

CJEU Brings AG Szpunar to Heel in Finding Louboutin Registration to be Valid

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After two trips to the Advocate General, who on both occasions found to the contrary, the Grand Chamber of the Court of Justice of the European Union has ruled in *Louboutin v Van Haren Schoenen BV*¹ that Louboutin's famous mark consisting of the colour red applied to the sole of a high-heeled shoe is not a shape mark and therefore not subject to the prohibition on the registration of "signs which consist exclusively of ... the shape which gives substantial value to the goods" under the Trade Marks Directive art.3(1)(e)(iii).²

Background

In January 2010, Christian Louboutin and Christian Louboutin SAS (collectively "Louboutin") secured the registration of a Benelux trade mark for goods in class 25, namely "footwear (other than orthopaedic footwear)", which was later amended in April 2013 to cover "high-heeled shoes (other than orthopaedic shoes)" ("red sole mark"). The red sole mark, as described, consisted "of the colour red (Pantone 18 1663TP) applied to the sole of a shoe as shown (the contour of the shoe is not part of the trade mark but is intended to show the positioning of the mark)", and is depicted below (the shaded sole in the below graphic is Pantone 18 1663TP red in the registered mark):



In 2012, Dutch footwear retailer, Van Haren, started selling high-heeled women's shoes with red soles. Louboutin sued Van Haren for trade mark infringement. Van Haren challenged the validity of Louboutin's red sole mark on the ground that it consisted of a shape that gave substantial value to the goods.

The District Court of The Hague considered that Louboutin's mark was inextricably linked to a shoe sole. In its view, the red sole did give substantial value to Louboutin shoes since that colour formed part of the appearance of those shoes and played an important role in a consumer's decision to purchase them. Nonetheless, it noted that Christian Louboutin first used red colouring on soles for aesthetic reasons and only later started regarding it as an identifier of origin and using it as a trade mark.

Rather than get itself in a knot, the District Court referred the case to the CJEU for polished guidance as to whether the concept of "shape", within the meaning of art.3(1)(e)(iii), is limited solely to three-dimensional properties of a product, such as its contours, measurements and volume, or whether that concept also covers other characteristics, such as colours.

Decision

According to the CJEU, what the Dutch Court was essentially asking was whether art.3(1)(e)(iii) meant that a sign consisting of a colour applied to the sole of a high-heeled shoe, such as Louboutin's, consisted exclusively of a "shape", within the meaning of that provision.

Given that the Directive provides no definition of the concept of "shape", the CJEU held that its meaning must be determined by considering its usual meaning in everyday language, while also taking into account the context in which it occurs and the purposes of the rules of which it is part.³ In the context of trade mark law, the court said, the concept of "shape" is usually understood as a set of lines or contours that outline the product

¹ *Louboutin v Van Haren Schoenen BV* (C-163/16) EU:C:2018:423; [2018] Bus. L.R. 1411.

² Directive 2008/95 to approximate the laws of the Member States relating to trade marks [2008] OJ L299/25.

³ See, by analogy, *Deckmyn and Vrijheidsfonds* (C-201/13) EU:C:2014:2132; [2014] Bus. L.R. 1368.

concerned. It did not follow from the Directive, CJEU case law, or the usual meaning of the concept, that a colour per se, without an outline, constitutes a “shape”.

For the court, the question was whether, as in this case, a particular colour applied to a specific part of a product results in the sign consisting of a “shape” for the purposes of the substantial value prohibition. In the court’s view, it doesn’t. While the shape of the product or of a part of the product plays a role in creating an outline for the colour, the court said it cannot not be held that a sign consisted of that shape where the registration of the mark does not seek to protect that shape but seeks solely to protect the application of a colour to a specific part of the relevant product. In the current case, Louboutin’s mark did not relate to a specific shape of sole for high-heeled shoes since the description of the mark explicitly stated that the contour of the shoe did not form part of the mark and was intended purely to show the positioning of the red colour covered by the registration.

The court also held that a sign, like Louboutin’s, could not, in any event, be regarded as consisting “exclusively” of a shape, where the main element of that sign was a specific colour designated by an internationally recognised identification code.

For these reasons, the CJEU booted out the contrasting AG’s opinions and concluded that a sign consisting of a colour applied to the sole of a high-heeled shoe, such as that at issue in this case, does not consist exclusively of a “shape”, within the meaning of art.3(1)(e)(iii).

Comment

Great news for fashionistas who must have feared the prospect of all and sundry strutting their stuff in cheap red-soled high-heeled shoes. AG Szpunar has been brought to heel and the shoe is on the other foot for Louboutin. It seems likely that the District Court of The Hague will now allow Louboutin to sashay away, mark intact and valid, with the acquired distinctiveness of the red colouring on soles and with resultant capacity to act as an identifier of origin seemingly not in doubt. What AG Szpunar makes of CJEU’s decision is another matter. The AG was adamant that the substantial value prohibition was capable of applying to a sign combining colour and shape and that Louboutin’s mark could not be classified as a colour mark per se. He doubted whether the colour red could perform the essential function of a trade mark and identify its proprietor where that colour was used out of context, i.e. separately from the shape of the sole. But, arguably, the AG’s opinion overlooked two things: (i) Louboutin was not seeking trade mark protection in relation to any shape and

certainly not “exclusively” in relation to a shape for the purposes of art.3(1)(e)(iii); and (ii) while colour marks are difficult to register, ultimately, marks consisting of colours in a particular field can be shown to have of acquired distinctive character where there is robust evidence that a significant number of consumers of that type of product would think that the colour, in conjunction with the product, is from a specific undertaking (as opposed to various undertakings or none at all). Although this case appears nicely laced up, it will be interesting to see if any similar cases are considered under the provisions of the recent recast EU Trade Mark Regulation (effective from October 2017)⁴ and the soon-to-be implemented recast Trade Marks Directive,⁵ which extend the prohibition to “signs which consist exclusively of ... a shape, or another characteristic, which gives substantial value”. Time will tell whether anyone will be able to successfully sneaker claim through the European courts that finds registered marks like Louboutin’s to be invalid because that registered mark is the element that provides substantial value to the goods in question.

ML and WW v Germany—Article 8 Right to be Forgotten and the Media

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[Ⓙ] Anonymised data; Archives; Convictions; Freedom of expression; Germany; Media; Right to erasure; Right to respect for private and family life; Search engines; Websites

In the case of *ML and WW v Germany*,¹ the Fifth Section of the Court of Human Rights dismissed an art.8 “right to be forgotten” application in respect of the historic publication by the media of information concerning a murder conviction.

The court emphasised the protection of media archives, and public access to them, conferred by art.10 of the Convention. However, the decision confirms the availability of an art.8 right to be forgotten against primary publishers as well as search engines.

⁴ Regulation 2015/2424 amending Council Regulation 207/2009 on the Community trade mark and Commission Regulation 2868/95 implementing Council Regulation 40/94 on the Community trade mark, and repealing Commission Regulation 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) [2015] OJ L341/94.

⁵ Directive 2015/2436 to approximate the laws of the Member States relating to trade marks [2015] OJ L336/1.

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¹ *ML and WW v Germany* [2018] ECHR 554 (28 June 2018) (available only in French).