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Commercial Law Update

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Louboutin sees rouge: Can other traders colour the soles of their shoes red?

THE BATTLEGROUND – RED SOLES FOR WOMEN’S SHOES

The latest litigation launched by Christian Louboutin regarding his trademarked colour red for the soles of shoes is likely to test the bounds of the protection to which a trade mark owner is entitled.



Classic Louboutin pump with red sole

After famously having started a craze for his red-soled shoes by painting the black soles with red nail polish nearly 20 years ago, Louboutin has since successfully brought pressure to bear on Australian shoemaker PeepToe¹ and other shoemakers internationally² to change the colour of their soles (in the case of PeepToe, it went from red to purple). He has now successfully trademarked the colour red for the application to the soles of shoes in a number of jurisdictions, including the United States in 2008³.

His application to the Australian Trade Marks Office is still under examination at the time of writing⁴.

Louboutin’s latest trade mark suit - against YSL

Louboutin has recently launched a United States suit against Yves Saint Laurent (YSL) for selling red-soled shoes, however, the shoes in question are part of a range of different coloured shoes in which the soles of each pair are coloured to match the upper. The range includes shoes in red, green, tan, purple, and black.

Australian trade mark infringement requires use “as a trade mark”

While to many people’s taste this may result in a product so ostentatious as to be unsaleable, it is also very hard to see how the colour of the sole of these shoes could be said to be being used as a trade mark by YSL. Since it is a part of the overall design and presentation of the shoe, the colouring of the soles in this way is unlikely to constitute “use as a trade mark”, which would be an essential element for successful proof of infringement if the proceedings had been taken in Australia under the Australian *Trade Marks Act 1995* (Cth).



YSL red shoe YSL green shoe

The requirement for “use as a trade mark” by an infringer has bedevilled many claims of infringement by trade mark owners here in Australia over the years⁵. The non-standard marks - shape, colour, sound and smell - each present their own complexities in this area, as these features have not been traditionally used by traders as badges of origin, and accordingly, the Australian case law is still developing.

However, trade mark law is grounded in the idea that a trade mark is used to distinguish the user’s goods from those of other traders. In this respect, it is fundamentally different from the statutory monopoly protection granted to a registered patent.

Footnotes

- 1 PeepToe has denied this is why it changed its sole colour to purple -- see www.sassybella.com.
- 2 See www.wwd.com, and more recently, the Brazilian label, Carmen Steffens, www.sassybella.com, which says it has used soles of various colours on its designs, including red, since 1996.
- 3 See www.counterfeitchic.com.
- 4 See Australian trade mark application number 1352410 (International Registration 1031242) and the image at the end of this article.



Branding using colours, smells, shapes and sounds is more subtle than perhaps sticking on a sticker, label or stamp, but it is still branding. It is likely that the purchasers of Louboutin heels are attracted to them precisely because the soles advertise the brand. The fact that there are few wedge heels in the range (as one can't really see the red sole all that easily on a wedge-heeled shoe) lends support to this theory. Even the bridal shoes in the Louboutin range have a red sole.

RED SOLES NOT A MONOPOLY RIGHT

The above is all terrific marketing but it is not a patentable invention giving rise to a monopoly in this use of the colour red. In other words, the idea that Louboutin had for distinguishing his shoes from the shoes of other traders, and the fact that he has trademarked it nevertheless, does not give him the right to prevent other traders from using the colour on the soles of their shoes if that is part of the overall design of their products.

Another argument that would support YSL's position is that the aesthetics of colour are essential to the fashion industry and its products and they should be allowed to use whatever colours they want on their designs for that reason.

It should also be remembered that a consumer who is about to spend \$1000 or more on a pair of shoes is likely to examine the goods carefully before purchase; the two different products are no doubt quite distinctively and clearly branded on the inner sole with the respective designer's word trade mark or logo, as are most shoes.

Some intellectual property lawyers are predicting that this will be a Goliath versus Goliath legal battle, but it may be over sooner than we think, subject to the slightly different tests for infringement applicable under the United States Lanham (Trademark) Act and the application of United States style doctrines, such as initial interest confusion. Only one thing is certain, fashion will have moved on by then.

STOP PRESS - As predicted in this article, on 10 August 2011 US District Judge Victor Marrero refused the relief sought by Louboutin on the grounds that "awarding one participant in the designer shoe market a monopoly on the colour red would impermissibly hinder competition among other participants." Louboutin's lawyer has said that they did not agree with the judgment and were evaluating the alternatives available.



Image of the trade mark applied for by Christian LOUBOUTIN (Trade Mark Application:1352410) for Class 25: Ladies footwear.

The endorsement reads: The trade mark consists of the colour RED (Pantone No. 18.1663TP) applied to the sole of a shoe as shown in the representation attached to the application form. The outline of the shoe is not part of the trade mark but is intended only to show the trade mark in use.



Footnotes

5. See for example, *Shell Co of Australia Ltd v Esso Standard Oil (Australia) Ltd (Oil Drop case)* (1963) 109 CLR 407; [1963] ALR 634; (1963) 1A IPR 484; BC6300320, and *Top Heavy Pty Ltd v Killin* (1996) 34 IPR 282; (1996) AIPC 91-225; BC9601506 (authority for the "decorative" use of the mark "chill out" on a tee-shirt being allowable as an "exhortation to relax"). Contrast to the position in the United Kingdom where any form of use of the mark in the course of trade may infringe, whether or not the sign is used as a trade mark -- s 10 of the Trade Marks Act 1994.

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