



The Red Shoes

Christian Louboutin, Christian Louboutin SAS v Van Haren Schoenen BV, Case C-163/16

In a case that has attracted a lot of attention in the intellectual property and fashion worlds, as well as in the wider press, the Court of Justice of the European Union (CJEU) has ruled that Christian Louboutin's "red sole" trade mark registration in the Benelux is not invalidly registered pursuant to Article 3(1)(e)(iii) of Directive 2008/95.

Background

Christian Louboutin owns a Benelux trade mark registration for "the colour red (Pantone 18 1663TP) applied to the sole of a shoe as shown (the contour of the shoe is not part of the trade mark but is intended to show the positioning of the mark)" in respect of 'High-heeled shoes (other than orthopaedic shoes)'.

On the basis of this registration, Louboutin brought proceedings against a Dutch retailer, Van Haren Schoenen BV, which had been selling high heels with red soles. Louboutin succeeded at first instance, but Van Haren then counterclaimed for

invalidity of Louboutin's registration, claiming that, when the two-dimensional trade mark depicted in the registration is applied to physical, three-dimensional shoes, it effectively becomes a shape that gives substantial value to the goods. On that basis, it claimed, the mark was invalidly registered pursuant to Article 3(1)(e)(iii) of Directive 2008/95.

The Dutch court stayed proceedings and referred the following question to the Court of Justice of the European Union:

Is the notion of 'shape' within the meaning of Article 3(1)(e)(iii) of Directive 2008/95/EC (1) ('Form', 'vorm' and 'forme' in the German, Dutch and French language versions of the Trade Marks Directive respectively) limited to the three-dimensional properties of the goods, such as their contours, measurements and volume (expressed three-dimensionally), or does it include other (non three-dimensional) properties of the goods, such as their colour?



The decision

The CJEU ruled that the registration could not be found to consist exclusively of a “shape” within the meaning of the provision.

Given that there is no definition of “shape” provided in the Directive, it was necessary to consider its usual meaning in everyday language. In this case, the description of the mark explicitly states that the contour of the shoe is not part of the mark but is intended to show the position of the mark. The CJEU found that the main element of Louboutin’s mark was in fact “a specific colour designated by an internationally recognised identification code.”

So, Louboutin’s Benelux registration will stand valid for now. However, recent updates to EU trade mark law (introduced after the commencement of these proceedings) mean that the equivalent absolute ground for refusal now extends to “signs which consist exclusively of the shape, *or another characteristic*, which gives substantial value to the goods”. Given the number of attacks against Louboutin’s marks in various jurisdictions over the years, we expect to see the new provision tested. At the time of writing, Louboutin’s corresponding EUTM registration is facing several recently-filed cancellation actions, including by Van Haren Schoenen B.V..

The CJEU’s decision is available [here](#).

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