



**CONNECTING THE DOTS-AN  
EXPLORATIVE ANALYSIS OF  
LOUBOTIN'S CASE AS AN  
OVERARCHING REGIME OF  
TRADEMARKS**

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**Abstract**

Colours come under the ambit of public domain and are devoid of any fanciful feature to classify distinctiveness. With globalization and economical advancement, distinctive usage of single colours has developed a secondary meaning making them eligible for trademark registration. Such novel forms of mark i.e., the unconventional/ non-traditional marks are the new stem of trademark jurisprudence. Fashion has developed as a dynamic industry making the question of protectibility of Intellectual Property of creative fashion designers need of the hour. The European Court of Justice recently recognized that the signature shoes with the red colour lacquered sole designed by the famous designer Christian Louboutin is a valid trademark. This leading judgement centred on the technicalities of European trademark law, questioning whether a trademark that includes a colour painted on the sole of a shoe consists exclusively of a shape; which is not entitled to protection, or whether it is a position mark, capable of trademark protection. Against the backdrop of the judgment by the European Court of Justice this article focuses on the unconventional trademarks as the overarching regime of trademarks. The

author makes an attempt to understand the stance of Delhi High Court on the same issue and the position of colour marks in India

**Keywords:** Distinctiveness, Colour, Trademark, Red Sole, Unconventional Trademark

**Introduction**

According to Section 2(1)(zb), A trademark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours.<sup>1</sup> On initial reading the definition mentioned in the Act tends to be open-ended, thus making way for the unconventional marks relating to smell, colour, etc which are not mentioned in the Act to be considered as trademarks. When comprehensively considered, an unconventional mark should have the expressive ability to distinguish among the goods or services of one person from that of another.

The basic hindrance behind registration of unconventional mark lies under the necessary condition of 'graphical representation' of the mark. The Indian Trade Marks Registry often finds this criterion of graphical representation unsatisfied by the unconventional marks and thus such applications for registration are often rejected. The Trademark Rules, 2017 introduced a developing and welcoming period for registration of unconventional or non-traditional marks. Under the rules sound marks can be registered by submitting a sound clip along with the musical notations.<sup>2</sup> The Act while defining Trademark

<sup>1</sup>The Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999 (India).

<sup>2</sup> Rule 26(5), The Trade Mark Rules, 2017.



includes the expression ‘combination of colours’ and not a single colour. This is the inherent reason behind rejection of applications of single colour as a trademark by the registry. The basic assumption behind not granting trademark protection to a single colour is that it will create monopoly in the market thus hampering the competitiveness in the industry. It is usually difficult to show the combination of colours or single colour as inherently distinctive. The Application for registration of such marks should also be annexed with evidentiary documents showing that the colour or combinations of colours are solely related with the Applicant. Further it exclusively represents their goods and the consuming public associates the colour with the goods or services of the Applicant.

The onus for proving acquired distinctiveness of the mark or secondary meaning through continuous bonafide usage of the mark is upon the Applicant. The brand owners or the users of the mark can make an application for registration of the mark even if the mark is not inherently distinctive, by providing satisfactory evidence that the mark has acquired distinctiveness in the market due to its usage over a long span of time. According to Halsbury, certain conditions are required to be fulfilled to register an unconventional trademark-

- The mark should be intrinsically distinctive.
- The mark should be able to distinguish the particular product from other products.
- The mark should be capable of graphical representation.<sup>3</sup>

To achieve protection of trademark in a particular colour, the colour must ‘act as an indicator of source’ instead of serving any function. Many single colours have been granted protection under the umbrella of Trademarks like the orange of Home Depot, Tiffany’s specific shade of blue used on its boxes and catalogues. These protected shades of colours have gained a secondary meaning in the industry, as the concerned set of consumers associates these protected colours with the specific goods or services provided by the brands. However, to protect an individual colour it is essential that it is used in respect of brand promotion and does not affect the brand’s identity by indulging into the functionality aspect of the goods or services. The essential objective of Trademark law is to provide protection to consumers from getting confused about the ‘origin and quality of the product’ and giving a unique identity to the goods. Colour Trademarks is debatable topic in various countries, each one managing the issue differently. There is no doubt on the fact that colours are playing a fairly significant role in the realm of fashion. Colours sometimes provide the distinctive feature in a product or service. Recognizing this Article 15(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) redefined the definition of trademark law to encompass ‘any sign...capable of distinguishing the goods or services of one undertaking from those of other undertakings’. This paved the way for a non-conventional trademark i.e. Colour to be granted trademark protection. The test while granting exclusive rights in that how closely is the colour to the design and whether the

<sup>3</sup> Halsbury’s Laws of India: Intellectual Property Rights.(2018).23rd Vol. LexisNexis.



target consumers are capable of instantly recognizing the colour being particularly connected with the design or not?

### The peculiar case of Christian Louboutin's Red Sole

Colour has dependably been a standout amongst the most critical parts of fashion industry. The issue of securing rights over a colour is an interesting battleground among courts and international brands, with different parties playing with various set of rules. According to world famous shoe designer Christian Louboutin, red *implies sensuality -and serves as a crafty, subtle branding tool. I selected the colour because it is engaging, flirtatious, memorable and the colour of passion.* The designer's label is a well known luxury brand of shoes with signature red soles to distinguish it in the industry. The controversial Christian Louboutin's Red Sole Case in the European Court of Justice focuses over one significant and basic question, that 'Can a designer be permitted to have exclusive rights over a colour?'

### The Ruling of European Court of Justice

Christian Louboutin was granted a Benelux trademark for the red colour (Pantone 18-1663TP) applied to the sole of high heels shoe in 2010. In 2012, Van Haren, a Dutch brand started to sell high-heeled women's shoes with red coloured soles. This led to the trademark infringement proceedings initiated by Louboutin before the District Court in The

Hague, Netherlands, succeeded in the initial proceeding<sup>4</sup>.

The validity of Louboutin's red sole trademark was challenged by Van Haren under Article 3(1)(e)(iii)<sup>5</sup>, which prevents registration of any sign which consists 'exclusively of [...] the shape which gives substantial value to the goods. Van Haren contended that the mark at issue was 'a two-dimensional figurative mark that consists of a red coloured surface' and hence cannot be registered as a trademark. The Hague District Court indeterminate about the ambit and scope of the term 'shape' sought opinion from the Court of Justice of the European Union on the issue that whether the concept of 'shape' is limited to three-dimensional properties of the goods, such as their contours, measurements and volume, or whether it includes non-three-dimensional properties of the goods, such as their colour.

In an additional opinion, the Court of Justice of the European Union Advocate General indicated his inclination to maintain the mark as a sign inclusive of the shape of the goods because the shape of the sole matches the spatial delimitation of the colour red<sup>6</sup>. The Court of Justice of the European Union, however, did not follow this opinion and confirmed the validity of the trademark. The Court concluded that where the main element of a sign is a specific colour designated by an internationally recognized identification code, that sign cannot be regarded as consisting 'exclusively' of a shape.<sup>7</sup> The court observed that the Louboutin's trademark description expressly excluded the

<sup>4</sup> Louboutin v Van Haren Schoenen BV (Case C-163/16).

<sup>5</sup> Directive 2008/95/EC.

<sup>6</sup> Christian Louboutin SAS v. Van Haren Schoenen BV, ECLI:EU:C:2018:423.

<sup>7</sup> The Devil Wears Trademark: How The Fashion Industry Has Expanded Trademark Doctrine To Its Detriment, Harvard Law Review, Vol. 127, No.3.



contour of the sole from trademark protection. Article 3(1)(e)(iii)<sup>8</sup> must therefore be interpreted as meaning that the sign in question did not consist exclusively of a ‘shape’, within the meaning of that provision.

This leading case centred on the technicalities of the European trademark law, questioning whether a trademark that consists of a colour, applied to the sole of a shoe consists exclusively of a shape; which is not entitled to protection, or whether it is a position mark, capable of trademark protection.<sup>9</sup>The Court of Justice of the European Union held that the red sole mark is a perfectly valid position mark and is not contradictory to the clause relating to the shape marks, thus acknowledging that Louboutin’s red soles are capable of protection under E.U. trademark law. This decision of the court has opened up plethora of opportunities in the fashion industry to register the trademarks and acquire distinctiveness in a single colour in some specific configurations and protect its creative identities.

### Stand of Delhi High Court on the ‘Red Sole’

In India the destiny of *Louboutin*’s red coloured sole has been dubious inferable from the differed opinions of the Delhi High Court. In recent years the Delhi High Court has given fluctuated opinions in three different decisions where the essential pith of the issues in matter was whether the red coloured sole was a well known trademark in India. Except if there is a dictum by the Apex

Court these judgments will continue creating a predicament on the issue. These judgments are summarized below to understand the mindset of the court in arriving at the distinguished conclusion in each case.

In the case of *Christian Louboutin Sas vs Mr Pawan Kumar & Ors*<sup>10</sup>, 2017 the Plaintiff prayed for issue of permanent injunction restraining the Defendants from manufacturing and selling footwear bearing the Plaintiff’s red sole trademark. The Plaintiff also prayed to declare its Red Sole Trademark as a well-known trademark in India. The Delhi High Court held that the plaintiff’s trademark is internationally recognized and has extensive usage in India. It enjoys trans-border reputation in the country and the consumers were well aware about the goodwill enjoyed by the mark even before it was formally introduced in the Indian market.

Unlike the above decision, the same court in the case of *Christian Louboutin SAS v Abubaker*<sup>11</sup>, 2018 dismissed the plaintiff’s suit of infringement against the defendants by holding that the usage of a single colour in the sole of the shoe does not qualify as a valid trademark in India. The court’s pronouncement essentially cantered around the definitions of a ‘mark’ and ‘trademark’ mentioned in the Act. It also relied on the absolute grounds for refusal of the mark specified under Section 9 of the Act and the corresponding provisions relating to the limits of the effect of a registered trademark laid down in Section 30 of the Trade Marks Act. It categorically referred to the legislative intent behind that the deliberate use of the

<sup>8</sup> Directive 2008/95/EC.

<sup>9</sup>The Christian Louboutin Decision –E.U. Court Says Red Soles Are Capable of Trademark Protection, Jacqueline, 2018.

<sup>10</sup>CS(COMM) 714/2016

<sup>11</sup>CS (COMM) No 890/2018



expression 'combination of colours', and not use of the word 'colour' in singular form, thus clearly indicating that a single colour could not be included in the definition of 'mark'.

Such use of a colour by a competitor cannot be forestalled, despite the fact that the very characteristic has received a registration. The court also highlighted that it has the authority to reject claims of ownership of, or entitlement to, a sign which is not capable of being a trademark. However in the case of *Christian Louboutin SAS v Ashish Bansal*<sup>12</sup>, 2018 on similar facts an infringement suit was filed by the Plaintiff, wherein the court granted a decree of permanent injunction against the defendant from infringing the well known and registered 'red sole trademark'. This recent judgment is in sync with the first case by the same court which recognised the validity of the red sole mark.

The Trademark Act, 1999 does not explicitly provide for protection of a single colour trademarks. Nonetheless, the practice guidelines drafted by the Trade Mark Office propose that single colours will be protected on strict evidence of acquired distinctiveness and that the registration of single colour will be permitted strictly to the degree of colour shade – in any case, with regards to enforcement, in principle, the comparable shades can be challenged against one another. Hence, to secure a single colour trademark registration, the Registrar shall be provided with the proof of acquired distinctiveness in India, before the date of filing of the trademark application. The Manual perceives

that a single colour is proficient of obtaining registration.

Nevertheless, the Manual clearly cautions that such marks will be subject to the objections under S.9 (1) (a)<sup>13</sup> and profound evidence might be required to overcome these objections, given that they are not inherently distinctive. The Trade Mark Manual includes that while '*a colour per se is not normally used by traders as a means of brand identification..*' and '*consumers are not in the habit of making assumptions about the origin of goods based and services based solely on their colour or colour of their packaging*', single colours may be '*in exceptional circumstances be capable of denoting the origin of a product or service*'.

The Manual anyway clearly directs towards what can comprise of exceptional circumstances. According to it, if the colour is '*very unusual and peculiar in a trade and is recognized by traders and consumers alike that it serves as a badge of origin for that class of goods*', it might be registerable.<sup>14</sup>

### Conclusion

After doing a comprehensive study on the *Christian Louboutin's* red sole dispute and the strikingly varied decision by the European Court of Justice and the Delhi High Court a realisation can be made that colour is an unmistakable component and a noteworthy player in the fashion industry and is frequently sought to have distinctive features. These characteristics often raise the question of trademark registration of a specific shade of a single colour. The decision of the European Court of Justice has potential to change the game in the fashion

<sup>12</sup> CS(COMM) 503/2016

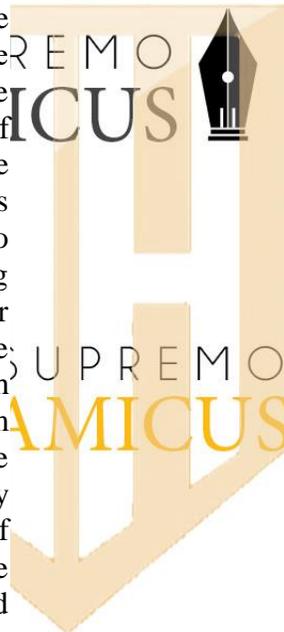
<sup>13</sup> The Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999 (India).

<sup>14</sup> Draft of Trade Marks Manual Practice and Procedure, 2008.



industry, focusing the players to seek protection for their colour marks if the specific shade adds distinctiveness to it.

However in India the archaic Trademark Act of 1999 nowhere discusses single colours but rather combination of colours. There is a reasonable weakness and a clear shortcoming in the Act as it is not in parity with the ever changing and evolving scenario in the competitive market. There is dire need of amendments in the Act for further clarity and to cater the needs of the developing economy. While each of the three cases before the Delhi High Court appear to have comparable realities, similar facts and revolve around the plaintiff's Red Sole trademark there are diametrically opposite perspectives in the Delhi High Court's decisions on the point of protection of single colour marks. The conflicting decisions and clashing opinions leave uncertainty with respect to registrability and implications of existing trademark registrations for single colour marks in India. It is very peculiar that in the time span of two to three years the Delhi High Court has looked at the issue in dispute from different angles. These decisions have cleared way for a debate on the registrability of single colour marks and the significance of pantone numbers, explicitly in the restrictive field of fashion, where it is getting easier and easier for big brands to monopolize the industry and corner the business.



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