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# A Red Step In The Right Direction But Not Quite There: How The 2nd Circuit Shortchanged Christian Louboutin

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## **A Red Step in the Right Direction but not Quite There: How the 2<sup>nd</sup> Circuit shortchanged**

### **Christian Louboutin.**

#### ***Introduction:***

In some industries it is believed that “Imitation is the sincerest form of flattery”<sup>1</sup>, however, in a trillion dollar industry like fashion, designers beg to differ. “The fashion and apparel sector has become one of the largest and most dynamic in the global economy, accounting for nearly four percent of the total global [Gross Domestic Product], a sum now in excess of \$1 trillion per year.”<sup>2</sup> In fashion, trademark law offers fashion designers some protection for their brands, albeit limited.<sup>3</sup> “For example, this area of law protects designer logos like the Louis Vuitton “LV,” the Chanel “interlocking C,” the Lacoste alligator, the Ralph Lauren polo horse, and other such emblems that are placed directly on garments and accessories.”<sup>4</sup> Yet the limitations of intellectual property law, including trademark law, have caused a great deal of legal controversy in the ever changing fashion industry. “Intellectual property distinguishes a protected work's aesthetic value from its functionality [to then provide protection to the aesthetic value].”<sup>5</sup> Intellectual property law is not always up to speed with the constant creative evolution present in the fashion industry. For instance, the issue of single color trademarks has long been a subject of controversy in both legal and fashion communities, yet no concrete solutions have been provided to resolve this issue.

Luxury brands Christian Louboutin and Yves Saint Laurent brought the issue of single color trademarks to the forefront in 2011 with a legal battle that ensued for a year. However, the Second Circuit essentially punted on the question of single color trademarks in its 2012 decision providing Christian Louboutin with a less than desirable level of protection for his red sole.

This paper will be divided into five sections; Part I will present pertinent background information about the Christian Louboutin brand; Part II will provide a historical overview of single color trademark cases; Part III will address both the District Court and Second Circuit *Christian Louboutin v. Yves Saint Laurent* opinions; Part IV will discuss the fallacies in the limited trademark protection the Second Circuit granted to Christian Louboutin with some suggestions for strengthening the protection afforded to the red sole or any other single color trademarks and Part V will provide the conclusion.

### **Part I: Christian Louboutin Brand Information:**

Christian Louboutin is a French luxury, high fashion shoe and handbag designer whose brand has achieved worldwide notoriety and success. He began his solo career in 1991 in Paris designing shoes for iconic clients such as Princess Caroline of Monaco.<sup>6</sup> In 1992, he conceived the iconic red soles that would become the trademark and very essence of his brand.<sup>7</sup> Finding that his shoe prototype was lacking something, Louboutin borrowed red nail polish from his assistant and painted the soles a high gloss red.<sup>8</sup> The Chinese –red sole [went on to] become Louboutin’s signature.”<sup>9</sup> “In 2008, he registered the red lacquered outsole as a trademark with the United States Patent and Trademark Office (“PTO”).”<sup>10</sup> “Specifically, the registration for the Louboutin mark states: “The color(s) red is/are claimed as a feature of the mark. The mark consists of a lacquered red sole on footwear.” Joint App’x 294 (capitalization altered).”<sup>11</sup> ““The shiny red color of the soles has no function other than to identify to the public that they are mine,” he attested, in a petition to the court... “I selected the color because it is engaging, flirtatious, memorable, and the color of passion.””<sup>12</sup>

By 2012, Louboutin was selling over five hundred thousand pairs of his red soled shoes annually at prices ranging from three hundred and ninety-five dollars to six thousand dollars.<sup>13</sup>

“The sole of each of his shoes is lacquered in a vivid, glossy red. The red soles offer the pleasure of secret knowledge to their wearer, and that of serendipity to their beholder. Like Louis XIV’s red heels, they signal a sort of sumptuary code, promising a world of glamour and privilege. They are also a marketing gimmick that renders an otherwise indistinguishable product instantly recognizable. Elizabeth Semmelhack, the senior curator at the Bata Shoe Museum, in Toronto, [said], “Louboutin took a part of the shoe that had previously been ignored and made it not only visually interesting but commercially useful.” With flickers of telltale color, Louboutin’s shoes issue their own press release...he has elicited the most frenzied attention to soles since the days of Adlai Stevenson.”<sup>14</sup>

The high gloss red sole on every Louboutin shoe is the brand; without it, there is no Christian Louboutin shoe. “Part of the genius of the red sole is that it is beautiful.”<sup>15</sup> Christian Louboutin previously stated “My red soles are a part of my identity because people relate them to me, to my shoes and to my work.”<sup>16</sup> Even when creating high cost custom shoes for elite clients, Louboutin will not tweak the color of his sole.<sup>17</sup> Regardless of the potential profit, that request is simply out of the question. “Louboutins [with their red sole] have penetrated...the acquisitive consciousnesses of even the most far-flung shoppers.”<sup>18</sup>

With colossal success and popularity, like that achieved by the Christian Louboutin brand, comes imitation whether deliberate or unintentional. Christian Louboutin’s brand and red soles are synonymous, thus the need to legally protect them is inherent. The tense legal battle caused by the Christian Louboutin and Yves Saint Laurent red sole controversy gives the impression that issues involving single color trademarks have been sparsely discussed in case law. However, the following section demonstrates that this is in fact a fairly developed area of law.

## Part II: A Historical Overview of Single Color Trademark Cases

### A. *Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.* (1906)

Appellant Leschen & Sons Rope Company “Leschen” brought this action against appellee for the trademark infringement of a wire rope registered under the act of Congress.<sup>19</sup> Leschen registered a trademark for a high grade of wire rope with a strand of a different color from the other strands of the.<sup>20</sup> The rope, with the one distinctive strand, had been heavily advertised with high sales thus the trademark was registered on December 4, 1900.<sup>21</sup> Appellee unlawfully used appellant’s trademarked rope arguing that the trademark was invalid.<sup>22</sup>

The trademark reads as follows: ““The trademark consists of a red or other distinctively colored streak applied to or woven in a wire rope. The color of the streak may be varied at will, so long as it is distinctive from the color an[d] body of the rope.”<sup>23</sup> The court ultimately found this trademark invalid because the language was overly broad and gave the appellant a monopoly over every color in existence.<sup>24</sup> When discussing the role of colors in trademarks Justice Brown said:

“Whether mere color can constitute a valid trademark may admit of doubt. Doubtless it may, if it be impressed in a particular design, as a circle, square, triangle, a cross, or a star. But the authorities do not go farther than this... ‘It is the plain intention of the act that, where the distinction of the mark depends upon color, that will not do. You may register a mark, which is otherwise distinctive, in color, and that gives you the right to use it in any color you like; but you cannot register a mark of which the only distinction is the use of a color, because practically, under the terms of the act, that would give you a monopoly of all the colors of the rainbow.’<sup>25</sup>

Justice Brown clearly expressed that his interpretation of the act of Congress prohibited the use of single color trademarks.<sup>26</sup> Colors alone despite any attached symbolism could not be registered as valid trademarks.<sup>27</sup>

***B. Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.(1945)***

Both plaintiff and defendant involved in this case operated well known and reputable transport businesses in Louisville, Kentucky as well as in many other separate cities.<sup>28</sup> Appellee Louisville Taxicab was engaged in a taxicab business using yellow cars with black trimmings for freight, truck, passenger and baggage transport.<sup>29</sup> Many names were adopted for this business namely featuring the word “yellow” such as “Yellow Cab”, “Yellow Truck Rental” and “Yellow Baggage Service”.<sup>30</sup> Shortly thereafter, appellant organized the Yellow Cab Transit Company which provided freight transport services in many locales including Louisville, Kentucky.<sup>31</sup> As appellant never engaged in the taxi cab business, the name of the company was changed to Yellow Transit Company, however similar to appellees, appellant operated yellow vehicles with black fenders.<sup>32</sup> Appellees filed this action to enjoin appellants from using “yellow” in their company name or advertisements as its use was causing brand confusion among consumers.<sup>33</sup>

The District Court enjoined the appellant ““1. (a) From using, employing, displaying or advertising the trade name ‘Yellow Cab’ or any variation thereof or similar name in connection with the operation and conduct of its transportation business in Louisville or Jefferson County, Kentucky [and] (b) [f]rom using, employing, displaying or advertising the trade name ‘Yellow Transit’ or any variation thereof or similar name in combination with the distinctive yellow color scheme, designs or markings of the plaintiff, in connection with the operation and conduct of its transportation business in Louisville or Jefferson County, Kentucky.”<sup>34</sup>

The District Court reasoned that the use of the color and design as well as the name “Yellow Transit Company” could cause a reasonable person to believe that both companies were connected to the appellee.<sup>35</sup> This reasoning was in line with the brand confusion argument advanced by the appellees.<sup>36</sup>

The Sixth Circuit partially agreed with the District Court but found the scope of its holding was overly broad by requiring the appellant to abandon the company name or vehicle

colors despite the fact that the parties operate distinct transportation businesses.<sup>37</sup> “From the most favorable aspect of protection of appellee's right against adoption by others of the words and color used by it in connection with its business, which have acquired a secondary meaning as identifying in the public mind appellee's business and transportation service, we are confronted with a border-line case in the field of the constantly expanding doctrine of unfair competition. There is no direct competition between the parties involved.”<sup>38</sup>

When addressing the matter of registering the single color yellow as a trademark, the Sixth Circuit stated:

“The appellee has no exclusive right to the use of the primary color yellow; but is entitled to protection in its long established use of the color yellow on its taxicabs in Louisville, inasmuch as it has acquired a good will by use of the yellow color scheme on taxicabs by virtue of appropriate application of the doctrine of secondary meaning. Relief is not precluded by the fact that the appellant is not an actual competitor of the appellee. The extent of the relief to be accorded appellee is for determination upon equitable principles. As has been previously indicated, paragraph 1(b) of the decree entered below is too broad and should be stricken; and, in lieu thereof, provisions should be inserted in the decree which will fairly balance the equities between the parties.”<sup>39</sup>

Judge Martin suggested replacing paragraph 1(b) with language requiring appellant to place large legible signs on its buildings and cars displaying the words: “Yellow Transit Company, of Oklahoma City Oklahoma Freight Lines.”<sup>40</sup> “Appellant’s leased pickup trucks should remain yellow per leasee’s request but the commercial coups should be distinguished with colors other than yellow so as to not be confused with appellee’s taxi cabs.”<sup>41</sup>

It is important to note that this case represents a shift in thought from *the Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.* case. While the court in *Leschen & Sons Rope Co.* outright prohibited single color trademarks, the court in *Yellow Cab Transit Co.* conveyed the appellee’s right to protection in its established use of yellow taxicabs.<sup>42</sup>

### *C. Application of HEHR Manufacturing Company. (1960)*

HEHR Manufacturing Company (HEHR) appealed the decision of the Trade-Mark Trial and Appeal Board of the United States Patent Office which refused to register appellant's trademark.<sup>43</sup> The trademark in dispute was "a square red label upon which appellant's secondary trademarks were usually placed which were for use on windows and ventilators for automobile trailers."<sup>44</sup> Chief Judge Worley reversed and held that the red square labels sufficiently distinguished and identified appellant's goods thus warranted trademark registration.<sup>45</sup>

HEHR began marking its products by sticking square red labels on them in 1950 and has continuously marked them since then.<sup>46</sup> Even without the secondary marks, the red square labels are readily identified by the public as goods pertaining to HEHR.<sup>47</sup> "As a result, a series of advertisements were prepared commencing in March 1954, and continuing to date, which repeatedly emphasized the shape and color of the Red Square per se as a trademark identifying Petitioner's goods."<sup>48</sup> HEHR spent over thirty thousand dollars advertising the red square with slogans stressing the red square as an identifying trademark.<sup>49</sup> Phrases such as "Always look for the Red Sticker" were used in advertisements, some of which only bore the red square with no secondary trademark.<sup>50</sup>

Many factors must be analyzed when deciding whether a trademark can be registered. "With respect to the degree of proof required to establish a secondary meaning sufficient to identify an applicant's goods, the statute is silent except for the suggestion that substantially exclusive use for a period of five years immediately preceding filing of an application may be considered prima facie evidence."<sup>51</sup> "The general principle derived from those decisions is that unless a design is inherently distinctive it is registrable only if sufficient evidence is presented to



show that it has acquired secondary meaning as a trademark; and that the exact kind and amount of evidence necessary to establish such meaning necessarily depends on the circumstances of the particular case.”<sup>52</sup>

A shift in single color trademark analysis is also present in this case, as unlike the court in *Leschen & Sons Rope Co.* and *Yellow Cab Transit Co.*; this court applied the doctrine of secondary meaning.

***D. In re Owens-Corning Fiberglas Corp.(1985)***

In this case, Owens-Corning Fiberglas Corporation “OCF” appealed the decision of the United States Patent and Trademark Office's Trademark Trial and Appeal Board which held that the color pink could not be registered as a trademark for fibrous glass residential insulation.<sup>53</sup> “OCF submitted extensive affidavit and documentary evidence [showing they had] advertised the “pink” color mark as applied to fibrous glass residential insulation since 1956; that OCF spent approximately \$42,421,000 on consumer advertising for its “pink” insulation in the media of television, radio, newspapers, and consumer magazines during the period of 1972 through 1981, with an estimated expenditure of \$11,400,000 in 1981 alone; and that additional sums were spent on brochures, displays, and other promotional items that highlighted the “pink” color as applied to applicant's insulation.”<sup>54</sup> OCF also equipped their many radio and television commercials with statements such as “think pink”, “plant some pink insulation in your attic”, “America’s favorite pink product” and “beat the cold with pink” ultimately making a “syndetic” relationship between the color “pink” and OCF.<sup>55</sup> “The Court of Appeals held that: (1) color “pink” had no utilitarian purpose, did not deprive competitors of any reasonable right or competitive need, and, thus, was not barred from registration as a trademark on the basis of functionality, and (2) manufacturer was entitled to register the color “pink” as a trademark for its

fibrous glass residential insulation under section of Lanham Trade-Mark Act codifying the common-law doctrine of secondary meaning.”<sup>56</sup>

The Lanham Act allows people to protect their brands via trademark registration.<sup>57</sup> This protection prevents brand confusion among consumers.<sup>58</sup> The legislative history of the Act clearly shows its objective to make trademark registration more liberal by modernizing trademark statutes so they conform to present-day business practice.<sup>59</sup> Section 45 of the Act defines “trademark” to include “any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others [ marking a departure from prior statutes which only permitted registration of common law trademarks].”<sup>60</sup> “The preamble of section 2 of the Lanham Act states that “[n]o trademark ... shall be refused registration on the principal register on account of its nature”, unless one or more specific exceptions to registrability set forth in that section apply, [c]olor is not such an exception.”<sup>61</sup> “In determining registrability of color marks, courts have considered factors such as the nature of the goods, how the color is used, the number of colors or color combinations available, the number of competitors, and customary marketing practices.”<sup>62</sup>

“Note the following examples where, in determining registrability of trademarks based on color, the Lanham Act has been applied with exercise of judgment, as Congress intended. In *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (CCPA 1960), the court allowed registration of a square red label for use on automobile trailer windows wherein the only distinctiveness of the label was its color. In *In re Data Packaging Corp.*, 453 F.2d 1300, 172 USPQ 396 (CCPA 1972), the court allowed registration of a mark consisting of a colored band applied to a computer tape reel of contrasting color. In *Plastilite Corp. v. Kassnar Imports*, 508 F.2d 824, 184 USPQ 348 (CCPA 1975), registration was denied to a combination of yellow and orange colors for fishing floats, on the basis that the color scheme lacked distinctiveness. In *In re Shaw*, 184 USPQ 253 (TTAB 1974), the Board

denied trademark registration for green suede book covers on the ground of lack of distinctiveness. The standard for registrability was that the color be arbitrarily applied to the goods, in a distinctive way. Contrary to an absolute prohibition on registrability of color marks, administrative and judicial implementation of the statute illustrates that each case is decided upon its facts.”<sup>63</sup>

When a color serves a primarily utilitarian purpose when applied to goods, it cannot be protected by trademark.<sup>64</sup> The color must not be functional and a secondary meaning must be established.<sup>65</sup>

“The Supreme Court of the United States has stated a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.”<sup>66</sup> “In *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1340–41, 213 USPQ 9, 15–16 (CCPA 1982), the court [examined] the following factors to determine functionality: (1) whether a particular design yields a utilitarian advantage, (2) whether alternative designs are available in order to avoid hindering competition, and (3) whether the design achieves economies in manufacture or use.”<sup>67</sup> The Court of Appeals held the use of the color pink was non-functional in nature because in the insulation industry, there is no competitive need for colors to remain available as any color can be used for insulation.<sup>68</sup> Thus, none of the above mentioned factors were violated by OCF.<sup>69</sup> A secondary meaning for the color pink was also established by OCF; with the use of radio, television commercials and slogans the pink color of the insulation became synonymous with OCF’s company.

This case also exhibits a shift in single color trademark case law because it relied heavily on the Lanham Act and provided a more systematic approach for trademark disputes.

#### ***E. Qualitex Co. v. Jacobson Products Co.(1995)***

In *Qualitex Co.*, plaintiff Qualitex Company used the same shade of gold-green on its dry cleaning pads for many years ultimately trade marking the color once competitor defendant Jacobson Products began to use the same color on its pads.<sup>70</sup> Plaintiff filed suit against defendant for trademark infringement when defendant continued to use the gold-green color on its pads.<sup>71</sup> The District Court affirmed Qualitex’s trademark and claim; however the Ninth Circuit reversed, stating the Lanham Act does not permit the registration of single color trademarks.<sup>72</sup> Upon review, the Supreme Court of the United States held that in fact the Lanham Act does not bar single color trademark registration.<sup>73</sup>

“The Lanham Act gives a seller or producer the exclusive right to “register” a trademark, 15 U.S.C. § 1052 (1988 ed. and Supp. V), and to prevent his or her competitors from using that trademark, § 1114(1). Both the language of the Act and the basic underlying principles of trademark law would seem to include color within the universe of things that can qualify as a trademark. The language of the Lanham Act describes that universe in the broadest of terms. It says that trademarks “includ[e] any word, name, symbol, or device, or any combination thereof.” § 1127. Since human beings might use as a “symbol” or “device” almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive. The courts and the Patent and Trademark Office have authorized for use as a mark a particular shape (of a Coca-Cola bottle), a particular sound (of NBC's three chimes), and even a particular scent (of plumeria blossoms on sewing thread)...If a shape, a sound, and a fragrance can act as symbols why, one might ask, can a color not do the same?”<sup>74</sup>

Colors may not be similar to suggestive words or slogans that immediately identify brands however the Doctrine of Secondary Meaning allows them to enjoy similar identifying capabilities.<sup>75</sup> “[O]ver 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...[a]nd, 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 (say, “Trim” on nail clippers or “Car-Freshner” on

deodorizer) can come to indicate a product's origin.”<sup>76</sup> “[S]econdary meaning” is acquired when “in the minds of the public, the primary significance of a product feature [like the color in this case] ... is to identify the source of the product rather than the product itself”).”<sup>77</sup>

After the identifying mechanism is deemed to sufficiently classify the brand in the minds of consumers whether via suggestive words or secondary meaning, the functionality doctrine can still render it ineligible for trademark registration.<sup>78</sup> “The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.”<sup>79</sup> “If a product's functional features could be used as trademarks ... a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).”<sup>80</sup> “[I]n general terms, a product feature is functional,” and cannot serve as a trademark, “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,” that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.”<sup>81</sup>

There are many instances where color is not essential to the use, quality or cost of a product, where it does not play an important role in the desirability of said product.<sup>82</sup> That is indicative of the inapplicability of the functionality doctrine.<sup>83</sup> That very scenario is highlighted within the facts of this case, the gold green color does not make the dry cleaning pads more desirable, nor does it serve an essential role to the use of the product.

#### ***F. Mana Products, Inc. v. Columbia Cosmetics Mfg., Inc.***

In *Mana Products, Inc.*, “Plaintiff Mana Products, Inc. “Mana” appealed from a judgment that granted summary judgment to defendants Columbia Cosmetics Mfg. Inc., “Columbia” and dismissed plaintiff’s complaint for trade dress infringement under the Lanham Act, 15 U.S.C. §

1051-1127 (1988), the New York state common law of unfair competition, and the New York Anti-dilution statute, N.Y.Gen.Bus.Law § 368-d (McKinney 1984).”<sup>84</sup> Mana alleged that Columbia sold and continues to sell a line of cosmetics that in every significant way is a copy of Mana's makeup products.”<sup>85</sup> Both Companies manufacture and sell wholesale lines of cosmetics to retailers throughout the United States.<sup>86</sup> Plaintiff alleged that defendant began selling cosmetics which infringed on the rights Mana has to its products.<sup>87</sup>

One of the main arguments advanced by the plaintiff is that the cosmetic compact's black color should be protected by trademark law.<sup>88</sup>

“... at one time it was accepted that trademark protection could not be granted for color alone. See Richard J. Berman, Note, *Color Me Bad: A New Solution to the Debate Over Color Trademark Registration*, 63 Geo.Wash.L.Rev. 111 (1994). Sweeping away that barrier the Federal Circuit in *In re Owens-Corning*, 774 F.2d at 1116, permitted Owens-Corning to register the color pink for its insulation material. And now the debate over whether color alone may be a valid trademark has been put to rest earlier this year in *Qualitex Co. v. Jacobson Products Co. Inc.*, 514 U.S. 159, 115 S.Ct. 1300, 131 L.Ed.2d 248 (1995). See also *Fabrication Enterprises, Inc. v. The Hygienic Corporation*, 64 F.3d 53 (2d Cir.1995). In *Qualitex* the Supreme Court could not discern any “obvious theoretical objection”-based on the purposes of trademark law-why color alone should not obtain protection where the color attains secondary meaning, thereby identifying a particular product as to its source. *Qualitex*, 514 U.S. at ----, 115 S.Ct. at 1303. In light of the Supreme Court's decision in *Qualitex*, color is today capable of obtaining trademark status in the same manner that a descriptive mark satisfies the statutory definition of a trademark, by acting as a symbol and attaining secondary meaning. In *Qualitex*, the Supreme Court held that the green-gold color of plaintiff's dry cleaning press pads qualified as a trademark under the broad terms of the Lanham Act. The Court reasoned that “over time, customers may come to treat a particular color on a product or its packaging ... 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.’ ” *Id.* at ----, 115 S.Ct. at 1303. In this instance, the Court found that although the green-gold color may not be inherently distinctive, it has developed secondary meaning.”<sup>89</sup>

The court provided six factors to determine whether a mark allows consumers to associate a given product with its source: “These elements are: “(1) advertising expenditures, (2) consumer studies linking the mark to a source, (3) unsolicited media coverage of the product, (4) sales

success, (5) attempts to plagiarize the mark, and (6) length and exclusivity of the mark's use.”<sup>90</sup>

The Plaintiff failed to provide sufficient evidence to show that the black color of their compacts acquired secondary meaning and identified their products to consumers.<sup>91</sup>

“... although color may be a protected trademark, it is not always so protected. The color black does not act as a symbol and distinguish Mana's compacts from its competitors. It does not identify plaintiff as the source because there are countless numbers of cosmetic companies that sell black compacts. The district court properly recognized that the color black could not reasonably be given protection since it would be analogous to “according trade dress protection to a product's ‘plain brown wrapper’ merely because it did not have to be brown.” We agree that black is as common a color for a makeup case as brown is for a paper bag.”<sup>92</sup>

This court relied heavily on case law from most of the cases discussed in this section. Its single color trademark analysis serves as a good synthesis of the applicable law.

### **Part III: Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.**

#### ***A. District Court Opinion***

As discussed in the Part I “Brand Information” portion of this paper, Plaintiff Christian Louboutin is a luxury, high fashion footwear and accessory designer. In 2008 the USPTO granted Christian Louboutin’s application for trademark ownership of its red sole. Below is the image and language produced on the trademark registration form:



“FOR: WOMEN'S HIGH FASHION DESIGNER FOOTWEAR, IN CLASS 25 (U.S. CLS. 22 AND 39). FIRST USE 0-0-1992; IN COMMERCE 0-0-1992. THE COLOR(S) RED IS/ARE CLAIMED AS A FEATURE OF THE MARK. THE MARK CONSISTS OF A LACQUERED RED SOLE ON FOOTWEAR.

THE DOTTED LINES ARE NOT PART OF THE MARK BUT ARE INTENDED ONLY TO SHOW PLACEMENT OF THE MARK.”<sup>93</sup>

Defendant Yves Saint Laurent (YSL), another high fashion designer, released a line in 2011 with four monochromatic shoes made available in many colors including red.<sup>94</sup> The red monochromatic shoes contained a red glossy sole.<sup>95</sup> Louboutin filed the present action after YSL refused to withdraw the red monochromatic shoes. He was alleging “claims under the Lanham Act for (1) trademark infringement and counterfeiting, (2) false designation of origin and unfair competition and (3) trademark dilution, as well as state law claims for (4) trademark infringement, (5) trademark dilution, (6) unfair competition and (7) unlawful deceptive acts and practices.”<sup>96</sup> In response YSL counterclaimed seeking “(1) cancellation of the Red Sole Mark on the grounds that it is (a) not distinctive, (b) ornamental, (c) functional, and (d) was secured by fraud on the PTO, as well as (2) damages for (a) tortious interference with business relations and (b) unfair competition.”<sup>97</sup>

In order to succeed on the trademark infringement claims under the Lanham Act, Louboutin must show “(1) its Red Sole Mark merits protection and (2) YSL's use of the same or a sufficiently similar mark is likely to cause consumer confusion as to the origin or sponsorship of YSL's shoes.”<sup>450</sup>

*1. Whether Louboutin's Red Sole merits protection*

When approaching this question, the District Court followed the analysis mentioned in many of the cases discussed above, beginning with a discussion of the validity of color trademarks. “Color alone “*sometimes*” may be protectable as a trademark, “where that color has attained ‘secondary meaning’ and therefore identifies and distinguishes a particular brand (and thus indicates its ‘source’).”<sup>98</sup> In the event that secondary meaning is found, the doctrine of



functionality is applied barring trademarks for anything that is functional or essential to the use of the product.<sup>99</sup> As defined in the Restatement (Third) of Unfair Competition, a design is functional if its “aesthetic value” is able to “confe [r] a significant benefit that cannot practically be duplicated by the use of alternative designs.”<sup>100</sup>

The District Court made a careful distinction between allowing single color trademarks in industrial products and fashion products. In the former, color merely serves the purpose of identifying the product while in the latter, color is much more significant.<sup>101</sup> The fashion industry is about creativity and aesthetics, where color does not merely identify rather it advances “expressive, ornamental and aesthetic purposes”.<sup>102</sup> “Hence, color in this context plays a unique role... color in turn elementally performs a creative function; it aims to please or be useful, not to identify and advertise a commercial source.”<sup>103</sup> Thus, the fear of the District Court was that allowing Christian Louboutin to trademark the glossy Chinese red sole would give him a monopoly in the fashion industry and stifle creativity, competition and art.<sup>104</sup> “Louboutin's claim to “the color red” is, without some limitation, overly broad and inconsistent with the scheme of trademark registration established by the Lanham Act...[a]warding one participant in the designer shoe market a monopoly on the color red would impermissibly hinder competition among other participants.”<sup>105</sup> “If Louboutin owns Chinese Red for the outsole of high fashion women's shoes, another designer can just as well stake out a claim for exclusive use of another shade of red, or indeed even Louboutin's color, for the insole, while yet another could, like the world colonizers of eras past dividing conquered territories and markets, plant its flag on the entire heel for its Chinese Red... [A]nd who is to stop YSL, which declares it pioneered the monochrome shoe design, from trumping the whole footwear design industry by asserting rights to the single color shoe concept in all shades?”<sup>106</sup> The fear of color wars and findings of

aesthetic functionality when it comes to color in the fashion industry left the District Court less than convinced that Louboutin's trademark was enforceable.

### ***B. Second Circuit Opinion***

The Second Circuit disagreed with the District Court's finding that single color trademarks are invalid however it also found the trademark was invalid in its current state. The Second Circuit found the mark acquired distinctiveness and secondary meaning only when the red sole is contrasting with the remainder of the shoe.<sup>107</sup>

“The crucial question in a case involving secondary meaning always is whether the public is moved in any degree to buy an article because of its source. Factors that are relevant in determining secondary meaning include (1) advertising expenditures, (2) consumer studies linking the mark to a source, (3) unsolicited media coverage of the product, (4) sales success, (5) attempts to plagiarize the mark, and, (6) length and exclusivity of the mark's use... The record before the District Court included extensive evidence of Louboutin's advertising expenditures, media coverage, and sales success, demonstrating both that Louboutin has created a “symbol” within the meaning of *Qualitex*, see *Qualitex*, 514 U.S. at 162, 115 S.Ct. 1300, and that the symbol has gained secondary meaning that causes it to be “uniquely” associated with the Louboutin brand... There is no dispute that Louboutin originated this particular commercial use of the lacquered red color over twenty years ago. As the District Court determined, in findings of fact that are supported by the record and not clearly erroneous, “Louboutin invested substantial amounts of capital building a reputation and good will, as well as promoting and protecting Louboutin's claim to exclusive ownership of the mark as its signature in women's high fashion footwear. And there is no dispute that Louboutin's efforts were successful “to the point where, in the high-stakes commercial markets and social circles in which these things matter a great deal, the red outsole became closely associated with Louboutin, and where unsolicited media attention to that red sole became rampant.”<sup>108</sup>

The Court found the evidence provided by Louboutin of historical significance, media attention, consumer surveys; notoriety etc. indicates that the secondary meaning obtained by the red sole depends on the contrast with the remainder of the shoe making the red sole “pop”.<sup>109</sup>

### **Part IV: Critiquing the Second Circuit Decision**

### *A. Issues*

There are many issues with the Second Circuit's solution for the Louboutin trademark controversy. First, by allowing use of the red sole in shoes with red uppers, the Second Circuit is enabling and facilitating many of the harms the Lanham Act intended to remedy. Despite the limitations applied to the "lawful" use of the lacquered Chinese red sole, the potential for brand confusion is still alive and well if any designer is free to use the same sole. The high gloss flash of the red sole is the very essence of Christian Louboutin shoes; many would venture to say that the sole alone is the brand. The flash of red immediately identifies the luxury brand to most; however that identifying element will soon be shared with any other brand as long as their shoe does not have a "contrasting" upper. Because of the immense variety of designs in Christian Louboutin collections, almost any shoe with a red lacquered sole could be perceived as a Louboutin shoe despite quality or design. This will dilute Mr. Louboutin's brand, which contradicts the purpose of the Lanham Act.

The Second Circuit's limited trademark also alleviates some concerns for counterfeiters, despite the fact that counterfeiting is a serious problem in the fashion industry. "[Co]nfusing the customer is the whole purpose of creating counterfeit goods...one produces counterfeit goods in an apparent attempt to capitalize upon the popularity of, and demand for, another's product."<sup>110</sup> Those whose sole purpose is to confuse customers into purchasing counterfeit replicas of Christian Louboutin shoes can now advance an argument as to why their red sole shoes with "non-contrasting" uppers are not counterfeit, as they do not even rise to the level of trademark infringement. They can now legally trick consumers into buying their shoes with red "uppers" and a high gloss Chinese red sole.

Another significant defect in the Second Circuit’s analysis is the assertion that Christian Louboutin’s red sole only achieves secondary meaning when the shoe has a “contrasting” upper. The court provided six factors to apply when searching for the existence of a secondary meaning. “Factors that are relevant in determining secondary meaning include (1) advertising expenditures, (2) consumer studies linking the mark to a source, (3) unsolicited media coverage of the product, (4) sales success, (5) attempts to plagiarize the mark, and, (6) length and exclusivity of the mark's use...”<sup>111</sup> In the *Owens Corning Fiberglass* case, those factors were essential to the discovery of a secondary meaning for the color pink used in the plaintiff’s insulation.<sup>112</sup> It was the extensive extrinsic evidence provided by the plaintiff that proved the existence of a secondary meaning.<sup>113</sup> The evidence provided included: “affidavit and documentary evidence [showing they] advertised the “pink” color mark as applied to fibrous glass residential insulation since 1956; that OCF spent approximately \$42,421,000 on consumer advertising for its “pink” insulation in the media of television, radio, newspapers, and consumer magazines during the period of 1972 through 1981, with an estimated expenditure of \$11,400,000 in 1981 alone; and that additional sums were spent on brochures, displays, and other promotional items that highlighted the “pink” color as applied to applicant's insulation.”<sup>114</sup> OCF also provided evidence of the use of statements such as “think pink”, “plant some pink insulation in your attic”, “America’s favorite pink product” and “beat the cold with pink” in all advertisements, ultimately making the color “pink” synonymous with OCF.<sup>115</sup>

Christian Louboutin provided the following extrinsic evidence to show his red sole achieved secondary meaning regardless of the color on the “upper” part of his shoes.

“The record before the District Court included extensive evidence of Louboutin's advertising expenditures, media coverage, and sales success, demonstrating both that Louboutin has created a “symbol” within the meaning of *Qualitex*, see

*Qualitex* ... and that the symbol has gained secondary meaning that causes it to be “uniquely” associated with the Louboutin brand, *see Two Pesos, Inc.*, 505 U.S. at 766 n. 4, 112 S.Ct. 2753.... “Louboutin invested substantial amounts of capital building a reputation and good will, as well as promoting and protecting Louboutin's claim to exclusive ownership of the mark as its signature in women's high fashion footwear.” *Louboutin*, 778 F.Supp.2d at 447. And there is no dispute that Louboutin's efforts were successful “to the point where, in the high-stakes commercial markets and social circles in which these things matter a great deal, the red outsole became closely associated with Louboutin,” *id.* at 447–48 (emphasis added), and where unsolicited media attention to that red sole became rampant. Indeed, the Chief Executive Officer of YSL's parent corporation, François–Henri Pinault, himself acknowledged that, “[i]n the fashion or luxury world, it is absolutely clear that we recognize the notoriety of the distinctive signature constituted by the red sole of LOUBOUTIN models in contrast with the general presentation of the model, particularly its upper, and so for all shades of red.”<sup>24</sup> Joint App'x 529. In light of the evidence in the record, including extensive consumer surveys submitted by both parties during the preliminary injunction proceedings, and of the factual findings of the District Court, we think it plain that Louboutin's marketing efforts have created what the able district judge described as “a ... brand with worldwide recognition,” *Louboutin*, 778 F.Supp.2d at 448. By placing the color red “in [a] context [that] seems unusual,” *Qualitex*, 514 U.S. at 162, 115 S.Ct. 1300, and deliberately tying that color to his product, Louboutin has created an identifying mark firmly associated with his brand which, “to those in the know,” “instantly” denotes his shoes' source, *Louboutin*, 778 F.Supp.2d at 448.”<sup>116</sup>

The evidence described above makes a persuasive argument for Christian Louboutin’s red soles to achieve secondary meaning regardless of the color of the remainder of the shoe. As mentioned above, Louboutin invested a substantial amount in advertising, demonstrated extensive media coverage, significant sales success and a solid reputation among other things. His red soles have become “closely associated” with him and his brand both in high end social circles and mainstream culture. It is difficult to understand how the Second Circuit interpreted all the success, fame, public esteem and instant recognition of Mr. Louboutin’s red soles, to only demonstrate a secondary meaning when the red sole “contrasts” with the upper part of the shoe. Contrary to what the Second Circuit argues, the evidence explicitly indicates that the public’s instant association of the red sole with Christian Louboutin shoes occurs regardless of the actual

shoe's color. Consumers are not identifying distinct soles and shoes as Christian Louboutins; they are identifying all shoes with high gloss, Chinese red soles as Christian Louboutins. The power and brand is in the red sole, not in the contrast created by a black shoe with a red sole. During surveys, when consumers were shown different Louboutin shoes as well as the Yves Saint Laurent monochrome shoes, "the consumers who misidentified the pictured shoes as Louboutin-made... cited the red *sole* of the shoe..."(refer to this endnote for another example)<sup>117</sup> Again, the identifying element is always the red sole, not the contrast created by different color shoes with red soles.

Another issue in the Second Circuit's analysis, is the fear of the alleged "color war" that will erupt if Christian Louboutin is allowed to fully trademark his red sole. It is unlikely that the fashion industry will turn into a territorial color hunting frenzy attempting to trademark single colors on obscure locations on apparel or accessories. Notable Intellectual Property attorney Stacy Riordan also advanced the "color war" argument, in her podcast interview about the Christian Louboutin case. She stated:

"The problem with color is, there is only a limited number of colors although the shades are probably indefinite and designers need to be able to use whatever color they want on whatever part of a garment that they want to use. If you give one person an exclusive right to the color red, no one else can use that color. So then you are going to have shoes that if he owns red, someone may own blue, someone may own yellow and imagine if Reebok tries to own... black for the color of sneakers or purple or something like that. If the trademark is upheld, I think it is going to cause chaos in the fashion industry."<sup>118</sup>

This "color war" argument is unpersuasive and premature as, designers attempting to wage these alleged "color wars" will find it difficult to prove the secondary meaning of their colors without that synonymous status achieved by Christian Louboutin's red sole. For example, Tiffany & Co., the luxury jeweler, trademarked the color "Tiffany Blue" in 1998 and a color war has yet to erupt

among members of the jewelry industry. It is not easy for colors to achieve the status and meaning that “Tiffany blue” and Christian Louboutin’s lacquered red sole have achieved in the fashion industry.

Even if designers did attempt to wage a “color war”, the Lanham Act has built in safe guards to prevent that from occurring and wreaking havoc on the fashion industry. As established in the case law presented above, at the most basic level, in order to achieve trademark registration the symbol must be synonymous with the brand serving as an identifier expressly or via secondary meaning. In the *Mana Products, Inc.* case, the court stated that although there are not set rules on the amount of proof needed to establish secondary meaning in single color marks, the burden is very heavy because by nature single color marks are not distinctive.<sup>119</sup> It is unlikely for colors to achieve that identifying status expressly, thus the only method is to achieve secondary meaning. Achieving that secondary meaning is much more difficult than one may think; Christian Louboutin’s red soles did not achieve this secondary meaning overnight; rather it took years of reputation building, consistent advertising, media attention, the saturation of pop culture and the infiltration of both elite and mainstream societies for that red sole to become synonymous with the brand. With the high burden set by the Lanham Act for achieving secondary meaning with single color marks, the fashion industry is protected from the alleged “color wars”.

The Second Circuit also failed to be explicit within the limited trademark it provided for Christian Louboutin. In her analysis of the limited trademark granted to Christian Louboutin by the Second Circuit, Reanna L. Kuitse made the following, very persuasive argument, which is in line with the critical views in this paper:

“Although the Circuit Court stipulated that the [red sole mark] only covers shoes with a contrasting upper, the court did not explicitly define the exact parameters of the exception. For example, would a red sole shoe with a partially red “upper” be considered a contrast? Although the court defined the “upper” as “the visible portions of the shoe other than the outsole,” it did not explicitly outline how much of the “upper” has to contrast with the remainder of the shoe.”<sup>120</sup>

There is no language in the opinion quantifying how much of the shoe’s “upper” must be red in order to escape claims of trademark infringement. This leaves the possibility for designers to release shoes with a lacquered red sole and multi colored uppers as long as so much as a splash of red is on the upper. Please refer to the following examples below:



These photos provide a spectrum of shoes that have multi colored uppers with some red portions; the Second Circuit opinion provides no clarity on where to draw the line between infringement and protection. Arguably, all of these shoes escape trademark infringement despite their red soles and distinctive “uppers” because they all contain some red on top. This will ultimately result in brand confusion because Christian Louboutin is known for outrageous multi colored shoes (as evidenced above) and per this trademark, should a brand release a multi colored shoe with red spots on the upper and a red sole, the design will not infringe Christian Louboutin’s limited trademark. How does that distinguish the shoes of other designers from Christian Louboutin’s shoes? The trademark basically gives the fashion industry free reign of the red sole so long as there is some red present in the upper. The Second Circuit should revisit this trademark and



explain with precision the exact level of protection it meant to afford Christian Louboutin with this limited trademark.

A viable alternative to the inefficient, limited trademark provided by the Second Circuit is the solution Mr. Louboutin proposed for this issue while it was in litigation. He proposed the trademark grant him the exclusive use of the color Chinese red on the sole along with a few tones higher and lower to prevent the use of colors that might cause brand confusion.

“In response to this legal dilemma, Louboutin proposes that the Court simply draw a designated range both above and below the borderlines of Pantone No. 18–1663 TP, and declare all other stripes of red within that zone forbidden to competitors. Its suggested metric references *Olay Co., Inc. v. Cococare Prods., Inc.* See 218 U.S.P.Q. 1028, 1045 (S.D.N.Y.1983) (issuing injunction requiring infringer to use “a discernibly different pink, at least 40% different in terms of [Pantone Matching System] tones” from that used by registrant). Louboutin's proposal would have the effect of appropriating more than a dozen shades of red—and perhaps other colors as well<sup>6</sup>—and goes far beyond the injunction upon which Louboutin relies. In *Olay*, the protectable interest was not “in the color pink alone,” but rather in the color in combination with graphics and packaging. *See id.* Here, Louboutin's claimed mark is, in essence, the color red alone when used on the soles of “high fashion” footwear. (Mourot Decl. Ex. A (Docket No. 22–1).) Moreover, although Louboutin attempts in these proceedings to limit the scope of the mark to high-*heeled* footwear, no such limitation appears on the face of the registration.”<sup>121</sup>

This is a reasonable idea once one considers the defects in the “color war” argument. This proposal would still allow competition and creativity as only very few tones of the color red would be ineligible for use on a high-gloss, lacquered sole. The District Court made a minute distinction between Christian Louboutin’s color proposal, and the proposal allowed in the *Olay* case, claiming Louboutin’s idea falls outside the *Olay* scope. However, *Olay*’s protection for its particular tone of pink in combination with graphics and packaging requires other brands to use a pink 40% different in tone. This is very similar to the proposal Christian Louboutin made, he asked for exclusive use of a small range of red tones (like *Olay*’s pink), in combination with a

high-gloss lacquered Sole (like Olay’s combination of graphics and packaging). Despite the Circuit Court’s opinion, Christian Louboutin’s suggestion falls well within the *Olay* scope, as his protection is not just for a particular tone of red but rather for the tone of red in combination with the high-gloss, lacquered sole. When one carefully assesses the proposals in both cases it is difficult to find material differences.

Because the Circuit Court failed to follow Christian Louboutin’s suggestion, and instead granted a limited trademark, no infringement was found on behalf of Yves Saint Laurent. This holding caused the Second Circuit to provide an incomplete analysis of the very important and current issue of single color trademarks which will undoubtedly revisit the judicial system as the world of fashion continues to rapidly evolve.

“Because we conclude that the secondary meaning of the mark held by Louboutin extends only to the use of a lacquered red outsole that contrasts with the adjoining portion of the shoe, we modify the Red Sole Mark, pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119,<sup>26</sup> insofar as it is sought to be applied to any shoe bearing the same color “upper” as the outsole. We therefore instruct the Director of the Patent and Trade Office to limit the registration of the Red Sole Mark to only those situations in which the red lacquered outsole contrasts in color with the adjoining “upper” of the shoe. In sum, we hold that the Red Sole Mark is valid and enforceable as modified. This holding disposes of the Lanham Act claims brought by both Louboutin and YSL because the red sole on YSL’s monochrome shoes is neither a use of, nor confusingly similar to, the Red Sole Mark. We therefore affirm the denial of the preliminary injunction insofar as Louboutin could not have shown a likelihood of success on the merits in the absence of an infringing use of the Red Sole Mark by YSL. Having limited the Red Sole Mark as described above, and having established that the red sole used by YSL is not a use of the Red Sole Mark, it is axiomatic that we need not—and should not—address either the likelihood of consumer confusion or whether the modified Mark is functional.”<sup>122</sup>

With this decision, the Circuit Court essentially punted on two major portions of single color trademark analysis. Given the persuasive arguments presented against the limited trademark, and the defects highlighted in many of the court’s arguments, the Second Circuit should return to

this issue and complete the analysis of the doctrine of functionality and the likelihood of customer confusion as it applies to this case. This will provide meaningful precedent and guidelines for the analysis of single color trademarks in fashion, an issue that was not fully resolved and will certainly re-emerge.

## **Part V: Conclusion**

The Second Circuit's decision has ultimately created more potential for harm to the Louboutin brand than protection. More viable alternatives should be considered. There are too many defects within the limited trademark granted to the brand that need to be addressed before more litigation ensues. As discussed above, the past decades have brought significant development to the law governing single color trademarks; however many important questions to the legal community in the fashion industry were left unanswered in this case.

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<sup>1</sup> CHARLES C. COTTON, 1 *LACON*, No. 183 (1820–22), *quoted in BARTLETT'S FAMILIAR QUOTATIONS AT* 409:5 (Justin Kaplan ed., 17th ed. 2002).

<sup>2</sup> Erica S. Schwartz, *Red with Envy: Why the Fashion Industry Should Embrace Adr As A Viable Solution to Resolving Trademark Disputes*, 14 *Cardozo J. Conflict Resol.* 279 (2012).

<sup>3</sup> Schwartz, *supra* note 2 at 291.

<sup>4</sup> *Id.*

<sup>5</sup> N. Elizabeth Mills, *Intellectual Property Protection for Fashion Design: An Overview of Existing Law and A Look Toward Proposed Legislative Changes*, 5 *Shidler J. L. Com. & Tech.* 24 (2009).

<sup>6</sup> Christian Louboutin, *Voguepedia*, *VOGUE.COM*,

[http://www.vogue.com/voguepedia/Christian\\_Louboutin](http://www.vogue.com/voguepedia/Christian_Louboutin) (last visited Dec. 4, 2013).

<sup>7</sup> *Id.*

<sup>8</sup> Kevin Perry, *The Secret of My Success*, *GQ MAGAZINE.COM*, <http://www.gq-magazine.co.uk/style/articles/2012-12/06/christian-louboutin-shoes-interview> (Dec. 6, 2012).

<sup>9</sup> *Id.*

<sup>10</sup> *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 211-12 (2d Cir. 2012)

<sup>11</sup> *Id.*

<sup>12</sup> Lauren Collins, *Sole Mate Christian Louboutin and the Psychology of Shoes*, *THE NEW YORKER*, [http://www.newyorker.com/reporting/2011/03/28/110328fa\\_fact\\_collins?currentPage=all](http://www.newyorker.com/reporting/2011/03/28/110328fa_fact_collins?currentPage=all) (Mar. 28, 2011).

<sup>13</sup> *Id.*

<sup>14</sup> *Id.*

<sup>15</sup> *Id.*

<sup>16</sup> Perry, *Supra* note 8.

<sup>17</sup> Collins, *Supra* note 12.

<sup>18</sup> *Id.*

<sup>19</sup> *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U.S. 166, 167, (1906) abrogated by *Hurn v. Oursler*, 289 U.S. 238, 53 S. Ct. 586, 77 L. Ed. 1148 (1933)

<sup>20</sup> *Id.*

<sup>21</sup> *Id.*

<sup>22</sup> *Id.*

<sup>23</sup> *Id.* at 170.

<sup>24</sup> *Id.* at 171.

<sup>25</sup> *Id.* at 172.

<sup>26</sup> *Id.*

<sup>27</sup> *Id.*

<sup>28</sup> *Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.*, 147 F.2d 407, 409 (6th Cir. 1945).

<sup>29</sup> *Id.*

<sup>30</sup> *Id.*

<sup>31</sup> *Id.*

<sup>32</sup> *Id.*

<sup>33</sup> *Id.*

<sup>34</sup> *Id.* at 411.

<sup>35</sup> *Id.*

<sup>36</sup> *Id.* at 409.

<sup>37</sup> *Id.* at 411.

<sup>38</sup> *Id.* at 412.

<sup>39</sup> *Id.* at 415.

<sup>40</sup> *Id.*

<sup>41</sup> *Id.*

<sup>42</sup> *Id.*

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<sup>43</sup> *Application of Hehr Mfg. Co.*, 279 F.2d 526 (C.C.P.A. 1960).  
<sup>44</sup> *Id.*  
<sup>45</sup> *Id.*  
<sup>46</sup> *Id.* at 527.  
<sup>47</sup> *Id.*  
<sup>48</sup> *Id.* at 528.  
<sup>49</sup> *Id.*  
<sup>50</sup> *Id.*  
<sup>51</sup> *Id.*  
<sup>52</sup> *Id.*  
<sup>53</sup> *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1118 (Fed. Cir. 1985).  
<sup>54</sup> *Id.* at 1125.  
<sup>55</sup> *Id.* at 1126-28.  
<sup>56</sup> *Id.* at 1116.  
<sup>57</sup> *Id.* at 1118-19.  
<sup>58</sup> *Id.*  
<sup>59</sup> *Id.*  
<sup>60</sup> *Id.* at 1118-19.  
<sup>61</sup> *Id.* at 1119.  
<sup>62</sup> *Id.* at 1119-20.  
<sup>63</sup> *Id.* at 1120.  
<sup>64</sup> *Id.* at 1120-21.  
<sup>65</sup> *Id.*  
<sup>66</sup> *Id.* at 1121.  
<sup>67</sup> *Id.*  
<sup>68</sup> *Id.*  
<sup>69</sup> *Id.*  
<sup>70</sup> *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 115 S. Ct. 1300, 1301, 131 L. Ed. 2d 248 (1995).  
<sup>71</sup> *Id.*  
<sup>72</sup> *Id.*  
<sup>73</sup> *Id.*  
<sup>74</sup> *Id.* at 1302.  
<sup>75</sup> *Id.* at 1303.  
<sup>76</sup> *Id.*  
<sup>77</sup> *Id.*  
<sup>78</sup> *Id.* at 1304.  
<sup>79</sup> *Id.*  
<sup>80</sup> *Id.*  
<sup>81</sup> *Inwood Laboratories, Inc.*, 456 U.S., at 850, n. 10, 102 S.Ct., at 2186, n. 10.  
<sup>82</sup> *Supra*, note 70 at 1304.  
<sup>83</sup> *Id.*  
<sup>84</sup> *Mana Products, Inc. v. Columbia Cosmetics Mfg., Inc.*, 65 F.3d 1063, 1065-66 (2d Cir. 1995).  
<sup>85</sup> *Id.*  
<sup>86</sup> *Id.* at 1066.  
<sup>87</sup> *Id.*  
<sup>88</sup> *Id.* at 1070.  
<sup>89</sup> *Id.* at 1070-71.  
<sup>90</sup> *Id.*  
<sup>91</sup> *Id.*

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- <sup>92</sup> *Id.*
- <sup>93</sup> *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 448-49 (S.D.N.Y. 2011).
- <sup>94</sup> *Id.* at 449.
- <sup>95</sup> *Id.*
- <sup>96</sup> *Id.*
- <sup>97</sup> *Id.*
- <sup>98</sup> *Supra*, note 70 at 1300.
- <sup>99</sup> *Supra*, note 93 at 450.
- <sup>100</sup> *Restatement (Third) of Unfair Competition* § 17 cmt. c (1993).
- <sup>101</sup> *Supra*, note 93 at 451.
- <sup>102</sup> *Id.*
- <sup>103</sup> *Id.* at 452.
- <sup>104</sup> *Id.* at 453.
- <sup>105</sup> *Id.* at 454.
- <sup>106</sup> *Id.* at 457.
- <sup>107</sup> *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 225 (2d Cir. 2012).
- <sup>108</sup> *Id.* at 226-27.
- <sup>109</sup> *Id.* at 228.
- <sup>110</sup> *Gucci Am., Inc. v. Duty Free Apparel, Ltd.*, 286 F. Supp. 2d 284, 287-88 (S.D.N.Y. 2003).
- <sup>111</sup> *Supra*, note 107 at 226-27.
- <sup>112</sup> *Supra*, note 53 at 1125.
- <sup>113</sup> *Id.*
- <sup>114</sup> *Id.*
- <sup>115</sup> *Id.* at 1126-28.
- <sup>116</sup> *Supra*, note 107 at 226-27.
- <sup>117</sup> *Id.* at 228. (similar to the informal quiz performed on my colleagues during my presentation, most misidentified the YSL monochrome shoes as Louboutins because of the high gloss, red sole.)
- <sup>118</sup> Mid-day Extras: Christian Louboutin Battles YSL for its Soles, MARKETPLACE, (Oct. 21, 2011), <http://www.marketplace.org/topics/business/mid-day-update/mid-day-extra-christian-louboutin-battles-ysl-its-soles> (19:44-20:17).
- <sup>119</sup> *Supra*, note 84 at 1070.
- <sup>120</sup> Reanna L. Kuitse, *Christian Louboutin's "Red Sole Mark" Saved to Remain Louboutin's Footmark in High Fashion, for Now . . .*, 46 Ind. L. Rev. 241, 262 (2013).
- <sup>121</sup> *Supra*, note 93 at 455-56.
- <sup>122</sup> *Supra*, note 107 at 228.