
European Union: LOUBOUTIN SUCCESSFULLY DEFENDS AGAINST CANCELLATION OF RED SOLE REGISTRATION

By [Joseph A.R. Gerber](#)

Christian Louboutin in May 2019 walked away unscathed from another challenge to his famous Red Sole trademark, this one before the Cancellation Division of the European Union Intellectual Property Office (“EUIPO”). Competitor Van Haren Schoenen (“Van Haren”) lodged a cancellation action against the iconic designer in an attempt to boot the Red Sole off the EU trademark registry.[More](#)

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Van Haren argued that Louboutin’s Red Sole could not function as a trademark in the EU. Louboutin successfully defended against this argument in its infringement suit against Van Haren before the Court of Justice of the European Union (“CJEU”) in 2018. However, the CJEU issued its decision in accordance with an EU regulation that has since been revised. The previous regulation prohibited registration of marks that “consist exclusively of [. . .] the shape which gives substantial value to the goods.” The new EU regulation prohibits registration of marks consisting exclusively of a “shape or another characteristic” giving substantial value to the goods (emphasis added).

Louboutin's Red Sole mark registered in the EU in May of 2016, two months after the new regulation took effect. Van Haren therefore argued that Louboutin's registration was invalid under the new regulation because the color red intrinsically adds value to the goods in that it is "sexy," conveys "energy," and "attracts men to women who wear red-soled shoes" (internal quotations omitted).

The EUIPO disagreed, holding that the new regulation did not apply. By its own language, the new regulation applies to marks "registered" before the March 2016 effective date. Regardless, the EUIPO held that the new regulation cannot be applied to applications filed before the effective date, even if the mark registered thereafter. "[T]he date of filing the application for registration of the EUTM is the material date for the examination of the ground for invalidity invoked [by Van Haren]." Thus, Van Haren would have to prove that on the date Louboutin filed his EU trademark application, Louboutin's Red Sole could not be registered according to the prior EU regulation.

This Van Haren could not do, the EUIPO held. The EUIPO relied on Louboutin's favorable CJEU decision in which the CJEU rejected Van Haren's argument on precisely this point. "[I]t cannot, however, be held that a sign consists of that shape in the case where the registration of the mark did not seek to protect that shape but sought solely to protect the application of a colour to a specific part of that product," the CJEU reasoned in its 2018 decision upholding the validity of Louboutin's Benelux trademark registration for the Red Sole.

The EUIPO nevertheless entertained Van Haren's argument that Louboutin's registration should be cancelled under the new EU regulation. The color red applied to the soles of high-heeled shoes substantially affects their aesthetic value, Van Haren argued. The EUIPO disagreed in principle and on the evidence. "It is not likely that the red colour of a usually very subordinate component of a shoe, such as a shoe sole, has an inherent aesthetic value that can dominate the overall appearance of any high-heeled shoe and would therefore give an intrinsic substantial value to these shoes."

Van Haren provided consumer surveys to support its claims; however, both Louboutin and the EUIPO discredited the evidence because the survey asked only about the appearance of the shoes in their entirety, ignoring consumers' perception of the soles in particular. "If consumers buy shoes, it is because of the appearance of the shoe as a whole, generally excluding the soles," the EUIPO reasoned.

Even under the new EU regulation Van Haren’s argument failed to show that consumers intrinsically value a red sole. What consumers do value, the EUIPO concluded, are clear indications of the source and quality of the goods they purchase. As the EUIPO noted, “[e]ven if today the red sole of the models created by Christian Louboutin is seen as a very attractive feature, this is only because it works as a trade mark and serves as the signature of Christian Louboutin.”