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**SO LET THE PAINT BE SPREAD, WE'RE PAINTING THE  
*SOLES RED*<sup>†</sup>**

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<sup>†</sup> SAMMY FAIN & BOB HILLIARD, PAINTING THE ROSES RED (1951), *available at* [http://disney.wikia.com/wiki/Painting\\_the\\_Roses\\_Red](http://disney.wikia.com/wiki/Painting_the_Roses_Red) (adapting the lyrics to *Painting the Roses Red* for the title of this paper).

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## I. INTRODUCTION

In fantasy, one imagines improbable or impossible things.<sup>1</sup> There is a sense of adventure, wonder, and magic transcending reality.<sup>2</sup> If literary characters like Cinderella<sup>3</sup> and Dorothy Gale<sup>4</sup> had an opinion on the matter, they would certainly agree. In fairy tales and fantasies, audiences have seen how glass slippers<sup>5</sup> can make dreams come true, and how the power of a pair of ruby red slippers<sup>6</sup> can take someone home with nothing more than a click of the heels.<sup>7</sup> Footwear designer Christian Louboutin has said, “A shoe has so much more to offer than

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<sup>1</sup> See “Fantasy in English,” OXFORD DICTIONARIES ONLINE, <http://oxforddictionaries.com/definition/english/fantasy> (last visited Sept. 14, 2014) (defining “fantasy” as the imagining of impossible or improbable things).

<sup>2</sup> See *id.* (describing how “fantasy”, when used as a modifier, can mean unrealistic ideas or fiction involving magic and adventure).

<sup>3</sup> See “Cinderella,” BRITANNICA ONLINE ENCYCLOPEDIA, <http://www.britannica.com/EBchecked/topic/676833/Cinderella> (last visited Sept. 14, 2014) (providing an overview of the 1950 film adaptation made by Walt Disney of the original fairy tale Cinderella by Charles Perrault). In the animated adaptation of the classic fairy tale, Cinderella is a young, beautiful girl virtually enslaved by her cruel stepmother and her jealous stepsisters. *Id.* With the help of the enchantments of her fairy godmother, Cinderella is able to attend a royal ball where she has until midnight to meet Prince Charming. *Id.* With no time to spare, Cinderella flees from Prince Charming as the clock strikes midnight. *Id.* Cinderella accidentally leaves behind one of her glass slippers as she runs from the ball. *Id.* Prince Charming then uses the glass slipper to find Cinderella, and, shortly after, they get married and live happily ever after. *Id.*

<sup>4</sup> See “The Wizard of Oz,” BRITANNICA ONLINE ENCYCLOPEDIA, <http://www.britannica.com/EBchecked/topic/646330/The-Wizard-of-Oz> (last visited Sept. 14, 2014) (providing an overview of the 1939 musical film adaptation of Frank L. Baum’s classic book). In *The Wizard of Oz*, Dorothy Gale, a young girl from Kansas, runs away from home with her dog Toto out of fear that Toto will be put down for biting her neighbor. *Id.* After encountering Professor Marvel, a fortune-teller, she is persuaded to return home to her aunt and uncle. *Id.* However, while in her home waiting for her aunt and uncle, she is knocked unconscious during a tornado. *Id.* During this period of unconsciousness, she is transported, or so she believes, in her home to the land of Oz. *Id.* Dorothy’s home lands in Munchkinland on top of the Wicked Witch of the East who was wearing ruby red slippers at the time. *Id.* After realizing she has killed the Wicked Witch of the East, the magical ruby red slippers then appear on Dorothy’s feet. *Id.* Dorothy soon embarks on an adventure to the Emerald City seeking the Wizard of Oz to help her return home in Kansas. *Id.* Once Dorothy meets the Wizard, she realizes he does not have any powers of wizardry to transport her home. *Id.* Glinda the Good Witch then informs Dorothy that she will return to Kansas simply by clicking her ruby red heels. *Id.* Dorothy follows the instructions and awakens in her home in Kansas. *Id.*

<sup>5</sup> See *supra* note 3 and accompanying text.

<sup>6</sup> See *supra* note 4 and accompanying text.

<sup>7</sup> See *id.*

just to walk.”<sup>8</sup> Some have argued that shoes can act as a looking glass into the age, income, and personality of a person by simply looking at their choice of footwear rather than the person wearing the shoes.<sup>9</sup> Whether this ability to understand someone by their shoes is rooted in the fantastical idea of true omniscience or whether it is plain human judgment, it seems more likely to be the latter.

The fantasy of power in footwear has grown considerably since the development of shows like *Sex and the City*.<sup>10</sup> Carrie Bradshaw,<sup>11</sup> the glamorous protagonist of *Sex and the City*, frequently wore designs by Christian Louboutin,<sup>12</sup> Manolo Blahnik,<sup>13</sup> and Jimmy Choo,<sup>14</sup> not only

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<sup>8</sup> See Lauren Collins, *Sole Mate*, NEW YORKER (Mar. 28, 2011), <http://www.newyorker.com/magazine/2011/03/28/sole-mate> (quoting French footwear and handbag designer Christian Louboutin).

<sup>9</sup> See Cari Nierenberg, *You Really Can Judge People by Their Shoes*, TODAY.COM (June 13, 2012), [http://todayhealth.today.com/\\_news/2012/06/13/12206095-you-really-can-judge-people-by-their-shoes](http://todayhealth.today.com/_news/2012/06/13/12206095-you-really-can-judge-people-by-their-shoes) (describing a study testing how accurate sixty-three college students could gauge a person’s “personality, attachment style, political bent and demographic measures, such as age, gender, and family income” by looking at their shoes). Researchers have found that age, income, and gender are visible characteristics that can be more easily discerned without viewing the person wearing the shoe but simply by viewing the shoe. *Id.* However, most surprisingly, researchers found that people could accurately guess a person’s attachment anxiety. *Id.* Attachment anxiety connotes how concerned a person is with being rejected or abandoned in a close relationship. *Id.*

<sup>10</sup> See generally *Sex and the City Premieres on HBO*, HISTORY, <http://www.history.com/this-day-in-history/sex-and-the-city-premiered-on-hbo> (last visited Sept. 14, 2014) (detailing a comprehensive overview of the premise of the cable network television show *Sex and the City* and the success of the show). In 1998, the cable network HBO launched the comedy series *Sex and the City*. *Id.* The show follows the lives of four single females living in New York City. *Id.* Actress Sarah Jessica Parker portrayed the lead character Carrie Bradshaw, a writer using her own life as inspiration to write her column for the fictional newspaper *New York City Star*. *Id.* It is explained that “[t]he main premise--that each episode provides fodder for one of Carrie’s columns, each of which features a different question about sex, love and relationships--remained constant throughout the show.” *Id.*

<sup>11</sup> See generally *Carrie Bradshaw*, HBO, <http://www.hbo.com/sex-and-the-city/cast-and-crew/carrie-bradshaw/index.html#/sex-and-the-city/cast-and-crew/carrie-bradshaw/bio/carrie-bradshaw.html> (last visited Sept. 14, 2014) (describing the fictional author Carrie Bradshaw of the HBO show *Sex and the City*). Despite the trials and tribulations of love faced by Carrie Bradshaw spanning six seasons, it is her sense of style that became a true staple of the show. *Id.* In describing the protagonist’s style, “[r]ummage through Carrie’s closet and you’ll find haute couture pieces side by side with vintage frocks, downtown club wear and miles of Manolo Blahnik stilettos. Carrie expresses her eclectic, whimsical self and that of her city through a masterful and sometimes outrageous mix of these styles.” *Id.*

<sup>12</sup> See generally Kori Ellis, *Christian Louboutin - Fashion Designer*, ABOUT

on the show but also in the subsequent films.<sup>15</sup> However, the significance of the footwear revolution goes beyond the impact on the common shopper, but on the companies producing the shoes.<sup>16</sup> Though high fashion<sup>17</sup> footwear is not normally lumped into categories with companies such as Tiffany & Co.<sup>18</sup> and the United

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STYLE, <http://accessories.about.com/od/fashiondesigners/p/louboutin.htm> (last visited Sept. 14, 2014) (recounting a brief biography of French fashion designer Christian Louboutin). Footwear designer Christian Louboutin is widely known for producing shoes with red lacquered soles. *Id.* Shoes by the designer have been seen on numerous celebrities such as Angelina Jolie, Britney Spears, and Madonna. *Id.*

<sup>13</sup> See generally *Manolo Blahnik*, MANOLO BLAHNIK, <http://www.manoloblahnik.com/> (last visited Sept. 14, 2014) (discussing Manolo Blahnik's remarkably successful career as a high fashion footwear designer for over thirty years).

<sup>14</sup> See generally *Jimmy Choo*, BIOGRAPHY.COM, <http://www.biography.com/people/jimmy-choo-20692491> (last visited Sept. 14, 2014) (detailing the life and success of high fashion footwear designer Jimmy Choo).

<sup>15</sup> See *Sex and the City: A Product Placement Roundup*, VANITY FAIR (May 30, 2008), <http://www.vanityfair.com/online/daily/2008/05/sex-and-the-city> [hereinafter *A Product Placement Roundup*] (describing the abundance of product placement in *Sex and the City*, the television series and the film); see also Julia Neel, *Sex and the City 2*, BRITISH VOGUE (Nov. 5, 2009), <http://www.vogue.co.uk/spy/celebrity-photos/2009/11/05/sex-and-the-city-2-fashion-and-costumes> (describing how designer staples of *Sex and the City* such as Chanel and Manolo Blahnik were featured in *Sex and the City 2*). The television series *Sex and the City* put designers such as Manolo Blahnik and Jimmy Choo in the spotlight. VANITY FAIR, *supra*. With the 2008 release of *Sex and The City: The Movie*, there was an abundance of product endorsements seen throughout the film. *Id.* Designer pieces by Chanel, Christian Louboutin, and Manolo Blahnik were featured in the film. *Id.*

<sup>16</sup> See *Shoes and the City*, INSTYLE, [http://www.instyle.com/instyle/package/general/photos/0,,20164501\\_20198488\\_20217652,00.html](http://www.instyle.com/instyle/package/general/photos/0,,20164501_20198488_20217652,00.html) (last visited Sept. 14, 2014) (describing how with the launch of the television series *Sex and the City*, a shoe revolution began with the emergence of a voice in a character like Carrie Bradshaw who has an unwavering passion for fine footwear); see also, e.g., *A Product Placement Roundup*, *supra* note 15 (demonstrating how proper product recognition alone is coveted by large companies as a means of marketing).

<sup>17</sup> See "High Fashion," MERRIAM-WEBSTER ONLINE, <http://www.merriam-webster.com/dictionary/high%20fashion> (last visited Sept. 14, 2014) (defining "high fashion" as "high style" or "haute couture").

<sup>18</sup> See *Tiffany & Co. (TIF) Profile*, YAHOO! FINANCE, <http://finance.yahoo.com/q/pr?s=TIF+Profile> (last visited Sept. 14, 2014) (describing how Tiffany & Co. "designs, manufactures, and retails jewelry worldwide."). *Id.* Since 2012, Tiffany & Co. "operated 292 stores, including 121 stores in the Americas, 72 stores in the Asia-Pacific, 55 stores in Japan, and 38 stores in Europe, 5 stores in the United Arab Emirates, and 1 store in Russia. The company was founded in 1837 and is headquartered in New York, New York." *Id.*

Parcel Service (“UPS”),<sup>19</sup> there is a common factor that these two companies and a high fashion footwear designer like Christian Louboutin share. The power of a single trademarked color has become essential to the recognition and success of each company.<sup>20</sup>

With the help of a color and the image of Audrey Hepburn as Holly Golightly standing in front of a jewelry store window on Fifth Avenue in New York City,<sup>21</sup> Tiffany & Co. has become a world-renowned jeweler exceeding 200 stores around the world.<sup>22</sup> Tiffany Blue,<sup>23</sup> sometimes referred to as robin’s-egg blue or forget-me-not blue, was chosen by Tiffany & Co. founder Charles Lewis Tiffany for the cover of the Blue Book in 1845.<sup>24</sup> Tiffany Blue was later adopted

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<sup>19</sup> See *United Parcel Service, Inc. (UPS) Profile*, YAHOO! FINANCE, <http://finance.yahoo.com/q/pr?s=UPS> (last visited Sept. 14, 2014) (“United Parcel Service, Inc., a package delivery company, provides transportation, logistics, and financial services in the United States and internationally.”). It has been noted that United Parcel Service, Inc. “operates a fleet of approximately 103,000 package cars, vans, tractors, and motorcycles; and owns 33,000 containers used to transport cargo in its aircraft. United Parcel Service, Inc. was founded in 1907 and is headquartered in Atlanta, Georgia.” *Id.*

<sup>20</sup> See *infra* notes 22–36 and accompanying text.

<sup>21</sup> See Laurie Boeder, *Breakfast at Tiffany’s’ with Holly Golightly*, ABOUT ENTERTAINMENT, <http://classicfilm.about.com/od/comedies/fr/BreakfastTiffan.htm> (last visited Sept. 14, 2014) (providing a brief synopsis of the 1961 film adaptation of Truman Capote’s novella *Breakfast at Tiffany’s* starring Audrey Hepburn in the lead as Holly Golightly); see also *Tiffany Flagship*, TIFFANY & CO. FOR THE PRESS, <http://press.tiffany.com/ViewBackgrounder.aspx?backgrounderId=3> (last visited Sept. 14, 2014) (stating that the Fifth Avenue location in New York City is where the scene of Audrey Hepburn standing as Holly Golightly in front of the windows at Tiffany & Co. was filmed for the movie *Breakfast at Tiffany’s*). The opening scene of the film begins in the morning with Holly Golightly eating a danish and drinking a cup of coffee while in her night gown as she peruses the display windows at Tiffany & Co. in New York City. Boeder, *supra*.

<sup>22</sup> See *Tiffany & Co. History*, TIFFANY & CO. FOR THE PRESS, <http://press.tiffany.com/ViewBackgrounder.aspx?backgrounderId=38> (last visited Sept. 14, 2014) (asserting that Tiffany & Co. is world-renowned and currently supporting over 200 stores worldwide).

<sup>23</sup> See *id.* (explaining that the shade of turquoise known as Tiffany Blue was likely chosen because of the popularity of turquoise gemstones in the nineteenth century); see also Susannah Frankel, *Ready to Wear: The Fight over Red Is Really Just About the Colour of Money*, THE INDEPENDENT (Oct. 31, 2011), <http://www.independent.co.uk/life-style/fashion/frankel/ready-to-wear-the-fight-over-red-is-really-just-about-the-colour-of-money-6252706.html> (providing that Tiffany & Co. registered the Tiffany Blue color trademark in 1998).

<sup>24</sup> TIFFANY & CO. FOR THE PRESS, *supra* note 22; see *Blue Book*, TIFFANY & CO. FOR THE PRESS, <http://press.tiffany.com/ViewBackgrounder.aspx?backgrounderId=30> (last visited Sept. 14, 2014) (explaining that Tiffany’s Blue Book is an annual publication of the jeweler’s “latest and most spectacular jewels in all their glamour and brilliance” that

*continued . . .*

for the shopping bags and promotional materials.<sup>25</sup> With the launch of the Tiffany Blue Box®,<sup>26</sup> Tiffany & Co. would mold into the vision of its founder as an icon of luxury, opulence, and exclusivity.<sup>27</sup> In 1906, the *New York Sun*<sup>28</sup> reported that Charles Lewis Tiffany had implemented an inexorable rule at Tiffany & Co.<sup>29</sup> The longstanding rule still in place today is that Tiffany Blue boxes bearing the name “Tiffany & Co.” cannot be purchased, and may only leave the establishment if an item has been sold for which Tiffany & Co. is responsible.<sup>30</sup>

Beyond companies producing shoes and jewelry, companies like UPS<sup>31</sup> and others internationally have seen great success with trademarked colors as a means of identification and marketing.<sup>32</sup>

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has been delivered to customers since 1845); *see generally* Charles Lewis Tiffany, TIFFANY & CO. FOR THE PRESS, <http://press.tiffany.com/ViewBackgrounder.aspx?backgrounderId=8> (last visited Sept. 14, 2014) (describing the founding of Tiffany & Co. by Charles Lewis Tiffany in 1837).

<sup>25</sup> *Blue Book*, *supra* note 24.

<sup>26</sup> *See* TIFFANY & CO. FOR THE PRESS, *supra* note 22; *see also* *Tiffany Blue: The Color of Love*, LUXURY INSIDER, <http://www.luxury-insider.com/features/2012/tiffany-blue-the-color-of-love> (last visited Sept. 14, 2014) (describing how Tiffany Blue Boxes have become independently iconic).

Charles Tiffany’s coveted box has become an international symbol of exclusivity, elegance and sophistication. Today, all Tiffany & Co. designs are presented in the Tiffany Blue Box, instantly recognizable as an icon of design excellence and a symbol of the most precious gifts. . . . [T]he Tiffany Blue Box® is a harbinger of a happy occasion, as well as an enduring token of historical value.

*Tiffany Blue: The Color of Love*, *supra* note 22.

<sup>27</sup> TIFFANY & CO. FOR THE PRESS, *supra* note 22.

<sup>28</sup> *See* “*New York Sun*,” BRITANNICA ONLINE ENCYCLOPEDIA, <http://www.britannica.com/EBchecked/topic/412540/New-York-Sun> (last visited Sept. 14, 2014) (providing the history of the American newspaper the *New York Sun*). Benjamin H. Day founded the daily newspaper the *New York Sun* in 1833. *Id.* The *New York Sun* was published from 1833–1950 in New York City. *Id.*

<sup>29</sup> TIFFANY & CO. FOR THE PRESS, *supra* note 22.

<sup>30</sup> *Id.*

<sup>31</sup> *See* YAHOO! FINANCE, *supra* note 19 and accompanying text.

<sup>32</sup> *See infra* notes 33–36 and accompanying text; *see also* Lucy Tobin, *Cadbury Wins Legal Battle Over Purple Packaging*, THE INDEPENDENT (Oct. 2, 2012), <http://www.independent.co.uk/news/business/news/cadbury-wins-legal-battle-over-purple-packaging-8193220.html> (describing briefly the litigation between Cadbury and Nestlé over the trademark of the color purple in the United Kingdom); *Cadbury Trademarks Purple Chocolate Wrappers, Wins 3-Year Battle with Nestle*, UFF POST FOOD (Nov. 21, 2011), [http://www.huffingtonpost.com/2011/11/21/cadbury-trademarks-purple\\_n\\_1105662.html](http://www.huffingtonpost.com/2011/11/21/cadbury-trademarks-purple_n_1105662.html). *See generally* Nestle, FORBES,

*continued . . .*

Since 1916, UPS, the world's largest package-delivery company, has used the color brown as a signifier of the company.<sup>33</sup> Brown® is a registered trademark of UPS.<sup>34</sup> In 2002, a \$45 million campaign was launched by UPS revolving around the slogan “[w]hat can brown do for you?”, which cites the famous trademarked color.<sup>35</sup> At UPS, brown is considered more than a color—it is a tangible asset to the company's brand.<sup>36</sup>

French footwear designer Christian Louboutin (“Christian Louboutin”) produces shoes with a trademarked, red-lacquered sole.<sup>37</sup> Christian Louboutin's line of shoes has become instantly recognizable to those most attuned to current fashion due to the famous starlets who have popularized the shoes.<sup>38</sup> Catherine Deneuve,<sup>39</sup> Gwyneth

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<http://www.forbes.com/companies/nestle/> (last visited Sept. 14, 2014) (providing that Nestlé is a Swiss company responsible for producing items such as beverages, water, milk products, ice cream, confectionary, and pharmaceutical products); *The Story*, CADBURY.CO.UK, <http://www.cadbury.co.uk/the-story> (last visited Sept. 14, 2014) (providing a timeline of the history and development of the almost 200 year old British confectionary giant Cadbury). Although the British confectionary company Cadbury has succeeded in trademark litigation for the color purple overseas, the importance of a single color trademark can be appreciated despite transnational legal differences. Tobin, *supra*. Cadbury has utilized the color purple for its packaging for over 100 hundred years. HUFF POST FOOD, *supra*. Cadbury has sought exclusive use of the right to the particular shade of purple since 1995, and in 2008, the British Intellectual Property Office granted the trademark for the color purple. *Id.* After a three-year legal battle with Nestlé, Cadbury received full rights to the color. *Id.*

<sup>33</sup> Victoria Slind-Flor, *GE, UPS, Ubisoft, ASCAP, General Motors: Intellectual Property*, BLOOMBERG, (Mar. 26, 2008), [http://www.bloomberg.com/apps/news?pid=new\\_sarchive&sid=aBywjiegVKZE](http://www.bloomberg.com/apps/news?pid=new_sarchive&sid=aBywjiegVKZE).

<sup>34</sup> *UPS Trademark Guidelines in the U.S.*, UPS (2014), <http://www.ups.com/media/en/trademarks.pdf> (documenting UPS trademarks and servicemarks, including Brown®, that are registered with the United States as of January 2014).

<sup>35</sup> See *UPS Unveils ‘What Can Brown Do for You?’ Ad Campaign*, BUSINESS JOURNALS (Feb. 7, 2002), <http://www.bizjournals.com/louisville/stories/2002/02/04/daily35.html> (describing the development and cost of UPS's ‘What Can Brown Do For You?’ ad campaign).

<sup>36</sup> See *id.* (“‘At UPS, brown is more than a color—it’s a tangible asset that people associate with all the things that are good about our brand,’ said Dale Hayes, vice president for brand management and customer communications, in a news release.”).

<sup>37</sup> See CHRISTIAN LOUBOUTIN, [http://us.christianlouboutin.com/us\\_en](http://us.christianlouboutin.com/us_en) (last visited Sept. 14, 2014) (showing the collection of shoes produced by Christian Louboutin featuring red soles); see also Cindy Clark, *Christian Louboutin's Red-Soled Shoes Are Red-Hot*, USA TODAY (Dec. 25, 2007), [usatoday30.usatoday.com/life/lifestyle/fashion/2007-12-25-louboutin-shoes\\_N.htm](http://usatoday30.usatoday.com/life/lifestyle/fashion/2007-12-25-louboutin-shoes_N.htm) (stating that red-lacquered soles are a registered trademark of Christian Louboutin).

<sup>38</sup> Clark, *supra* note 37.

Paltrow,<sup>40</sup> and Nicole Kidman<sup>41</sup> are only a few of the many celebrities who have donned a pair of the red-lacquered high heels.<sup>42</sup> Christian Louboutin has stated, ever so simply, that he began painting the soles of shoes red because “it is the color of love. It’s the color of passion. Even if a woman is wearing all black, she might choose a red lip or red nails.”<sup>43</sup> The importance of the simple idea of red lacquer on the sole of a shoe has become a tool of identification and instant recognition of Christian Louboutin once the red sole is spotted.<sup>44</sup> However, designer Christian Louboutin is certainly not the first to utilize a distinct color as a tool of recognition and marketing.<sup>45</sup>

With lucrative companies like Tiffany & Co. and UPS making certain colors instrumental to their brands, respectively, for over 100 years, Christian Louboutin’s emergence as an up-and-coming designer utilizing a single color appeared to be a brilliant business strategy.<sup>46</sup> However, the pattern of protecting single color trademarks may be approaching a legal halt.<sup>47</sup> In *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*,<sup>48</sup> the red-lacquered sole trademark became the focal point of litigation between Christian Louboutin S.A. (“Louboutin”) and Yves Saint Laurent America, Inc. (“Yves Saint Laurent”).<sup>49</sup> After a heated legal battle, the Second Circuit allowed Louboutin to retain the rights to Pantone-18 Chinese Red<sup>50</sup> splashed on the bottom of

<sup>39</sup> See generally *Catherine Deneuve*, BIO, <http://www.biography.com/people/catherine-deneuve-38260> (last visited Sept. 14, 2014) (providing a very brief biography of French actress Catherine Deneuve).

<sup>40</sup> See generally *Gwyneth Paltrow Biography*, LIFETIME, <http://www.thebiographychannel.co.uk/biographies/gwyneth-paltrow.html> (last visited Sept. 14, 2014) (describing the life and work of Academy Award-winning actress Gwyneth Paltrow).

<sup>41</sup> See generally *About Nicole*, NICOLE KIDMAN, <http://nicolekidmanofficial.com/about-nicole/> (last visited Sept. 14, 2014) (detailing the life and career of award-winning actress Nicole Kidman).

<sup>42</sup> See Clark, *supra* note 37 (listing several actresses who have worn shoes by Christian Louboutin).

<sup>43</sup> *Id.*

<sup>44</sup> *Id.* (describing Christian Louboutin red soles as recognizable when seen in films, fashion photo shoots, red carpet events, and commercials).

<sup>45</sup> See *supra* notes 22–36 and accompanying text; see also *infra* text accompanying notes 75–112.

<sup>46</sup> See *supra* text accompanying note 18; see also *Company History*, UPS, <http://www.ups.com/content/us/en/about/index.html> (last visited Sept. 14, 2014) (providing that UPS was founded in 1907).

<sup>47</sup> See, e.g., *infra* text accompanying notes 72–110.

<sup>48</sup> See generally *Christian Louboutin S.A. v. Yves Saint Laurent Am., Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012).

<sup>49</sup> *Id.* at 228.

<sup>50</sup> See PANTONE, COLOR IDENTIFICATION/CONTROLS (2006), available at

*continued . . .*

every high-heeled shoe.<sup>51</sup> However, the trademark had to be changed from its original version to a version that effectively diminished the level of protection initially afforded to Louboutin.<sup>52</sup> The Second Circuit weighed its decision to change Louboutin's single color trademark on a determination that the trademark only carries a secondary meaning when the red sole of the shoe contrasts with the color of the shoe's body.<sup>53</sup> With the recent decision in *Christian Louboutin*,<sup>54</sup> does the Louboutin fashion house have a leg, or *red-lacquered heel*, to stand on in the matter of single color trademarks?

Though the decision in *Christian Louboutin* appears to be a victory for the red-lacquered shoes, the reality is that Louboutin lost the full rights to the red-lacquered sole trademark when the court determined that it was acceptable for Yves Saint Laurent to produce a monochromatic red shoe.<sup>55</sup> *Christian Louboutin* jeopardizes the comfort of companies like Tiffany & Co. and UPS in their single color trademarks in the United States.<sup>56</sup> If the Louboutin red-lacquered sole is only protected when the red sole contrasts with the rest of the shoe as the court determined, the implications of such a decision could be

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[http://www.pantone.com/downloads/articles/pdfs/ColorIDControls\\_Brochure.pdf](http://www.pantone.com/downloads/articles/pdfs/ColorIDControls_Brochure.pdf) (explaining how Pantone operates a color licensing program that allows manufacturers "to produce their products in PANTONE Colors and to identify the colors by its respective Pantone-approved color identification."); *see also What We Do*, PANTONE, <http://www.pantone.com/pages/pantone/pantone.aspx?pg=19295&ca=10> (last visited Sept. 14, 2014) (providing an overview of what the company Pantone does in relation to its color-matching system internationally which has been adopted in industries such as "digital technology, fashion, home, plastics, architecture and contract interiors, and paint."); Martha de Lacey, *DIY Louboutins? Sales of Red Tester Paint Pots Soar as Women Create Homemade Versions of Stars' Favourite Shoes*, DAILY MAIL (July 10, 2012), <http://www.dailymail.co.uk/femail/article-2171399/Sales-red-tester-paint-pots-soar-women-create-homemade-Louboutin-copies.html> (detailing how Louboutin uses Pantone-18 Chinese Red paint for the red-lacquered soles).

<sup>51</sup> *See infra* text accompanying notes 173–74.

<sup>52</sup> *See infra* text accompanying notes 173–74.

<sup>53</sup> *See infra* text accompanying note 172.

<sup>54</sup> *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 206 (2d Cir. 2012).

<sup>55</sup> *See infra* text accompanying notes 175–76.

<sup>56</sup> *See generally* Danielle E. Gorman, *Revisiting Single Color Trademarks in Fashion After Louboutin*, 31 CARDOZO ARTS & ENT. L.J. 209, 212 (2013) [hereinafter *Revisiting Single Color Trademarks*] (discussing how the Second Circuit's opinion in *Louboutin* could leave companies with trademarks at risk to an aesthetic functionality defense). The Second Circuit set out a test for aesthetic functionality, but did not apply it to the facts of the case. *Id.* Thus, even *Christian Louboutin*'s trademark is not safe if a company can bring a "fact-based aesthetic functionality defense." *Id.*

disastrous for companies like Tiffany & Co. or UPS.<sup>57</sup> A potential challenge to the single color trademarks of Tiffany & Co. and UPS could yield limitations to trademark protection just as in *Christian Louboutin*.<sup>58</sup>

Mindful of these developments, this article delves into the legal importance of single color trademark registration in the United States, and how companies relying on the legal protections afforded to single color trademarks may no longer feel safe from trademark infringement as exemplified by the recent holding in *Christian Louboutin*.<sup>59</sup> Part II provides a brief overview of the history of trademark legislation in the United States and contains a carefully detailed analysis of the advancement of the law in protecting single color trademarks.<sup>60</sup> Part III explains the landmark decision made by the Supreme Court of the United States, which resolved the issue of whether single color trademarks could be granted protection under the law.<sup>61</sup> Part IV details the most recent decision regarding single color trademark and questions whether single color trademarks are safe under the current state of the law.<sup>62</sup> Part V proposes amending the Lanham Act as a means of providing uniformity to the law on single color trademarks, expanding the analysis under secondary meaning specifically for single color trademarks, and imposing new time limitations that should be set in place for single color trademarks.<sup>63</sup>

## II. HISTORY AND DEVELOPMENT OF SINGLE COLOR TRADEMARK REGISTRATION

In 1870, the United States passed its first federal trademark statute, the Trademark Act of 1870.<sup>64</sup> It would not be until the passing of the

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<sup>57</sup> See *supra* note 56 and accompanying text; *infra* notes 173–74 and accompanying text.

<sup>58</sup> See *supra* note 56 and accompanying text.

<sup>59</sup> *Christian Louboutin S.A.*, 696 F.3d at 206.

<sup>60</sup> See *infra* Part II.

<sup>61</sup> See *infra* Part III.

<sup>62</sup> See *infra* Part IV.

<sup>63</sup> See *infra* Part V.

<sup>64</sup> Patent Act of 1870, ch. 230, 16 Stat. 198, 198–217 (1870), *invalidated by* Trade-Mark Cases, 100 U.S. 82 (1879); *see also* Trade-Mark Cases, 100 U.S. 96–97 (declaring the Trademark Act of 1870 unconstitutional because the statute did not limit the acts as taking place in interstate or foreign commerce and thus it was enacted beyond the constitutional powers of Congress); *see generally* 1 ANNE GILSON LALONDE & JEROME GILSON, GILSON ON TRADEMARKS § 1.06 (2014) (providing an elaboration on the history and progress of trademark law beginning with the Trademark Act of 1870). The Act of 1881 replaced the Trademark Act of

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Trademark-Law of 1946 (the “Lanham Act”)<sup>65</sup> that more broadened protections were afforded through a congressional statute for federal trademarks.<sup>66</sup> Pursuant to the Lanham Act, a “trademark” is any word, name, symbol, or device, or any combination of the preceding used by a person “to identify and distinguish his or her goods . . . .”<sup>67</sup> Trademarks are requested for registration with the United States Patent and Trademark Office (the “USPTO”) for the purpose of setting apart a product from those manufactured or sold by others and to signify the source of the goods.<sup>68</sup> Prior to the Lanham Act, color alone did not qualify for trademark registration.<sup>69</sup>

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1870, which was later replaced by the 1905 Act. The 1905 Act and a supplemental Act passed in 1920 would dictate trademark law until the passing of the Lanham Act in 1946.

<sup>65</sup> Trademark (Lanham) Act of 1946, 15 U.S.C. §§ 1051–1127 (2012); see Louis T. Pirkey, *Fritz Lanham—Portrait of A Remarkable Man*, 86 TRADEMARK REP. 355, 355 (1996) (illustrating the efforts taken by Congressman Fritz Garland Lanham to pass modern trademark legislation). In 1938, Congressman Fritz Garland Lanham introduced the “Lanham Trade-Mark Law” to Congress, which was later signed into law by President Harry S. Truman on July 5, 1946. *Id.*

<sup>66</sup> See Pirkey, *supra* note 65. Congressman Lanham fought Congress for eight years to pass the “Lanham Trade-Mark Act”—arguably the most important piece of modern legislation in the realm of trademarks—in a valiant effort to modernize trademark law because it was his conviction that the interests of the nation commanded modernization through a broadening of trademark legislation. *Id.*

<sup>67</sup> 15 U.S.C. § 1127 (2012).

<sup>68</sup> See 15 U.S.C. § 1051(a)(1) (2012) (explaining the initial process of trademark registration); see also 15 U.S.C. § 1127 (asserting that often trademarks are used to distinguish a product in a competitive market and as a manufacture mark so the consumer is aware of who the maker is despite not knowing the name of the company or manufacturer); *The USPTO: Who We Are*, USPTO, <http://www.uspto.gov/about/index.jsp> (last modified Mar. 4, 2013) [hereinafter *USPTO*] (providing a comprehensive overview of the responsibilities of the United States Patent and Trademark Office); *Trademark*, BRITANNICA ONLINE ENCYCLOPEDIA, <http://www.britannica.com/EBchecked/topic/601724/trademark> (last visited Sept. 14, 2014) (defining a trademark as a “visible sign or device” utilized by businesses to identify and distinguish a product from competing products in the market). In the United States, the rights to a trademark are established by mere use, but only by registration of the mark is the owner granted procedural advantages. *Id.* The owner of a trademark may request registration of the trademark on the principal register by paying the established fee and filing in the Patent and Trademark Office an application and verified statement. 15 U.S.C. § 1051(a)(1). The United States Patent and Trademark Office is responsible for granting United States patents and registering trademarks. *USPTO, supra.*

<sup>69</sup> See *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U.S. 166, 171 (1906) (“Whether mere color can constitute a valid trademark may admit of doubt. Doubtless it may, if it be impressed in a particular design, as a circle, square, triangle, a cross, or a star. But the authorities do not go farther than this.”) *abrogated by Hurn v. Oursler*, 289 U.S. 238 (1933).

Despite the exclusion of color registration, some courts afforded protection to companies who could demonstrate that trademark registration protection is an essential defense against unfair competition, and that the company's color trademark carries a secondary meaning.<sup>70</sup> With the hesitant emergence of color recognition prior to the Lanham Act, the United States would not recognize the trademark of a single color until 1987.<sup>71</sup> The Owens-Corning Fiberglas Corporation ("Owens-Corning") would be the first to pave a long-standing path in color mark litigation.<sup>72</sup>

Owens-Corning has effectively evolved an entire fibrous glass insulation business around the color PINK® by using the Pink Panther as its mascot since 1980 and managing to trademark the color PINK® in 1987.<sup>73</sup> Owens-Corning has achieved steady success since its

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<sup>70</sup> See, e.g., *Park 'n Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985) (explaining how a descriptive mark that only describes a good or service must hold a secondary meaning that "has become distinctive of the applicant's goods in commerce" to qualify for registration (citing 15 U.S.C. § 1052(f) (2012)); *Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.*, 147 F.2d 407, 415 (6th Cir. 1945) (establishing that the plaintiff had no exclusive claim over the color yellow, but is granted protection by virtue of the plaintiff's "long established use" of the color for taxicabs); *Clifton Mfg. Co. v. Crawford-Austin Mfg. Co.*, 12 S.W.2d 1098, 1101–02 (Tex. Civ. App. 1929) (finding that it was proper to restrain defendant from manufacturing "reddish brown" colored tents, tarpaulins, and wagon covers of a color similar to that which the plaintiff uses).

<sup>71</sup> See Glenn Collins, *COMPANY NEWS; Europe's Insulation Market is Target of Owens-Corning*, N.Y. TIMES, Nov. 12, 1994, <http://www.nytimes.com/1994/11/12/business/company-news-europe-s-insulation-market-is-target-of-owens-corning.html>.

<sup>72</sup> See, e.g., *id.*; see also *Owens Corning*, N.Y. TIMES, <http://topics.nytimes.com/topics/news/business/companies/owens-corning/index.html> (last visited Mar. 15, 2013) (detailing information on the Owens-Corning Corporation as well as its status in the stock market). The Owens-Corning Fiberglas Corporation was the first company to trademark a single color. Collins, *supra* note 71. In summation, "Owens-Corning is engaged in composite and building materials systems, delivering a range of products and services. The Company's products range from glass fiber used to reinforce composite materials for transportation, electronics, marine, infrastructure, wind-energy and other markets to insulation and roofing for residential, commercial and industrial applications." *Owens Corning*, *supra* note 71.

<sup>73</sup> *OC@75: A Heritage of Innovation: The 1980s*, <http://www2.owenscorning.com/acquainted/about/history/1980.asp> (last visited Sept. 6, 2013) (illustrating the Owens-Corning's economic and legal achievements since its founding). See Charles H. Ellerbrock, *Trademark Registration of a Color Having Secondary Meaning: In re Owens-Corning Fiberglass Corporation*, 27 IDEA 7, 7 (1986) (detailing the litigation in Owens-Corning's attempt and success in attaining recognition of the color PINK® as a trademark belonging to Owens-Corning). See generally Grey Hall, *A Cartoon History: The Pink Panther*, EXAMINER.COM (Oct.

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founding in 1938 and has been a Fortune® 500<sup>74</sup> company for the past fifty-nine years.<sup>75</sup> The success of Owens-Corning is attributed not only to its reputation in its innovation in glass fiber technology, but also to spearheading the first color trademark and utilizing the benefits of color recognition.<sup>76</sup> Currently, Owens-Corning still retains the rights to the Pink Panther and the color PINK®.<sup>77</sup>

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18, 2010), <http://www.examiner.com/article/a-cartoon-history-the-pink-panther> (detailing how Fritz Freleng created the Pink Panther cartoon character that appeared ever so suave and graceful as he moved to the sound of Henry Mancini's composition during the opening sequence of the movie *The Pink Panther*). Owens-Corning has expended millions of dollars in advertising and promotion of its pink insulation which has garnered insurmountable recognition. Ellerbrock, *supra*. Owens-Corning trademarked the color "PINK." *OC@75: A Heritage of Innovation: The 1980s, supra*.

<sup>74</sup> *Fortune 500*, INC.COM, <http://www.inc.com/encyclopedia/fortune-500.html> (last visited Sept. 6, 2014). In detailing what it means to be considered a "Fortune 500" company and the significance of the title in the business world, it has been explained that:

The term Fortune 500 refers to an annual listing by *Fortune* magazine of the top 500 public companies in the U.S., as ranked by sales, assets, earnings, and capitalization . . . . This list is important to a number of financial groups, but particularly to investors, who study the performance of these select companies. In addition, academic and business researchers look to these companies to learn about best practices in various industries and to discover the secrets to their business and financial success.

*Id.*

<sup>75</sup> See *Getting Acquainted*, OWENS CORNING, <http://www.owenscorning.com/acquainted/> (last visited Sept. 6, 2014) (providing a brief synopsis of Owens-Corning's founding date and its longstanding designation as a Fortune® 500 company).

<sup>76</sup> See *OC@75: A Heritage of Innovation: The 1980s, supra* note 73; Janet R. Hubbard, Note, *Think Pink! Color Can Be A Trademark*, 43 WASH. & LEE L. REV. 1433, 1439 (1986) (detailing the assertions of the Vice President of Owens-Corning from his affidavit regarding the expenditures of Owens-Corning in promoting pink insulation). By the end of the 1970's, Owens-Corning reported sales reaching two billion dollars. *OC@75: A History of Innovation: The 1970s*, OWENS CORNING, <http://www2.owenscorning.com/acquainted/about/history/1970.asp> (last visited Sept. 6, 2014). By the end of the 1980's, sales rose to three billion dollars. *OC@75: A History of Innovation: The 1980s, supra*. Owens-Corning spent more than forty-two million dollars from 1972–1981 in print, radio and television advertisements and promotional materials to promote and establish recognition for their pink fiber insulation. Hubbard, *supra*. An independent survey showed that forty-one percent of consumers in 1980 recognized Owens-Corning as the manufacturer of pink insulation and by 1981 it rose to fifty-one percent of consumers. *Id.*

<sup>77</sup> See *Owens Corning Copyright*, OWENS CORNING, <http://www.owenscorning.com/roofing/copyright> (last visited Sept. 9, 2014) (explaining all copyright and trademark materials presently retained by Owens-Corning).

Despite Owens-Corning's success with its PINK® trademark, *In re Owens-Corning Fiberglas Corp.*<sup>78</sup> resulted in friction among federal circuit courts.<sup>79</sup> Some circuit courts chose to follow *Owens-Corning* by facilitating the protection of a single color as a trademark while others followed the traditional ban on single color trademarks.<sup>80</sup> The *Owens-Corning* court established a limited rule holding that in certain situations it is acceptable to register a single color as a trademark so long as the party seeking single color trademark protection could satisfy the requirements of a two-prong analysis.<sup>81</sup> The analysis first requires a showing that there is no competitive need for the color by other manufacturers or producers in the industry and, second, it must be shown that the color has achieved a secondary meaning.<sup>82</sup>

<sup>78</sup> *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985).

<sup>79</sup> See Danielle E. Gorman, Note, *Protecting Single Color Trademarks in Fashion After Louboutin*, 30 CARDOZO ARTS & ENT. L.J. 369, 375 (2012) [hereinafter *Protecting Single Color Trademarks*]. It has been noted that in *Owens-Corning*:

[T]he court found that the color pink as applied to fibrous glass insulation served no utilitarian purpose (was not functional) and sufficiently acted as a trademark. In doing so, the court noted that the Lanham Act should be construed broadly to afford protection to a wide variety of marks, including color. Moreover, the court suggested that the color depletion theory should give way to more flexible review of each case on its facts. This decision created discord among the circuits, as some followed the *Owens-Corning* rationale permitting protection of single color while others adhered to the traditional ban on “mere color.”

*Id.*

<sup>80</sup> See, e.g., *supra* note 70 and accompanying text. Compare *Master Distribs., Inc. v. Pako Corp.*, 986 F.2d 219, 224 (8th Cir. 1993) (holding that the trademark of a color is valid based on the *Owens-Corning* decision), with *Nutrasweet Co. v. Stadt Corp.*, 917 F.2d 1024, 1027 (7th Cir. 1990) (ruling against the trademark of a “mere” color in accordance with the traditional rule). The court held “[a] per se rule prohibiting the protection of a color alone would essentially render a valid color trademark registration ineffective and unenforceable. This would be extremely confusing and inconsistent . . . [W]e decline to establish a per se prohibition against protecting color alone as a trademark.” *Master Distribs.*, 986 F.2d at 224. The Seventh Circuit Court of Appeals upheld the traditional rule that mere color cannot be monopolized to distinguish a product. *Nutrasweet Co.*, 917 F.2d at 1027. Without a distinctive design, shape, or symbol in conjunction with a color, the Seventh Circuit refused to allow a trademark monopoly of Nutrasweet blue. *Id.*

<sup>81</sup> See *In re Owens-Corning*, 774 F.2d at 1122–27; see also *First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378, 1382 (9th Cir. 1987) (clarifying the limited rule established in *Owens-Corning*); *infra* text accompanying note 84.

<sup>82</sup> See *First Brands*, 809 F.2d at 1382 (providing the *Owens-Corning* two-step analysis as applied to the facts of the case). The court determined that first, there

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The *Owens-Corning* court emphasized the importance of color registration in trademark law and the significance of the Lanham Act as a basis for fostering the much-awaited growth in color registration.<sup>83</sup> The Supreme Court took extensive measures, beyond creating a two-step analysis, to reach a comprehensive, legally historic decision.<sup>84</sup> Courts have customarily looked to factors such as “the nature of the goods, how the color is used, the number of colors or color combinations available, the number of competitors, and customary marketing practices” to determine whether a color qualifies for registration.<sup>85</sup> Outside the scope of the aforementioned factors, the Supreme Court in *Owens-Corning* gravitated to three especially significant considerations: “functionality,”<sup>86</sup> “color depletion,”<sup>87</sup> and “registration of a color having secondary meaning.”<sup>88</sup>

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was no competitive need for the color pink to remain available to insulation producers and, second, that the pink insulation had garnered such widespread recognition through aggressive promotion and the use of the Pink Panther that it had achieved a secondary meaning. *Id.*

<sup>83</sup>*In re Owens-Corning*, 774 F.2d at 1120, 1123 (describing the broad exercise of the Lanham Act in various jurisdictions just as Congress intended). Through judicial application of the Lanham Act, it is evident that a heavily fact-based analysis of each case was the intent of Congress in passing the Lanham Act. *Id.* at 1120. An absolute prohibition of “mere” color trademark registration runs afoul to the modernization of trademark law as intended by the statute. *Id.* Trademarks are essential in facilitating competition amongst businesses. *Id.* at 1123. By encouraging, supporting, and protecting trademarks, the law effectively fosters fair competition in the market and gives consumers the benefit of the quality and reputation expected of the producer or manufacturer of a particular good. *Id.*

<sup>84</sup> See *About our Group*, OWENS CORNING JAPAN, [http://owersorning.jp/index/php?cmd=en\\_group](http://owersorning.jp/index/php?cmd=en_group) (last visited Sept. 20, 2014) (“On May 12, 1987, Owens Corning made legal history as the first company to trademark a color, in this case, PINK.”).

<sup>85</sup>*In re Owens-Corning*, 774 F.2d at 1120 (describing the factors used by courts in determining the “registrability” of a color as a trademark following the Lanham Act).

<sup>86</sup> See *id.* at 1121 (asserting that functionality can bar trademark registration); see also *Ellerbrock*, *supra* note 73, at 26 (stating that courts have established a theory that bars color registration if it is functional by nature). A trademark’s functionality can be determined by the definition provided in the RESTATEMENT OF TORTS: “A feature of the goods is functional . . . if it affects their purpose, action or performance, or the facility or economy of processing, handling, or using them.” *Ellerbrock*, *supra* note 73, at 26 (citing RESTATEMENT OF TORTS § 742 (1938)).

<sup>87</sup> See *In re Owens-Corning*, 774 F.2d at 1120 (explaining the color depletion theory and how courts shied away from the theory following the passage of the Lanham Act); see also *Campbell Soup Co. v. Armour & Co.*, 175 F.2d 795, 798 (3d Cir. 1949) (establishing the color depletion theory); *Ellerbrock*, *supra* note 73, at 27 (providing that the color depletion theory is an antiquated notion that the amount of available colors will be depleted if the registration of colors as trademarks is

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The Supreme Court has determined that a product feature is “functional” if it is indispensable to the use of the product or the feature affects the quality or cost of the product.<sup>89</sup> If functionality is found without secondary meaning, it will result in a bar to trademark registration.<sup>90</sup> Unlike functionality, the color depletion theory no longer carries the legal weight it once did prior to the Lanham Act, therefore, it is not a driving factor in barring trademark registration.<sup>91</sup> Secondary meaning must be shown to overcome issues that functionality may present and to justify the need for registration.<sup>92</sup> If

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allowed). The fear the court demonstrated in *Campbell Soup* is that there are only so many colors so they may “soon run out.” Ellerbrock, *supra* note 73, at 27. The color depletion theory as applied in *Campbell Soup* was appropriate in application, but, with the passing of the Lanham Act, the per se prohibition of color registration for trademarks is contradictory to the “liberating purposes” of the Act. *In re Owens-Corning*, 774 F.2d at 1120.

<sup>88</sup> See *In re Owens-Corning*, 774 F.2d at 1122 (stating how colors have been protected when a secondary meaning has been shown and the colors were generally non-functional in nature, but denied when neither was satisfied).

<sup>89</sup> See *id.* at 1121 (defining functionality and providing the three factors establishing functionality). There are three factors that determine functionality: “(1) whether a particular design yields a utilitarian advantage, (2) whether alternative designs are available in order to avoid hindering competition, and (3) whether the design achieves economies in manufacture or use.” *Id.*

<sup>90</sup> See *In re Owens-Corning*, 774 F.2d at 1120–21 (distinguishing utilitarian features as ineligible for registration whether functional or non-functional); see also “Utilitarian,” DICTIONARY.COM, <http://dictionary.reference.com/browse/utilitarian?s=t> (last visited Mar. 15, 2013) (defining utilitarian as “having regard for utility or usefulness rather than beauty, ornamentation, etc.”); Ellerbrock, *supra* note 73, at 26 (elaborating on the relationship between functionality and secondary meaning as a bar to trademark registration). When color serves primarily as a utilitarian feature of a good, it will not qualify for trademark protection. *In re Owens-Corning*, 774 F.2d at 1120–21. A color trademark will not receive protection if it is merely “aesthetically functional” and without secondary meaning. *Id.* at 1121. Under the Lanham Act, “a trademark consisting of a color which is primarily distinctive of the applicant’s goods, but is otherwise nonregistrable due to incidental functionality, and which does not fall within 15 U.S.C. §1052(a)–(d), may nevertheless become registrable under 15 U.S.C. §1052(f) upon proof of secondary meaning.” Ellerbrock, *supra* note 73, at 26–27.

<sup>91</sup> See Ellerbrock, *supra* note 73, at 27 (describing how the color depletion theory was once a viable basis for refusing color protection until the passing of the Lanham Act excluded the theory as a sole reason for completely barring registration).

<sup>92</sup> See *In re Owens-Corning*, 774 F.2d at 1125 (providing the purpose of an evidentiary showing of secondary meaning and what constitutes evidence sufficient to support secondary meaning). An evidentiary showing of secondary meaning should demonstrate that a trademark has achieved “distinctiveness” manifesting the

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consumers associate a particular trademark with certain goods, then the trademark has achieved secondary meaning and the trademark is entitled to protection.<sup>93</sup> Functionality and secondary meaning have in effect become the crux of a proper color registration analysis as exemplified by *Owens-Corning*.<sup>94</sup> The split in the circuit courts on whether to follow *Owens-Corning* would see a resolution in the landmark decision *Qualitex Co. v. Jacobson Products Co.*<sup>95</sup>

### III. THE IMPACT OF *QUALITEX* ON SINGLE COLOR TRADEMARKS

The Qualitex Company (“Qualitex”) has manufactured dry cleaning press pads with a particular shade of green-gold since the 1950s.<sup>96</sup> In 1989, Jacobson Products (“Jacobson”), one of Qualitex’s competitors, began using a similar shade of green for its own press pads.<sup>97</sup> Qualitex brought a claim against Jacobson for unfair competition challenging Jacobson’s use of the green-gold color.<sup>98</sup>

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source of the goods. *Id.* The evidence should include the method of using the trademark and the effectiveness of the trademark as a means of identification of its source to the public. *Id.*

<sup>93</sup> See Ellerbrock, *supra* note 73, at 29 (elaborating on how products achieve a secondary meaning).

<sup>94</sup> See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 173 (1995) (describing how the Lanham Act was amended by Congress in 1988 partially against the background of the Federal Circuit Court decision in *Owens-Corning*); see also *In re Owens-Corning*, 774 F.2d at 1121 (asserting that in the past, litigation relief has been granted for color trademark status when the product feature proved to be non-functional and had attained a secondary meaning in the market).

<sup>95</sup> *Qualitex*, 514 U.S. at 172. See Sunila Sreepada, *The New Black: Trademark Protection for Color Marks in the Fashion Industry*, 19 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1131, 1140 (2009) (“The *Qualitex* decision resolved a circuit split that formed after the Federal Circuit ruled that a color alone could be registered as a trademark in *In re Owens-Corning Fiberglas Corp.*”).

<sup>96</sup> *Qualitex*, 514 U.S. at 161. See *Qualitex Difference*, QUALITEX, <http://www.qualitexco.com/http/qualitex.html> (last visited Sept. 19, 2014) (“Qualitex Company is the world’s largest manufacturer of press pads and the exclusive manufacturer of the Sun Glow® Press Pad. Recognizable by its unique green-gold color, [Qualitex’s] Sun Glow® press pads can be found on press machines in every corner of the world.”). Qualitex manufactures and distributes a line of press pads and other products purchased by dry cleaners and garment plants globally. *Qualitex Difference*, *supra*.

<sup>97</sup> *Qualitex*, 514 U.S. at 161. See generally *Main Page*, JACOBSON PRODUCTS, <http://www.jacobsonproducts.com> (last visited Sept. 3, 2014) (explaining that Jacobson Products has been dealing with the apparel and dry cleaning industry since 1951 and has produced numerous products benefitting the dry cleaning enterprise).

<sup>98</sup> *Qualitex*, 514 U.S. at 161. See generally 15 U.S.C. § 1125(a)(1)(A)–(B) (2012) (elaborating on how to establish a claim of unfair competition). A person in connection with a good, service, or container for goods who uses in commerce “any

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Subsequently, Qualitex registered the unique green-gold color on press pads with the USPTO in 1991.<sup>99</sup> Qualitex added a trademark infringement count to the unfair competition claim after the green-gold was registered.<sup>100</sup>

The Supreme Court in *Qualitex* determined that an absolute bar on single color trademarks is inconsistent with the Lanham Act after a careful analysis of Jacobson's four reasons for barring this specific type of trademark.<sup>101</sup> Jacobson argued the following key points in support of forbidding single color trademarks: (1) avoidance of "shade confusion,"<sup>102</sup> (2) the color depletion theory,<sup>103</sup> (3) legal precedent,<sup>104</sup>

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word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact" that will likely cause confusion of the source, origin, or sponsorship of the goods or services will face civil liability by any person who believes he or she is or will be negatively impacted by such actions. 15 U.S.C. § 1125(a)(1)(A) (2012). If a person of the same characteristics previously stated does not instigate confusion through terms, symbols, or words relating to the product or service, the same civil liability instead may be incurred by such persons if his or her "commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities." 15 U.S.C. § 1125(a)(1)(B) (2012).

<sup>99</sup> *Qualitex*, 514 U.S. at 161. See generally *USPTO*, *supra* note 68 (explaining the functions and responsibilities the USPTO exercises in trademark law).

<sup>100</sup> *Qualitex*, 514 U.S. at 161.

<sup>101</sup> See *id.* at 160–61, 166–67 (discussing how color alone can be trademarked if the color "meet[s] ordinary legal trademark requirements").

<sup>102</sup> See *id.* at 167; see also, e.g., *Nutrasweet Co. v. Stadt Corp.*, 917 F.2d 1024, 1027 (7th Cir. 1990) (stating that *Nutrasweet* is the most "vivid" example of issues with shade confusion). Jacobson's feared result was that competitors and courts would be perplexed when determining whether the use of a similar color on a product would confuse the consumer and thus infringe a trademark. *Qualitex*, 514 U.S. at 167. The issue of "shade confusion" was rooted in the notion that if the law permits single color trademarks, then "uncertainty and unresolvable court disputes" will ensue over what shades of a certain color a competitor may use. *Id.* The Seventh Circuit in *Nutrasweet* explained the shade confusion issue by stating that "NutraSweet does not contend that the color blue of the 'Sweet One' packet is identical to the color blue of the 'Equal' packet, but rather, based upon market research, that the shades of blue are confusingly similar. How different do the colors have to be?" *Nutrasweet Co.*, 917 F.2d at 1027.

<sup>103</sup> See *Qualitex*, 514 U.S. at 168–69; see also Ellerbrock, *supra* note 73 (explaining the origin of the color depletion theory and the concerns the theory presents as well as the functionality doctrine); Sreepada, *supra* note 95, at 1142–44 (explaining how the Supreme Court in *Qualitex* collapsed the color depletion theory into the functionality doctrine). The Court found that issues of color scarcity are too uncommon to "justify a blanket prohibition." *Qualitex*, 514 U.S. at 168. Even if issues of color depletion should arise, the trademark doctrine of functionality should properly prevent any anti-competitive consequences that concerned Jacobson. *Id.* at 169. The Supreme Court in *Qualitex* showed a more favorable disposition toward

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and (4) trade dress protection.<sup>105</sup> The Supreme Court found that none of these arguments were persuasive enough to rule against *Qualitex*.<sup>106</sup>

The Supreme Court's holding in *Qualitex* yielded a victory for color trademarks.<sup>107</sup> The Supreme Court determined that single color

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the functionality doctrine as a means of preventing the anticompetitive consequences that the color depletion theory was meant to prevent. Sreepada, *supra* note 95, at 1142–44. The color depletion theory collapses into the functionality doctrine. *Id.*

<sup>104</sup> See *Qualitex*, 514 U.S. at 171. The Court pointed out that the Supreme Court cases Jacobson addressed interpreted trademark law before 1946. *Id.* Once the Lanham Act was passed in 1946, the stringent view of trademark law dissipated, effectually liberalizing the common law to dispense of technicalities. *Id.* The Supreme Court cited language in the Lanham Act stating, “nothing . . . shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce.” *Id.* (citing 15 U.S.C. § 1052(f) (1988 ed., Supp. V) (current version at 15 U.S.C. § 1052(f) (2006))). The Court deduced that the language of the Lanham Act as applied to the trademark of words that have garnered a secondary meaning can logically apply to colors as well. *Id.* at 171–72. The Court recognized that Congress amended the Lanham Act with the Trademark Law Revision Act of 1988 without changing the language in the Act to establish a bar on single color trademarks. *Id.* at 172. The background Congress used to pass the 1988 Act consisted of the following: (1) the Federal Circuit's decision in *Owens-Corning*, (2) the USPTO had adopted a policy allowing color registration, and (3) the Trademark Commission had written a report which stated that the language of the Lanham Act should not be limited to preclude registering things like colors, shapes, smells, sounds, or any combination thereof which could function as a trademark. *Id.*

<sup>105</sup> See *id.* at 167–74 (providing Jacobson's four arguments in favor of forbidding the protection of single color trademarks); see also Theodore H. Davis, Jr., *Copying in the Shadow of the Constitution: The Rational Limits of Trade Dress Protection*, 86 TRADEMARK REP. 223, 225–26 (1996) (defining trade dress, forms of trade dress, and its composition). Jacobson's final argument relied on the idea that companies already had access to “trade dress” protection for colors as part of a trademark in the sense that the trademark is a colored circle or colored letter. *Qualitex*, 514 U.S. at 173. The Court reasoned that not every competitor can easily use a symbol or word on a product and may simply choose a color to denote its origin. *Id.* at 173–74. Trade dress is the “overall image used to present a product or service to purchasers.” Davis, Jr., *supra*, at 225. Trade dress commonly consists of the packing and labeling for certain goods. *Id.* at 225–26. Additional characteristics of trade dress usually consist of the good, “such as its configuration, color, or fragrance.” *Id.*

<sup>106</sup> *Qualitex*, 514 U.S. at 167. See generally Paige Stratton Bass, *Trademark Law: Qualitex v. Jacobson Products Co.—The Supreme Court Upholds Trademark Protection for a Color*, 49 OKLA. L. REV. 193, 193 (1996) (stating that the Supreme Court resolved the split among the Circuit Courts by unanimously ruling in favor of *Qualitex*). The Supreme Court's decision in *Qualitex* resolved the split between the United States Courts of Appeals. Bass, *supra*. The Seventh and Ninth Circuits had imposed a per se prohibition against single color trademarks while the Eighth Circuit and the Federal Circuit did not ban single color trademarks. *Id.* The Supreme Court determined that the Lanham Act “permits the registration of a trademark that consists, purely and simply, of a color.” *Qualitex*, 514 U.S. at 160–61.

trademarks could be registered and afforded protection so long as the color trademarks complied with ordinary legal trademark requirements.<sup>108</sup> Applying said determination, the Supreme Court held that the green-gold acts as a symbol because it has achieved a secondary meaning, and thus identifies the source of the product.<sup>109</sup> The Qualitex green-gold serves no other function than to act as an identifier and, without evidence of a competitive need for the color, there was no reason to deny Qualitex of trademark protection for the use of green-gold.<sup>110</sup>

#### IV. CHRISTIAN LOUBOUTIN'S LOSS PAINTED AS A VICTORY

In 2011, discord arose between Louboutin<sup>111</sup> and Yves Saint Laurent<sup>112</sup> when Yves Saint Laurent prepared to market a line of

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<sup>107</sup> See *Qualitex*, 514 U.S. at 174 (holding that Jacobson's argument did not justify a legal rule preventing the registration of single color trademarks); see also James Davey, *Intellectual Property—Trademarks—The Lanham Act Permits the Registration of Color Alone as a Trademark* *Qualitex Co. v. Jacobson Prods. Co.*, 115 S. Ct. 1300 (1995), 63 TENN. L. REV. 261, 278 (1995) (describing how the Supreme Court determined that color registration is permitted by the Lanham Act). *Qualitex* successfully liberalized trademark law as Congress had intended with the passing of the Lanham Act in 1946. Davey, *supra*, at 278.

<sup>108</sup> See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:1 (4th ed. 2012) (detailing the elements of a legal trademark); see also Davey, *supra* note 107, at 261, 261 n.9 (providing that the Supreme Court determined in *Qualitex* that a satisfaction of the elements of legal trademark is sufficient to afford single color trademark protection). Three elements will qualify a word or symbol as a protectable trademark:

- (1) [T]he tangible symbol: a word, name, symbol or device or any combination of these;
- (2) type of use: actual adoption and use of the symbol as a mark by a manufacturer or seller of goods or services;
- (3) the function: to identify and distinguish the seller's goods from goods made or sold by others.

<sup>1</sup> MCCARTHY, *supra*.

<sup>109</sup> *Qualitex*, 514 U.S. at 166.

<sup>110</sup> *Id.*

<sup>111</sup> See *Christian Louboutin*, BIOGRAPHY.COM, <http://www.biography.com/people/christian-louboutin-21105389> (last visited Mar. 15, 2013) (providing the biography of French designer Christian Louboutin). Christian Louboutin launched his own line of high fashion footwear in the 1990's. *Id.* Louboutin added the illustrious red lacquer to the soles of his line of footwear in 1993. *Id.*

<sup>112</sup> See *The Pants-Wearing Legacy of Yves Saint Laurent*, NBCNEWS.COM, <http://www.nbcnews.com/id/24937659/site/todayshow/ns/today-style/t/pants-wearing-legacy-yves-saint-laurent/#.URr3VKXC3MY> (last updated June 2, 2008, 5:33 PM) (providing a brief biography and overview of the success and innovation

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monochromatic<sup>113</sup> shoes.<sup>114</sup> Louboutin produces red-lacquered heels ranging in price from roughly \$625.00 to \$3995.00 per pair.<sup>115</sup> Within the leviathan<sup>116</sup> that is the business of women's footwear, Louboutin successfully built a multi-million dollar empire renowned for the red lacquer gracing the bottom of every heel produced.<sup>117</sup>

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of Algerian designer Yves Saint Laurent); *see also* Hedi Slimane, BRITISH VOGUE, <http://www.vogue.co.uk/person/hedi-slimane> (last visited Mar. 15, 2013) (providing the biography of current creative director Hedi Slimane of the fashion house Yves Saint Laurent); Jo Craven, *Yves Saint Laurent*, BRITISH VOGUE, <http://www.vogue.co.uk/spy/biographies/yves-saint-laurent-biography> (last visited Mar. 15, 2013) (providing a brief biography of Yves Saint Laurent). Algerian-born designer Yves Saint Laurent launched his fashion line in 1962. *The Pants-Wearing Legacy of Yves Saint Laurent, supra*. Saint Laurent sold his fashion house to the Gucci Group in 1999 and retired in 2002. *Id.* Saint Laurent died in Paris on June 1, 2008 at the age of seventy-one. Craven, *supra*. Hedi Slimane was appointed creative director at Yves Saint Laurent in March 2012 following the departure of Stefano Pilati. *Hedi Slimane, supra*.

<sup>113</sup> See THE AMERICAN HERITAGE DICTIONARY 1168 (3d ed. 1992) (defining "monochromatic" as "having or appearing to have only one color").

<sup>114</sup> *Christian Louboutin v. Yves Saint Laurent America, Inc.* [*Christian Louboutin II*], 696 F.3d 206, 213 (2d Cir. 2012).

<sup>115</sup> Don Jeffrey & Cotten Timberlake, *Louboutin Wins Appeal Over Saint Laurent Red-Soles Shoes*, BLOOMBERG, Sept. 5, 2012, available at <http://www.bloomberg.com/news/2012-09-05/louboutin-wins-appeal-over-saint-laurent-red-soles-shoes.html> (providing a price range of Louboutin heels gathered from the website of the high fashion department store Barney's New York, Inc.); *see* WEBSTER'S II NEW COLLEGE DICTIONARY 614 (Houghton Mifflin Co. ed., 1995) (defining 'lacquer' as "any various clear or colored synthetic coatings made by dissolving nitrocellulose or other cellulose derivatives together with plasticizers and pigments in a mixture of volatile solvents and used to impart a high gloss to surfaces"); *cf.* Lauren Collins, *Sole Mate*, NEW YORKER, Mar. 28, 2011, at 82, 83 (estimating the price range of Christian Louboutin shoes from \$395.00 to \$6000.00).

<sup>116</sup> See WEBSTER'S II NEW COLLEGE DICTIONARY 630 (Houghton Mifflin Co. ed., 1995) (defining "Leviathan" as "1. A sea monster mentioned in the Bible. 2. A very large animal. 3. Something exceptionally large and awesome.").

<sup>117</sup> See *Christian Louboutin vs. YSL 'Red Soles' Takes a New Twist*, HUFFINGTON POST (Sept. 5, 2012, 12:43 PM), [http://www.huffingtonpost.com/2012/09/05/christian-louboutin-ysl-red-soles\\_n\\_1857992.html](http://www.huffingtonpost.com/2012/09/05/christian-louboutin-ysl-red-soles_n_1857992.html) (asserting that Louboutin uses the trademarked signature red-lacquered sole on the bottom of its pumps); *see also* Amy Odell, *The Meaning Behind Women's Obsession with Shoes*, N.Y. MAGAZINE (Sept. 9, 2011, 12:20 PM), [http://nymag.com/thecut/2011/09/the\\_meaning\\_behind\\_womens\\_obse.html](http://nymag.com/thecut/2011/09/the_meaning_behind_womens_obse.html) (providing that "women's shoes account for sixty percent of the \$40 billion worth of shoes sold in the U.S. each year"); Harriet Walker, *Christian Louboutin: Sexual Heeling*, INDEPENDENT (Oct. 29, 2011), <http://www.independent.co.uk/news/people/profiles/christian-louboutin-sexual-heeling-2377441.html> (describing the span of the Louboutin empire and the number employed under Louboutin); *cf.* Lauren Collins, *Sole Mate*, NEW YORKER, Mar. 28, 2011, at 82, 83 (asserting that "Louboutin sells more than five hundred thousand

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In January 2011, Louboutin became aware that Yves Saint Laurent was marketing and selling a monochromatic red shoe with a red sole and requested the removal of the shoe from the market.<sup>118</sup> Yves Saint Laurent produced a monochromatic line of shoes featured in the colors purple, green, yellow, and *red*.<sup>119</sup> Thus, the red shoe had a red insole,<sup>120</sup> heel, upper,<sup>121</sup> and outsole (“sole”).<sup>122</sup> After failed negotiations between Louboutin and Yves Saint Laurent, Louboutin initiated legal action against Yves Saint Laurent.<sup>123</sup>

In 2011, Louboutin filed suit against Yves Saint Laurent alleging that Yves Saint Laurent violated the Lanham Act and New York law by producing shoes with Louboutin’s trademarked, red-lacquered soles.<sup>124</sup> Louboutin asserted claims under the Lanham Act including trademark infringement.<sup>125</sup> Yves Saint Laurent stressed that it had previously produced monochromatic footwear lines, and, since the 1970’s, had used red and other colors for the soles of shoes.<sup>126</sup> Yves Saint Laurent filed counterclaims seeking the cancellation of Louboutin’s red sole trademark on the grounds that it was not

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pairs of shoes per year”); Jeffrey & Timberlake, *supra* note 115 (providing that Louboutin’s sales were projected to reach over 100 million dollars in 2011). Louboutin employs 420 people across thirty-five stores in sixteen countries. Walker, *supra*. While embroiled in litigation with Yves Saint Laurent, Louboutin submitted court documents projecting retail sales of shoes in the United States to reach 135 million dollars in 2011. Jeffrey & Timberlake, *supra* note 115.

<sup>118</sup> *Christian Louboutin II*, 696 F.3d at 213. *See infra* text accompanying notes 119–22.

<sup>119</sup> *Christian Louboutin II*, 696 F.3d at 213.

<sup>120</sup> *See* THE AMERICAN HERITAGE DICTIONARY 665 (2d ed. 1982) (defining ‘insole’ as “the inner sole of a shoe or boot”).

<sup>121</sup> *See id.* at 1328 (defining “upper” as “the part of a shoe or boot above the sole”).

<sup>122</sup> *Christian Louboutin II*, 696 F.3d at 213; *see Outsole Definition*, MERRIAM-WEBSTER ONLINE, <http://www.merriam-webster.com/dictionary/outsole> (last visited Mar. 15, 2013) (defining “outsole” as “the outside sole of a boot or shoe”).

<sup>123</sup> *Christian Louboutin II*, 696 F.3d at 213.

<sup>124</sup> *Christian Louboutin v. Yves Saint Laurent America, Inc.* [*Christian Louboutin I*], 778 F. Supp. 2d 445, 445, 448 (S.D.N.Y. 2011) (detailing the outset of litigation between Louboutin and Yves Saint Laurent and noting the date and trademark of the red-lacquered soles by Louboutin). *See generally supra* notes 69–70 and accompanying text (describing the Lanham Act). The USPTO awarded Louboutin a trademark for the “Red Sole Mark” with Registration No. 3,361,597 on January 1, 2008. *Christian Louboutin I*, 778 F. Supp. 2d at 448.

<sup>125</sup> *Christian Louboutin II*, 696 F.3d at 213. In addition to trademark infringement, Louboutin filed claims alleging counterfeiting, false designation of origin, and trademark dilution in addition to violations of state law trademark infringement, trademark dilution, unfair competition, and unlawful deceptive acts and practices. *Id.*

<sup>126</sup> *Id.*

distinctive and merely ornamental, it is functional, and the trademark was procured by fraud on the USPTO.<sup>127</sup> In response to Yves Saint Laurent's counterclaims, Louboutin moved for a preliminary injunction against Yves Saint Laurent.<sup>128</sup>

The United States District Court for the Southern District of New York (the "District Court") denied Louboutin's motion for a preliminary injunction and Louboutin appealed.<sup>129</sup> The District Court cited the *Qualitex* decision explaining that a single color trademark is only protectable if "it acts as a symbol that distinguishes a firm's goods and identifies their source, *without serving any other function.*"<sup>130</sup> Without citing to any authority discussing the interplay between trademarks and the fashion industry, the District Court asserted that commercial purposes for extending trademark protection to single colors did not necessarily translate well to the fashion industry due to the unique characteristics and needs such as the creativity, aesthetics, taste, and seasonal change.<sup>131</sup> The District Court

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<sup>127</sup> *Id.* at 214. See generally *USPTO*, *supra* note 68 (explaining the function of the USPTO).

<sup>128</sup> *Christian Louboutin I*, 778 F. Supp. 2d at 447.

<sup>129</sup> *Christian Louboutin II*, 696 F.3d at 214.

<sup>130</sup> *Id.* at 214 (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 166 (1995)).

<sup>131</sup> *Id.* See Belinda White, *Christian Louboutin Loses Round One of Red Sole Battle with Yves Saint Laurent*, TELEGRAPH.CO.UK (Aug. 10, 2011), <http://fashion.telegraph.co.uk/news-features/TMG8694008/Christian-Louboutin-loses-round-one-of-red-sole-battle-with-Yves-Saint-Laurent.html> (describing Federal Judge Victor Marrero's rationale for denying Louboutin's motion for a preliminary injunction); see also *Fashion Industry*, BRITANNICA ONLINE ENCYCLOPEDIA, <http://www.britannica.com/EBchecked/topic/1706624/fashion-industry> (last visited Sept. 9, 2014) (detailing a comprehensive overview of the fashion industry and its development). The fashion industry is a modern product of the twentieth century. *Fashion Industry*, *supra*. Fashion shifted from the mid-nineteenth century custom of handmade clothes for individuals by home production or tailors and dressmakers to the modern age of mass production and fixed prices with the rise of new technologies such as sewing machines, the boom of global capitalism, and department stores. *Id.* The fashion industry has grown into a multi-billion dollar global enterprise dedicated not only to the buying and selling of high fashion clothing but also to its large subpart known as the "apparel industry." *Id.* While the fashion industry is most notably associated with expensive designer fashions emerging from Paris and New York, the apparel industry has merged into the fashion industry and is considered the source of "ordinary" clothes or "mass fashion." *Id.* In explaining the District Court's decision in *Christian Louboutin*, Judge Marrero explained reasoned that:

Because in the fashion industry colour serves ornamental and aesthetic functions vital to robust competition, the court finds that Louboutin is unlikely to be able to prove that its red outsole brand

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found that a single color in the fashion industry is functional.<sup>132</sup> Therefore, the District Court held that Louboutin's red-lacquered sole trademark was unlikely to be afforded trademark protection, and denied Louboutin the preliminary injunction against Yves Saint Laurent.<sup>133</sup> Louboutin appealed to the United States Court of Appeals for the Second Circuit (the "Second Circuit").<sup>134</sup>

On appeal, the Second Circuit analyzed the District Court's decision by looking to the two steps in a trademark infringement claim and the functionality defense to such a claim.<sup>135</sup> The Second Circuit looked first to whether Louboutin's trademark is protectable.<sup>136</sup> A trademark is granted protection if it is inherently distinctive or has acquired a secondary meaning.<sup>137</sup> The Second Circuit then addressed the second step, which is that if, and only if, the trademark is considered distinctive will it then determine whether the competitor's product is likely to cause customer confusion.<sup>138</sup> Finally, if the competitor can prove in its defense that the trademark is functional, be it utilitarian functionality or aesthetic functionality, then the competitor will succeed.<sup>139</sup>

The Second Circuit first addressed the functionality defense.<sup>140</sup> The Court invoked language from *Qualitex* stating that the doctrine of

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is entitled to trademark protection, even if it has gained enough public recognition in the market to acquire secondary meaning.

White, *supra*.

<sup>132</sup> *Christian Louboutin II*, 696 F.3d at 214.

<sup>133</sup> *Id.*

<sup>134</sup> *Id.*

<sup>135</sup> *Id.* at 216–17.

<sup>136</sup> *Id.* at 216.

<sup>137</sup> *Id.* at 216 (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992)) (providing the requirements for a protectable trademark and an explanation of "inherently distinctive"). A trademark is considered inherently distinctive "if its intrinsic nature serves to identify a particular source." *Id.*

<sup>138</sup> *Christian Louboutin II*, 696 F.3d at 217; *cf.* 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:76 (4th ed. 2012) ("The confusion necessary for the trademark infringement of federally registered marks is not purely limited to confusion of purchasers as to the source of goods, but to any kind of confusion, such as confusion between the products themselves"). The possessor of a trademark can prove customer confusion to prevail in a trademark claim. *Christian Louboutin II*, 696 F.3d at 217. The Second Circuit determined that after analyzing whether Louboutin's trademark was protectable, it was unnecessary to address customer confusion. *Christian Louboutin II*, 696 F.3d at 217.

<sup>139</sup> *Id.*

<sup>140</sup> *See id.* at 218–24 (analyzing utilitarian and aesthetic functionality in relation to Louboutin's trademarked, red-lacquered soles).

functionality fosters fair competition in the market.<sup>141</sup> The relevant types of functionality the court hones in on are traditional or “utilitarian”<sup>142</sup> functionality and aesthetic<sup>143</sup> functionality.<sup>144</sup>

Although the Second Circuit briefly explained traditional functionality,<sup>145</sup> it appears that the Court focused on aesthetic functionality and how functionality affected the District Court’s decision.<sup>146</sup> The Second Circuit addressed the Supreme Court’s holding in *Qualitex*, which asserted that the aesthetic design of a product for which protection is sought could be deemed functional if it significantly disadvantaged competitors.<sup>147</sup> A threefold aesthetic functionality test is laid out by the Second Circuit to determine whether a product feature is aesthetic *and* functional.<sup>148</sup> If it is determined that that a product feature is aesthetic and functional, then trademark protection is denied.<sup>149</sup>

Under the first two prongs, it must be ascertained whether: (1) the design feature is essential to the use or purpose of the product, or (2) the design feature affects the overall cost or quality of the product.<sup>150</sup> If one of the first two questions is answered in the affirmative, the inquiry ends, and the design feature is considered functional and ineligible for trademark protection.<sup>151</sup> However, if a product feature does not meet either of the first two prongs, then it is necessary to

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<sup>141</sup> See *id.* at 218 (describing how the Supreme Court in *Qualitex* stated that the functionality doctrine prevents companies from monopolizing useful products and thus hindering fair competition).

<sup>142</sup> See WEBSTER’S II NEW COLLEGE DICTIONARY 1216 (Houghton Mifflin Co. ed. 1995) (defining “utilitarian” as “stressing the value of practical over aesthetic qualities”).

<sup>143</sup> See *id.* at 18 (defining “aesthetic” as “of or relating to the sense of the beautiful”).

<sup>144</sup> *Christian Louboutin II*, 696 F.3d at 218–24.

<sup>145</sup> See *id.* (explaining how under traditional functionality, a product feature is functional if it is essential to the use or purpose of the product or if the feature affects the cost or quality of the product as a whole).

<sup>146</sup> See generally *id.* at 219–25 (explaining the development and composition of aesthetic functionality and how the functionality defense was misapplied in the District Court).

<sup>147</sup> *Id.* at 219–20. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995) (describing how a functional component will not be afforded protection after the patent for the component has expired if it would hinder competition by frustrating a competitor’s efforts to improve their own equivalent product).

<sup>148</sup> *Christian Louboutin II*, 696 F.3d at 220.

<sup>149</sup> *Id.*

<sup>150</sup> *Id.*

<sup>151</sup> *Id.* (demonstrating how the first two prongs of the functionality test are also the first two prongs of the aesthetic functionality test). See generally *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844 (1982) (establishing a two prong test which determines if a product feature is functional).

move on to the third prong, whether protection of a product feature will not result in a significant,<sup>152</sup> negative effect on competition.<sup>153</sup>

The Second Circuit addressed the District Court's determination that Yves Saint Laurent's functionality defense was proper, and the District Court's adoption of a per se rule against color trademarks in the fashion industry because of their alleged functionality.<sup>154</sup> The Second Circuit recognized that the Supreme Court in *Qualitex* forbade the implementation of a per se rule denying legal protection for single color trademarks.<sup>155</sup> Thus, the District Court erred when it effectively created a per se rule prohibiting protection for single color trademarks in the fashion industry.<sup>156</sup> The functionality defense is meant to remove hindrances on fair competition within a certain market, not guarantee a competitor a vast range for creativity.<sup>157</sup>

After rejecting the District Court's per se rule against color trademarks, the Second Circuit turned to the two-step process within a trademark infringement claim: (1) whether the trademark is protectable, and (2) whether the trademark is distinctive.<sup>158</sup> A certificate of registration of a trademark with the USPTO is prima facie evidence of a valid and protectable trademark.<sup>159</sup> The District Court erroneously found that Yves Saint Laurent rebutted the presumption that Louboutin's red-lacquered soles were protectable based on the trademark registration because "a single color can never achieve trademark protection in the fashion industry."<sup>160</sup> The Second Circuit found that the District Court's rationale was improper, but recognized that Louboutin's trademark on red-lacquered heels was ineligible for protection as it was because it precluded competitors

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<sup>152</sup> See *Christian Louboutin II*, 696 F.3d at 222 (explaining that when determining whether the protection of an aesthetically functional trademark *significantly* undermines a competitor's ability to compete in the market, a court must weigh "the competitive benefits of protecting the source-identifying aspects' of a mark against the 'competitive costs of precluding competitors from using the feature'" (quoting *Fabrication Enters., Inc. v. Hygenic Corp.*, 64 F.3d 53, 59 (2d Cir. 1995))).

<sup>153</sup> *Id.* at 220. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995) (providing the third prong of the three prong aesthetic functionality test which is used to analyze whether the trademark of a product feature is detrimental to competitors).

<sup>154</sup> See *Christian Louboutin II*, 696 F.3d at 222.

<sup>155</sup> See *id.* at 223.

<sup>156</sup> See *id.*

<sup>157</sup> See *id.*

<sup>158</sup> See *supra* text accompanying notes 135–38.

<sup>159</sup> *Christian Louboutin II*, 696 F.3d at 224.

<sup>160</sup> *Id.* at 225.

from using red soles in *all situations*.<sup>161</sup> However, it was the second step of the trademark infringement analysis, on distinctiveness, that pushed the Second Circuit to protect Louboutin's trademarked red-lacquered heels in a modified form.<sup>162</sup>

The Second Circuit provides that distinctiveness may be shown either by proof that the trademark is inherently distinctive,<sup>163</sup> or by showing that the trademark has garnered a secondary meaning<sup>164</sup> in the public eye.<sup>165</sup> The Second Circuit notes that a single color can almost never be inherently distinctive, but a single color can surely acquire a secondary meaning.<sup>166</sup> If a single color is used so "consistently and prominently" by a fashion designer that it becomes a symbol of "primary significance" that acts as an identification of the source of the product, then there appears to be no valid reason to restrict single color trademarks in the fashion industry.<sup>167</sup>

The Second Circuit notes that an examination of a trademark's secondary meaning probes whether consumers are more compelled to purchase a product because of the source.<sup>168</sup> The Second Circuit recognized that the District Court was situated with an abundance of evidence of "Louboutin's advertising expenditures, media coverage,

<sup>161</sup> *Id.*

<sup>162</sup> *Id.*

<sup>163</sup> *See supra* note 137 and accompanying text.

<sup>164</sup> *See supra* note 92 and accompanying text; *see also infra* note 166 and accompanying text.

<sup>165</sup> *Christian Louboutin II*, 696 F.3d at 225.

<sup>166</sup> *Id.* *See Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162–63 (1995) (elaborating on the notion that color is almost never inherently distinctive by contrasting a color trademark that may become distinct through secondary meaning to the trademark of words or designs that are capable of automatically communicating the brand to a customer).

[O]ver time, customers may come to treat a particular color on a product or its packaging (say, a color that in context seems unusual, such as pink on a firm's insulating material or red on the head of a large industrial bolt) as signifying a brand. And, if so, that color would have come to identify and distinguish the goods—*i.e.*, 'to indicate' their 'source'—much in the way that descriptive words on a product . . . can come to indicate a product's origin.

*Id.* at 163.

<sup>167</sup> *Christian Louboutin II*, 696 F.3d at 226.

<sup>168</sup> *Id.* (noting that some factors analyzed to show a product source may induce purchase include: "(1) advertising expenditures, (2) consumer studies linking the mark to a source, (3) unsolicited media coverage of the product, (4) sales success, (5) attempts to plagiarize the mark, and, (6) length and exclusivity of the mark's use." (quoting *Centaur Commc'ns., Ltd. v. A/S/M Commc'ns., Inc.*, 830 F.2d 1217, 1222 (2d Cir. 1987))).

and sales success,” showing that Louboutin had created a “symbol” with its red-lacquered sole just as Qualitex had with green-gold.<sup>169</sup> Without question, the evidence showed that Louboutin red soles had become globally associated with Louboutin.<sup>170</sup> However, the Second Circuit found that the record did not support the idea that secondary meaning of the red-lacquered sole extended to shoes where the body of the shoes did *not* contrast with the red sole.<sup>171</sup> Therefore, the Second Circuit determined that Louboutin’s sole trademark *only* carried secondary meaning when the body of the shoe was in contrast to the red-lacquered sole.<sup>172</sup>

The Second Circuit modified Louboutin’s red-lacquered sole trademark, instructing the USPTO to limit the registration of the trademark to instances only where the body of the shoe contrasted with the red-lacquered sole.<sup>173</sup> The Court held that only the modified trademark would be considered valid and enforceable.<sup>174</sup> The Second Circuit affirmed the District Court’s decision to deny Louboutin’s motion for a preliminary injunction based on the rationale that the red sole on the Yves Saint Laurent monochromatic shoe was neither a use of Louboutin’s trademark nor was it confusingly similar to the Louboutin trademark.<sup>175</sup> With the Second Circuit’s decision in Louboutin’s case against Yves Saint Laurent, it is now questionable as to how much protection single color trademarks will be afforded in future trademark decisions.<sup>176</sup>

## V. RECOMMENDATIONS

### A. Amend the Lanham Act

The Supreme Court determined in *Qualitex* that single color trademarks are within the scope of trademark protection provided by the Lanham Act.<sup>177</sup> If the Lanham Act provides protection for words and symbols because they can garner secondary meaning and the

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<sup>169</sup> See *id.* See *supra* text accompanying notes 109–10.

<sup>170</sup> *Christian Louboutin II*, 696 F.3d at 226–27. Chief Executive Officer of Yves Saint Laurent’s parent company, François-Henri Pinault, acknowledged in the world of high fashion it is certain that the signature red sole is associated with Louboutin especially when the upper of the shoe contrasts with the red sole. *Id.* at 227.

<sup>171</sup> *Id.* at 228.

<sup>172</sup> *Id.*

<sup>173</sup> *Id.*

<sup>174</sup> *Id.*

<sup>175</sup> *Id.*

<sup>176</sup> See *Christian Louboutin II*, 696 F.3d at 228 (holding that Yves Saint Laurent is permitted to produce a monochromatic red shoe featuring a red sole).

<sup>177</sup> See *supra* text accompanying note 104.

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Supreme Court has determined that, logically, single colors can achieve secondary meaning as well,<sup>178</sup> the next reasonable step would be to explicitly include single color trademarks in the Lanham Act. By amending the Lanham Act, legislative clarity may prevent cases such as *Christian Louboutin* where the District Court effectively created a per se rule against single color trademarks in fashion despite the Supreme Court having already held that such a per se ban against single color trademarks was impermissible.<sup>179</sup> Express protection for single color trademarks in the Lanham Act will yield uniformity in the law as well as clear justification in the judicial system for granting, enforcing, and renewing single color trademarks.

### **B. Secondary Meaning . . . with a Bite**

Due to the peculiar nature of single color trademarks, if the Lanham Act were amended as proposed, it would require supreme clarity in lieu of the current law on single color trademarks.<sup>180</sup> Functionality must remain crucial in the process of approving a single color trademark.<sup>181</sup> However, it is with secondary meaning<sup>182</sup> that clarification is needed in the law.

Single color trademarks, unlike tangible symbols, should be analyzed differently under secondary meaning. It should be more difficult for companies to trademark single colors for reasons that implicate the color depletion theory, unfair competition, and functionality. The color depletion theory is virtually an outdated idea;<sup>183</sup> however, the dust must be blown off of this notion and brought back to the forefront if the Lanham Act should be amended. The Supreme Court has determined that single colors can be worthy of trademarks,<sup>184</sup> but this determination should be modified so that single color trademarks can only be granted where the color is the *focal point* of the business. The idea could be termed secondary meaning with a bite. The rationale is that if the single color trademark is the focal point of the company, then the company must pass secondary meaning with a bite. Secondary meaning with a bite would require a showing that the single color alone communicates the source to the consumer. The following factors would remain in place to examine how the

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<sup>178</sup> See *supra* text accompanying note 104.

<sup>179</sup> See *supra* text accompanying notes 154–55.

<sup>180</sup> See *supra* text accompanying notes 96–176.

<sup>181</sup> See *supra* text accompanying notes 86, 89, 146.

<sup>182</sup> See *supra* text accompanying note 92.

<sup>183</sup> See *supra* text accompanying note 87.

<sup>184</sup> See *supra* text accompanying note 108.

product's source has been proved to induce purchase due to secondary meaning: "(1) advertising expenditures, (2) consumer studies linking the mark to a source, (3) unsolicited media coverage of the product, (4) sales success, (5) attempts to plagiarize the mark, and, (6) length and exclusivity of the mark's use."<sup>185</sup> The aforementioned factors will assist in determining whether a single color is considered the focal point of the business.

The "bite" under secondary meaning for single color trademarks would be dedicated to innovation. Companies have used particular colors to take their businesses to a level of worldwide recognition.<sup>186</sup> By using certain colors, these companies have established secondary meaning so that within the minds of people it has come to a point where a robin's egg blue box is certainly from Tiffany & Co. and a brown delivery truck must be a UPS truck.<sup>187</sup> The "bite" would prevent the primary colors from being trademarked in one stroke of a judicial pen. The innovation of utilizing a certain color as the focal point of an entire company has proved to be successful.<sup>188</sup> Analyzing the secondary meaning of a product must go beyond the factors in place and look to the "effectiveness of this effort to create it."<sup>189</sup> The "level of innovation" should be a factor that supports innovative effort by including four sub-factors: (1) whether the product been manufactured or produced previously by another company with this particular color, (2) if the product in combination with the specific color or a shade very similar has been produced in this fashion before, how many times was it produced in this fashion and/or for what length of time was it produced, (3) whether the producer or manufacturer of the product using the contentious single color established secondary meaning at the time the product was in circulation, and (4) whether the use of the color by the company is so novel that to deny the trademark, deny enforcement, or deny renewal would unduly prejudice the company.

### C. Time Limitations

Where a company uses a single color trademark as the focal point of the business, stricter time limitations for the trademark should be

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<sup>185</sup> See *supra* text accompanying note 168.

<sup>186</sup> See *supra* text accompanying notes 21–36.

<sup>187</sup> See *supra* text accompanying notes 25, 36.

<sup>188</sup> See *supra* text accompanying notes 21–36.

<sup>189</sup> See *Int'l Jensen, Inc. v. Metrosound U.S.A., Inc.*, 4 F.3d 819, 824 (9th Cir. 1993) ("[T]he true test of secondary meaning is the effectiveness of [the] effort to create it.") (citing *First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378, 1383 (9th Cir. 1987)).

imposed on a case-by-case basis.<sup>190</sup> Companies should not be hindered from establishing their name in a manner similar to Tiffany & Co. and UPS.<sup>191</sup> However, the length of time allotted to a trademark should be substantial and renewable as it relates to the innovation, history, and length of time the trademark has been in place. There is no sense in revoking the single color trademarks of globally recognized institutions that have been in place for over 100 years.<sup>192</sup> Simply, there must be a manner in which newer businesses can venture into color creativity without unjustifiably allowing a monopoly on a color that is not the crux of their business or can no longer be considered as such. If a company fails to sustain innovation and recognition of their trademark, renewal of the trademark should be denied. The law should foster creativity and innovation in the use of single color trademarks rather than facilitate the misappropriation of trademarks or keep afloat trademarks no longer carrying the weight of recognition they once did.

## VI. CONCLUSION

Gloria Steinham once stated, “[w]ithout leaps of imagination, or dreaming, we lose the excitement of possibilities.”<sup>193</sup> Imagination and innovation are intertwined with creativity. The possibilities imagined by great designers, thinkers, and business entrepreneurs will soon falter if innovation becomes endangered by the law. The Lanham Act was intended to expand the possibilities of trademarks in the future.<sup>194</sup> To ignore the intent of the Lanham Act would be to dispose of a crucial turning point in the history of trademarks in the United States.<sup>195</sup>

The purpose of the Lanham Act was to modernize trademark law.<sup>196</sup> However, with modernity comes new ideas, new technology, and new views on the law. With cases like *Owens-Corning* and *Qualitex*, it becomes evident that trademark law has grown from new and innovative ideas taking on single color trademarks in a

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<sup>190</sup> See generally 15 U.S.C. § 1058(a) (2012) (providing that a registered trademark is enforceable for ten years and may be renewed at the end of each ten year period).

<sup>191</sup> See *supra* text accompanying notes 21–36.

<sup>192</sup> See, e.g., *supra* text accompanying notes 23, 45.

<sup>193</sup> GLORIA STEINEM, <http://www.gloriasteinem.com> (last visited Sept. 11, 2014).

<sup>194</sup> See *supra* text accompanying note 66.

<sup>195</sup> See *supra* text accompanying note 66.

<sup>196</sup> See *supra* text accompanying note 66.

business.<sup>197</sup> In lieu of such an evolution of single color trademarks in the law, it is only sensible that the law should adapt to a changing world where colors can communicate more than a source, but also a sense of quality and trust in the creator's craft. The powerhouses Tiffany & Co. and UPS have stood the test of time, arguably, because of the time, effort, and creativity used to make a single color the focal point of the companies.<sup>198</sup>

In *Christian Louboutin*, the Louboutin fashion house faced a loss masked as a victory. By permitting Yves Saint Laurent and any future designers to create a monochromatic red shoe with a red sole, Louboutin loses the full rights to a trademark that had flourished to worldwide recognition after nearly twenty years of utilizing and promoting the red-lacquered sole.<sup>199</sup> If courts begin splitting hairs in the law, longstanding companies like Tiffany & Co. and UPS may fear for their own trademark protections if challenged. Louboutin single-handedly put red soles on the map regardless of contrast as the Second Circuit determined.<sup>200</sup> The Second Circuit effectively diminished the efforts of the Louboutin empire to create a secondary meaning for the red-lacquered soles independent of the body of the shoe by limiting the trademark.<sup>201</sup> Unless and until the law is changed to expand the requirements of secondary meaning on single color trademarks, it appears that Tiffany & Co. and UPS will be the last to build empires of their caliber on a foundation of color. By amending the Lanham Act, changing single color trademarks as only permissible by passing functionality and secondary meaning with a bite, and imposing a new structure to time limitations, the spectrum of single color trademarks will be protected by the law and limited carefully through case by case judicial proceedings. Now is the time to protect and encourage the imagining of improbable or impossible things so that from such fantasies new hues of innovation can grow.

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<sup>197</sup> See *supra* text accompanying notes 73–110.

<sup>198</sup> See *supra* text accompanying notes 21–36.

<sup>199</sup> See *supra* text accompanying notes 116–18, 175.

<sup>200</sup> See *Louboutin Red Soles Inspire Women to Paint Their Own Shoes*, HUFFINGTON POST (July 10, 2012, 1:32 PM), [http://www.huffingtonpost.com/2012/07/10/louboutin-shoes-red-soles\\_n\\_1662364.html](http://www.huffingtonpost.com/2012/07/10/louboutin-shoes-red-soles_n_1662364.html) (asserting that “Christian Louboutin shoes are known for two things: bearing those iconic red soles and being incredibly expensive”).

<sup>201</sup> See *supra* text accompanying note 173.