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Louboutin's Red Sole Mark: A Step toward Tertiary Meaning

“*[F]ashion is the fashion.*”¹

I. Introduction

Louis Armstrong's wonderful world contains “trees of green . . . red roses, too.”² The wonderful world of trademark law contains its own rainbow—a rainbow of attributed colors³—and that rainbow just got one red wider, if certain conditions are met: In September, the Second Circuit upheld Christian Louboutin's trademark protection for the red-lacquered soles⁴ that make J-Lo sing,⁵ that have popularized red paint,⁶ and that constitute the totemic center of the shoe-based religion he preaches.⁷ To the extent that the soles' redness contrasts with the rest of the shoe, the soles have secondary meaning—“these are Louboutins”—and are thus protectable.⁸

¹ WILLIAM SHAKESPEARE, *MUCH ADO ABOUT NOTHING* act 3, sc. 3.

² LOUIS ARMSTRONG, *WHAT A WONDERFUL WORLD* (ABC Records 1967).

³ To name but a few examples: Tiffany blue, UPS Brown, Owens-Corning Pink. See Ashby Jones, *The Red-Sole Case*, *WALL ST. J.* (Jan. 25, 2012), <http://online.wsj.com/article/SB10001424052970203718504577181360914355808.html>; see also *infra* app. at Figure 1.

⁴ See *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012).

⁵ JENNIFER LOPEZ, *LOUBOUTINS* (Epic 2009). Apparently, Louboutin is a fan of the song—and of the fact that Lopez pronounced his name correctly. See Sarah Karmali, *Christian Louboutin loves J-Lo's new single... Louboutins!*, *MARIE CLAIRE* (Dec. 3, 2009), <http://www.marieclaire.co.uk/news/fashion/433382/christian-louboutin-loves-j-lo-s-new-single-louboutins.html#beGotDKEtWbWdtSe.99>.

⁶ *Cash-strapped Women are Painting Their Shoe Soles Red to Get the Louboutin Look for Less*, *TELEGRAPH* (July 10, 2012), <http://fashion.telegraph.co.uk/news-features/TMG9389255/Cash-strapped-women-are-painting-their-shoe-soles-red-to-get-the-Louboutin-look-for-less.html>.

⁷ Louboutin has been outspoken about the significance of the shoes he creates. Some highlights include the notions that “comfy” is a dirty word (“I *hate* the whole concept of comfort! You’re abandoning a lot of ideas when you are too into comfort. ‘Comfy’—that’s one of the *worst* words! I just picture a woman feeling bad, with a big bottle of alcohol, really puffy.”); that men can’t resist women who wear his shoes (“‘Men are like bulls,’ Louboutin said. ‘They cannot resist the red sole.’”); that “shoes are like books, or workouts: if they doesn’t demand anything of you, you’re not going to get a lot out of them;” that feet are “lucky” (“The foot has this lucky thing. . . . A lot of women don’t like when they’re sort of fat, but a fat foot is as beautiful as a skinny foot. Think of Greek statues. Look how many people love the foot of the baby! There is something super-charming about the baby foot.”); that shoes should mold the body, not vice-versa (“His best shoes are almost prosthetic, morphing the body—lengthening the legs, defining the calves, lifting the butt—as radically as it is possible to do without surgery. ‘One thing I detest . . . is

So what’s so special about the conditional proprietization of yet another hue? In granting Louboutin dominion over the red sole, the Second Circuit underlined the “industry” in the fashion industry. Rejecting the district court’s condemnation of Louboutin’s attempt to rob other designer-artists of the ability to express themselves and compete with his products through red,⁹ the Second Circuit determined that shoes as a useful product whose functionality is not *necessarily* enhanced through sole color. Louboutin’s red soles, the circuit held, serve to refer to Louboutin himself, regardless of whatever primary, artistic meaning they contain.¹⁰

This case note argues that by holding that the red soles’ secondary meaning trumps their primary meaning, the Second Circuit created space for the soles to take on tertiary meaning. The act of contrast that the Second Circuit wrote into the very definition of the red sole mark can now be reintegrated into the pool of possibilities other designers may use—we can imagine, for example, mugs with red bases, nails with red undersides, cupcakes with red centers.¹¹ Shoes with soles of other contrasting colors have already been suggested to Louboutin¹² and made

when a shoe is too soft, . . . molding to the foot,’ Louboutin said. ‘This is quite disgusting.’”); that high heels help you appreciate scenery:

Louboutin . . . is not sympathetic to complaints about the deleterious effects of high heels on locomotion. He told me a story about a client who, having bought her first pair of his heels, was forced to slacken the pace of her morning walk. “She began to notice the little details of her neighborhood for the first time,” he said, proudly.

Lauren Collins, *Sole Mate: Christian Louboutin and the psychology of shoes*, NEW YORKER, Mar. 28, 2011, http://www.newyorker.com/reporting/2011/03/28/110328fa_fact_collins?currentPage=all. To see how these ideas are made manifest in Louboutin’s shoes, see *infra* app. at Figure 2.

⁸ *Louboutin*, 696 F.3d at 228.

⁹ See *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 778 F. Supp.2d 445, 454–55 (S.D.N.Y. 2011).

¹⁰ See *Louboutin*, 696 F.3d at 225–27.

¹¹ The manicure and cupcake already exist; see *infra* app. at

Figure 3.

¹² See Collins, *supra* note 7 (“The one thing Louboutin does not tweak is the color of the sole, even though charities are always hounding him to do a pink one for National Breast Cancer Awareness Month, or a green one for Earth Day. Shawna Rose [(famed publicist and Louboutin’s director of communications for the Americas)] told me, ‘I don’t even torture him with it anymore.’”).

reality by others.¹³ Thanks to the careful framing of the Second Circuit, the contrasting bottom has become *quotable*, which increases its Benthamian utility¹⁴ and fosters Aristotelian human flourishing,¹⁵ while still respecting the maker’s rights of Lockean theory¹⁶ and the Hegelian emphasis on personhood.¹⁷ In other words, the decision is a fashion-forward compromise between the competing concerns that underlie intellectual property (“IP”) protections.

Part II of this note fills in the background against which the Second Circuit decided the fate of the red soles, first by detailing some of the peculiarities of the fashion industry that have made it a difficult match for IP law and then by setting forth the legal background of the single-color trademark. Part III explores the Louboutin case itself, concentrating on the different approaches of the district and circuit courts and the significance of these differences. Part IV explores the potential created by the Second Circuit’s decision and argues that trademark protection in fashion can, as it does in this case, encourage cultural production rather than curb it.

II. Background

A. The Fashion Industry & the Law

Graphic designer and blogger Dyske Suematsu has observed that, “[a]lthough the skills required to create the work are quite similar, the internal processes of so-called ‘fine arts’ and ‘commercial arts’ are fundamentally different. . . . What drives most fine artists is their urge to *say something*[;] what drives most commercial artists is their urge to be *heard*.”¹⁸ Suematsu

¹³ See ROSSO SOLINI: DESIGNER SOLES, <http://www.rossosolinishop.com/> (last visited Mar. 8, 2013) (selling stick-on soles in a variety of colors and prints).

¹⁴ See GREGORY S. ALEXANDER & EDUARDO M. PEÑALVER, AN INTRODUCTION TO PROPERTY THEORY 11–19 (2012).

¹⁵ See *id.* at 200–03.

¹⁶ See *id.* at 191–97.

¹⁷ See *id.* at 197–99.

¹⁸ Dyske Suematsu, *What Makes Art “Fine” or “Commercial”?*, DYSKE: CULTURAL CRITIQUE (Aug. 7, 2010) <http://dyske.com/paper/933> (emphasis in original).

suggests that this distinction sets unfiltered self-expression at one pole and reception-driven production at the other, with most art falling somewhere along the spectrum between the poles.¹⁹

Fashion is a prime example of the need for artistic compromise in light of the practical concerns of a commercial world. Even schools that require uniforms have had to acknowledge fashion as a prized means of self-expression;²⁰ the Metropolitan Museum’s Costume Institute showcases “five continents and seven centuries of fashionable dress.”²¹ Artistry is not enough, however—as any fan of *Project Runway* knows, if you fail as a designer to strike a successful balance between artistry and salability, “you’re out.”²² Indeed, “Fashion = Art + Commerce.”²³

The commercial aspect of fashion distinguishes it from—and, to some, may make it “lesser” than—a fine art, where beauty need not bow to functionality, where expression remains unfettered, and where the final form of the artistic product is determined by the artist, not by differences among human figures or by the vagaries of the wearers’ accessory choices.²⁴ At the

¹⁹ *See id.*

²⁰ *See* Stephanie Clifford, *A Little Give in the Dress Code*, N.Y. TIMES, Sept. 1, 2011, http://www.nytimes.com/2011/09/02/business/school-dress-codes-letting-a-little-style-slip-in.html?pagewanted=all&_r=0.

²¹ THE METROPOLITAN MUSEUM OF ART, <http://www.metmuseum.org/about-the-museum/museum-departments/curatorial-departments/the-costume-institute> (last visited Mar. 5, 2013).

²² “You’re out” is the catchphrase with which host Heidi Klum dismisses eliminated contestants each week. *Project Runway* (Bravo 2004–08; Lifetime Television, 2009–present). As an example of the show’s frequent discussions of the need to balance creativity with retail potential, series judge Michael Kors told one contestant who had strayed too much toward the experimental, “I understand a non-traditional wedding. But I don’t care if you’re getting married in Winesberg in a loft, you’re not wearing that.” Louis Virtel, *Happy Birthday, Michael Kors! Here are His 9 Best ‘Project Runway’ Putdowns*, AFTERELTON, (Aug. 9, 2012), <http://www.afterelton.com/people/2012/08/9-best-michael-kors-project-runway-jokes?page=1,1> (quoting *Project Runway*: “*Model*” Clients (Bravo television broadcast Jan. 12, 2005)).

²³ This was the title of the 2012 symposium presented by Fordham University School of Law’s Fashion Law Institute. *See* FASHION LAW INSTITUTE, <http://fashionlawinstitute.com/institute-events/fashion-art-commerce>, (last visited Mar. 3, 2013); *see also* Joy Sewing, “Project Runway” Judge Zac Posen Talks Fashion, HOUS. CHRON. (Dec. 30, 2012), <http://www.houstonchronicle.com/news/article/Project-Runway-judge-Zac-Posen-talks-fashion-4150043.php> (presenting comments by the designer on fashion as an industry as well as a creative process).

²⁴ Kant, for example, in creating a hierarchy of the beautiful arts—a hierarchy that did not include fashion design—prized forms that allow the communication of the artist’s idea(s) along with sensations of pleasure. *See* IMMANUEL KANT, CRITIQUE OF JUDGMENT, part I, § 52, 214 (J. H. Bernard trans., 2d ed. 1914), *available at* http://files.libertyfund.org/files/1217/0318_Bk.pdf (“[I]n all beautiful art the essential thing is the form, which is purposive as regards our observation and [judgment], where the pleasure is at the same time cultivation and disposes the spirit to Ideas, and consequently makes it susceptible of still more pleasure and entertainment.”). Interestingly,

same time, however, fashion's commercial aspect is a source of credibility and cultural prominence—should a skeptic deride fashion choices as frivolous like Anne Hathaway's character in *The Devil Wears Prada*, Meryl Streep's Miranda Priestly has a compelling retort:

You go to your closet and you select... I don't know... that lumpy blue sweater, for instance because you're trying to tell the world that you take yourself too seriously to care about what you put on your back. But what you don't know is that that sweater is not just blue, it's not turquoise. It's not lapis. It's actually cerulean. And you're also blithely unaware of the fact that, in 2002, Oscar de la Renta did a collection of cerulean gowns. And then I think it was Yves Saint Laurent... wasn't it who showed cerulean military jackets? . . . And then cerulean quickly showed up in the collections of eight different designers. And then it . . . filtered down through the department stores and then trickled on down into some tragic Casual Corner where you, no doubt, fished it out of some clearance bin. However, that blue represents millions of dollars and countless jobs and it's sort of comical how you think that you've made a choice that exempts you from the fashion industry when, in fact, you're wearing the sweater that was selected for you by the people in this room from a pile of stuff.²⁵

It is difficult to disagree with this logic—fashion is a \$350 billion-a-year industry,²⁶ with “annual U.S. sales of more than \$200 billion—larger than those of books, movies, and music

Kant does include “the art of tasteful dressing (with rings, snuff-boxes, etc.)” as an analog to painting in his taxonomy of the arts, another indication that the final disposition is key. *Id.* at part I, § 51, 211.

Susan Scafidi has noted—and condemned—a similarly dismissive attitude toward fashion among lawyers:

Two dress forms grace the entrance of Fordham University Law professor Susan Scafidi's new ground-floor office. One is hugged by a lavender RM by Roland Mouret moon dress, and the other wears a pink knockoff by the—perhaps ironically named—label Rare. “It's no accident that I put pink dresses on there,” Scafidi says, gesturing to the dress forms. “Fashion is a pink-and-lavender discipline. It's associated with women and gay men, and there is an ongoing perception that this is a lighthearted subject. It can be, but the legal issues are every bit as complicated and hard to crack as in any other field.”

Shakthi Jothianandan, *Fordham's New Fashion Law Institute Will Serve, Protect, Talk Shoes*, THE CUT (Aug. 11, 2010, 2:10 PM), http://nymag.com/thecut/2010/08/fashion_law_institute.html; *see also* C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1150 (2009) (noting that the law treats fashion design as different from literature, music, and art).

²⁵ *Memorable quotes for The Devil Wears Prada*, IMDB, <http://www.imdb.com/title/tt0458352/quotes> (last visited Mar. 3, 2013) (quoting THE DEVIL WEARS PRADA (Twentieth Century Fox 2006)).

²⁶ Lynsey Blackmon, Comment, *The Devil Wears Prada: A Look at the Design Piracy Prohibition Act and the Extension of Copyright Protection to the World of Fashion*, 35 PEPP. L. REV. 107, 11 (2007) (citing Design Piracy Prohibition Act: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Prop. of the H. Comm. on the Judiciary, 109th Cong. (2006) (testimony of Jeffrey Banks, a fashion designer)).

combined.”²⁷ Indeed, “fashion is an *industry* of major economic, environmental and cultural significance [that has] been significant to the industrial and economic development of a number of countries . . . [and] has also played a significant role in the global relations between nations.”²⁸

Despite the fashion industry’s financial and social importance, however, fashion design has largely fallen by the legal wayside in the United States.²⁹ Scholars and industry insiders are starting to call attention to this neglect—and to call for a change: Fordham’s Fashion Law Institute, directed by Professor Susan Scafidi, opened its doors in late 2010;³⁰ The New York City Bar’s new Fashion Committee was created in 2011,³¹ the new and improved iteration of fashion-friendly legislation originally penned in 2006 began to make the Congressional rounds in 2012.³² If passed, this legislation will come over eighty years after Learned Hand presaged its necessity, when he announced that no law protected designers:

It seems a lame answer in such a case to turn the injured party out of court Congress might see its way to create some sort of temporary right, or it might not. Its decision would certainly be preceded by some examination of the result upon the other

²⁷ Hemphill & Suk, *supra* note 24, at 1148.

²⁸ JOANNE ENTWISTLE, *THE FASHIONED BODY: FASHION, DRESS AND MODERN SOCIAL THEORY* 208 (2000) (emphasis in the original).

²⁹ See Hemphill & Suk, *supra* note 24, at 1150.

³⁰ See Jothianandan, *supra* note 24

(Scafidi is the director of Fordham University’s new Fashion Law Institute, the first of its kind, which officially launches September 8. The Institute, supported in part by the Council of Fashion Designers of America, will be the primary nerve center for the academic study of fashion-related legal issues; it’ll also offer pro bono legal counseling to designers in need. “Fashion law is a new academic field and it’s new to even call it ‘fashion law,’ never mind to even conceive of it as a whole,” says Scafidi.)

³¹ See *City Bar Creates New Committee on Fashion Law*, NEW YORK CITY BAR (Jan 10., 2011, 2:09 PM), http://www.nycbar.org/component/wordpress/2011/01/10/city-bar-creates-new-committee-on-fashion-law/?option=com_wordpress&Itemid=299 (“The New York City Bar Association has announced the creation of a new committee on Fashion Law, which will study and comment on a wide range of legal issues associated with the fashion industry.”).

³² See Susan Scafidi, *Fashion PROTECTION Week: New "fashion copyright" bill (IDPA); red sole relief; and a new design manifesto*, COUNTERFEIT CHIC (Sept. 10, 2012), <http://counterfeitichic.com/2012/09/fashion-protection-week-new-fashion-copyright-bill-idpa-red-sole-relief-and-a-new-design-manifesto.html> (“In the U.S. Congress today, Senator Chuck Schumer introduced the newest version of the fashion design protection legislation originally proposed in 2006 and currently pending in the House of Representatives. . . . Happily the title isn’t such a mouthful this time; the IDPPPA is now simply the IDPA, the “Innovative Design Protection Act.”).

interests affected. Whether these would prove paramount we have no means of saying; it is not for us to decide.³³

It is surprising that an industry of such economic prominence has only recently begun to garner concerted legal attention. It is even more surprising that *fashion* in particular has lacked protection when it seems so fundamentally akin to IP. As Barton Beebe has noted,

Sumptuary law^[34] did not disappear with industrialization and democratization, as is generally believed. Rather, it has taken on a new . . . form: intellectual property law. To be sure, the express purpose and primary effect of intellectual property law remains the prevention of misappropriation and the promotion of technological and cultural progress. But for various reasons, we are increasingly investing intellectual property law with, and forcing the law to adapt to, a new purpose. This purpose is to preserve and stabilize our modern sumptuary code in the face of emerging social and technological conditions that threaten its viability We are thus increasingly relying on intellectual property law not so much to enforce social hierarchy as simply to conserve . . . our system of consumption-based social distinction and the social structures and norms based upon it.³⁵

If IP is the modern means of protecting consumption-derived status, it should be fashion's soul mate—after all, “apparel oft proclaims the man,”³⁶ and “fashions are not distinctive because they are beautiful; they are beautiful because they are distinctive.”³⁷ Seeming harmony of purpose notwithstanding, fashion does not enjoy easy access to intellectual property protection.

“The term ‘intellectual property,’ conventionally understood, includes, on a federal level, utility and design patents and copyrights, on a federal and state level, trademark and trade dress protection.”³⁸ The United States Copyright Office distinguishes among the three as follows:

³³ *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279, 281 (2d Cir. 1929).

³⁴ “A statute, ordinance, or regulation that limits the expenditures that people can make for personal gratification or ostentatious display.” BLACK’S LAW DICTIONARY 1574 (9th ed. 2009).

³⁵ Barton Beebe, *Intellectual Property Law and the Sumptuary Code*, 123 HARV. L. REV. 809, 813–14 (2010).

³⁶ WILLIAM SHAKESPEARE, HAMLET act 1, sc. 3.

³⁷ Beebe, *supra* note 35, at 865–66.

³⁸ Charles E. Colman, *An Overview of Intellectual Property Issues Relevant to the Fashion Industry*, in NAVIGATING FASHION LAW: LEADING LAWYERS ON EXPLORING THE TRENDS, CASES, AND STRATEGIES OF FASHION LAW (Aspatore 2012), 2012 WL 167352 at *1, 1. Colman also notes that there are several forms of state-level protection for intellectual property, such as “trade secret protection, the right of publicity, the right against misappropriation,

Copyright protects original works of authorship, while a patent protects inventions or discoveries. Ideas and discoveries are not protected by the copyright law, although the way in which they are expressed may be. A trademark protects words, phrases, symbols, or designs identifying the source of the goods or services of one party and distinguishing them from those of others.³⁹

Fashion arguably encompasses inventions (the zipper, for example), original works (such as a design, like that of the foldable Longchamp bags) and trademarks (e.g. embroidered alligator logos). All three main varieties of legal protection for intellectual property could thus protect fashion designers, at least in theory. In practice, because of the idiosyncrasies of the fashion industry, none of these three has provided the designs that deck the runways and drive the industry the legal protection that many feel they both deserve and require.⁴⁰

and other causes of action that vary by state.” *Id.* These peripheral protections, however, vary greatly and do not offer much protection to fashion designs. *see id.* at *56–57.

³⁹ COPYRIGHT, <http://www.copyright.gov/help/faq/faq-general.html> (last visited Mar. 9, 2013). *But see* Wendy J. Gordon, *Intellectual Property*, in *THE OXFORD HANDBOOK OF LEGAL STUDIES* 617–46 (Peter Cane & Mark Tushnet eds., 2003) (suggesting that the demarcations among these three protections are not quite so tidy and that there is potential for slippage among them).

⁴⁰ Not all scholars believe that protecting fashion designs through intellectual property law is desirable. First, there are those who resist intellectual property protections in general, or who would at least seek to limit them. *See, e.g.*, GNU OPERATING SYSTEM, <http://www.gnu.org/copyleft/> (last visited Mar. 7, 2013) (“Proprietary software developers use copyright to take away the users’ freedom; we use copyright to guarantee their freedom. That’s why we reverse the name, changing ‘copyright’ into ‘copyleft.’”); Carrie McLaren, *Copyrights and Copywrongs: An Interview with Siva Vaidyanathan*, *STAY FREE!* (Fall 2002) <http://www.stayfreemagazine.org/archives/index.html> (presenting interviewee’s distinction between intellectual “property,” which he defines as a “government-granted monopoly” from real property and noting that “copyright is not natural, it’s something that we the people decided to give to a certain class of people in exchange for something”); Martin Skladany, *Alienation by Copyright: Abolishing Copyright to Spur Individual Creativity*, 55 *J. COPYRIGHT SOC’Y U.S.A.* 361, 392 (2008) (“The death of copyright would hopefully dampen the over-consumption of commercial art and encourage people to resist ossification of their personalities by creating art on their own. More critically, we would be building a democracy of people who do, rather than people who sample.”); FREEDOM OF EXPRESSION ®, <http://www.freedomofexpression.us/trademark.html> (last visited Mar. 7, 2013) (featuring Kembrew McLeod’s explanation of how he trademarked the expression “Freedom of Expression:”

In my application to the Patent and Trademark Office, I didn’t write: “I want to trademark ‘freedom of expression’ as an ironic comment that demonstrates how our culture has become commodified and privately owned.” I simply applied to register this trademark and let the government decide whether or not we should live in a world where someone can legally control freedom of expression®. In filing this application, I crossed the enemy line at the Patent and Trademark Office, feigning allegiance by speaking their slippery language of legalese, fooling them into saying what I hoped wasn’t actually possible.).

Joining these voices of generalized discomfort with intellectual property rights are those who feel that fashion, in particular, benefits from the relatively low level of IP protections. While Kal Raustiala and Christopher Sprigman do not go so far as to claim that the fashion industry would collapse “in a high-IP environment,” they do

Before turning to the three IP protections and assessing their relative in/compatibility with the fashion industry, it is important to stress the difference between copying and counterfeiting. BLACK'S LAW DICTIONARY defines the verb "counterfeit" as "[t]o unlawfully forge, copy, or imitate and item . . . or to possess such an item without authorization and with the intent to deceive or defraud by presenting the item as genuine."⁴¹ The dictionary notes that "[c]ounterfeiting includes producing or selling an item that displays a reproduction of a genuine trademark, usually to deceive buyers into thinking they are purchasing genuine merchandise."⁴² Counterfeiting is criminalized by the United States Code, which provides that "[w]hoever intentionally . . . traffics in goods or services and knowingly uses a counterfeit mark on or in connection with such goods or services," is fined, "if an individual, . . . not more than \$2,000,000

argue that "a regime of low IP protection, by permitting extensive and free copying, enables emerging trends to develop and diffuse rapidly, and, as a result of the positionality of fashion, to die rapidly." Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1733–34. Thus, Raustiala and Sprigman assert, "[m]ore fashion goods are consumed in a low-IP world than would be consumed in a world of high IP protection precisely because copying rapidly reduces the status premium conveyed by new apparel and accessory designs, leading status-seekers to renew the hunt for the next new thing." *Id.* at 1733. In this way, low IP protection can stimulate innovation rather than stifle it. *See id.* at 1688. Ann Bartow also argues against IP protection for fashion, which "depriv[es] poor and penny-pinching people of noncounterfeit knockoffs." Ann Bartow, *Counterfeits, Copying and Class*, 48 HOUS. L. REV. 707, 747 (2011). Bartow suggests that the alleged fear of consumer confusion is just a smokescreen for trying to use the law to avoid "the effects of legitimate competition based on attributes such as price, quality, consumer appeal and retail availability." *Id.* at 707.

But see Blackmon, *supra* note 26, at 159 (expressing hope for a future offering greater IP protection to the fashion industry and in which "fashion designers will for once be respected and recognized, like those before them, for their creative contributions to our society."); Whitney Potter, Comment, *Intellectual Property's Fashion Faux Pas: A Critical Look at the Lack of Protection Afforded Apparel Design under the Current Legal Regime*, 16 INTELL. PROP. L. BULL. 69, 89 (2011) ("The arguments against design protection have stood for too long upon too weak a foundation. Once the underlying justifications for these arguments are explored, such as the allegedly unbreakable link between innovation and piracy, their futility becomes apparent and their damaging effects undeniable."); Alexandra Manfredi, Note, *Haute Copyright: Tailoring Copyright Protection to High-Profile Fashion Designs*, 21 CARDOZO J. INT'L & COMP. L. 111, 152 (2012) ("Although introduction of a new intellectual property protection may inspire an increase in anticompetitive behavior and could have some negative implications, the benefits of this proposed provision would likely outweigh its drawbacks."); Kevin V. Tu, *Counterfeit Fashion: The Interplay between Copyright and Trademark Law in Original Fashion Designs and Designer Knockoffs*, 18 TEX. INTELL. PROP. L.J. 419, 448–49 (2010) (arguing that increased protection for fashion IP has been made necessary by technological changes through which "designs can now be purloined and placed in competition with the original almost instantly," a phenomenon that disincentivizes innovation and thus threatens the forward movement of the industry).

⁴¹ BLACK'S LAW DICTIONARY 402 (9th ed. 2009).

⁴² *Id.* at 402–03.

or imprisoned not more than 10 years, or both, and, if a person other than an individual, shall be fined not more than \$5,000,000.”⁴³ The statute also subjects repeat offenders to increased sentences.⁴⁴ There is thus considerable legal recourse for designers who are the victims of actual counterfeiting. Less clear is what protects designers from imitation that threatens the marketability of their designs without directly trying to mislead the market via counterfeiting.

One main source of protection for any creator who can fix their design in a tangible medium is the United States Copyright Act.⁴⁵ Copyright is a long-lived but not permanent protection—for the typical “work created on or after January 1, 1978, [copyright] subsists from its creation and . . . endures for a term consisting of the life of the author and 70 years after the author’s death.”⁴⁶ *Nolo’s Plain-English Law Dictionary* defines copyright as

[a] bundle of exclusive rights granted to the author of a creative work such as book, movie, song, painting, photograph, design, computer software, or architecture. These rights include the right to make copies, authorize others to make copies, make derivative works, sell and market the work, and perform the work. Any one of these rights can be sold or licensed separately through transfers of copyright ownership. Copyright rights are acquired automatically once the work is fixed in a tangible medium of expression. Registration of the work with the Copyright Office offers additional benefits to the copyright owner.⁴⁷

Among these “additional benefits” is the capacity to enforce your copyright— although “registration is voluntary” and “[c]opyright exists from the moment the work is created[, y]ou will have to register . . . if you wish to bring a lawsuit for infringement of a U.S. work.”⁴⁸

“Copyright . . . protects original works of authorship including literary, dramatic, musical, and

⁴³ 18 U.S.C. § 2320 (2013).

⁴⁴ *Id.*

⁴⁵ 17 U.S.C. §§ 101–810 (2013).

⁴⁶ 17 U.S.C. § 302(a) (2013).

⁴⁷ NOLO’S PLAIN-ENGLISH LAW DICTIONARY, <http://www.nolo.com/dictionary/copyright-term.html> (last visited Mar. 5, 2013).

⁴⁸ COPYRIGHT, *supra* note 39.

artistic works, such as poetry, novels, movies, songs, computer software, and architecture.

Copyright does not protect facts, ideas, systems, or methods of operation, although it may protect the way these things are expressed.”⁴⁹ Copyright protects even unintentional copying, so “it is sometimes said that civil copyright is a ‘strict liability’ offense.”⁵⁰

Given the scope of copyright protection, fashion design—the tangible representation of a designer’s vision—would seem to be an excellent match for this form of legal protection. In reality, however, fashion designs are often unable to overcome the hurdles that items must clear to secure copyright protection. Charles E. Colman ranks copyright’s anti-utility requirement as the bar most likely to preclude copyright protection for fashion: “Because the Copyright Act excludes ‘useful articles’ from federally copyrightable subject matter, 17 U.S.C. § 101, clothing—‘useful’ insofar as it covers the body for reasons of warmth or social norms—generally receives no protection under copyright law.”⁵¹ Another bar to copyright protection that is particularly relevant to the fashion industry is the so-called “idea/expression dichotomy”: “in the visual arts, including fashion, ‘it is not clear that there is any real distinction between the idea in a work of art and its expression [because an] artist’s idea, among other things, is to depict a subject in a particular way.’”⁵² Although lobbyists are trying to change copyright law to gain more protection for fashion design,⁵³ copyright does not currently offer designers much recourse.

⁴⁹ COPYRIGHT, *supra* note 39.

⁵⁰ Colman, *Overview of IP Issues*, *supra* note 38, at *3. Colman cautions against the “strict liability” descriptor, however, as potentially misleading. *See id.*

⁵¹ *Id.* The doctrine of separability does allow certain “useless” adornments or features of a garment to be copyrighted where the work as a whole cannot; such features include “fabric patters of sufficient originality; images affixed to garments; some embroidery, beading and lace; some sculptural components of fashion; original jewelry; and certain elements of ‘fanciful’ costumes.” *Id.* at *4.

⁵² *Id.* at *11 (quoting *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 458 (S.D.N.Y. 2005)).

⁵³ For a discussion of the proposed legislation, see Alexandra Manfredi, *supra* note 40, at 139–50.

Nor does patent law⁵⁴ afford designers much in the way of protection. “Patents, exclusively a creature of federal law, come in two varieties that are relevant [to the fashion industry]: utility patents, which protect previously undiscovered utilitarian processes and devices; and design patents, which protect non-functional, original, ornamental designs for manufactured articles.”⁵⁵ Utility patents protect inventions for twenty years from the date on which the patent application is filed; design patents protect inventions for fourteen years from the grant of the patent.⁵⁶ Both varieties of patents require fees, though utility patents are more costly than design patents.⁵⁷ It can take quite a while to obtain either kind of patent.⁵⁸

The timing of patents is a major obstacle for the fast-moving fashion industry. As Oscar Wilde once wrote, “[W]hat is a fashion? From the artistic point of view, it is usually a form of ugliness so intolerable that we have to alter it every six months.”⁵⁹ So ephemeral are fashion trends that, in many cases, the item for which a patent were sought would be moot before the USPTO would decide whether to grant the patent.⁶⁰ Patent law also poses other hurdles that make it a dubious match for most fashion design. For both varieties of patent,⁶¹ the invention

⁵⁴ Title 35 of the U.S. Code is devoted to patent law. *See* 35 U.S.C. §§ 1 *et seq.* (2013).

⁵⁵ Colman, *Overview of IP Issues*, *supra* note 38, at *17.

⁵⁶ *See* THE UNITED STATES PATENT AND TRADEMARK OFFICE, <http://www.uspto.gov/inventors/patents.jsp> (last visited Mar. 10, 2013).

⁵⁷ *See id.*

⁵⁸ The United States Patent and Trademark Office (“USPTO”) acknowledges the time delay involved in obtaining a patent by offering utility patents applied for since June 8, 1995, the greater of 20 years from the application or 17 years from the grant. *See id.*

⁵⁹ Oscar Wilde, *Literary and Other Notes*, WOMEN’S WORLD (Nov. 1887), *available at*: <ftp://ibiblio.org/pub/docs/books/gutenberg/1/4/2/4/14240/14240.txt>.

⁶⁰ *See* Potter, *supra* note 40, at 76. As a result of the industry’s speed, Charles E. Colman notes, “design patents tend to be clustered in areas of the fashion industry where products change relatively slowly, such [as] the footwear, sportswear, and accessory segments of the market.” Colman, *supra* note 38, at *22.

⁶¹ The two types of patents are explicitly linked in the text of 35 U.S.C. § 171, the design patent provision: “Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title. . . . The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.” 35 U.S.C. § 171 (2013). Thus, in addition to directly requiring newness and originality, which echo the newness, novelty and non-obviousness required for utility patents, the other utility patent requirements are implicated through cross reference.

must be “new and useful,”⁶² and demonstrate “novelty;”⁶³ its innovation, moreover, must not have been “obvious.”⁶⁴ These requirements are a tall order for an industry of limited possibilities; as Vera Wang has noted, “We’re dealing with the human body. You can lower the waistline down to your kneecaps or raise it all the way up to your neck, but unless a woman grows another leg or another arm or two heads, we’re still working within a certain structure.”⁶⁵ Consequently, “[n]othing has never been done before.”⁶⁶ Patent law, like copyright, is too rigid to keep pace with the fleet and supple fashion industry.

The last of the IP triumvirate, trademark law,⁶⁷ is “the most flexible, sharpest little dagger” in the armory of the fashion lawyer.⁶⁸ Trademark offers renewable protection in ten-year increments;⁶⁹ “trademark protection is [thus] potentially perpetual in duration.”⁷⁰ “At a fundamental level, trademarks serve to indicate the source of goods and services,”⁷¹ with the twofold goal of incentivizing innovation by prohibiting free riding and of preventing consumer confusion.⁷² This second aim leads courts to ask, “[H]ow close is too close?”⁷³ The manner in which a court will go about answering this question will vary, because “[e]ach federal circuit has

⁶² 35 U.S.C. § 101 (2013).

⁶³ 35 U.S.C. § 102 (2013).

⁶⁴ 35 U.S.C. § 103 (2013) (“A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”).

⁶⁵ Venessa Lau, *Can I Borrow That? When designer “inspiration” jumps the fence to full-on derivation, the critics’ claws pop out*, W Mag. (Feb. 2008), http://www.wmagazine.com/fashion/2008/02/fashion_derivations?currentPage=4 (quoting Wang).

⁶⁶ *Id.* Vera Wang thus evokes with respect to fashion what Harold Bloom has dubbed “the anxiety of influence” in his literary analysis. See HAROLD BLOOM, *THE ANXIETY OF INFLUENCE: A THEORY OF POETRY* 96 (2d ed. 1997) (“A poem is a poet’s melancholy at his lack of priority.” (emphasis in original)).

⁶⁷ Federal trademark protection is granted by the Lanham Act, 15 U.S.C. § 1051 et seq. (2013).

⁶⁸ Susan Scafidi, Director, Fashion L. Inst. at Fordham Univ. Sch. of L., Address at the Fashion Inst. of Tech.: Technology Trap: Fashion, Copying, and the Speed of Information (Mar. 6, 2013).

⁶⁹ See 15 U.S.C. § 1058 (2013).

⁷⁰ *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1530 (Fed. Cir. 1994).

⁷¹ Colman, *Overview of IP Issues*, *supra* note 38, at *25.

⁷² See *id.*

⁷³ *Id.* at 26.

developed its own ‘likelihood of confusion’ factors.”⁷⁴ Thus, although grounded in federal statute, trademark law has been shaped by the courts.

Trademarks can take many forms. Charles E. Colman’s classification includes: words; generic marks; descriptive marks; suggestive, arbitrary, and fanciful marks; names and personas; full names; pictorial or design marks; sound and smell marks; color marks.⁷⁵ In the next section, we will focus on color trademarks and, more specifically, single-color trademarks. As Colman has observed, “*color* is its own animal in the trademark realm[, and n]aturally color trademarks are of particular interest to the fashion industry, where visual impact is of the utmost importance.”⁷⁶ When we later turn to the following section, which discusses the *Louboutin* case itself, we will see how the Second Circuit tailored trademark law to suit fashion.

B. Single-Color Trademarks

In 1995 the Supreme Court asked “whether the [Lanham Act] permits the registration of a trademark that consists, purely and simply of a color.”⁷⁷ Qualitex Company, a manufacturer of dry-cleaning press pads, had decked its pads in “a special shade of green-gold” for nearly forty years when rival Jacobson Products began to sell its own pads, “color[ing] those pads in a similar green gold.”⁷⁸ Would trademark law allow Qualitex to prevent Jacobson from using the color?

The Court began to answer this question by looking to the language of the Lanham Act and finding no indication that color is excluded from “the universe of things that can qualify as a

⁷⁴ *Id.* Thus, trademark depends greatly on common law in practice, though its theory is codified as federal law.

⁷⁵ *See id.* at *30–42. Colman’s lucid and helpful discussion provides an excellent overview of the law for those seeking more information on trademarks.

⁷⁶ *Id.* at 41 (emphasis in original).

⁷⁷ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 160–61 (1995). “The Lanham Act, 15 U.S.C. §§ 1051 *et seq.*, was enacted by Congress in 1946.” LEGAL INFORMATION INSTITUTE, http://www.law.cornell.edu/wex/lanham_act (last visited Mar. 24, 2013). Nolo’s defines the Lanham Act as “[t]he federal statute that governs trademarks, service marks, and unfair competition. The Lanham Act covers matters that include the procedures for federally registering trademarks, when owners of trademarks may be entitled to federal judicial protection against infringement, and other guidelines and remedies for trademark owners.” NOLO’S PLAIN-ENGLISH LAW DICTIONARY, <http://www.nolo.com/dictionary/lanham-act-term.html> (last visited Mar. 24, 2013).

⁷⁸ *Id.* at 161.

trademark.”⁷⁹ Perusing the roster of registered marks, the Court found startling heterogeneity and asked: “If a shape, a sound, and a fragrance can act as symbols why . . . can a color not do the same?”⁸⁰ Although color is “unlike ‘fanciful,’ ‘arbitrary,’ or ‘suggestive’ words or designs, which almost *automatically* tell a customer that they refer to a brand,”⁸¹ the Court observed, a color can nevertheless “come to signify and distinguish the goods [it is used to mark] . . . much in the way that descriptive words on a product . . . can come to indicate a products origin.”⁸² Noting that “[i]t is the source-distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word or sign—that permits it to serve [the] basic purposes [of trademark law],”⁸³ the Court found no “reason to disqualify absolutely the use of color as a mark.”⁸⁴

Finding no absolute bar to using color as a mark does not lead inexorably to upholding a single-color trademark, however. Notably, the would-be color mark needs (1) to have “attained ‘secondary meaning’”⁸⁵ and (2) to not have a function upon which competition is based.⁸⁶ Thus, the Court “conclude[d.] . . . *sometimes*, a color will meet ordinary legal trademark requirements. And, when it does so, no special legal rule prevents color alone from serving as a trademark.”⁸⁷

Applying its test to the Qualitex pads, the Court found the color to be a valid mark:

The green-gold color acts as a symbol. Having developed secondary meaning (for customers identified the green-gold color as Qualitex’s), it identifies the pads’ source. And, the green-gold color serves no other function. (Although it is important to use *some* color on the press pads to avoid noticeable stains, the [district] court found no competitive need in the press pad industry for the green-gold color, since other colors are equally usable).⁸⁸

⁷⁹ *Id.* at 162.

⁸⁰ *Id.*

⁸¹ *Id.* at 162 (citation omitted).

⁸² *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163 (1995) (citations omitted).

⁸³ *Id.* at 164 (citation omitted).

⁸⁴ *Id.*

⁸⁵ *Id.* at 163.

⁸⁶ *See id.* at 164–65.

⁸⁷ *Id.* at 161.

⁸⁸ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 166 (1995).

This two-part test for single-color trademarks remains good law.⁸⁹

The first prong, “secondary meaning,” is difficult to satisfy on a practical level—it requires time and effort to build referentiality—but simple in theory—whether that meaning has been created is an empirical question, at least for color-based trademarks.⁹⁰ To determine whether a mark has attained secondary, or source-identifying meaning, “certain evidentiary factors are appropriate to consider: (1) the length and manner of its use, (2) the nature and extent of advertising and promotion of the mark, and (3) the efforts made to promote a conscious connection, in the public’s mind, between that mark and a single source.”⁹¹ This is a fact-intensive inquiry, and the weight given to particular facts will vary from industry to industry.⁹²

Whereas the existence of secondary meaning is fairly straightforward, the second prong of the *Qualitex* test poses quite a theoretical conundrum—what does “functional” mean? The green-gold of the *Qualitex* pads served to mask stains but was not “functional” because other colors could serve the same purpose.⁹³ Because the green-gold was not functional, it could be protected.⁹⁴ Now, suppose the green-gold was used on a hunting jacket. In this context, the same color could not be protected because it would function to camouflage the hunter. To grant one producer an exclusive right to that color would be tantamount to granting that producer a monopoly on hunting-jackets—competitors would be forced to use non-camouflaging colors, a major disadvantage.⁹⁵ “The functionality doctrine . . . forbids the use of a product’s feature as a

⁸⁹ See Charles E. Colman, *A Red-Leather Year for Aesthetic Functionality*, 4 *LANDSLIDE* 26, 27 (2011).

⁹⁰ Secondary meaning is a more complex inquiry with respect to word-based trademarks. Laura Heymann observes that trademark doctrine favors image marks over linguistic marks because the former are more obviously referential. See Laura A. Heymann, *The Grammar of Trademarks*, 14 *LEWIS & CLARK L. REV.* 1313, 1330–32 (2010).

⁹¹ LOUIS ALTMAN & MALLA POLLACK, 3 *CALLMAN ON UNFAIR COMP., TR. & MONO.* § 20:29 (4th ed. 2012).

⁹² See *id.*

⁹³ See *Qualitex*, 514 U.S. at 166.

⁹⁴ See *id.*

⁹⁵ This is the reasoning the Federal Circuit used in holding that, because the color black makes outboard boat engines compatible with a variety of boat colors and also makes the engine appear smaller, black is a functional and

trademark where doing so will put a competitor at a significant disadvantage because the feature is essential to the use or purpose of the article or affects its cost or quality.”⁹⁶

But what happens in a field like fashion, where competition turns not on the actual function of the items offered—most shirts, for example, will cover the body and provide shirt-level warmth—but on their aesthetic appeal? This problem was envisioned back in 1938:

The trademark law doctrine of “aesthetic functionality” has a . . . humble origin . . . —the blandly named “Comment a” in § 742 of the *Restatement of Torts*, which explained: “When goods are bought largely for their aesthetic value, their features may be functional because they definitely contribute to that value and thus aid the performance of an object for which the goods are intended.” From this seed grew the gnarled tree now known as “aesthetic functionality.”⁹⁷

As presented in this form, aesthetic functionality does not seem so complicated: in markets in which competition stems not from actual functionality, but rather from aesthetics, than the aesthetic value of an object essentially becomes part of that object’s function. As a result, trademark protection would not extend to features that contribute to the item’s aesthetic appeal.

In *Qualitex*, however, the Supreme Court reformulated the doctrine of aesthetic functionality:

[I]f a design’s “aesthetic value” lies in its ability to “confe[r] a significant benefit that cannot be duplicated by the use of alternative designs,” then the design is “functional.” The “ultimate test of aesthetic functionality, [therefore,] . . . is whether the recognition of trademark rights would significantly hinder competition.”⁹⁸

This formulation is both more obscure and, potentially, more supple than the original version of the doctrine. Whereas the original first asks whether the item is purchased for its aesthetics or its

non-protectable via trademark in that context. *See* Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 1533 (Fed. Cir. 1994).

⁹⁶ *Id.* at 169 (quotations omitted).

⁹⁷ Colman, *Red-Leather Year*, *supra* note 89, at 27.

⁹⁸ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 170 (1995) (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 cmt. c (1993)).

function (such that dry cleaning pads, bought for their function, survive the test, but fashionable items, bought for their attractiveness, might not), the *Qualitex* version first asks whether the item's appearance creates a significant benefit. Thus, if it is the green-gold of the *Qualitex* dry cleaning pads that served to make them desirable, then the green-gold would not be protectable.

No one would accuse the *Qualitex* test for aesthetic functionality of being easy to apply. Indeed, “[t]he status of the aesthetic functionality doctrine is not clear,” and the circuits have not applied this doctrine in the same way.⁹⁹ As we turn now to the *Louboutin* saga, we will see how the Second Circuit approaches the question of functionality and whether colors can ever be anything other than functional in a field in which appearance is everything.

III. Louboutin's Red Soles

Louboutin painted his first sole red in 1992.¹⁰⁰ As Lauren Collins tells the story,

Louboutin had thought of making a shoe inspired by Andy Warhol's "Flowers." The prototype, a pink stacked heel with a cartoonish cloth blossom, had arrived from Italy. "I was very happy, because it was similar to the drawing," Louboutin recalled, "but the drawing still was stronger and I could not understand why." Louboutin continued, "There was this big black sole, and then, thank God, there was this girl painting her nails at the time." Louboutin grabbed the nail polish—it was red—from the assistant and slathered it on the sole of the prototype. "Then it popped," he recalled, "and I thought, *This is the drawing!*"¹⁰¹

Louboutin has colored his soles red ever since that fateful day. The red soles no longer serve to evoke Warhol; rather, they have taken on their own meaning: "I selected the color because it is engaging, flirtatious, memorable, and the color of passion," Louboutin has affirmed.¹⁰² In addition to their seductive virtues, the red soles are clever from a business perspective: "Part of

⁹⁹ MALLA POLLACK, CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW § 4:18 (2012).

¹⁰⁰ See *Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 448 (S.D.N.Y. 2011) (reprinting the passage from Louboutin's certificate of registration for his trademark, which lists the date of first use as 1992).

¹⁰¹ Collins, *supra* note 7 (emphasis in original). See also *infra* app. at Figure 4.

¹⁰² *Id.*

the genius of the red sole is that it is beautiful. The other part is that it requires a lot of refreshing: Louboutins, which look horrible scuffed, start to depreciate the day you walk them off the lot.”¹⁰³ Yet, though he acknowledges red’s connotation of passion, and though the fragility of the colored sole keeps customers coming in for refreshments and replacements at a lucrative clip, Louboutin also asserts that “[t]he shiny red color of the soles has no function other than to identify to the public that they are mine.”¹⁰⁴ Accordingly, Louboutin argued, his red soles are a valid mark upon which Yves Saint Laurent (“YSL”) infringed when it released an all-red shoe.¹⁰⁵

Judge Marrero, in an opinion for which he is likely to be infamous for some time,¹⁰⁶ relied on the somewhat enigmatic doctrine of aesthetic functionality to hold that the expressive potential inherent in the red sole trumped its secondary meaning (“these are Louboutins”):

Because in the fashion industry color 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 is entitled to trademark protection, even if it has gained enough public recognition in the market to acquire secondary meaning.¹⁰⁷

While the Supreme Court did uphold a single-color marks in *Qualitex*,¹⁰⁸ Marrero notes, “whatever commercial purposes may support extending trademark protection to a single color for industrial goods do not easily fit the unique characteristics and needs . . . that define production

¹⁰³ *Id.* See also *infra* app. at Figure 5.

¹⁰⁴ *Id.*

¹⁰⁵ See *Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 449 (S.D.N.Y. 2011)

¹⁰⁶ Marrero’s opinion has been noted for its flair as frequently as for its faulty analysis. Charles E. Colman called it “unusually flowery,” Colman, *Overview of IP Issues*, *supra* note 38, at *42; an IP blogger referred to Marrero’s “lengthy and somewhat overly-zealous reasoning,” Annsley Merelle Ward, *Letter from AmeriKat: Tiffany is Blue for Louboutin’s Red*, THE IPKAT (Nov. 14, 2011, 3:39 AM), <http://ipkitten.blogspot.com/2011/11/letter-from-amerikat-tiffany-sees-blue.html>; Afigo I. Fadahunsi was more descriptive, noting that the wittily-penned opinion surprised even the more ardent literary canon enthusiasts among us. Equating the whims of fashion with the brushstrokes of Picasso, quoting the likes of Walt Whitman’s “Leaves of Grass” and Jennifer Lopez’s “Louboutin,” Judge Marrero sought to underscore the notion that fashion has a dependence on color as an “indispens[a]ble medium.”

Afigo I. Fadahunsi, *Monochromatic Victory: Designers Eee Red amid Sole Trademark Ruling*, LEXOLOGY (Dec. 3, 2012), <http://www.lexology.com/library/detail.aspx?g=b692c4ea-0626-41ef-b061-33f511cf6c3b>.

¹⁰⁷ *Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d. at 449.

¹⁰⁸ See *supra*, Part II.B.

of articles of fashion.”¹⁰⁹ To Marrero, the difference between the industries makes them incomparable—after all, “industrial models [do not] sashay[] down the runways in displays of the designs and shades of the season’s collections of wall insulation.”¹¹⁰

Marrero argues that fashion is more appropriately analogized to painting, “[b]ecause both find common ground and goals in two vital fields of human endeavor, art and commerce.”¹¹¹ In both domains, “the whole spectrum of light serves as a primal ingredient without which neither painting nor fashion design as expressive and ornamental art would flourish.”¹¹² Just as we would not want Picasso to be able to preclude Monet from painting water the same shade of blue that Picasso used,¹¹³ Marrero reasons, trademark “law should not countenance restraints that would interfere with creativity and stifle competition by one designer, while granting another a monopoly invested with the right to exclude use of an ornamental or functional medium necessary for freest and most productive artistic expression by all engaged in the same enterprise.”¹¹⁴ This is precisely what upholding the red sole mark would produce, Marrero fears:

[A]t any moment when the market and the deities of design, by whatever fancy they decide those things, proclaim that “passion” is in for a given season and must be expressed in reds in the year’s various collections, Louboutin’s claim would cast a red cloud over the whole industry, cramping what other designers could do, while allowing Louboutin to paint with a full palette.¹¹⁵

Accordingly, Judge Marrero denied Louboutin’s request for an injunction.¹¹⁶

¹⁰⁹ Louboutin S.A. v. Yves Saint Laurent Am., Inc., 778 F. Supp. 2d. at 451.

¹¹⁰ *Id.*

¹¹¹ *Id.* at 452.

¹¹² *Id.*

¹¹³ *See id.* at 451.

¹¹⁴ *Id.* at 453.

¹¹⁵ Louboutin S.A. v. Yves Saint Laurent Am., Inc., 778 F. Supp. 2d 445, 454 (S.D.N.Y. 2011).

¹¹⁶ Judge Marrero’s reasoning largely echoes Wendy Gordon:

When the age of modern copyright first arrived, a painter was free to depict what came before; her exercising that liberty should not close it off from others who come after her. A painter in the modern city should be as able as the cave painter to depict and interpret her surroundings, even if in the modern world

Judge Marrero did correctly perceive that Louboutin’s registration certificate was overbroad: it claimed the lacquered red sole as a trademark when placed on “women’s high fashion designer footwear.”¹¹⁷ A trademark of such vague contours would take many shades of red off the sole market for anything that could be argued to be “high fashion designer footwear.”¹¹⁸ Both the Second Circuit, as we will see below, and the Cour de cassation, France’s highest court, agree that, as described in his registration certificate, Louboutin’s mark is overbroad.¹¹⁹ In what is perhaps a case of jurisprudence imitating art, however, Judge Marrero framed the question he was addressing much more broadly than he should have, such that his decision ended created per se rule against single-color trademarks in fashion:

The narrow¹²⁰ question presented here is whether the Lanham Act extends protection to a trademark composed of a single color used

many of the things she sees are artifacts created by others. That a first creator has labored is not sufficient ground to justify giving her a right to keep others from achieving their proper goals.

Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 Yale L.J. 1534, 1558 (1993). Whereas Gordon links painting to depiction of reality, however, Marrero makes no such claim for shoe design. Marrero prefaces his *Louboutin-Picasso* analogy by declaring that he intends to “[p]ut[] aside the thousand technicalities lawyers would conjure and quibble about in arguing why the imagined case is inapposite or distinguishable from the real controversy before the Court. . . .” *Louboutin*, 778 F. Supp. 2d at 451–52. The different aims of painters and designers, however, would seem to necessitate regarding the means they require to achieve their aims differently, and to complicate the seamless transfer of Gordon’s logic to the world of fashion design, regardless of the District Court’s disclaimer.

¹¹⁷ *Id.* at 448–49.

¹¹⁸ *See id.* at 454–57.

¹¹⁹ For information on the French court’s decision, see Lucy Waterlow & Hannah Roberts, *Louboutin Loses Case to Stop Zara Selling Red-Soled Shoes*, MAILONLINE (June 11, 2012, 5:47 AM), <http://www.dailymail.co.uk/femail/article-2157558/Christian-Louboutin-loses-case-stop-high-street-store-Zara-selling-red-soled-shoes.html>. The Cour de cassation’s decision is interesting because France is known for being the country that offers the most protection to designers. The United States, on the other hand, is known for being the least protective of fashion IP, yet, discussed below, the Second Circuit rewrote Louboutin’s registration for him to make it valid, rather than simply declare it unenforceable. Credit for information on the relative levels of protection offered to fashion IP in different countries to Te Smith, MarkMonitor, Address at the Fashion Inst. of Tech.: Technology Trap: Fashion, Copying, and the Speed of Information (Mar. 6, 2013). Louboutin’s trademark registration is reproduced *infra*. *See infra* app. at

Figure 6.

¹²⁰ As Tiffany (NJ) LLC pointed out in its amicus brief, “the forgoing [*sic*] is not a ‘narrow question’ but a broad one, and was not necessary or appropriate to ask or answer in resolving the preliminary injunction motion.” Brief for Tiffany (NJ) LLC and Tiffany and Company in Support of Appellants’ Appeal Seeking Reversal of the District Court’s Decision Denying Appellants’ Motion for Preliminary Injunction, *Louboutin S.A. v. Saint Laurent Am. Holding, Inc.*, 696 F.3d 206 (2012) (No. 11-3303), 2011 WL 5126167, at *6.

as an expressive and defining quality of an article of wear produced in the fashion industry. In other words, the Court must decide whether there is something unique about the fashion world that militates against extending trademark protection to a single color, although such registrations have sometimes been upheld in other industries.¹²¹

This sweeping question led to an equally sweeping YES: “the Court cannot conceive that the Lanham Act could serve as the source of the broad spectrum of absurdities that would follow recognition of a trademark for the use of a single color for fashion items.”¹²² Thus, encapsulated in Judge Marrero’s decision is an argument for excluding fashion from the trademark protection that other industries enjoy, even though it cannot secure the copyright protection from which other, less “useful” artistic media, benefit.¹²³ Through his focus on the functional potential of appealing elements, moreover, Judge Marrero brought the difficult doctrine of aesthetic functionality to the Second Circuit’s door.¹²⁴

The Second Circuit did not leave the fashion industry betwixt and between. Rather, it reined in the scope of the issue and of Louboutin’s trademark. Although the circuit court did not engage in the sort of cultural critique the district court practiced, it did nevertheless contribute to culture by taking action—the Second Circuit took its blue pencil to Louboutin’s red soles and defined them in a way that makes them both protectable and more meaningful.

The Second Circuit took a methodical approach from the outset:

We address the District Court’s order in three parts. We first consider whether a single color is protectable as a trademark, both generally and in the specific context of the fashion industry. We then address the doctrine of “aesthetic functionality” and consider whether, as the District Court held, a single-color mark is necessarily “functional” in the context of the fashion industry—with the result that no such mark could ever be trademarked in that

¹²¹ Louboutin, 778 F. Supp. 2d at 451.

¹²² *Id.* at 457.

¹²³ See *supra* Part I.A.

¹²⁴ See Colman, *Red-Leather Year*, *supra* note 89, at 28–29.

industry. Finally, we determine whether the Red Sole Mark is a valid trademark entitled to the protection of the Lanham Act.¹²⁵

In answering the first question, the Second Circuit stressed the consumer-protective purpose of trademark law and noted that, although this protection has the benefit of entailing protection of for the producer, “it is *not* intended to protect innovation by giving the innovator a *monopoly* over a useful product feature.”¹²⁶ The Second Circuit stressed that “[s]uch a monopoly is the realm of patent law or copyright law, which seek to encourage innovation, and not of trademark law, which seeks to preserve a vigorously competitive market for the benefit of consumers.”¹²⁷

Despite this caveat, the court noted, a mark merits protection if it is distinctive, either inherently or by having acquired secondary meaning.¹²⁸ When a mark is distinctive, it is enforceable against those competitors whose products feature marks so similar that they might create consumer confusion—unless, that is, the competitor can show that the mark is functional on either a utilitarian or an aesthetic level.¹²⁹ The Second Circuit described “the test for aesthetic functionality [as] threefold: At the start, we . . . ask[] whether [(1)] the design feature is either essential to the use or purpose or [(2)] affects the cost or quality of the product at issue.”¹³⁰ If the answer to either of these is “yes,” then the inquiry ends and trademark protection is denied. If, on the other hand, the answer to both is “no,” then (3) the mark must still “be shown not to have a significant effect on competition in order to receive trademark protection.”¹³¹

Having set forth the contours of the usual test for trademark validity and the affirmative defense of aesthetic functionality, the Second Circuit turned to the question of whether there was

¹²⁵ *Louboutin, S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 215 (2d Cir. 2012).

¹²⁶ *Id.* at 216 (emphasis in original) (quotation omitted).

¹²⁷ *Id.* (quotation omitted). *But see* Colman, *Overview of IP Issues*, *supra* note 38, at *25 (naming the incentivizing of producer investment as the first of trademark law’s two aims).

¹²⁸ *Louboutin*, 696 F.3d at 216.

¹²⁹ *Id.* at 217.

¹³⁰ *Id.* at 220.

¹³¹ *Id.*

anything special about the use of single-color trademarks in the fashion industry that would require modifying the test. Noting that the test for aesthetic functionality is necessarily fact-intensive¹³² and that “the Supreme Court specifically forbade the implementation of a *per se* rule that would deny protection for the use of a single color as a trademark in a particular industrial context,”¹³³ the Second Circuit “determined that no *per se* rule governs the protection of single-color marks in the fashion industry, any more than it can do so in any other industry.”¹³⁴

Accordingly, the Second Circuit began its analysis of Louboutin’s trademark case by asking whether the red sole was distinctive enough to merit protection. The court observed that “a single color, standing alone, can almost never be inherently distinctive,”¹³⁵ but found that the red soles to be distinctive by virtue of the secondary meaning they have acquired: “Louboutin’s marketing efforts have created [a]brand with worldwide recognition. . . . By placing the color red in a context that seems unusual and deliberately tying that color to his product, Louboutin has created an identifying mark firmly associated with his brand which, to those in the know, instantly denotes his shoes’ source.”¹³⁶ The Second Circuit noted, however, that Louboutin’s red soles only carry secondary meaning in certain circumstances:

We conclude, based upon the record before us, that Louboutin has not established secondary meaning in an application of a red sole to a red shoe, but *only* where the red sole contrasts with the “upper” of the shoe. The use of a red lacquer on the outsole of a red shoe of the same color is not a use of the Red Sole Mark.¹³⁷

The Second Circuit therefore rewrote Louboutin’s trademark in keeping with the contrast the court found to be a central element of his soles’ significance: “We . . . instruct the Director of

¹³² *See id.* at 222.

¹³³ *Id.* at 223.

¹³⁴ *Louboutin, S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 224 (2d Cir. 2012).

¹³⁵ *Id.* at 225.

¹³⁶ *Id.* at 227.

¹³⁷ *Id.* at 228.

the Patent and Trade Office to limit the registration of the Red Sole Mark to only those situations in which the red lacquered outsole contrasts in color with the adjoining ‘upper’ of the shoe.”¹³⁸

The Second Circuit’s decision was win-win for the parties involved: Louboutin’s red sole mark is protected, and Saint Laurent’s monochromatic red shoe marches forward.¹³⁹ The fashion industry also won big: although it remains unclear how the circuit will address questions of functionality in aesthetic elements going forward, it is now evident that aesthetic trademarks in fashion will at least get the benefit of a fact-intensive inquiry into their validity. Susan Scafidi applauded the Second Circuit’s decision, celebrating the fact that “the district court’s overreaching attempt to ban all single-color trademarks in fashion was tossed out like a bad impulse purchase. One small sigh of relief for a man, one giant sigh of relief for the fashion community. Now we can all put up our red soles and rest.”¹⁴⁰

The biggest victory in the Second Circuit’s decision was arguably the court’s modification of Louboutin’s trademark. This is, first and foremost, a triumph of common sense: the circuit court could simply have invalidated the mark for overbreadth as the Cour de cassation did in Louboutin’s Hexagon-based battle,¹⁴¹ a harsh result that would ill reward the effort Louboutin has expended in promoting his brand through his red sole mark.¹⁴² The modification

¹³⁸ *Id.*

¹³⁹ *See id.* at 228–29. The Second Circuit stressed that, because YSL’s monochrome shoe did not run afoul of Louboutin’s trademark, it was not going to opine any matters exceeding the scope of its holding: “it is axiomatic that we need not—and should not—address either the likelihood of consumer confusion or whether the modified Mark is functional.” *Id.* at 229.

¹⁴⁰ Scafidi, *Fashion PROTECTION Week*, *supra* note 32.

¹⁴¹ *See Waterlow & Roberts*, *supra* note 119.

¹⁴² Like an adverse possessor who gains title to real property, Louboutin earned his red sole mark. He openly used red on his soles, and even added “hostility” to his possession through litigation. Although Judge Marrero ultimately denied Louboutin trademark protection, he did openly recognize Louboutin’s innovation: “Louboutin . . . departed from longstanding conventions and norms of his industry, transforming the staid black or beige bottom of a shoe into a red brand with worldwide recognition at the high end of women’s wear, a product visually so eccentric and striking that it is easily perceived and remembered.” *Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 448 (S.D.N.Y. 2011). It is not until after the red soles gained fame and became associated with Louboutin that many other designers suddenly took interest in red outsoles. To allow them to use red soles now that Louboutin has made them special would be to condone free riding. By allowing Louboutin to take “ownership” of contrasting

is also important because, by defining the soles as deriving meaning through contrast, the Second Circuit *made* contrast an element of the red sole mark. Contrast may always have made the mark stand out, but making it an explicit feature of the mark is significant: like a filter in a search engine, this additional definitional element makes the red soles easier to identify—and to invoke. The next section focuses on why increased invocative potential is a win for culture in general.

IV. Analysis

Karl Lagerfeld once said that “[f]ashion is a language that creates itself in clothes to interpret reality.”¹⁴³ Design elements and garments are like letters and words, and it is perhaps easier to understand the perils and potential of trademark protection in the fashion world through this fashion-as-language concept. If the fashion industry is a conversation between designers and consumers, the goal—regardless of whose philosophy of property and society we apply—is to encourage the discussion to range over many topics and to include as many voices as possible.

The question is thus whether protection such as Louboutin’s trademark stimulates the conversation or stifles it. Did the Second Circuit’s decision partially gag designers who might choose to express themselves via red soles, by taking away something akin to the letter “O,” like James Thurber’s pirates?¹⁴⁴ This note argues that, while the Second Circuit certainly *did* take an

red outsoles, the court sends a clear message to designers: if you want to preserve your right to use similar elements, do not let secondary meaning build unchecked. Jeffrey J. Look has warned that this need for vigilance has been made more acute for secondary meaning that can be built via the internet:

The creators of copyrightable works, as well as trademark owners, will need to exercise vigilance in patrolling the Internet for infringers and will need to act quickly to stop the activity. If not, they risk losing their right to control the manner by which their intellectual works are distributed, used and displayed.

This is not unlike the real property concept of adverse possession.

Jeffrey J. Look, *The Virtual Wild, Wild West (Www): Intellectual Property Issues in Cyberspace: Trademarks, Service Marks, Copyrights, and Domain Names*, 22 U. ARK. LITTLE ROCK L. REV. 49, 89 (1999).

¹⁴³ Quoted at GOODREADS, <http://www.goodreads.com/quotes/tag/fashion?page=4> (last visited Mar. 4, 2013).

¹⁴⁴ See JAMES THURBER, *THE WONDERFUL “O”* (1957). The residents of the island upon which the pirates embark lament the loss of “o” and the related deprivations they will suffer: “‘They will take my dough,’ moaned the baker. ‘They will take my gold,’ moaned the goldsmith. ‘And my forge,’ sighed the blacksmith. ‘And my cloth,’ wept the tailor. ‘And my chocolate,’ muttered the candymaker.” *Id.* at 17. The key difference between the villagers in the story and the other designers who may no longer use red lacquered soles on their high-fashion women’s shoes is that

expressive option off the table, as if it had removed a tile from the Scrabble board of fashion,¹⁴⁵ it framed its decision in such a way as to create third level of meaning—“tertiary meaning,” or the meaning that can be attached to a brand name, such as the safety that many suburbanites equate with Volvos¹⁴⁶—to join the secondary meaning that secured Louboutin’s red sole mark.

This tertiary meaning can come from without—when other designers refer to and reframe the protected design—as well as from within, when companies adopt social aims so that their brand markers signify these goals as well. Thus, although upholding Louboutin’s mark protected his ability to benefit from his maker’s rights in a Lockean sense¹⁴⁷ and the artistic expression of his person in a Hegelian sense,¹⁴⁸ the increased potential for communication through tertiary meaning maximizes—via a spillover effect identified by Brett M. Frischmann and Mark A. Lemley¹⁴⁹—both Benthamian utility¹⁵⁰ (by multiplying available choices and thus allowing participants to compare options and make selections offering the most favorable pleasure-to-pain ratio) and Aristotelian human flourishing¹⁵¹ (by multiplying available choices and thus allowing participants to develop “autonomy, practical reason, and sociability”). This is the very sort of

designers will be able to play with the idea of the contrasting sole (as in by soles of other colors) and the contrasting use of red (as in the red underside of a handbag), and these design elements will have additional meaning by dint of referencing Louboutin’s red sole mark.

¹⁴⁵ Marc R. Poirier, Remarks at Paper Conference (Mar. 14, 2013).

¹⁴⁶ For information on Volvo safety, see MOTORING, <http://motoring.ninemsn.com.au/article.aspx?id=8613032> (last visited Mar. 30, 2013) (“It’s official: Volvo has built the world’s safest car. And it doesn’t just protect drivers.”). For amusing evidence of Volvo’s reputation as the vehicle-of-choice for suburbanites, see *infra* app. at Figure 7.

¹⁴⁷ See ALEXANDER & PEÑALVER, *supra* note 14, at 191–93.

¹⁴⁸ *Id.* at 197–99.

¹⁴⁹ In the words of the authors:

Spillovers—uncompensated benefits that one person’s activity provides to another—are everywhere. My decision to plant an attractive flower bed benefits my neighbors and people who happen to stroll by. Your decision to educate your children well, making them into productive, taxpaying, law-abiding members of society, benefits the people who buy the goods they will produce, the people who will receive the government benefits their taxes fund, and the people they might otherwise have robbed.

Brett M. Frischmann & Mark A. Lemley, *Spillovers*, 107 COLUM. L. REV. 257, 258 (2007).

¹⁵⁰ *Id.* at 12–13, 203.

¹⁵¹ *Id.* at 202.

balanced solution that Wendy J. Gordon advocates as a means to protect the creator from “stowaways” while still adhering to the Lockean proviso of “enough and as good.”¹⁵²

It is nothing new to suggest that the clothes and accessories in which we dress ourselves have the ability to communicate. In fact, it is precisely because such choices are meaningful that people are able to make what are commonly called “fashion statements.” In making a fashion statement, however, it is the wearers of clothes who have chosen both the message and the means of communicating that message, not the fashion designers.¹⁵³ Roland Barthes similarly emphasized the split that exists between a tangible fashion item and the message attributed to it. He noted that every piece of clothing featured in a magazine is actually three garments:

The first is the one presented to me as photographed or drawn—it is image-clothing. The second is the same garment, but described, transformed into language; this same dress, photographed on the right, becomes on the left: a leather belt, with a rose stuck in it, worn above the waist, on a soft Shetland dress; this is a written garment. . . . [T]hese two garments recover a single identity at the level of the real garment they are supposed to represent.¹⁵⁴

Thus, the inherent “semiotic nature” of fashion design—that is, of the “real garment” in Barthes’s analysis—is expanded and accentuated by the photographic and verbal representations of the garment, such that “[f]ashion becomes *narrative*.”¹⁵⁵ It is important to note that, in Barthes’s conception of how fashion acquires meaning, there must first be translation—the intermediary known as a “shifter,” to use Barthes’s term—among these three garments.¹⁵⁶

¹⁵² See Gordon, *A Property Right in Self-Expression*, *supra* note 116, at 1572–76.

¹⁵³ See *supra* note 24 (discussing Kant’s inclusion of artful dressing—but not fashion design—within his hierarchy of the arts).

¹⁵⁴ ROLAND BARTHES, *THE FASHION SYSTEM* 3–4 (Matthew Ward & Richard Howard trans., University of California Press 1990). Barthes, of course, goes on to complicate the notion of identity among the “three garments,” but his theories of the production of meaning and the interplay between fashion producers and the fashion press is beyond the scope of the present study. For the purposes of this note, the essential kernel of Barthes’s analysis is that mediation is required between fashion feature and meaning, whereas trademark within fashion is able to exist on the linguistic and the vestimentary planes at the same time.

¹⁵⁵ *Id.* at 277.

¹⁵⁶ See *id.* at 5–7.

C. Scott Hemphill and Jeannie Suk focus on the manner in which designers communicate through the fashions they create, arguing that “[i]nnovation in fashion creates vocabularies for self-expression that relate individuals to social worlds.”¹⁵⁷ They note that, “[a]s a means of signaling and communicating about oneself, and of perceiving messages about others, dress has a symbolic function and is even considered by some social theorist to be a code or a language that provides visual cues and signifiers of identity, personality, values, or other social meanings.”¹⁵⁸ Hemphill and Suk assert that this communicative, quasi-linguistic capacity of fashion design frequently leads designers to communicate by “remixing”¹⁵⁹ statements made by their creative peers and predecessors. Citing Chanel jackets and quilted purses as designs to which designers frequently allude, Hemphill and Suk liken such referencing to forms of musical allusion, “homage and pastiche.”¹⁶⁰ They assert that

designers . . . may engage in interpretation or ‘referencing.’ They may quote, comment upon, and refer to prior work. Unlike much close copying, such interpretation does not pass off the work as the work that is being copied. Instead, it marks awareness of the difference between the two works as it looks to the prior work as a source of influence, or even a precursor. Even where the influence is not completely conscious or direct, the latter work draws on the meaning of the earlier work, rather than being simply a copy of it.¹⁶¹

Hemphill and Suk clearly support creative remixing as an outlet of expression, a means of imparting meaning, and even a process that can drive fashion forward.¹⁶²

Hemphill and Suk thus argue that design elements can take on the same role in shaping the language of fashion that verbal trademarks hold with respect to language itself. One of the

¹⁵⁷ Hemphill & Suk, *supra* note 24, at 1151.

¹⁵⁸ *Id.* at 1158.

¹⁵⁹ *Id.* at 1154.

¹⁶⁰ *See id.*

¹⁶¹ *Id.* at 1160.

¹⁶² *See id.* at 1161. This is the same right of reference that Wendy J. Gordon argues must be conserved; indeed, Gordon suggests that a cause of action for infringement could include an element of intent that would allow courts to penalize intellectual “stowaways” while allowing culture to progress through creative recombination and referencing. *See* Gordon, *A Property Right in Self-Expression*, *supra* note 116, at 1576–78.

most common marks is the single word (e.g. Fendi®, Armani®, Crocs®).¹⁶³ Single-word trademarks have proven quite adept at capturing the public interest and infiltrating daily speech. Once they enter the idiom, trademarked words both submit to and spark metamorphoses—they are converted into various forms of speech at the whim of the speaker, on the one hand, and they oust older yet perfectly serviceable words on the other, changing the linguistic landscape forever. Recognizing the linguistic importance of trademarks, Professor Laura A. Heymann notes that:

We use “Coke” to refer to the Coca-Cola beverage in the North, and “coke” to refer to any kind of soda in the South, yet we still manage to get the drinks we desire. We use trademarks as verbs—we “xerox” a document or “tivo” a television program—without losing sight of the fact that “Xerox” and “TiVo” are brands of particular products. We use trademarks as metaphor and as slang—“Kleenex,” for example, has been used as street language for ecstasy. . . .¹⁶⁴

Indeed, single-word marks are so common and can exert such strong effects on language that one can forget they are trademarks (e.g. jet ski, bubble wrap, onesies).¹⁶⁵ In we might call linguistic Darwinism, brand names sometimes prove stronger and survive longer than generic terms.

Although Hemphill and Suk encourage design Darwinism through reference and preference, they are careful to distinguish referencing from copying,¹⁶⁶ which they say “threatens

¹⁶³ See UNITED STATES PATENT & TRADEMARK OFFICE, <http://www.uspto.gov/trademarks/index.jsp> (last visited Mar. 8, 2013) (“A trademark is a brand name. A trademark or service mark includes any word, name, symbol, device, or any combination, used or intended to be used to identify and distinguish the goods/services of one seller or provider from those of others, and to indicate the source of the goods/services.”).

¹⁶⁴ Heymann, *supra* note 90, at 1313. Heymann argues that courts should recognize the trend to incorporate trademarked words into daily speech and should be less restrictive in determining what types of words can serve as trademarks. *Id.* (“[T]rademark law might benefit from a more direct consideration of its role in creating language—in other words, whether it should be prescriptive (and define proper word usage) or descriptive (and reflect common word usage.”). Such suppleness would alleviate what Heymann argues to be the nonsensical burdens placed on single-word trademark holders that do not wish to lose proprietary rights to their trademarked terms to not only refrain from using their own trademarked words in creative ways, but to actively combat such playful usage by the public. See *id.* at 1326–27 (decrying the perceived need for trademark holders to educate the public about how to use their verbal trademark “in order to prevent a slide into generic status”). This paper argues that a similar balance can be struck between creativity and brand protection with respect to single-color trademarks in the fashion industry.

¹⁶⁵ See Lauren Harrell, *25 Words You Might Not Know are Trademarked*, MENTAL_FLOSS (July 14, 2011, 8:42 AM), <http://mentalfloss.com/article/28238/25-words-you-might-not-know-are-trademarked>; see also Lauren Harrell, *10 More Trademarked Words*, MENTAL_FLOSS (Aug. 5, 2011, 11:46 AM), <http://mentalfloss.com/article/28439/10-more-trademarked-words>.

the amount of innovation and pulls the direction of innovation toward fashion's status conferral aspects an away from its expressive agents."¹⁶⁷ Of course, the line between clever allusion and copy is not necessarily a bright one. Notably, remixers and their "mixees" may disagree on whether a reference constitutes a knowing wink or a theft.¹⁶⁸ fashion designers may be as willing as any to take their place on the shoulders of giants,¹⁶⁹ but the giants do not always want them there, nor do fashion critics. After a show by Marc Jacobs, for example, one critic lamented his "remixing" of other designers:

Most disappointing was that Jacobs spent a significant amount of time merely repeating or paraphrasing what designers such as Kawakubo, Margiela and the Dutch team of Viktor & Rolf have already said aesthetically. . . . Jacobs's greatest gift is his unique voice, his ability to create clothes that rise out of his interest in popular culture—from animation to music. This collection seemed to emerge from the pages of other designers' old sketchbooks.¹⁷⁰

¹⁶⁶ As the backlash Derek Lam faced for a collection in which he felt that he referenced the work of another designer, but that critics felt was merely copying, the distinction between play, which Hemphill and Suk praise, and plunder, which they condemn, is not always easy to draw. *See infra* note 174 and accompanying text. This paper argues that granting IP protection to fashion helps to make this line easier to draw. *See infra* note 182 and accompanying text.

¹⁶⁷ Hemphill & Suk, *supra* note 24, at 1170. An example they give of how copying distorts innovation is by encouraging designers such as Gucci to cover their products in their protectable logos. "Such 'logofication' affects the communicative vocabulary that fashion provides, pulling fashion toward a status-conferring function and away from the communication of diverse messages." *Id.* at 1178.

¹⁶⁸ And this difficulty is assuming deliberate reference or imitation; as Wendy J. Gordon points out, a certain level of similitude with respect to prior works is unavoidable, and no designer could—or should—seek compensation for every contribution his designs make to fashion. After discussing the positives that can flow from granting IP protection, Gordon admonishes her readers to

note an important caveat: no one would suggest that IP should internalize *all* the benefits that flow from an intangible. For example, imagine how odd the world would be if a young person had to pay the authors of his textbooks for all the benefits that, over a lifetime, the books generated for him. . . . Among other things, IP must be as concerned with the follow-on innovator as with originators. In the year 2006, every originator is a borrower as well.

Gordon, *Intellectual Property*, *supra* note 39, at 623.

¹⁶⁹ "Bernard of Chartres used to compare us [(modern thinkers)] to [puny] dwarfs perched on the shoulders of giants. He pointed out that we see more and farther than our predecessors, not because we have keener vision or greater height, but because we are lifted up and born aloft on their gigantic stature." JOHN OF SALISBURY, *THE METALOGICON: A TWELFTH-CENTURY DEFENSE OF THE VERBAL AND LOGICAL ARTS OF THE TRIVIUM 167* (Daniel D. McGarry, trans., University of California Press 1955), available at <http://en.calameo.com/read/000107044639e1e85b433>.

¹⁷⁰ Robin Givhan, *In Hip's Tight Grip*, WASH. POST, Sept. 13, 2007, <http://www.washingtonpost.com/wp-dyn/content/article/2007/09/12/AR2007091202646.html>.

Clearly, to Robin Givhan, design elements should not be referenced like elements of pop culture. Although this seems like a strange—and strained—line to draw when the fashion industry thrives on its popularity, it is not an uncommon sentiment.

[T]he bashing Jacobs took this season only proves that the critics' love-hate relationship with derivation is an ever[-]swinging pendulum. A designer may be lauded for appropriating one season—as happened when Jacobs's Yves Saint Laurent/Walter Albini-inspired fall 2007 collection was nearly universally praised—and castigated the next. Over the years, many major designers have been so chided. Calvin Klein was at various times chastised for leaning toward Giorgio Armani and Helmut Lang; a retailer even termed his fall 1998 show "Comme des Calvin" for its strong Japanese motifs. Klein's successor, Francisco Costa, has taken shots as well, most recently in spring 2007 for a stunning resemblance to Lang.¹⁷¹

While many voices in fashion do not distinguish—at least systematically and predictably—between referencing and copying, some designers do support “quoting” the work of others. Tom Ford, “often accused of seeing the world through Halston-colored glasses, [has] remarked, ‘Nothing made me happier than to see something that I had done copied.... Appropriation has always been a trend.’”¹⁷² Derek Lam, after being criticized for copying, admitted the reference and expressed regret that no one understand what he was trying to do through that reference: “‘Definitely, I was looking at Alaïa,’ he says. . . . ‘[T]he message I was proposing didn’t come across clearly enough.’ As for what tipped the balance from inspiration to perceived plagiarism, Lam wonders if he should have provided show notes.”¹⁷³

It seems that Derek Lam was trying to live the dream of self-conscious referencing that Hemphill and Suk favor. For Lam, that dream turned into a publicity nightmare. If the designs he was quoting were protected as intellectual property, however, Lam would have had an easy

¹⁷¹ Lau, *supra* note 65, at http://www.wmagazine.com/fashion/2008/02/fashion_derivations?currentPage=3.

¹⁷² *Id.* at http://www.wmagazine.com/fashion/2008/02/fashion_derivations?currentPage=6.

¹⁷³ *Id.* at http://www.wmagazine.com/fashion/2008/02/fashion_derivations?currentPage=4.

answer: he would either have crossed the line and infringed, or walked the line and imbued his work with the meaning derived from the designs he referenced. It is the ambiguity of the signified designs' status that left Lam vulnerable to criticism.¹⁷⁴

The Second Circuit's *Louboutin* decision offers such clarity to those who would like to refer to his work. In upholding the red-sole trademark and, especially, in defining it with the precision it originally lacked, the Second Circuit made the scope of Louboutin's message very clear. Because the contrasting red lacquered sole is Louboutin's, those designers who wish to incorporate statements about Louboutin into their works can do so without fear that their designs will be interpreted as unoriginal rather than deliberately referential.¹⁷⁵ This referentiality is a third layer of meaning: if the provocativeness Louboutin sought to capture is the primary meaning of his soles, and the fact that the soles say "Louboutin" is their secondary meaning, references to Louboutin's soles would allow designers to graft tertiary meaning upon those soles.¹⁷⁶ While designers may no longer be able to legally create high-heeled women's pumps

¹⁷⁴ While Lam faced what could be called market abundance confusion—*i.e.*, given the amount of designs displayed each year, Lam's reference to Balenciaga was at once too obvious not to garner criticism for unoriginality and too vague to send a clear message via referencing, because the quoted collection apparently did not mean to Lam's critics what it meant to him. *But see* Potter, *supra* note 40, at 70 (expressing the optimistic view that "[t]oday's heightened fashion consciousness has led to a new level of consumer sophistication—specifically, the ability to recognize the individual style of their favorite designers without referencing a label or trademark").

¹⁷⁵ Trademarked designs are powerful signifiers of the brand they protect, as Abercrombie & Fitch acknowledged when—whether seriously or in a P.R. ploy is anyone's guess—it offered to pay a JERSEY SHORE cast member "to stop wearing clothes carrying their brand. . . . because the series is 'contrary to the aspirational nature of the brand. We are deeply concerned that Mr. Sorrentino's association with our brand could cause significant damage to our image,' the retailer said in a press release." Mae Anderson, *Abercrombie Asks 'The Situation' to Shop Elsewhere*, WASH. TIMES (Aug. 17, 2011), <http://www.washingtontimes.com/news/2011/aug/17/abercrombie-asks-the-situation-to-shop-elsewhere/#ixzz2N0IOjMBb>. Given the powerful referentiality of trademarked designs, it is possible to take an element from a trademark and recast it without losing the ability to evoke the original. Thus, for example, now "[t]here is a Louboutin manicure, in which the underside of the nail is painted with scarlet polish." Collins, *supra* note 127; *see also infra* app. at

Figure 3.

¹⁷⁶ Although IP law does not use the term "tertiary meaning," both copyright and trademark law do this level of significance. Thus we have the fair use exception to copyright protection and the parody exception to trademark protection, both of which allow for the use of protected material in order to make certain kinds of statements about

with contrasting red soles, in other words, they have gained the ability to add their own gloss to the meaning of “Louboutin” by evoking the soles in meaning-rich ways in their designs.¹⁷⁷

Literature gives us some examples of the kinds of meanings that can be implicitly attached to brand markers. The potential for the creation of multiple levels of meaning via design protection was already apparent in 1883, when Émile Zola fictionalized the creation of the first department store in Paris and offered a very perceptive account of the massive commercial and social impact of the *grands-magazins*. Zola’s *Au Bonheur des dames* begins with a long, detailed description of the spell-binding power that the window displays of the new retail colossus exert upon the novel’s heroine, Denise, and her family. After several pages of adjective-laden accounts of the diverse wares on offer, Denise arrives at the final display:

A display of silks, satins, and velvets spread out before them in a supple, shimmering range of the most delicate flower tones: at the top were the velvets, of deepest black and as white as curds; lower down were the satins, pink and blue, with bright folds fading into infinitely tender pallors; lower down still were the silks, all the colours of the rainbow, pieces rolled into shell shapes, folded as if round a drawn-in waist, brought to life by the knowing hands of the shop assistants; and, between each motif, between each coloured phrase of the display, there ran a discreet accompaniment, a delicate gathered strand of cream-coloured foulard. And in colossal piles at each end were the two silks for which the shop held exclusive rights, the Paris-Paradise and the Cuir-d’Or, exceptional items that were to revolutionize the drapery trade.¹⁷⁸

The fabrics mentioned at the end are the only proprietary names in Zola’s long catalog of available goods and, after mentioning these names, the lyrical *lèche-vitrines*¹⁷⁹ ends and the action of the story begins. Just as the explicit meaning of Zola’s text foreshadows the revolution

that material. See Colman, Overview of IP issues, *supra* note 38, at *12; Bruce P. Keller & Rebecca Tushnet, *Even More Parodic than the Real Thing: Parody Lawsuits Revisited*, 94 TRADEMARK REP. 979, 1000–08 (2004).

¹⁷⁷ But see Michael A. Heller, *The Tragedy of the Anticommons: Property in the Transition from Marx to Markets*, 111 HARV. L. REV. 621, 677 (1998) (arguing that excessive property rights can lead to the *underuse* of resources that occurs when access to them is blocked by property rights and that “[a] *tragedy of the anticommons* can occur when too many individuals have rights of exclusion in a scarce resource”).

¹⁷⁸ ÉMILE ZOLA, *THE LADIES’ PARADISE* 5 (Brian Nelson trans., 1995).

¹⁷⁹ The English expression “window shopping” is a poor substitute for the French “window licking,” with its connotations of appetite, need, desire and Pavlovian response.

produced by the proprietary fabrics, IP functions as both an end and a beginning in within the prose of the novel. By placing protected fabrics at the transition point between charming but relatively static description and action-packed, verb-driven narration, Zola symbolically captures both the loss of communicative possibilities that those who argue against IP protection lament and IP's ability to drive industry forward that those who advocate IP protection celebrate.¹⁸⁰

Flashing forward six score years, we come to Sophie Kinsella's best-selling *Shopaholic* series, an ode to brand-worship. Kinsella's works depict even more directly the communicative potential of branding. In the book that launched the series, the eponymous shopping addict, Becky Bloomwood, walks through London on her way to work and reflects on her outfit:

I'm wearing my black skirt from French Connection, and a plain white T-shirt from Knickerbox, and a little angora cardigan which I got from M&S but looks like it might be Agnès b. And my new square-toed shoes from Hobbs. Even better, although no one can see them, I know that underneath I'm wearing my gorgeous new matching knickers and bra with embroidered yellow rosebuds. They're the best bit of my entire outfit. In fact, I almost wish I could be run over so that the world would see them.

It's a habit of mine, itemizing all the clothes I'm wearing I've been doing it for years—ever since I used to read *Just Seventeen*. Every issue, they'd stop a girl on the street, take a picture of her, and list all her clothes. . . . I used to read those lists avidly, and to this day, if I buy something from a shop that's a bit uncool, I cut the label out. So that if I'm ever stopped in the street, I can pretend I don't know where it's from.¹⁸¹

In this text, brands stand as unqualified nouns and add their own meaning to Becky's outfit. We have no idea what Becky's skirt looks like—is it long or short? Straight or pleated? Ruffled? Sequined? Feathered? Wool? Cotton? Linen? Such visual minutia cannot compete with the skirt's brand affiliation, because it is the brand—not the look—that signifies coolness or lack

¹⁸⁰ See *supra* note 40 for an overview of both anti- and pro-IP scholarship. See *infra* pages 37–40 for a discussion of how granting trademark protection to Louboutin's red soles can offer designers—including Louboutin himself—new communicative possibilities while simultaneously foreclosing another.

¹⁸¹ SOPHIE KINSELLA, *CONFESSIONS OF A SHOPAHOLIC* 14 (2003).

thereof. The first meaning of the skirt is whatever aesthetic it conveys; the second is its function as a brand identifier; the third meaning, which derives from the second, is “coolness.” Here, the author achieves descriptive economy by underscoring the capacity of brands to serve as signs.

Literary works are able to build meaning upon fashion brand names by changing the medium in which they occur, by exploiting the shift that must occur between real garment and written garment, to use Barthes’s terms, to attach an extra layer of significance to the brand. Designers can accomplish similar statements but must in some way tweak the proprietary design to do so because they operate within the same medium as the original. One clever young designer has found a way to quote Louboutin’s soles without simply copying them. In 2010, a high-school student completed a school project that soon became a business: she creates colored stickers that can be affixed to the soles of shoes.¹⁸² Although red was the first color offered by Rosso Solini, “[t]he product range . . . has now expanded to include over 30 colours and designs including a new bridal range.”¹⁸³ Her stick-on soles are meaning-rich through their referentiality. On their own, the stickers may connote only whim or a desire to adorn; by evoking Louboutin the stickers take on an aspirational quality, yet also unmistakably suggest that fancy soles are not only for the affluent. Rosso Solini is thus an outstanding example of tertiary meaning created through reference to a protected design element.¹⁸⁴

It is culturally fruitful to add another potential layer of meaning to design and to encourage designers to both create and comment, such that the conversation of fashion becomes

¹⁸² ROSSO SOLINI, *supra* note 13. Founder Tara Haughton, seventeen, “has . . . won the Enterprise Award, The Kildare Enterprise award[,] the Ulster Bank Business [Achiever]’s Award[,] and the Sean Lemass Enterprise [A]ward.” *Id.*

¹⁸³ *Id.*

¹⁸⁴ Another example is the Thursday Friday bags—open, canvas sacs bearing pictures of expensive pocketbooks. See Thursday Friday, <http://www.thufri.com/> (last visited Mar. 9, 2013). Unfortunately, not everyone appreciates the statement these bags make; see also *infra* app. at Figure 8. See *Hermès Sues Thursday Friday for Using Birkin Bag Image*, HUFFINGTON POST (Jan. 31, 2011, 4:31 PM), http://www.huffingtonpost.com/2011/01/31/hermes-sues-thursday-frid_n_816613.html (“This just in: Hermès has no sense of humor.”).

more far-reaching and self-reflexive,¹⁸⁵ but Professor Frank Pasquale has identified a different, and more important potential social function for intellectual property. Although expressivity is a lovely thing, it is a luxury. But designers whose work is protected have the ability to attach less luxurious, more socially imperative meanings to their own works:

Following the types of ‘green certifications’ offered for development projects in [less developed countries], perhaps the Copyright Office could condition design protection on applicants’ contractors’ meeting certain fair labor standards and practices. A symbol for protected designs could then reflect a verified judgment that the designer’s licensee respects certain wage and labor standards. IP protections could be combined and leveraged to reflect the social values of those concerned about the exploitation of the poor, just as they now reflect the social values of those concerned about the exploitation of the copied.¹⁸⁶

If Louboutin subscribed to this view, he could make his red sole a symbol for ethical production as well as status. While there is nothing to indicate that he holds such aims, other luxury designers have striven to make their brands socially meaningful.¹⁸⁷ IP protections can thus serve social causes while simultaneously protecting brands.

¹⁸⁵ Although adding referentiality to a fashion design may seem as frivolous as adding another ruffle or fringe, it is important to remember the analogy between garment and text. Just as allusions—always an implicit form of critique—enrich literary works, so too can they enhance fashion by provoking thought:

The first modern novel was already a product, even an expression, of negative criticism: “Don Quixote” contains a quite explicit critique of the chivalric romance and its insufficiency to account for the way real life feels when you get up in the morning in 17th-century Spain. Cervantes dreamed a distorted dream of “Amadis of Gaul,” in which the giants had all been turned into windmills—and the novel was born. It’s to this kind of critical impulse that we owe the growth of literature.

Elif Batuman, *From the Critical Impulse, the Growth of Literature*, N.Y. TIMES (Dec. 31, 2010), <http://www.nytimes.com/2011/01/02/books/review/Batuman-t-web.html?pagewanted=all>. Not everyone reads Cervantes, but everyone wears clothes; if clothing can inspire people to think beyond the literal—to think more analytically—then we risk falling into the same trap as Anne Hathaway’s character in *The Devil Wears Prada* if we dismiss that potential as mere frivolity. See *supra* note 25 and accompanying text. Indeed, there is no reason to distinguish referentiality in fashion from the “geographical indications, mash-ups, fan fiction, and machinima” that Madhavi Sunder lauds as part of the “life that is culturally fulfilling,” as part of the United Nation’s aspirational “Knowledge Society.” Madhavi Sunder, *IP3*, 59 STAN. L. REV. 257, 314 (2006).

¹⁸⁶ Frank Pasquale, *Joining or Changing the Conversation? Catholic Social Thought and Intellectual Property*, 29 CARDOZO ARTS & ENT. L.J. 681, 722 (2011).

¹⁸⁷ Luxury designer Stella McCartney, for example, has taken great pains to equate her brand with responsible production. See *Company Statement*, STELLA MCCARTNEY, <http://www.stellamccartney.com/experience/us/stellas->

Professor Pasquale’s suggestion could help combat animal cruelty in addition to sweatshop conditions and the systemic exploitation of laborers. Uggs, for example, are as imitated as they are popular. They are made of shearling. “Shearling, a lambskin or sheepskin pelt . . . is considered by some to be a separate category [from exotic furs].”¹⁸⁸ Because authentic Uggs are expensive, cheap copies have flooded the market.¹⁸⁹ Many of the imitations do use fur—fur from raccoon dogs.¹⁹⁰ In China, these dogs are skinned alive and then tossed onto heaps—still alive—to live out the final agonizing hours of their lives with no skin.¹⁹¹ The boots made from these animals cost a mere fraction of what authentic Uggs do.¹⁹² With better intellectual property protection for designs, it may be possible to halt this brutal shadow

world/sustainability/company-statement/ (last visited Mar. 30, 2013). When one sees her products, one knows that they were produced in sustainable ways and that they do not contain animal skins or furs. *See id.* Seeing the signature chains with which she trims her bags, for example, the first meaning is whatever style the bags convey, the second is that the bag is a Stella McCartney bag, the third is that the bag is not made of leather and was made using environmentally innocuous methods. *See* STELLA MCCARTNEY, <http://www.stellamccartney.com/us/stella-mccartney/women/bags/> (last visited Mar. 30, 2013); *infra* app. at Figure 9. This chain of logic is possible only if Stella McCartney’s signature design elements can be protected.

¹⁸⁸ Patrick Range McDonald, *West Hollywood’s New Fur Ban Could Be a Model for the Nation. But Opponents Are Still Trying to Strike It Down*, L.A. WEEKLY, July 26, 2012, <http://www.laweekly.com/2012-07-26/news/west-hollywood-fur-ban-boutique-designer-peta-shearling/>. “‘Shearling’ is not sheared wool. A shearling is a yearling sheep who has been shorn once. A shearling garment is made from the skin and coat of a sheep or a lamb who was shorn shortly before slaughter; the skin is tanned with the wool still on it.” PETA, <http://www.peta.org/issues/animals-used-for-clothing/inside-the-wool-industry.aspx> (last visited Mar. 9, 2013). What makes some consumers think of shearling as being different from fur is that the sheep or lamb is killed for its meat, not just for its coat. *See, e.g.*, Eric Wilson, *Fuzzy Logic*, N.Y. TIMES (Feb. 20, 2009) <http://runway.blogs.nytimes.com/2009/02/20/fuzzy-logic/> (explaining that shearling is considered akin to leather rather than to fur even by PETA).

¹⁸⁹ *See, e.g.*, Linda Mora Lee, *Top 5 Fake UGGs Websites: Were [sic] to Find the Best Knock Offs*, YAHOO! VOICES (Dec. 10, 2009), <http://voices.yahoo.com/top-5-fake-uggs-websites-were-find-best-knock-5041108.html>. This citation is not to suggest that the products featured on this site are among those fakes that use raccoon dog fur—I have no idea which fakes use the fur and which do not.

¹⁹⁰ *See* Lydia Warren & Oliver Pickup, *Skinned Alive to Make Fake Uggs: Horrific Footage Reveals Slow, Sickening Death of Raccoon Dogs*, MailOnline (Oct. 12, 2011, 9:59 AM), <http://www.dailymail.co.uk/news/article-2045016/Raccoon-dogs-skinned-alive-make-cheap-copies-Ugg-boots.html>. For a description and images of the raccoon dog, *see infra* app. at Figure 10.

¹⁹¹ *See id.*

¹⁹² *See* Caroline Grant, *Uggy Truth: Video Shows Raccoon Dogs Being Flayed Alive for the Fur on Fake Trendy Boots*, THE SUN (Oct. 4, 2011), <http://www.thesun.co.uk/sol/homepage/news/3851468/Uggy-truth.html#ixzz2N2GM4jWZ>.

industry.¹⁹³ Through marketing, Uggs could equate its brand with the humane harvesting of skins, such that aspiring customers would not only want the look, but also the philosophy.¹⁹⁴

When cultivated to connote social policy—be it labor standards, the humane treatment of animals, sustainable production methods, or a company practice of charitable giving—IP law has the capacity to give consumers the security of knowing that they are purchasing brands that stand for values in which they believe.¹⁹⁵ This is part of what Madhavi Sunder brilliantly labels the New Enlightenment,¹⁹⁶ and it would implicate the same, third level of meaning upon which designers draw when remixing another designer’s protected creation. IP protection is a necessary component in the production of tertiary meaning in fashion: one cannot bypass the brand affiliation of secondary meaning to arrive at either social message or inter-designer referentiality directly from the aesthetic connotations of the garment.¹⁹⁷ By paving the way for both more self-conscious artistic innovation on the one hand, and the visual promotion of social platforms on the other, the Second Circuit’s *Louboutin* decision is a step in the right direction.¹⁹⁸

¹⁹³ See *Protecting a Billion Dollar Brand*, World Intellectual Property Review (Jan. 1, 2013), <http://www.worldipreview.com/article/protecting-a-billion-dollar-brand> (noting that while the company works with enforcement agencies to catch and thwart counterfeiting operations, legal protections against imitators are limited).

¹⁹⁴ See Scafidi, WHO OWNS CULTURE, *supra* note 174, at 132 (“The most successful intellectual properties in economic and cultural terms are those in which the public has become the greatest investment. Such creative works become cultural icons A community may define itself in terms of an intellectual property . . . or in opposition to an intellectual property.”). Designers could thus create communities around humanitarian business practices.

¹⁹⁵ This would be an example of philanthropic intellectual property law, which Barton Beebe argues to be the desirable evolutionary aim of IP, which will move beyond sumptuary significance as we enter the post-scarcity age. See Beebe, *supra* note 35, at 884–86.

¹⁹⁶ See Sunder, *supra* note 185, at 319–21.

¹⁹⁷ One would not look at chain trim and think “playful contrast of hard and soft” and then immediately think “pro-environment and pro-animals.” This jump in logic is only made possible by associating the design with Stella McCartney, who has, in turn, associated her work with social messages. See *supra* note 187 and accompanying text.

¹⁹⁸ This is arguably “the [super-]idealized vision of intellectual property.” JAMES BOYLE, THE PUBLIC DOMAIN: ENCLOSING THE COMMONS OF THE MIND 7 (2008). With respect to “the legal protection of trademarks . . . this ‘homestead law for the English language,’” *Id.* at 6 (quoting Letter from Thomas Jefferson to Abraham Baldwin (Apr. 14, 1802), in 19 WRITINGS OF THOMAS JEFFERSON at 128–29 (Albert Ellery Bergh ed.) (Washington, D.C.: The Thomas Jefferson Memorial Association of the United States, 1907), Boyle presents the “idealized vision”—a harmonious combination of “sav[ing] consumers time” and “giv[ing] manufacturers an incentive to make good products—or at least to make products of consistent quality or price to build up a good brand name and invest in consistency of its key features, knowing that no other firm can take their name or symbol.” *Id.* at 6–7. The promotion of values through tertiary meaning would thus be beyond even this “idealized vision.” As Boyle notes,

Conclusion

The Second Circuit reached the right decision in *Louboutin v. Yves Saint Laurent* from both a legal and a philosophical perspective. Although the fashion industry largely wants for applicable intellectual property law, at present it does have trademark and trade dress protections. The district court improperly treated these protections as dependent on the nature of the mark's primary meaning—functional or functionless—rather than on whether the mark had secondary meaning. The Second Circuit set forth a different test, one that accords more strongly with Supreme Court precedent as well as the innovation-incentivizing goal behind IP law: if a mark has acquired secondary meaning, then it is protectable.

By protecting Louboutin's red sole as a single-color trademark, the Second Circuit *did* foreclose the use of red soles as a contrast to the uppers of high-heeled women's shoes by other designers. But, to replace this mode of expression that it restricted, the Second Circuit fashioned the possibility of imbuing the soles with tertiary meaning. The Second Circuit has defined the red soles to mean "Louboutin," which gives other designers the opportunity to quote the soles and thus to comment on Louboutin, much like the creator of the Rosso Solini stick-on soles. It simultaneously invited Louboutin to define himself, as Stella McCartney has done.

To be sure, Louboutin may decline this invitation and stick with the primary, man-bait meaning that he originally ascribed to the soles, leaving the interpretive ground that the Second Circuit tilled to lie fallow. Nevertheless, the Second Circuit has created fertile space in which designers may cultivate social messages. Though less flashy than the district court opinion, the circuit's decision will be a wardrobe staple for designers and IP lawyers for years to come.

however, IP protections work differently in different industries. *See id.* at p. 4. Given the very visual nature of fashion, its potential for communicating values outstrips that of other industries. Through IP protection, messages can reach a larger audience, because many more people may choose to communicate through red soles or chain trim than through the more literal Message Tee, which is suitable for only casual contexts. *See infra* app. at Figure 11.

APPENDIX

Figure 1: A Rainbow of Proprietary Colors

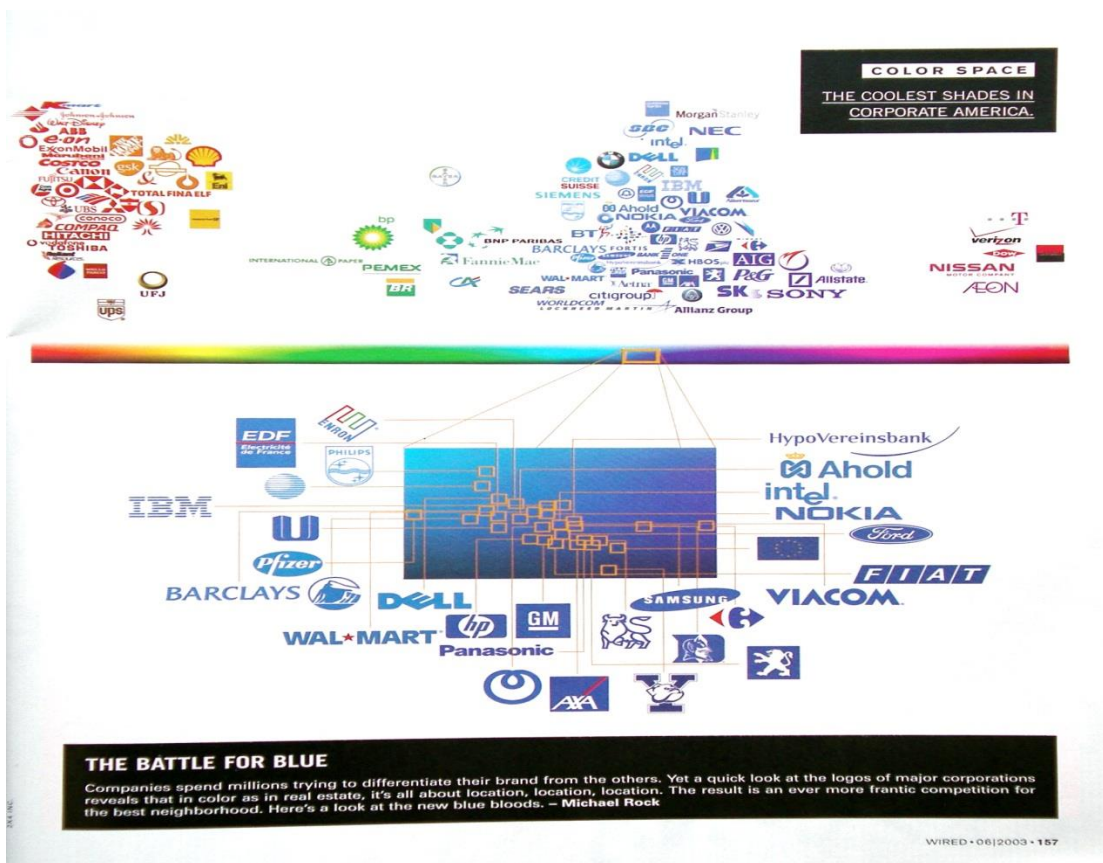


Figure 2: Some Louboutins Currently Available at Neiman Marcus



Alti Spike Red Sole Pump
\$1495



Lady Peep Spike Red Sole Pump, Canary
\$1395



Daffodile Snakeskin Red Sole Platform Pump, Stone
\$1395



Lady Peep Spikes Metallic Red Sole Pump, Turquoise/Violet
\$1395



Funky Multi-Buckle Patent Red Sole Sandal
\$1395



Anita Buckled Red Sole Pump
\$1395

Figure 3: The Louboutin Manicure & Cupcake



Figure 4: "Poppy" and the First Red Sole



Figure 5: Wear and Tear on the Red Soles



Figure 6 : Louboutin's Trademark Registration

Int. Cl.: 25	
Prior U.S. Cls.: 22 and 39	
United States Patent and Trademark Office	Reg. No. 3,361,597 Registered Jan. 1, 2008
TRADEMARK PRINCIPAL REGISTER	
	
CHRISTIAN LOUBOUTIN (FRANCE INDIVIDUAL) 24 RUE VICTOR MASSÉ PARIS, FRANCE 75009	THE MARK CONSISTS OF A LACQUERED RED SOLE ON FOOTWEAR. THE DOTTED LINES ARE NOT PART OF THE MARK BUT ARE INTENDED ONLY TO SHOW PLACEMENT OF THE MARK.
FOR: WOMEN'S HIGH FASHION DESIGNER FOOTWEAR, IN CLASS 25 (U.S. CLS. 22 AND 39).	SEC. 2(F).
FIRST USE 0-0-1992; IN COMMERCE 0-0-1992.	SER. NO. 77-141,789, FILED 3-27-2007.
THE COLOR(S) RED IS/ARE CLAIMED AS A FEATURE OF THE MARK.	NORA BUCHANAN WILL, EXAMINING ATTORNEY

Figure 7: Police Log from Suburbia Heights, in THE PARTY, AFTER YOU LEFT 3 (2004).

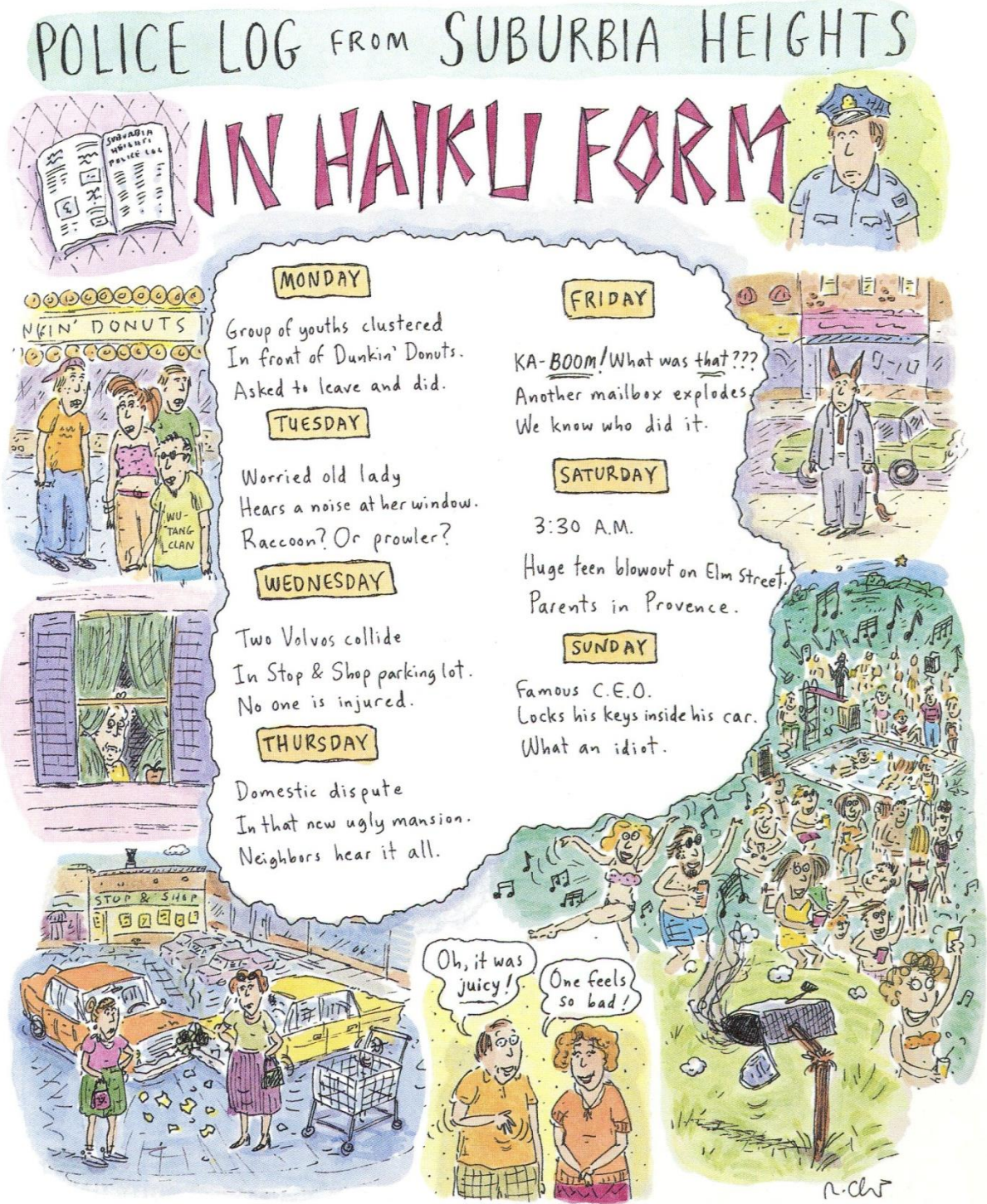


Figure 8: The Real Birkin Bag & the Referenced Birkin Bag



Figure 9 : A Stella McCartney Bag with Chain Trim



Figure 10: The Raccoon Dog

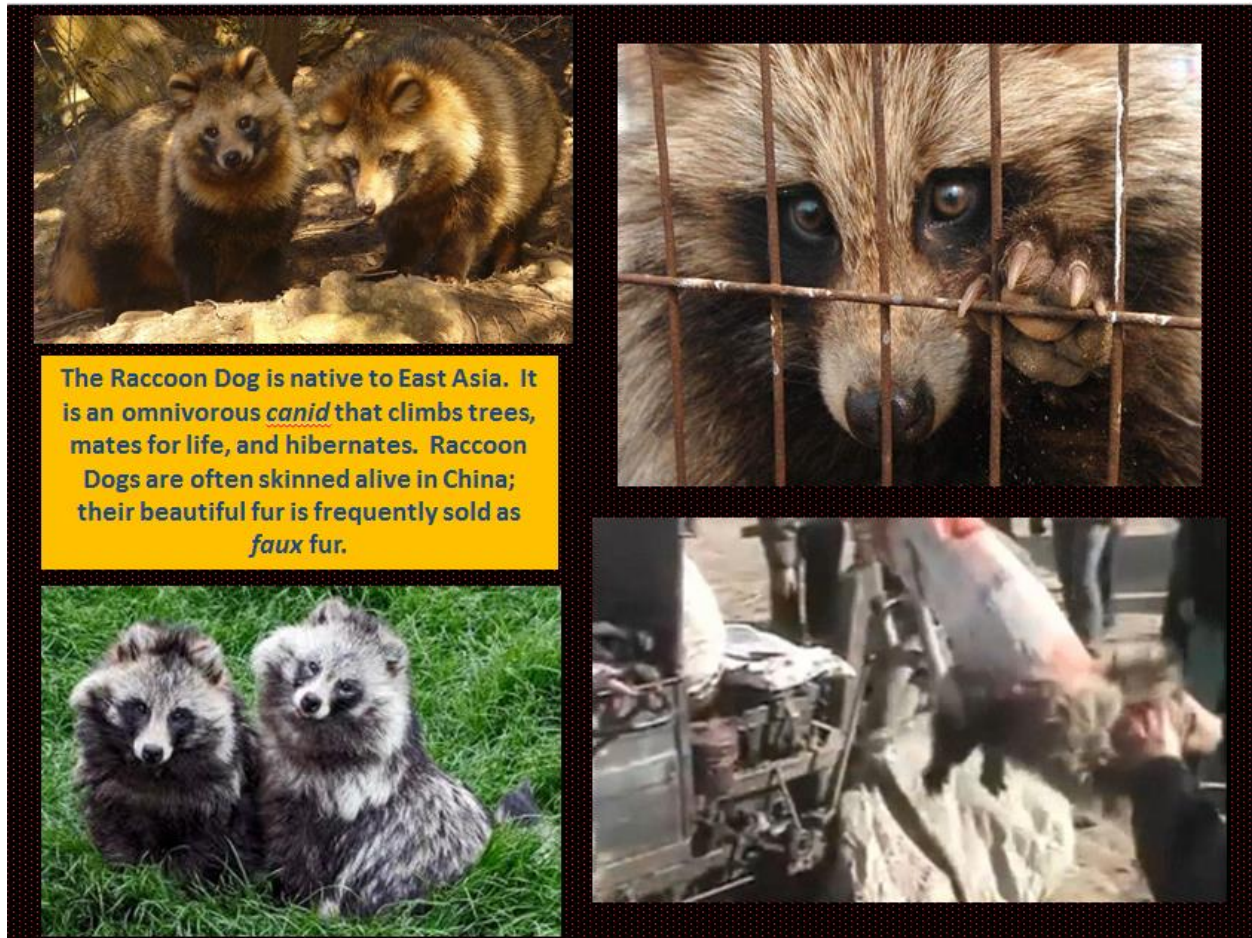


Figure 11: Message Tees

