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The Devil Wears Solely Louboutin. The Red Sole as a Trade Mark in Light of the Rulings of CJEU and the US Court of Appeals for the Second Circuit²

Abstract. The iconic red sole of the high-heeled shoes designed by legendary French shoemaker Christian Louboutin is considered not only as a beautiful decorative element of the shoe but also a Louboutin signature. To protect his brilliant idea of lacquering a shoe outsole with the Chinese Red colouring the designer had pursued a trade mark protection for his red sole in many countries which resulted in many court battles with his competitors and trade mark invalidation attempts around the world. The aim of this article is to present and compare results of such battles in the US and before the CJEU with particular emphasis on considerations of applying the doctrine of aesthetic functionality to the red sole mark in both legal systems. The author has conducted her research using mostly the dogmatic method and the comparative method.

Keywords: Christian Louboutin, red sole, trade mark protection, non-traditional trade marks, absolute grounds for refusal or invalidity, functionality doctrine, aesthetic functionality

Louboutin Red-soled High-heeled Shoes – the Object of Desire and the Subject of Trade Mark Protection (and Litigation)

It all started in 1993 when young French designer Louboutin borrowed red nail polish from his assistant, who was painting her nails, to paint the sole of a high-

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heeled shoe prototype he had not been satisfied with as it was lacking energy (Collins, 2011). Not only has the Chinese Red colour on the sole made Louboutin's high heel more than just a shoe, but it has also become Louboutin's signature, resulting in the famous shoemaker selling 700,000 pairs of the spectacular red-sole high-heeled shoes yearly around the world (Veerasamy, 2017). Besides earning him a significant amount of money (as one pair of his classic red-soled *Pigalle* heels costs 545 €), it has drawn a plethora of fans and admirers to Louboutin and has given his shoes a special place in pop culture (and a Jennifer Lopez song – *Louboutins*). Twenty years after Louboutin's lacquering of the shoe sole with nail polish and making the red sole a cherry on top of his shoes, this fairy-tale story came full circle when in 2014 the designer launched a nail polish of the very same shade of red as the soles (Carreon, 2014). It is fair to say that nowadays having at least a pair of Louboutin's red-soled high-heeled shoes is a dream of every fashionista.

No wonder that other designers and shoe manufacturers became envious of the worldwide fame and recognition of the red sole and have notoriously copied his idea, wanting to attract their clients with red-soled shoes the same way Louboutin had done and leading him to many court battles around the world. In order to protect his iconic shoes the French shoemaker decided to pursue trade mark protection for their iconic red sole in class 25 of the Nice Classification for high-heeled footwear. More precisely, he applied for the registration of a trade mark consisting of the Pantone 18.1663TP colour applied to the sole of a shoe with the outline of the shoe not being part of the trade mark but serving only to show the positioning of the trade mark – that is how the trade mark has been described (*e.g.* Louboutin's EU trade mark no. 008845539). Besides having filed for the registration in the US in 2007, Louboutin later wanted to get the trade mark protection for his stand-out red sole *inter alia* in the UK, France, Switzerland, Mexico, Australia, China. He also registered the sole as a Benelux trade mark in 2010 and in 2016, after long, six-year proceedings before EUIPO (then OHIM) as a European Union trade mark (then called Community trade mark), which is unitary in character and valid throughout the European Union.

The registrability of Louboutin's red sole mark has engendered a lot of controversy, and the French designer has not been able to feel confident about the results of the registration proceedings before trade mark offices and courts. "Consistent" is the last adjective one could use to describe the jurisprudence the registration has encountered. Suffice it to say that while the registration of the trade mark in the US and in EU member states has become successful for Louboutin, Swiss Federal Supreme Court has not been so favourable for the shoemaker and refused the registration of the red sole mark due to its merely decorative function (Hellyer, 2017).

Despite successful registration of the red sole mark in the US and in Benelux countries, in recent years Louboutin's competitors have done their best to invalidate this trade mark in those areas. The famous shoemaker had to fight for his red sole

with famous French luxury fashion house Yves Saint Laurent in American courts, with the Dutch company Van Haren in courts in the Netherlands and later before the Court of Justice of the European Union. Both opponents of Louboutin pursued the red sole mark invalidation due to its purely aesthetic function which made it unregistrable in the light of the Trademark Act of 1946 (Pub. L. No. 79-489, 60 Stat. 431, as amended, hereinafter: the Lanham Act) and the Benelux Convention of Intellectual Property (Trade Marks and Designs) (publication address in the Netherlands: Trb 2005, 96, as amended, hereinafter: the Benelux Convention) respectively.

The proceedings concerning the Benelux trade mark brought the case to the Court of Justice of the European Union, as the Benelux Convention then implemented Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ L 299, 8.11.2008, p. 25-33, hereinafter: Directive 2008/95)³ and the District Court from the Hague had requested CJEU for a preliminary ruling concerning the interpretation of Article 3(1)(e)(iii) in that directive. As trade mark protection in the EU member states coexists with protection available at Union level through EU trade marks and the grounds for invalidity of trade marks registered in each member state and in EUIPO are the same; the CJEU ruling can be considered not only in relation to the provisions of the directive which impinges on the registration of marks with national offices but also with regard to the interpretation of the provisions regarding the registration of European Union trade marks.

Christian Louboutin has succeeded in both judicial battles, the one against YSL in the USA as well as the one having its final before the CJEU. They both have ended with the rejection to declaring Louboutin's trade marks invalid and allowing further protection of the red sole. However, this does not mean that the red sole mark has been identically perceived by American and European courts or that it has been granted equal protection in both jurisdictions, as the aesthetic functionality doctrine is not applied identically on both sides of the Atlantic.

Contrast Needed. The Red Sole Mark in the US

In 2011, Yves Saint Laurent prepared to market a line of "monochrome" high-heeled shoes in purple, green, yellow and, horror of horrors, red. The shoes of YSL, featured the same colour on the entire shoe, so that the red version had also red outsole. Despite the fact that the French design house maintained that since the

3 By 15th Jan 2019 EU Member States should have implemented new Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ L 336, 23.12.2015, p. 1-26, hereinafter: Directive 2015/2436).

1970s it had sold such monochrome shoes; when Louboutin had found out about the monochrome YSL shoes, he requested the removal of the allegedly infringing shoes from the market, and, after failed negotiations, the two opponents entered into a court room with Louboutin asserting claims under the Lanham Act, *inter alia* trademark infringement and counterfeiting and unfair competition, and YSL filing for cancellation of the red sole mark on the grounds that it was not distinctive but merely ornamental and functional and that it was secured by fraud on the US Patent and Trademark Office.

Pursuant to the Lanham Act § 45 a trade mark may consist of any word, name, symbol, or device, or any combination thereof used or *bona fide* intended to be used to identify and distinguish a person's goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods even if that source is unknown. A colour is not enumerated in the non-exhaustive list of possible devices comprising a trade mark set out in the aforementioned provision, but neither are there provisions which would explicitly prohibit the registration of a colour as a trade mark under American law. Does that mean that a single colour can be recognised as a mark which is able to identify the source of the goods?

As the Supreme Court of the United States stated in *Qualitex* decision, a colour is protectable as a trade mark only if it "acts as a symbol that distinguishes a firm's goods and identifies their source, without serving any other significant function" (*Qualitex Co. v. Jacobson Products Co.*, 1995). So long as a colour mark meets requirements set out for all trade marks, *i.e.* use in commerce, distinctiveness, indication of source and non-functionality, there is no special legal rule preventing colour alone from its registration as a trade mark under the US law (*Qualitex Co. v. Jacobson Products Co.*, 1995). Speaking of distinctiveness, it must be noted that according to American jurisprudence, a colour can never be inherently distinctive and a showing of acquiring distinctiveness through secondary meaning is required to obtain its trade mark protection (*Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 2000).

What may have been the source of sleepless nights for Louboutin was however not the need to prove the secondary meaning of the red sole mark but the necessity to overcome the non-functionality requirement. The Lanham Act § 2(e)(5) prohibits the registration of a mark that comprises any matter that, as a whole, is functional. This provision is an emanation of functionality doctrine that, at least according to YSL and the US District Court for the Southern District of New York, which decided the case at first instance, had seemed to be a bar placed too high for the French shoemaker's red soles. The District Court went so far as to proclaim *per se* rule denying protection for the use of a single colour trademark in the fashion industry, as, according to this court, "there is something unique about the fashion world that militates against extending trademark protection to a single colour" (*Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 2011). Nonetheless, Christian Louboutin had not given up

and had appealed, what opened doors to the judgment of the United States Court of Appeals for the Second Circuit (*Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 2012), which may as well be called the judgment of Solomon.

In this judgment the court meticulously considered applying that functionality doctrine, which prevents trade mark law from inhibiting legitimate competition by giving monopoly control to a producer over a useful product, has today two forms: utilitarian functionality and aesthetic functionality (*Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 2012). A product feature is considered as having utilitarian functionality when it is either essential to the use or purpose of the article or when it affects the cost or quality of the article (*Inwood Labs. v. Ives Labs.*, 1982). When judging Louboutin's red sole mark, it was more important to focus on aesthetic functionality rather than utilitarian functionality, though, and that was what the court did.

The aesthetic functionality doctrine is based on the assumption that the visual appeal of a trade mark should be available for all to imitate as it is essential in the commercial success of a product and restricting its use would hinder fair competition (Gorman, 2012). As the US Supreme Court stated in the aforementioned *Qualitex* ruling, a functional feature of the product has to be denied protection "if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage" (*Qualitex Co. v. Jacobson Products Co.*, 1995). The aim of this doctrine is to exclude from trade mark protection these features that others have to imitate so as to compete with the right holder (Tischner, 2015). It was based on the assumption that if the particular feature is an important ingredient in the commercial success of the product, the interest in free competition permits its imitation in the absence of a patent or copyright (*Pagliero v. Wallace China Co.*, 1952). Another reason standing behind aesthetic functionality doctrine is to separate different IP regimes –patents and trade marks (Tischner, 2015). Thus, it is assumed that due to functionality doctrine ornamental features of goods are unregistrable and unprotectable as trade marks

However, there should be a few words dedicated to, in my opinion, very deserved criticism of aesthetic functionality doctrine in the US, the state it was created in, only later being adopted in European countries. Firstly, it should be noted that the aesthetic functionality doctrine engenders a lot of controversy and is used inconsistently and unpredictably by US courts (Thurmon, 2004), with the Second Circuit court being one of only three circuits showing interest in applying the aesthetic functionality doctrine (Gambino & Bartow, 2013). Some call it an oxymoron and unwarranted expansion of the utilitarian functionality that goes too far from the rationale that justifies the policy (McCarthy, 2009). Some also note that the doctrine in its original form has had the potential to impede trade mark protection for designs; however, it instead "rewarded fruitless designs with unnecessary protection, but exposed successful designs to unchecked imitation" (Dinwoodie,

1999). It cannot also be forgotten that while utilitarian functionality is judged on the basis of objective circumstances, the aesthetic one is highly arbitrary (Sztoldman, 2012). Hence, there is nothing worse than having “cool” designs denied trade mark protection while allowing neutral ones such protection at the same time on the basis of a random opinion (Brancusi, 2019a). It would definitely not encourage designers to care about the beauty of a design.

Moreover, the aesthetic functionality doctrine is based on the presumption that a decorative design can only be either an element that consumers find appealing or a source of indication of a product. In reality, it can be, and usually is, both (Kur, 2011), exactly as the Louboutin sole is.

Nevertheless, YSL was lucky as the case was judged in the Second Circuit, where, as I have mentioned, the aesthetic functionality used to be applied. Thus, YSL could successfully try to argue that the colour red had been used for decades (if not centuries) as a decorative feature on the outsoles of shoes. What is more, YSL stated, it was Louboutin himself who acknowledged the fact that he first had lacquered the sole with red nail polish to give life to a creative concept and not to identify the brand (Furi-Perry, 2013).

The US Court of Appeals for the Second Circuit firstly noted that contrary to what the District Court stated, a *per se* rule denying protection for the use of a single colour trademark would be neither necessary nor appropriate for the fashion industry. Thus, without individualized, fact-based inquiry into the nature of the trade mark, there is no possibility of implementing a rule that under any circumstances such a colour mark is ineligible for registration. For, as the Court correctly observed, a product feature’s successful source of origin indication can sometimes be difficult to distinguish from such a feature’s aesthetic function if any (Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc., 2012).

By placing the red colour in an unprecedented context and deliberately tying that colour to his product Louboutin, according to the court, has created an identifying mark firmly associated with his brand. At the same time, the court did not directly answer the question whether the red sole mark was aesthetically functional or not. The court merely stated that it was not possible to automatically assume that the colour mark filed for registration in the fashion industry was purely functional.

Of course, at the beginning of the 90s Louboutin was indeed putting a red colour on soles of his shoes for aesthetic reasons only. However, over the years, Louboutin has turned the red sole from a decorative feature to a mark indicating the origin of his heels, *i.e.* nothing else than a trade mark. However, as stated before, a single colour mark can almost never be inherently distinctive; Louboutin’s red used on the shoe outsole was capable of acquiring distinctiveness through use and that was what it did – it attained *secondary meaning*, as Americans say.

However, interestingly, the American court found the secondary meaning of the red sole mark had resulted from the contrast between the outsole and the upper part

of the shoe. Moreover, Louboutin presented evidence only for a secondary meaning of such a contrast effect of lacquered red sole, according to the court. As the French shoemaker failed to prove that his mark had acquired secondary meaning also for monochrome red shoes, the court declared that the red sole trade mark protection did not extend to its use on monochrome shoes. Thus, both Christian Louboutin and Yves Saint Laurent company could have proclaimed victory.

Green Light for the Red Sole Mark in the EU and its Member States

Louboutin's opponent in the European court battle was not as glamorous as Yves Saint Laurent. Van Haren Schoenen BV is a Dutch company operating retail shoe outlets in the Netherlands and selling shoes much more affordable than those sold by YSL or Louboutin. In 2012, the Dutch shoe retailer sold high-heeled shoes with red soles which resulted in proceedings before the Dutch District Court of The Hague initiated by Louboutin in 2013. Van Haren in its defence claimed that the mark at issue was invalid on the basis of Article 2.1(2) of the Benelux Convention, pursuant to which signs consisting solely of a shape which results from the nature of the goods, which gives a substantial value to the goods or which is necessary to obtain a technical result cannot be considered trade marks. As the Benelux Convention implemented then Directive 2008/95, the court referred the following question to the CJEU for a preliminary ruling: "Is the notion of "shape", within the meaning of Article 3(1)(e)(iii) of Directive 2008/95 (...) limited to the three-dimensional properties of the goods, such as their contours, measurements and volume (expressed three-dimensionally), or does it include other (non-three-dimensional) properties of the goods, such as their colour?"

Pursuant to Art. 2 of Directive 2008/95, which is not in force anymore but which was implemented by the Benelux Convention at that time, a trade mark may have consisted of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. Although the ruling of CJEU was issued on the basis of this directive, it is worth noting that the definition of a trade mark under the new directive and under the Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ L 154, 16.6.2017, p. 1-99, hereinafter: EUTMR) has changed. Not only has the graphic representation requirement disappeared, but also the non-exhaustive list of potential signs that a trade mark may consist of has broadened as sounds, and, more importantly, colours have been added to it. It however does not change the fact that under the previous law a colour, naturally, subject to its

capability of distinguishing goods, could also be a trade mark (Wojcieszko-Głuszko, 2017).

The possibility of registration of non-traditional trade marks such as those mentioned above (and such as a Louboutin sole) in the EU and its Member States is not, of course, that easy. Besides having to overcome standard absolute grounds for refusal such as a lack of distinctiveness, such trade marks also cannot be functional, including aesthetic functionality. The European concept of functionality derives from the US' functionality doctrine described above. When it comes to EU Member States, Benelux states were the first to incorporate it into their Uniform Trade Mark Act of Benelux Countries in 1975, which later inspired the EU legislator (Kur, 2011). As, despite some differences, the aesthetic functionality doctrine in both jurisdictions has a similar rationale, all the remarks on numerous negative aspects of its applying remain valid with regard to European provisions cited below.

As Art. 3(1)(e) of Directive 2008/95 provided, signs which consist exclusively of: (i) the shape which results from the nature of the goods themselves; (ii) the shape of goods which is necessary to obtain a technical result; (iii) the shape which gives substantial value to the goods shall not be registered or, if registered, shall be liable to be declared invalid. That was the provision implemented by Art. 2.1(2) of the Benelux Convention, based on which the Dutch court was supposed to issue a verdict on the red sole mark case.

It must be noted that in Directive 2015/2436 (and the EUTMR) these absolute grounds for refusal or invalidity have broader scope and apply not only to signs consisting only of shape but also any other characteristic (Art. 4(1)(e) of Directive 2015/2436 and Art. 7(1)(e) of EUTMR). That however does not mean that as the EU version of the functionality doctrine has become broader than it previously was; the question of the Dutch in the Louboutin case does not deserve attention. The remainder of this work will mainly focus on the old provisions as the CJEU had to rule on their basis.

It is necessary, though, to remember that new, broader scope of these grounds may result in new highly interesting battles on aesthetic functionality, maybe for Louboutin, too. The lack of intertemporal provisions in both Directive 2015/2436 and Regulation 2017/1001 may, and should, lead to the clarification of CJEU regarding the retroactive impact of the broadening of the scope of functional grounds for invalidity. Despite the current approach of the EUIPO (EUIPO, 2017), some arguments may be found in favour of the possibility of the invalidation of trade marks registered on the basis of old provisions invoking the new ones. One of relevant examples of such argumentation may be found in AG Szpunar's opinion (AG Szpunar Opinion on Christian Louboutin and Christian Louboutin SAS v. Van Haren Schoenen BV, 2017) in the *Louboutin* case, which will be cited below many times, where AG Szpunar pointed out that adding "another characteristic" to the new provisions being "a mere clarification" of the previous category of signs being one

of them (Brancusi, 2019b). For now it is hard to imagine that the broader grounds for invalidity would be applied to trade marks already registered, such as a Louboutin red sole mark, but it cannot be ignored that such a contrary approach is present e.g. in AG Szpunar's opinions, and it may suggest that the CJEU would go this way in its rulings.

Returning to the topic, in June 2017 and February 2018 Advocate General M. Szpunar issued opinions in the preliminary ruling on the Louboutin case, and the media around the world were sure of a spectacular loss of the legendary shoemaker in his battle before the CJEU, urging Louboutin's company to decline these forecasts. According to the Advocate General Louboutin sought the protection for a certain colour not in the abstract, but for its use on the sole of a high-heeled shoe, and thus the red sole mark "should therefore be equated with one consisting of the shape of the goods and seeking protection for a colour in relation to that shape, rather than one consisting of a colour *per se*" (AG Szpunar Opinion on Christian Louboutin and Christian Louboutin SAS v. Van Haren Schoenen BV, 2017).

One cannot deny that the red colour of the sole mark is not recognized in an abstract way but only on the footwear sole. The shape of the sole is not a part of the trade mark but serves only to show the positioning of the trade mark on a shoe. AG Szpunar rightly observed that these aspects of that shape "which enable us to recognise it as high-heeled women's shoe, appear to be part of the mark" (AG Szpunar Opinion on Christian Louboutin and Christian Louboutin SAS v. Van Haren Schoenen BV, 2017).

In spite of the fact that at first glance both opinions of AG Szpunar suggested that the red sole trade mark should be invalidated, the judgment of the CJEU turned out to be different. Luckily for the French designer, the CJEU did not respond explicitly to the question asked by the Dutch court and ruled that "Art. 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that a sign consisting of a colour applied to the sole of a high-heeled shoe, such as that at issue in the main proceedings, does not consist exclusively of a 'shape', within the meaning of that provision".

The Court has placed great importance on the description of the red sole mark in the registry, where Louboutin explicitly stated that the contour of the shoe does not form part of the mark and is intended purely to show the positioning of the red colour covered by the registration. Moreover, the CJEU has explained that in any event, the red sole mark cannot be regarded as comprising 'exclusively' a shape, where, "the main element of that sign is a specific colour designated by an internationally recognised identification code" (Christian Louboutin and Christian Louboutin SAS v. Van Haren Schoenen BV, 2018).

Should the CJEU judgment not be in favour of Louboutin's trade mark if issued under the rule of new provisions? By answering the question very precisely and ruling that under the old directive Louboutin's red sole mark was out of the scope of the provision reflecting aesthetic functionality doctrine, the CJEU, unfortunately, has

lost, for now, the chance to clarify the notion of ‘substantial value’ given by a shape (or another characteristic) to the goods which makes such a feature unregistrable as a trade mark. We also still do not know if a combination of two features of a product, such as a position of a mark and its colour would come into the scope of new provisions (Brancusi, 2019b).

Apart from that, though, one must remember that the public dreams of red-soled shoes not because of its unique, beautiful design or the fact that it gives substantial value to shoes, but because a red sole is a mark of a famous designer Christian Louboutin. Bearing in mind the fact that shapes, and now also other features appreciated by consumers as aesthetically appealing (as Louboutin’s red sole is), are at risk of being declared unregistrable irrespectively of their aesthetic value becoming eventually inferior to their function of identification of commercial origin (Kur, 2011); it must be noted that AG Szpunar was absolutely right to notice in his opinion in the Louboutin case that the application of the provision regarding aesthetic functionality doctrine “is not justified where the advantage does not result from the intrinsic characteristics of the shape, but from the reputation of the mark or its proprietor. Indeed, the possibility of acquiring such a reputation is an important aspect of the system of competition which trade mark law helps to maintain” (AG Szpunar Opinion on Christian Louboutin and Christian Louboutin SAS v. Van Haren Schoenen BV, 2017). Such a reputation of the red sole mark or of Christian Louboutin himself is an emanation of nothing other than a basic function of a trade mark – serving the purpose of identifying the origin of goods. It must be also noted again that applying aesthetic functionality doctrine to marks of such a reputation and prestige requires as much caution as possible, as it may easily lead to these marks being deprived of protection which are the most worthy of it (Brancusi, 2019b).

What is also worth pointing out is the fact that in EU proceedings, Louboutin had ultimately no need to prove that his red sole had acquired distinctiveness. The CJEU did not also have to pay attention to this aspect of the trade mark in its ruling. It had been, however, examined before by EUIPO, which after long proceedings considered it distinctive. As EUIPO’s Board of Appeal stated in its decision in 2010, “the colour red Pantone No 18.1663TP applied to the sole of a high-heeled shoe (...) departs significantly from the norm or customs of the sector” and thus it shall be perceived as surprising and unexpected (Decision of the Second Board of Appeal of 16 June 2011 in Case R 2272/2010-2).

Nevertheless, the acquired distinctiveness (secondary meaning) should be utterly important in the context of aesthetic functionality of a trade mark. Contrary to the US approach, the aesthetic functionality exclusion cannot be overcome by proof of acquiring secondary meaning through use in the EU and its Member States (Brancusi, 2019a). As it may be justified not to take into account acquired distinctiveness when it comes to highly more objective utilitarian functionality of a mark, it usually does not make much sense regarding aesthetic functionality bar.

Such postulates were also raised by the Max Planck Institute for Intellectual Property and Competition Law in the Study on the Overall Functioning of the European Trade Mark System of 2011 (Max Planck Institute for Intellectual Property and Competition Law, 2011); unfortunately, despite the recent reform of the EU trade mark system, this proposition has not been taken into account. Still, it should be constantly repeated after A. Kur that “any considerations of the fact that the aesthetic appeal may eventually become inferior to the message it conveys about commercial origin – meaning that it is primarily bought for the brand and not for its design – does not make sense” (Kur, 2011).

The Red Sole Mark in the US and the Red Sole Mark in the EU – a Brief Summary

The analysis of the American and European trade mark provisions and judgments regarding granting the trade mark protection to Louboutin’s red sole leads to the conclusion that despite some similarities in trade mark protection (industrial property rights are governed by numerous international conventions binding both the US and the EU as well as its member states), in the case of a mark as non-conventional as the red sole mark, the differences between wording and understanding of respective legal norms in both jurisdictions have become more visible.

At a time when the courts needed to examine the registrability of Louboutin’s mark, the functionality doctrine in trade mark law of United States was interpreted much more broadly than under European law. The new EU trade mark directive extended the scope of absolute ground for refusal or invalidity of the registration of signs determined by their nature or technical function and of signs having aesthetic function making it applicable not only to signs consisting exclusively of shapes but also to those comprising another characteristic. That does not mean, however, that such signs could be granted trade mark protection in the EU before the implementation of Directive 2015/2436. They were often refused registration due to their lack of distinctiveness or, more precisely, because of their descriptiveness. For the very same reason EUIPO at first had declined to register the red sole mark, finally reversing this opinion and deciding that it was not descriptive and could be granted a trade mark protection (Szczepanowska-Kozłowska, 2017).

Interestingly, while the US courts judging the red sole mark focused on the single colour that the trade mark consists of, the CJEU rightly did not forget the fact that this colour is put on an outsole and as such should be considered as a position mark.

The distinctiveness of the red sole mark was judged differently in both jurisdictions. In the USA Louboutin had to present evidence that his red sole had acquired a secondary meaning, while in the EU, as mentioned above, it was granted

inherent distinctiveness, and there was no need to prove that the mark has acquired it as a consequence of its use. For that reason in the EU the red sole mark has been granted protection against its unjustified use in all footwear (but orthopaedic, as it was excluded from the list of goods the trade mark was registered for by the trade mark owner himself), while in the US its trade mark protection does not cover monochromatic red shoes. No need for Louboutin to prove red sole mark's secondary meaning in the EU should not be perceived as all good as, in the case of declaring the red sole aesthetically functional, in the USA Louboutin could have fought this exclusion thanks to proving his red sole mark acquired secondary meaning through use, while in the EU he would not be able to overcome it at all.

What is, however, of utmost importance for Louboutin, is that both courts refused to declare the red sole mark invalid on grounds of its aesthetic function.

Aesthetic Functionality – Conclusion and Suggestions for the Future

Although both analysed rulings on Louboutin red sole mark had their “happy endings” for Louboutin and for common sense, due to highly ambiguous and arbitrary concepts comprising aesthetic functionality doctrine in both the USA and the EU, it was a “close shave” for Louboutin.

There is no denying that the doctrine of aesthetic functionality, despite being founded on good intentions, engenders a lot of controversy and may lead to dangerous deprivation of trade mark protection of these marks that highly deserve it. As a famous saying goes, “the road to hell is paved with good intentions,” and this may be the case. As previously mentioned, the public interest connected with the demand for free competition and the concept of separation of intellectual property protection regimes that stand behind aesthetic functionality may not be sufficient to justify its applying. In my opinion, the risk of the lack of protection for appealing trade marks that earned themselves reputations that go with the aesthetic functionality doctrine is too high.

The controversial character of aesthetic functionality exclusion of trade mark protection even in the USA, where many courts simply ignore it, may be a suggestion to contemplate deleting the provision preventing marks of aesthetic functionality from trade mark protection in European legislation. As for now, this grounds for refusal has been broadened instead of narrowed or even deleted.

The golden rule that could be applied in the EU to prevent some “cool” trade marks from being excluded from trade mark protection on the basis of their aesthetic functionality is adding a provision to allow them to be registered if they acquire secondary meaning, just as it is possible in the US. There is no denying that the look of Louboutin's red sole is appealing to the consumers. It is appealing, though, not so much because of the beauty of the Chinese Red but because of its Louboutin origin.

THE DEVIL WEARS SOLELY LOUBOUTIN. THE RED SOLE AS A TRADE MARK...

One could call it snobbery, but it is just reality. Moreover, that reality should be taken into account in trade mark legal system.

REFERENCES

- AG Szpunar Opinion of 22 June 2017, *Louboutin v. Van Haren Schoenen BV*, C-163/16, EU:C:2017:495.
- Brancusi, L. (2019a). Alternative products as a factor to determine the functionality of trade marks – How the criteria from the US functionality doctrine could be applied in the EU law. W S. (. Frankel, *Is Intellectual Property Pluralism Functional?* (pp. 178-205). Cheltenham & Northampton: Edward Elgar Publishing.
- Brancusi, L. (2019b). Trade Marks Functionality in EU law: Expected New Trends after the Louboutin Case. *European Intellectual Property Review*(2), pp. 98-106.
- Carreon, B. (2014, July 30). *Christian Louboutin Launches Red Nail Color*. Retrieved from Forbes: <https://www.forbes.com/sites/bluecarreon/2014/07/30/christian-louboutin-launches-red-nail-color/>
- Christian Louboutin and Christian Louboutin SAS v. Van Haren Schoenen BV*, C-163/16, EU:C:2018:423 (Court of Justice of the European Union June 12, 2018).
- Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 451, 457 (S.D.N.Y. 2011) (United States District Court for the Southern District of New York August 10, 2011).
- Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 696 F.3d 206, 228 (2d Cir. 2012) (United States Court of Appeals for the Second Circuit September 5, 2012).
- Collins, L. (2011, March 21). *Sole Mate*. Retrieved from The New Yorker: <https://www.newyorker.com/magazine/2011/03/28/sole-mate>
- Decision of the Second Board of Appeal of 16 June 2011 in Case R 2272/2010-2.
- Dinwoodie, G. B. (1999). The Death of Ontology: A Teleological Approach to Trademark Law. *Iowa Law Review*, pp. 611-752.
- Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (OJ L 336, 23.12.2015, p. 1-26).
- Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ L 299, 8.11.2008, p. 25-33).
- EUIPO. (2017, May 19). *Temporal scope of the application of the new grounds for refusal of EUTMR*. Retrieved from [euipo.eu: https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/AlicanteNews/MAY_2017_ALCNEWS_EUTM_ANNEX.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/AlicanteNews/MAY_2017_ALCNEWS_EUTM_ANNEX.pdf).
- Furi-Perry, U. (2013). Seeing Red: The Battle Over Your Sole . In U. Furi-Perry, *The Little Book of Fashion Law* (pp. 33-42). Chicago IL: American Bar Association.
- Gambino, D. C., & Bartow, W. L. (2013). *Trade Dress: Evolution, Strategy, Practice*. Oxford: Oxford University Press.

- Gorman, D. E. (2012, July 1). Protecting Single Color Trademarks in Fashion After Louboutin. *Cardozo Arts & Entertainment Law Journal*, 390.
- Hellyer, I. (2017, March 9). *who owns the red sole? christian louboutin can't convince swiss courts he does*. Retrieved from i-D: https://i-d.vice.com/en_au/article/mbvd5p/who-owns-the-red-sole-christian-louboutin-cant-convince-swiss-courts-he-does
- Inwood Labs. v. Ives Labs., 456 U.S. 844 (1982) (Supreme Court of the United States June 1, 1982).
- Kur, A. (2011, September 28). Too Pretty to Protect? Trade Mark Law and the Enigma of Aesthetic Functionality. *Max Planck Institute for Intellectual Property and Competition Law Research Paper No. 11-16*, 1-22.
- Max Planck Institute for Intellectual Property and Competition Law (2011), *Study on the Overall Functioning of the European Trade Mark System*.
- McCarthy, J. T. (2009). *McCarthy on Trademarks and Unfair Competition*. St. Paul MN: West Group.
- Pagliero v. Wallace China Co., 198 F.2d 339, 343 (U.S. Court of Appeals for the Ninth Circuit July 1, 1952). *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (Supreme Court of the United States March 28, 1995).
- Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ L 154, 16.6.2017, p. 1-99). (n.d.).
- Szczepanowska-Kozłowska, K. (2017). Bezwzględne przeszkody rejestracji znaku towarowego [*Absolute Grounds for the Refusal of Trade Mark Registration*]. In R. Skubisz (Ed.), *Prawo własności przemysłowej. System prawa prywatnego t. 14b* (pp. 639-721). Warszawa: Wydawnictwo C. H. Beck.
- Sztoldman, A. (2012). Ochrona prawna formy towaru lub opakowania znacznie zwiększającego wartość towaru [*Legal Protection of the Form of the Goods or Packaging which Gives Substantial Value to the Goods*]. *Przegląd Prawa Handlowego*(3), pp. 51-58.
- The Benelux Convention of Intellectual Property (Trade Marks and Designs) (publication address in the Netherlands: Trb 2005, 96, as amended).
- The Trademark Act of 1946 (Pub. L. No. 79-489, 60 Stat. 431, as amended (the Lanham Act)).
- Thurmon, M. A. (2004, April). The Rise and Fall of Trademark Law's Functionality Doctrine. *Florida Law Review*, pp. 243-371.
- Tischner, A. (2015). Kumulatywna ochrona wzornictwa przemysłowego w prawie własności intelektualnej [*Cumulative Protection of Industrial Design in Intellectual Property Law*]. Warszawa: Wydawnictwo C. H. Beck.
- Veerasamy, V. (2017, March 22). *Examining Christian Louboutins' Red-Hot Marketing Strategy*. Retrieved from ReferralCandy: <https://www.referralcandy.com/blog/louboutin-marketing-strategy/>
- Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205 (Supreme Court of the United States March 22, 2000).
- Wojcieszko-Głuszko, E. (2017). Pojęcie znaku towarowego. Rodzaje oznaczeń. Kategorie znaków towarowych [*The Concept of a Trade Mark. Types of Signs. Categories of Trade Marks*]. In R. Skubisz (Ed.), *Prawo własności przemysłowej. System prawa prywatnego, t. 14b* (pp. 470-556). Warszawa: Wydawnictwo C. H. Beck.