

## Again the “Red Sole Trademark”

**CRA – Coelho Ribeiro e Associados, SCARL**

**Jaime Medeiros**

**Ana Carolina Santos**



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In the past years, Christian Louboutin, S.A., hereinafter “Louboutin”, the well-known enterprise that commercializes the acclaimed high heel shoes with red sole, has been having some trouble in order to see protection granted to the popular red soles that characterize its high heel shoes.

In 2013, Louboutin had again some difficulties regarding the protection of the “Red Sole Trademark”<sup>1</sup>. Despite the referred trademark being registered in Benelux since 2010, the company Van Haren Schoenen, hereinafter “Van Haren”, a Dutch shoe maker, launched in 2012 a collection of shoes very similar with Louboutin’s, for a much lower price. Facing this, Louboutin sought protection for its trademark before the District Court of The Hague in Netherlands, seeking a finding of trademark infringement by Van Haren.

In April 2013, the Court ordered Van Haren to stop the manufacture and commercialization of the red sole shoes. Van Haren challenged that judgement stating that Louboutin’s trademark

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<sup>1</sup> Pantone no. 18 1663TP applied to the sole of a shoe.



was invalid towards the Benelux Convention – the article 2.1 (2) of the Convention refuses the registration of trademarks solely comprising a shape imposed by the nature of the product, which is necessary for obtaining a technical result.

For Van Haren, Louboutin’s trademark is a two-dimensional mark, namely the color red that when applied to the sole of the shoes, conforms to the shape of the shoe and gives them substantial value, which makes it invalid for the Article 3 (1) (e) (iii) of the Directive 2008/95/CE of the European Parliament and of The Council, of 22 October 2008<sup>2,3</sup>. However, the Court considered that the mark is not simply a two-dimensional mark in that it is inextricably linked to the sole of the shoe. For the Court, it was clear that the “Red Sole Trademark” was an element of the shoe, but was not clear if the concept of “shape”, within the meaning of the Article 3 (1) (e) (iii) is limited to three-dimensional properties of the goods, such as their contours, measurements and volume, to the exclusion of colors. If the shape did not include the color, the grounds for refusal in Article 3 (1) (e) (iii) of the Directive 2008/95/CE, would not be applicable. Consequently, it would be possible to obtain protection for marks incorporating a color, resulting from a function of the goods.

In that event, the Court decided to refer that question to the European Court of Justice for a preliminary ruling. Therefore, it was asked if the notion of “shape” within the meaning of the Article 3 (1) (e) (iii) of the Directive 2008/95/CE was limited to the three-dimensional properties of the goods or if it included other properties of the goods, such as their color.

Recently, on 22 June 2017, it was delivered the opinion of the Advocate General Maciej Szpunar, hereinafter “AG”<sup>4</sup>.

For the AG it was necessary to determine if the contested mark is a color mark or a trademark that consists in the shape of the product, but also seeks protection for the color. In order to

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<sup>2</sup> This Directive will be replaced by the Directive (EU) 2015/2436 of the European Parliament and of The Council, of 16 December 2015, until 14 January 2019.

<sup>3</sup> Article 4 (1) (e) (iii) of the Directive 2015/2436 refers to signs which consist exclusively of “the shape, or another characteristic which gives substantial value to the goods”.

<sup>4</sup> The Opinion was rendered in the Case C- 163/16 and it is accessible at <http://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX:62016CC0163>



reach a decision, it must be held in account the graphic representation and the description made when the registration was required, as well as all the material needed to identify the essential characteristics of the mark. Considering this, the contested mark is a trademark that consists in the shape of the product which seeks protection for the color too.

For the AG, given that the Article 3 (1) (e) was designed to prevent the monopolization of the external characteristics of the products that are vital to the market success and avoid the use of trademarks for getting unfair advantages, it should be applied to the trademarks that consists in the shape of the product that also look for protection of a color. The new Trademark Directive has the same direction.

The AG considered that the scope of the Article 3 (1) (e) (iii) is limited to the intrinsic value of the shape and does not permit the reputation of the mark or its proprietor to be taken into account.

Regarding this, the “Red Sole Trademark” is within the scope of the Article 3 (1) (e) and could be invalid. However, does it fill the condition of the Article 3 (1) (e) (iii)? The substantial value of the red sole is a result of Louboutin’s reputation, rather than a result of the intrinsic value of the shape. In the light of this, the opinion of the AG can be considered good news for Louboutin. Let’s wait for the decision of the Court.