press pad, color alone can be protected as a trademark if it does not serve any other significant function. The functionality of a mark is analyzed under two lenses: (1) traditional “utilitarian” functionality, which looks at whether the mark is (i) essential to the use or purpose of the article, or if it (ii) “affects the cost or quality of the article; and “aesthetic” functionality, where protection of the mark significantly undermines competitors’ ability to compete in the relevant market. Both forms of functionality serve as an affirmative defense against a trademark infringement claim.

A mark is functional in a utilitarian sense if it is essential to the use of the article or if it affects the cost of the article. Additionally, if the aesthetic design of the product is the mark itself, that mark can be deemed functional if giving the mark holder the exclusive right would create a significant disadvantage for competitors. For example, in *Johnson & Johnson v. Actavis Group HF* the plaintiff, Johnson & Johnson, brought action to enforce their Gold Mark, the color used on the packaging of the antibiotic ointment NEOSPORIN. The court addressed the Gold Mark’s functionality to determine whether the green/yellow color would significantly hinder competition for other antibiotic ointments. Finding it did not, the court concluded that various other colors were used in packaging of similar products and defendants could not prove the inability to use gold color put competitors at a disadvantage.

Turning to the red bottom shoes, the Second Circuit court did not reach the functionality defense arguments because it found that Louboutin’s Red Sole Mark only offered protection in the case of a *contrasting* shoe color. Meaning, the lacquered red outsole, as applied to a shoe with an “upper” of a different color, has acquired secondary meaning by identifying and distinguishing the Louboutin brand. As such, the distinctive symbol that qualifies for trademark protection is the red bottom on a shoe of a different color, such as black.

Accordingly, the appellate court affirmed the denial of the preliminary injunction finding YSL’s monochromatic red shoes did not infringe on Louboutin’s Red Sole Mark because YSL’s shoes were red throughout and did not use the red sole on a shoe of a different color.

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