

A victorious “red sole trademark”?

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Last June 12th, Christian Louboutin, S.A., hereinafter “Louboutin”, came out victorious after the Court of Justice of the European Union, hereinafter “CJEU”, released a press statement¹ with its final decision² ruling in favour of the validity of the red sole trademark and declaring that a mark consisting of a colour applied to the sole of a shoe is not covered by the prohibition of the registration of shapes.

a) The legal battle

The decision came out in the scope of Louboutin’s legal battle with the Dutch shoemaker company Van Haren Schoenen, hereinafter “Van Haren”, who, in 2012, launched a collection of shoes very similar with the famous Louboutin’s red soled shoes for a much lower price.

Louboutin – who registered the trademark in Benelux for footwear in 2010 and for high-heeled shoes in 2013, which was described as “the colour of red (Pantone 18 1663TP) applied to the sole of a shoe as shown (the contour of the shoe is not a part of the trademark but is intended to show the positioning of the mark)” – sought protection for trademark infringement in the District Court of The Hague, in the Netherlands.

Following an order from the court for Van Haren to stop the manufacture and commercialization of the red sole shoes, the latter claimed Louboutin’s red sole trademark was invalid in the light of the article 2.1 (2) of the Benelux Convention that refuses the registration of trademarks solely comprising a shape imposed by the nature of the product, which is necessary for obtaining a technical result.

¹ Cfr. Court of Justice of the European Union, Press Release no. 84/18, available at: <https://curia.europa.eu/jcms/upload/docs/application/pdf/2018-06/cp180084en.pdf>

² Cfr. Judgement of the Court available at: <http://curia.europa.eu/juris/document/document.jspx?text=&docid=202761&pageIndex=0&doclang=en&mode=req&dir=&occ=first&part=1&cid=621917>



Plus, Article 3 (1) (e) (iii) of the Directive 2008/95/CE of the European Parliament and of The Council, of 22 October 2008, states that a mark may be refused or declared invalid, if the sign consists exclusively of a shape that gives substantial value to the goods.

The Dutch Court referred the question to CJEU for a preliminary ruling to determine whether 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 colour – in case of an affirmative answer, Louboutin’s trademark could be invalid.

b) Advocate General’s opinion

On June 22nd, 2017, Advocate General Maciej Szpunar, hereinafter “AG”, delivered his opinion. The AG considered that the trademark at issue consisted in the shape of the product seeking also protection for the colour and since 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 colour. Concerning this, Louboutin’s trademark could be invalid.

However, since the AG also stated that the scope of the Article 3 (1) (e) (iii) was limited to the intrinsic value of the shape and did not permit the reputation of the mark or its proprietor to be taken into consideration. Given that 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, it could have been good news to Louboutin. On February 6th, 2018, the AG presented his complementary conclusions, where he enhanced his opinion.

c) CJEU’s decision

Despite the AG’s opinion, on June 12th, CJEU decided in the sense that a colour per se, without an outline, may constitute a ‘shape’ and that a sign does not consist in a shape where the registration of the mark did not seek to protect that shape but sought solely to protect the application of a colour to a specific part of that product.

In the light of this, CJEU concluded that the mark at stake did not relate to a specific shape of sole for high-heeled shoes since the description of that mark explicitly stated that the contour of the shoe


The logo consists of the letters 'CRA' in a serif font. The 'C' and 'R' are dark blue, while the 'A' is a lighter, greyish-blue color.

does not form part of the mark and is intended purely to show the positioning of the red colour covered by the registration.

The European Court of Justice's decision – that was unusually different from the AG's opinion – can be seen as victory for Louboutin's house.

Notwithstanding, the case will now return to the District Court of The Hague where it shall meet the final verdict.

