

The Louboutin Saga in France: a new victory

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The Paris Court of Appeal ruled that the French figurative trademark owned by Mr. Christian Louboutin and designating “*high-heeled shoes (except orthopedic footwear)*” in Class 25, reproduced above, is valid (*Paris Court of Appeal, 15 May 2018, No. 17/07124*).

The trademark is described as follows: “*The trademark consists of the color red (Pantone 18.1663TP) applied to the sole of a shoe as shown (the outline of the shoe is therefore not part of the trademark but serves to show the positioning of the trademark)*”.

In 2015, the French company Kesslord Paris, specializing in leather accessories, initiated a cancellation action against said trademark before the French courts. Initially, Mr. Christian Louboutin sent cease-and-desist letters to Kesslord Paris, which had launched a custom-made shoe concept that allowed customers to personalize shoes by choosing red soles, and claimed trademark infringement.

Kesslord Paris argued that Mr. Christian Louboutin's trademark was invalid because the graphic representation was not clear, objective, self-contained and consistent, in particular, with regard to the designated goods (Article L.711-1 of the French Intellectual Property Code). Kesslord Paris alleged that the representation and the description of the trademark, both evoking a specific sole, do not correspond to the designated goods, which are broadly defined. Kesslord Paris added that the public is not properly informed of the type of shoes that can be covered by Mr. Christian Louboutin's trademark (round toe or pointed toe shoe, with a large or a narrow sole, a high, average or low arch).

Kesslord Paris also argued that Mr. Christian Louboutin's trademark was invalid because the sign consisted exclusively of (i) the shape imposed by the nature or the function of the goods, and (ii) the shape which gives substantial value to the goods (Article L.711-2 c) of the French Intellectual Property Code, corresponding to Article 3(1)(e) of the Directive 2008/95/EC).

The Paris Court of Appeal affirmed the lower court decision and held that the trademark was valid. The Court found that the conditions of Article L.711-1 of the French Intellectual Property Code were met since the trademark was a combination of a specific color (precisely defined by a Pantone) and a specific position clearly defined by dotted lines (a sole of a high-heeled shoe), and since the fanciful nature of such combination gave the trademark a distinctive character. In addition, the Paris Court of Appeal noted that another color could have been applied to another part of the shoe. As an arbitrary choice was made, the Court ruled that such combination did not result from the shape imposed by the nature or function of the goods. Despite the iconic character of the red sole of high-heeled shoes, the Court also found that Kesslord Paris had not demonstrated that the elements of the trademark gave the goods their substantial value. The Court added that such value might result from the intrinsic quality of the shoes (materials or design) or from their success with famous customers.

This decision is positive for Mr. Christian Louboutin who actively sues third parties around the world selling high-heeled shoes with red soles. The Paris Court of Appeal might have come to the same positive decision by considering, as recently held by the Court of Justice of the European Union (CJEU) in a different Louboutin case, that a sign consisting of a color applied to the sole of a high-heeled shoe does not consist exclusively of a "shape" within the meaning of Article 3(1)(e) of the Directive 2008/95/EC (CJEU 12 June 2018, C-163/16).

To a certain extent, the Paris Court of Appeal anticipated the implementation of the new Article 4(1)(e) of the Directive 2015/2436 of 16 December 2015 that has to occur before 14 January 2019 pursuant to which signs which consist exclusively of the shape, or “*another characteristic*” (including potentially, a color), which gives substantial value to goods, will not be registered or shall be declared invalid. Whether this new ground for refusal can be held against trademarks whose filing date is prior to the implementation of the new law (or at least prior to the new Directive) is questionable, Mr. Christian Louboutin’s trademark would appear to be safe from attacks in France based on alleged lack of distinctiveness.