

LEGAL/PRIVACY

## YSL vs. Louboutin: Was this battle more trouble than it was worth?

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By RACHEL LAMB

The court decision surrounding the Yves Saint Laurent versus Christian Louboutin trademark case awarded each fashion house a small victory, but experts are wondering if this is something that should have been started in the first place since the footwear designer runs the risk of losing its trademark all together.

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Earlier this week, an appeals court ruled that Yves Saint Laurent could continue to manufacture its monochrome red shoe, while Louboutin still owned the red-sole trademark, so long as the product had a contrasting upper-half color. However, Yves Saint Laurent could move forward with a counterclaim that could strip Louboutin of its trademark all together.

“All along, this has been an overly-aggressive approach by Louboutin,” said Steven Gursky, partner and head of intellectual property practice at [Olshan Frome Wolosky LLP](#), New York. “Now for them to claim some sort of victory out of this does not make sense.

“All that happened was that they jeopardized the very heart of their protection,” he said. “A red sole on a red shoe was something that never should have been attacked.

“Every person, whether you are a fashionista or not, knew that a red sole on a shoe

belonged to Louboutin before this all even started.”

Mr. Gursky is not affiliated with the case, Yves Saint Laurent or Louboutin, but agreed to comment as an industry expert.

**Yves Saint Laurent** along with parent company **PPR** and **Louboutin** declined comment for this article.

Seeing red

Louboutin originally filed a claim in April 2011 that was ruled in Yves Saint Laurent’s favor last year, saying that the shoe in question was not infringing on Louboutin’s trademark.



*All-red shoe from the autumn/winter 2012 YSL collection*

The recent result earlier this week was the outcome of an appeal filed by Louboutin’s lawyers after the original ruling.

Ultimately, Yves Saint Laurent can continue to sell its monochrome red shoes.

The basis of the fashion house’s argument was that the reputation of the Louboutin sole was characterized by a contrast with the rest of the shoe.

Furthermore, Yves Saint Laurent has claimed that it has been selling single-color shoes in red, purple and blue since the 1970s.



*An all-blue YSL shoe*

Meanwhile, the court decided that Louboutin's red sole trademark is intact. It described it as "valid, protectable and enforceable," according to the footwear manufacturer.

However, this ruling is just how it was at the beginning of the trial. The only effect of the court's decision is that the world has been made right again, according to Mr. Gursky.

"A red shoe and a red sole should never been something to have propriety over," Mr. Gursky said. "This only brought into protection a trademark that was a well-known and recognizable trademark, and now it only has back what it had in the beginning.

"Louboutin's victory is just that it did not lose what it already," he said. "This was a very expensive effort to get back to where it started."

But it seems that Louboutin could risk more than what it bargained for.

Reportedly, Yves Saint Laurent filed a counterclaim seeking to cancel the Louboutin trademark on the grounds that the Trademark and Patent Office awarded it fraudulently.

However, this process would be very long and expensive, and likely would not be in Yves Saint Laurent's best interests to pursue, Mr. Gursky said.



### *Louboutin's red-lacquered soles*

Heels over head

Louboutin's specific trademark over red-soled shoes could very well spark other trademark issues.

"It appears that Yves Saint Laurent is satisfied because it can now manufacture the shoe in question," said Chris Ramey, president of [Affluent Insights](#), Miami. "We can assume we will see more lawsuits regarding color because color is finite, and sue is what lawyers do."

However, is it fair to say that a brand has claim over any one color?

"I do think that certain brands have claims over colors," Olshan's Mr. Gursky said. "When it has secondary meaning, a brand can own a color."

However, there are, and should be, boundaries.

For example, no one brand can own a blue shirt. But when consumers see a blue jewelry box, they know that a Tiffany & Co. product is inside of it, Mr. Gursky said.



### *Tiffany's blue box*

Likewise, brands should only have control over very specific shades of color or patterns. Some examples could include Louis Vuitton's monogram pattern or Burberry's plaid.

"China Red,' as Louboutin calls it, is difficult to protect because of its ubiquity," Mr. Ramey said. "Tiffany's blue and Vuitton's brown are unique and, therefore, easier to protect.

"Copiers of their colors are obvious and automatically discounted by anyone who knows better," he said. "Surely the affluent fit into this category."

The point is that everyone knew what a red-soled shoe was if that product had a contrasting color. The lesson learned from this is that brands should protect trademarks, but not be greedy about it, according to Mr. Gursky.

"The red-sole trademark is a perfectly good, powerful trademark, but it should not be over-claimed," Mr. Gursky said.

"Do not be overly aggressive," he said. "Understand what you own, prize it and treasure it, but do not think you own the world when you do not."

Final Take

*Rachel Lamb, associate reporter on Luxury Daily, New York*

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