



# Color War: The *Louboutin* Decision and Single-Color Marks in the Fashion Industry

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## INTRODUCTION

A pair of black high-heeled shoes from the mass-market retailer Nine West costs \$79.<sup>1</sup> The same style made under the label of Christian Louboutin starts at \$625.<sup>2</sup> The only visible difference is the bright red sole of the Louboutin shoes. Over the past two years, Christian Louboutin has fought to protect his valuable design from knockoffs by seeking to enforce his trademark on the red sole in court. Commentators are split on whether this distinctive feature of Louboutin shoes should be entitled to its own trademark protection.<sup>3</sup> As this question has made its way through the courts, judges have also been unable to agree on the answer: the Southern District of New York barred the trademark, only to be overturned on appeal by the Second Circuit.<sup>4</sup>

The substantial attention attracted by Louboutin's fight owes much to the considerable fame of the designer's shoes, popularized through celebrity

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<sup>1</sup> *Caress – round toe pump*, NINE WEST, <http://www.ninewest.com/Caress/6279317,default,pd.html?variantSizeClass=&variantColor=BLACKLE&cgid=8346252&prefn1=catalog-id&prefv1=ninewest-catalog&prefn2=variantColorValue&prefv2=Black> (last visited Mar. 13, 2013).

<sup>2</sup> *Christian Louboutin – Simple 100 Leather Pumps*, SAKS FIFTH AVENUE, [http://www.saksfifthavenue.com/main/ProductDetail.jsp?FOLDER%3C%3Efolder\\_id=2534374306418049&PRODUCT%3C%3Eprd\\_id=845524446158759&R=452541050967&P\\_name=Christian+Louboutin&N=4294912355+306418049+4294929607&bmUID=jIsQM7X](http://www.saksfifthavenue.com/main/ProductDetail.jsp?FOLDER%3C%3Efolder_id=2534374306418049&PRODUCT%3C%3Eprd_id=845524446158759&R=452541050967&P_name=Christian+Louboutin&N=4294912355+306418049+4294929607&bmUID=jIsQM7X) (last visited Mar. 13, 2013).

<sup>3</sup> See, e.g., Brandy G. Barrett, *Contrasting Levi v. Abercrombie with Louboutin v. Yves St. Laurent: Revealing Appropriate Trademark Boundaries in the Fashion World*, 13 N.C. J.L. & TECH. ON. 1 (2011); Nicollette Brandt, *Louboutin's Trademark Suit Against Yves Saint Laurent: Creating a Color War in the Fashion Industry*, 8 OKLA. J.L. & TECH. 58 (2012); Theodore C. Max, *Coloring Outside the Lines in the Name of Aesthetic Functionality: Qualitex, Louboutin, and How the Second Circuit Saved Color Marks for Fashion*, 102 TRADEMARK REP. 1081 (2012); Katie M. Morton, "Sole" Searching: *Christian Louboutin's Fight Against Yves Saint Laurent—and the Aesthetic Functionality Doctrine—to Own the Color Red*, 12 WAKE FOREST J. BUS. & INTELL. PROP. L. 293 (2012); Danielle E. Gorman, Note, *Protecting Single Color Trademarks in Fashion After Louboutin*, 30 CARDOZO ARTS & ENT. L.J. 369 (2012); Charlotte Cowles, *Don't Step on My Red-Soled Shoes!*, N.Y. MAG. (Aug. 14, 2011), <http://nymag.com/fashion/11/fall/christian-louboutin-red-soles/>; Jeannie Suk, *Little Red (Litigious) Shoes*, N.Y. TIMES (Jan. 1, 2012), <http://www.nytimes.com/2012/01/22/opinion/sunday/louboutin-and-the-little-red-litigious-shoes.html>.

<sup>4</sup> *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 451 (S.D.N.Y. 2011), *rev'd in relevant part sub nom.* *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012).

endorsements and even rap songs.<sup>5</sup> But it is also a sign of the increased interest in the law of fashion designs and of an ongoing debate over whether the industry merits more robust intellectual property protection.<sup>6</sup> As academics continue to discuss the best mechanisms to protect fashion—focusing mainly on the minutiae of proposed fashion copyright legislation—the case of the Louboutin red sole represents one designer’s attempt to use the current scant framework of intellectual property protection for fashion to his advantage. However, this Note argues that Louboutin’s claim also seeks to extend trademark law further into the realm of designs than it is intended and fit to go.

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Christian Louboutin first started imprinting his shoes with the famous red sole in 1993, in homage to the pop art of Andy Warhol.<sup>7</sup> In 2007, he filed for trademark protection for his colorful creation.<sup>8</sup> The United States Trademark Protection Office (USPTO) granted the trademark the next year, stating that “[t]he color(s) red is/are claimed as a feature of the mark. The mark consists of a lacquered red sole on footwear.”<sup>9</sup> A drawing of a shoe accompanied the mark to indicate that the trademark protected only the color’s placement on the outsole of the shoe.<sup>10</sup>

The trademark faced its first test in court in 2011, when Christian Louboutin sued fellow fashion designer Yves Saint Laurent for trademark infringement, alleging that a particular style of Yves Saint Laurent monochromatic red shoes was “virtually identical” to Louboutin’s famous red so-

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<sup>5</sup> See, e.g., Gary W. Glisson & Wendy S. Goffe, *Lady Gaga, Jennifer Lopez and Other Celebs Helped Louboutin Get Trademark for Red Soles*, FORBES (Sept. 13, 2012), <http://www.forbes.com/sites/deborahljacobs/2012/09/13/lady-gaga-jennifer-lopez-and-other-celebs-helped-louboutin-get-trademark-for-red-soles/>; JAY-Z, *I Know*, on AMERICAN GANGSTER (Roc-A-Fella Records 2007); JENNIFER LOPEZ, LOUBOUTINS (Epic Records 2009).

<sup>6</sup> Much has been written on this subject, as will be discussed more extensively in Parts II and III. One example of the increased academic attention to fashion law is Fordham Law School’s recent creation of a “Fashion Law Institute.” See Adam Tschorn, *Fordham University Launches Fashion Law Institute, a First for the Industry*, L.A. TIMES (Sept. 10, 2010), <http://latimesblogs.latimes.com/alltherage/2010/09/fordham-university-launches-fashion-law-institute.html>.

<sup>7</sup> See 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](http://www.newyorker.com/reporting/2011/03/28/110328fa_fact_collins).

<sup>8</sup> *Louboutin*, 696 F.3d at 213.

<sup>9</sup> *Id.*

<sup>10</sup> *Id.*

les.<sup>11</sup> The District Court for the Southern District of New York held that the red sole was ineligible for trademark protection and granted summary judgment to Yves Saint Laurent. Judge Marrero wrote in his opinion that “[t]here is something unique about the fashion world that militates against extending trademark protection to a single color.”<sup>12</sup> Concluding that a single-color trademark could harm competition in the fashion industry, Judge Marrero defined the mark as aesthetically functional and thus not eligible for trademark protection.<sup>13</sup> But on appeal to the Second Circuit, a three-judge panel rejected the district court’s industry-specific analysis for fashion and upheld the trademark on the red sole, although the court limited it to situations in which the sole’s color is in contrast to the rest of the shoe.<sup>14</sup>

The *Louboutin* case highlights the complexity of applying intellectual property laws to the world of fashion. The case arose in the midst of a debate among academics, legislators, and industry insiders about what type of intellectual property protection, if any, fashion should receive. Currently, fashion operates in a low intellectual property environment: aside from the protection of logos and patterns through trademark law, and of unique features through patent law, very few aspects of designs are protected from copiers.<sup>15</sup> This state of affairs is due in large part to the fact that clothing is considered a “useful article,” placing fashion outside of copyright protection.<sup>16</sup> In recent years, a heated debate has arisen over whether the existing framework should expand to include fashion within the domain of copyright law.<sup>17</sup> Such an expansion could have significant effects on the industry, particularly on brands that depend on their ability to copy trendy high-end designs to make them available to a broader market.<sup>18</sup> These discussions have led to congressional hearings and a series of bills proposing to modify the country’s current copyright legislation, Title 17 of the United States

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<sup>11</sup> Complaint at 15, *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445 (S.D.N.Y. 2011) (No. 11 Civ. 2381), 2011 WL 1327659; *see also* Cowles, *supra* note 3.

<sup>12</sup> *Louboutin*, 778 F. Supp. 2d at 451.

<sup>13</sup> *Id.* at 454.

<sup>14</sup> *Louboutin*, 696 F.3d at 212.

<sup>15</sup> *See infra* notes 126–157 and accompanying text.

<sup>16</sup> 17 U.S.C. § 101 (2006 & Supp. V 2011); *see also* C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1185 (2009).

<sup>17</sup> *See infra* note 150 and accompanying text.

<sup>18</sup> A brand like Forever 21, considered a “fast-fashion copyist,” serves as an example of a brand that might be most affected by such a statute. *See* Hemphill & Suk, *supra* note 16, at 1172.

Code, to grant copyright protection to fashion, yet so far no legislation has made it through Congress.<sup>19</sup>

As a result of these failures, designers currently have few legal options to protect their creations. Trademark law, because it grants wide protection to source-identifying logos and product features, provides one of the only available mechanisms for designers to shield themselves from copies and knockoffs. As a result, it is only natural that a high-end designer like Christian Louboutin would seek to use trademark law to protect his valuable shoe designs.

However, this use of trademark law in fashion creates significant risks for the industry. Unique features of the fashion industry—notably the complex interplay among creative art, copying, and competition—militate against allowing single-color trademarks on designs. In evaluating the Louboutin trademark, both the district and circuit courts relied on the doctrine of aesthetic functionality—which bars trademarks where the mark affects the purpose or cost of the article and where protecting the trademark might hinder competition—but each applied the test of functionality differently.<sup>20</sup> While both courts' analyses have their merits, this Note will argue that the district court's holding that the red sole is a functional mark appears better suited to protect creativity and competition among designers, especially given the essential role played by color in the fashion industry.

Trademark law is intended to protect source indicators.<sup>21</sup> Affording trademark protection to the Louboutin red sole extends this purpose beyond mere source indication and into the protection of designs that are part of the creative process. Trademark law is neither intended nor well suited to provide such broad intellectual property protection to fashion designs. In the case of the Louboutin red sole, Louboutin is attempting to use trademark rights as an imperfect bandage covering the inadequate framework of intel-

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<sup>19</sup> Katherine Boyle, *Fashion Industry Testifies in Favor of Design Copyright Protections (Again)*, WASH. POST (July 18, 2011), [http://www.washingtonpost.com/blogs/arts-post/post/fashion-industry-testifies-in-favor-of-design-copyright-protections-again/2011/07/18/gIQAd2MuLI\\_blog.html](http://www.washingtonpost.com/blogs/arts-post/post/fashion-industry-testifies-in-favor-of-design-copyright-protections-again/2011/07/18/gIQAd2MuLI_blog.html). The most recent iteration of the bill, the Innovative Design Protection Act of 2012, S. 3523, 112th Cong. (2012), was introduced in Congress in the fall of 2012, but failed to pass before the end of the year. See Staci Riordan, *Fashion Copyright Bill Dies in Congress*, FASHION LAW BLOG (Jan. 3 2013), <http://fashionlaw.foxrothschild.com/2013/01/articles/fashion-law/fashion-copyright-bill-dies-in-congress/>.

<sup>20</sup> Nancy Clare Morgan, *Aesthetic Appeal*, 34 L.A. LAW. Feb. 2012, at 34.

<sup>21</sup> See 15 U.S.C. § 1127 (2006) (defining trademarks as “any word, name, symbol, or device, or any combination thereof” used “to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown”).

lectual property for fashion. Yet, in this case, the cure may be worse than the disease. The rights that trademark law grants are extensive, providing a permanent monopoly to the holder. In an industry where commercial success depends on designers borrowing from each other and creating trends, often through the use of a certain color, these monopolies can significantly impact competition. Allowing single-color marks in fashion also interferes with the broader system of intellectual property protection by stretching trademark law into domains better suited for patent or copyright protection. As many scholars writing on fashion and intellectual property law have recognized, copyright law, specifically the Innovative Design Protection Act currently proposed in Congress, provides a more tailored solution to the lack of intellectual property protection in fashion.<sup>22</sup>

Part I of this Note will examine the doctrine of aesthetic functionality as the Supreme Court has defined it since the early 1980s. It will then look at the decisions of the District Court for the Southern District of New York and the Second Circuit in the *Louboutin* case and analyze how the two courts diverged in their application of the test for aesthetic functionality. Part II will consider the unique interplay among creative design, copying, and competition in the fashion industry. It will connect these distinctive characteristics of the fashion industry back to the doctrine of aesthetic functionality and argue that allowing single-color marks, like the Louboutin red sole, can significantly hinder competition. Finally, Part III will briefly discuss the weak legal framework—in trademark, copyright, and patent—that currently protects fashion designs. It will argue that the Second Circuit's extension of trademark law to fashion designs is ill-suited to protect the intellectual property rights of designers and that a narrowly tailored copyright bill would serve the purpose much more effectively.

## I. THE DOCTRINE OF AESTHETIC FUNCTIONALITY: TWO DIFFERENT INTERPRETATIONS

### A. *The Origins of Aesthetic Functionality*

The diverging decisions of the two courts in the *Louboutin* case stemmed from differing interpretations of aesthetic functionality, a doctrine of trademark law.<sup>23</sup> The Lanham Act codifies functionality as a defense: in a trademark infringement suit, a defendant may show that the contested mark

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<sup>22</sup> See *infra* notes 196–200 and accompanying text.

<sup>23</sup> For a detailed explanation of the meaning of aesthetic functionality and its judicial history, see Morgan, *supra* note 20.

is functional, and thus not eligible for trademark rights, to counter the claim of infringement.<sup>24</sup> A functional mark cannot be protected under the Lanham Act, even if it has acquired secondary meaning.<sup>25</sup> Traditionally, under the Restatement of Torts, functionality encompassed any mark that might affect the “purpose, action or performance, or the facility or economy of processing, handling or using” the article.<sup>26</sup> In the past thirty years, the doctrine of functionality has evolved and courts have expanded its applicability to include features that may not initially appear to be functional. For example, in *Pagliari v. Wallace China Co.*,<sup>27</sup> the Ninth Circuit found the design of hotel china to be an “essential selling feature,” and held that it should thus be protected as functional.<sup>28</sup> *Pagliari* exemplified an appellate court’s willingness to treat ostensibly aesthetic aspects of a product, such as its physical appearance, as functional in an industry where the appearance of a product plays a large part in the market to sell it.

In the context of the trademarking of colors, the Supreme Court has also suggested that functionality may bar the trademarking of aesthetically functional marks. Aesthetic functionality looks to a purely aesthetic aspect of a product—like its color—that might nonetheless have an effect on its utility or cost. The Supreme Court first defined the test for color-based aesthetic functionality in a footnote of a 1982 case, *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, which discussed the functionality of the color of medicine capsules.<sup>29</sup> “[A] product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,” Justice O’Connor wrote for the majority in *Inwood*.<sup>30</sup> This test echoed the original Restatement definition of functionality, focusing on the purpose of the article, even when the feature ostensibly relates only to the product’s appearance. The Court’s analysis of functionality in *Inwood*, however, did not extend beyond the footnote and thus gave no indication of how such a test might be applied in the future.

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<sup>24</sup> 15 U.S.C. § 1115(b)(8) (2002).

<sup>25</sup> *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 24 (2001).

<sup>26</sup> RESTATEMENT (FIRST) OF TORTS §742 (1938).

<sup>27</sup> 198 F.2d 339, 343–44 (9th Cir. 1952).

<sup>28</sup> *Id.* at 343.

<sup>29</sup> 456 U.S. 844, 851 n.10 (1982).

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

### B. *The Qualitex Decision*

The Supreme Court did not apply the test of functionality again until *Qualitex Co. v. Jacobson Products Co.*<sup>31</sup> In *Qualitex*, the Court grappled with the question of whether a manufacturer of dry-cleaning press pads could assert a trademark for a particular green-gold shade of pads. The Court found that no rule barred the trademarking of a color, emphasizing that “customers may come to treat a particular color on a product or its packaging . . . as signifying a brand.”<sup>32</sup> As a color may serve the same source-identifying role as any other trademark, it should be eligible for trademark protection.<sup>33</sup> Nonetheless, the Court also recognized that allowing trademarks on colors could give rise to the same risk as permitting trademarks on descriptive marks, mainly that of hindering competition.<sup>34</sup> To ensure that color trademarks would not affect market competition, the Court emphasized that, as is the case for descriptive marks, a color may only be trademarked if it has acquired secondary meaning.<sup>35</sup> Even if it has acquired secondary meaning, a color may still not be eligible for trademark protection if it is functional.<sup>36</sup> In the case of the press pads, however, the Court concluded that the color served no functional purpose, thus making the mark valid under the Lanham Act.<sup>37</sup>

In its analysis of functionality in *Qualitex*, the Court refined the test articulated in *Inwood* and provided a more detailed explanation of how it might apply to future cases. The Court expanded upon *Inwood*, finding a color functional “‘if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,’ that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.”<sup>38</sup> The Court highlighted the importance of promoting competition by not “allowing a producer to control a useful product feature.”<sup>39</sup> This emphasis on competition elucidated why the doctrine of functionality exists: while trademark law should protect aspects of a product that serve to identify its source, it should not apply in such a way that allows one company to

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<sup>31</sup> 514 U.S. 159, 165 (1995).

<sup>32</sup> *Id.* at 163.

<sup>33</sup> *Id.*

<sup>34</sup> *Id.* at 171.

<sup>35</sup> *Id.* at 163.

<sup>36</sup> *Qualitex*, 514 U.S. at 166.

<sup>37</sup> *Id.* at 174.

<sup>38</sup> *Id.* (quoting *Inwood Labs., Inc. v. Yves Labs. Inc.*, 456 U.S. at 851 n.10 (1982)).

<sup>39</sup> *Id.* at 164.



unjustly gain a monopoly, or even just a significant advantage, on the market for a product.

However, as the Court recognized, patent law does allow for such monopolies within carefully considered boundaries. “It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, after which competitors are free to use the innovation,” Justice Breyer wrote for the majority.<sup>40</sup> In contrast, allowing trademark law to protect such functional features would enable a manufacturer to acquire a monopoly on any feature—whether or not it would even be eligible for a patent—in perpetuity.<sup>41</sup> The Court thus recognized that to grant such vast intellectual property protection to a functional mark would extend trademark law far beyond its intended applicability.

### C. *The District Court’s Decision in Louboutin*

In evaluating Louboutin’s red sole trademark, the Southern District of New York did not inquire into the red sole’s secondary meaning.<sup>42</sup> Instead, it turned to Yves Saint Laurent’s defense that, regardless of its secondary meaning, the mark should not be protectable because it is aesthetically functional. The district court agreed with Yves Saint Laurent. Applying the doctrine of aesthetic functionality from *Qualitex* to the context of the fashion industry, the court found that the color of a shoe’s sole serves functional, non-trademark purposes and that it affects the cost of the shoe. The court thus concluded that it should not be protected under trademark law.

Evaluating the facts of the *Louboutin* case under the *Qualitex* test, the district court emphasized the non-trademark functions of the red sole that make it a functional mark. Judge Marrero described the painted red sole as “decorative, an object of beauty.”<sup>43</sup> This beauty, the court emphasized, serves not only to identify the source of the shoe, but also has its own independent ornamental function. “To attract, to reference, to stand out, to blend in, to beautify, to endow with sex appeal—all comprise nontrademark functions of color in fashion,” Judge Marrero wrote, describing the various appeals of the red sole.<sup>44</sup> Christian Louboutin himself, Judge Marrero noted, has acknowledged that he chose red for its “engaging” nature and to give

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<sup>40</sup> *Id.*

<sup>41</sup> *Id.* at 164–65.

<sup>42</sup> *Louboutin*, 778 F. Supp. 2d at 449.

<sup>43</sup> *Id.* at 454.

<sup>44</sup> *Id.*

the shoe “energy.”<sup>45</sup> To support the argument that the sole’s aesthetic appeals are non-trademark features, Judge Marrero quoted from *Qualitex*, which described that when a color serves “to satisfy the ‘noble instinct for giving the right touch of beauty to common and necessary things,’” color has a “significant nontrademark function.”<sup>46</sup> As the red sole has this effect, Judge Marrero found that the color red on the sole serves a “significant nontrademark function.”

By emphasizing the non-trademark functions of the red sole, the court sought to place the Louboutin trademark within the *Qualitex* framework of aesthetic functionality. The court held that because of the sole’s non-trademark functions, the mark should fall into the category of aesthetically functional features that are not eligible for protection. In reaching this conclusion, Judge Marrero equated “ornamental” with “functional,” at least in the context of the fashion industry. The court did not frame its functionality analysis in the language of *Qualitex*, which defined functional as “essential to the use or purpose of the article.”<sup>47</sup> Rather, Judge Marrero relied on a series of cases holding the aesthetic purpose of color, as applied for example to boat motors and farming equipment, to be a sufficiently functional feature.<sup>48</sup> Such cases, the court stated, “illustrate the principle that ‘[a]esthetic appeal can be functional; often we value products for their looks.’”<sup>49</sup> By employing these cases to support its finding of functionality within the *Qualitex* test, the court thus suggested that in certain contexts, including fashion, aesthetic appeal alone may be essential to the purpose of an article, in a way that renders the color functional.

To buttress its functionality argument, the court also discussed how the red sole affects the price of the shoe by making it more expensive to manufacture and consequently, costlier and more exclusive.<sup>50</sup> The court ac-

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<sup>45</sup> *Id.* at 453.

<sup>46</sup> *Id.* at 453–54 (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 170 (1995)) (internal citation omitted).

<sup>47</sup> *Qualitex*, 514 U.S. at 169 (citing *Inwood Labs., Inc. v. Yves Labs. Inc.*, 456 U.S. 844, 850 n.10 (1982)).

<sup>48</sup> *Louboutin*, 778 F. Supp. 2d at 453. The district court cited *Brunswick Co. v. British Seagull Ltd.*, where the color of outboard engines was found to be functional because it is “compatib[le] with a wide variety of boat colors and [can] make objects appear smaller,” 35 F.3d 1527, 1533 (Fed. Cir. 1994), and *Deere & Co. v. Farmhand, Inc.*, where the court considered the green color of tractor loaders to be functional because it matched other farm equipment, 560 F. Supp. 85, 98 (S.D. Iowa 1982), *aff’d*, 721 F.2d 253 (8th Cir. 1983).

<sup>49</sup> *Louboutin*, 778 F. Supp. 2d at 453 (quoting *Eco Mfg. LLC v. Honeywell Int’l Inc.*, 357 F.3d 649, 653 (7th Cir. 2003)) (emphasis in original).

<sup>50</sup> *Id.* at 454.

knowledge that these cost-related qualities of the sole may not have been what the Supreme Court intended as the relevance of cost in *Qualitex*.<sup>51</sup> Judge Marrero implicitly assumed that *Qualitex* intended to bar trademarks when use of a color might make a product cheaper and thus more competitive on the market, although *Qualitex* itself did not explicitly make such an argument.<sup>52</sup> Recognizing that production of shoes with a red sole would be more, not less, expensive, Judge Marrero nonetheless argued that “the higher cost of production is desirable because it makes the final creation that much more exclusive, and costly.”<sup>53</sup> Reading *Qualitex* literally, the court found that the red sole thus does “affect[ ] the cost and quality of the shoe,”<sup>54</sup> placing it within the category of aesthetically functional marks.

As these two analyses—of the red sole’s ornamental value and of its effect on cost—show, Judge Marrero rejected Louboutin’s trademark of the red sole by focusing primarily on the distinctive features of the fashion industry: “whatever commercial purposes may support extending trademark protection to a single color for industrial goods do not easily fit the unique characteristics and needs—the creativity, aesthetics, taste, and seasonal change—that define production of articles of fashion.”<sup>55</sup> Judge Marrero emphasized that in fashion, color serves not only as a source identifier, as can be the case for industrial objects, but also has its own aesthetic and expressive value.<sup>56</sup>

To support this point and to show how color affects competition in the context of a creative enterprise like fashion, Judge Marrero analogized fashion to art.<sup>57</sup> He suggested that allowing Louboutin to maintain its trademark would be akin to allowing Picasso to bring a suit against Monet for employing the same shade of indigo blue.<sup>58</sup> While Judge Marrero recognized that the two situations are imperfect parallels, he focused on their

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<sup>51</sup> *Id.* (“The red outsole also affects the cost of the shoe, although perhaps not in the way *Qualitex* envisioned”).

<sup>52</sup> Without referring specifically to cost, the Court in *Qualitex* stated that “[t]he functionality doctrine thus protects competitors against a disadvantage (unrelated to recognition or reputation) that trademark protection might otherwise impose, namely, their inability reasonably to replicate important non-reputation-related product features.” 514 U.S. at 169.

<sup>53</sup> *Louboutin*, 778 F. Supp. 2d. at 454.

<sup>54</sup> *Id.*

<sup>55</sup> *Id.* at 451.

<sup>56</sup> *Id.* (“[I]n fashion markets color serves not solely to identify sponsorship or source, but is used in designs primarily to advance expressive, ornamental and aesthetic purposes.”).

<sup>57</sup> *Id.* at 451–53.

<sup>58</sup> *Id.* at 451–52.

shared “creative stock”<sup>59</sup> and the close relationship between aesthetic and commercial value in both contexts. In fashion, as in painting, “artistic freedom” and “fair competition” are interrelated.<sup>60</sup> Restricting the available spectrum of colors “would unduly hinder not just commerce and competition, but art as well.”<sup>61</sup> This argument linking artistic value to competition went to the core of the *Qualitex* analysis, which sought to restrict trademarking that might hinder competition. The district court’s analysis, by demonstrating the importance of color to commercial value in the fashion industry, thus placed the red sole well within the purpose of *Qualitex*’s doctrine of aesthetic functionality.

Based on its analogy to art and its analysis of the red sole mark in the framework of functionality, the court held that “Louboutin is unlikely to be able to prove that its red outsole brand is entitled to trademark protection” because “in the fashion industry color serves ornamental and aesthetic functions vital to robust competition.”<sup>62</sup> With this conclusion, the court denied Louboutin’s claim for a preliminary injunction against Yves Saint Laurent.

#### D. *The Second Circuit’s Decision in Louboutin*

Like the district court, the Second Circuit relied on *Qualitex* in its analysis of Louboutin’s red sole trademark, but the court never applied *Qualitex*’s functionality test. Holding that no *per se* rule should bar the trademarkability of a color in fashion, the court held that Louboutin’s trademark on the red sole is permissible so long as the sole is in contrast with the rest of the shoe.<sup>63</sup>

The Second Circuit first rejected the district court’s dispositive argument that color usage in the fashion industry warrants a unique analysis. Judge Cabranes, writing for the unanimous three-judge panel,<sup>64</sup> interpreted *Qualitex* as explicitly forbidding such a *per se* rule on the trademarkability of color.<sup>65</sup> “Sometimes . . . a color will meet ordinary legal trademark requirements[, a]nd, when it does so, no special legal rule prevents color alone from serving as a trademark,” Judge Cabranes wrote, quoting from the *Qualitex*

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<sup>59</sup> *Louboutin*, 778 F. Supp. 2d. at 452.

<sup>60</sup> *Id.*

<sup>61</sup> *Id.* at 453.

<sup>62</sup> *Id.* at 449.

<sup>63</sup> *Louboutin*, 696 F.3d at 227–28.

<sup>64</sup> Judge Cabranes was joined by Judges Straub and Livingston.

<sup>65</sup> *Louboutin*, 696 F.3d at 223.

decision.<sup>66</sup> Instead, the court emphasized that the *Qualitex* test requires a case-by-case evaluation to determine whether a mark is functional.<sup>67</sup> In a detailed historical analysis, the Second Circuit opinion traced the evolution of trademarks on single colors from circuit decisions allowing such trademarks<sup>68</sup> to the decision in *Qualitex*.<sup>69</sup>

The court then offered a three-pronged framework for applying the *Qualitex* analysis: ask first, whether the color is “essential to the use or purpose” of the article; second, whether the color affects the cost and quality of the article; and third, whether a trademark on the color would have a significant effect on competition.<sup>70</sup> But the court never reached the application of that test to the red sole mark. Rather, it analyzed the distinctiveness of the mark and concluded that it had attained sufficient secondary meaning to warrant trademark protection, although only in the limited situations where the sole contrasts with the rest of the shoe.<sup>71</sup> The court thus held that the Yves Saint Laurent monochromatic shoe did not infringe on the Louboutin trademark, and, as this conclusion precluded Louboutin’s claim against Yves Saint Laurent, it also rendered unnecessary any analysis of the functionality defense that Yves Saint Laurent might raise.<sup>72</sup>

Although the Second Circuit did not resolve the issue of functionality, it nonetheless suggested that it would not find the mark functional. The court described the mark as “a distinctive symbol that qualifies for trademark protection.”<sup>73</sup> Furthermore, in discussing the district court’s opinion, Judge Cabranes recognized that while allowing the trademark on the red sole may not give a competing designer “the greatest range for [his] creative outlet,” it would still allow the designer to “fairly compete within a given

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<sup>66</sup> *Id.* (quoting *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 161 (1995)) (internal quotation marks omitted).

<sup>67</sup> *Louboutin*, 696 F.3d at 222.

<sup>68</sup> Among others, the Second Circuit cited *In re Owens–Corning Fiberglas Corp.*, 774 F.2d 1116, 1118–19 (Fed. Cir. 1985), which allowed a trademark on pink fiberglass, and *Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.*, 147 F.2d 407, 415 (6th Cir. 1945), which permitted a trademark on yellow taxi cabs. *Louboutin*, 696 F.3d at 217.

<sup>69</sup> *Louboutin*, 696 F.3d at 222.

<sup>70</sup> *Id.* at 219–20.

<sup>71</sup> *Id.* at 225.

<sup>72</sup> *Id.* at 228. This conclusion leaves open the possibility that the red sole might still be found functional if a designer were to assert a functionality defense in another trademark infringement suit brought by Louboutin. Nonetheless, the court’s validation of the red sole trademark in this case suggests that it would not necessarily accept such an argument.

<sup>73</sup> *Id.* at 227.

market.”<sup>74</sup> In reaching this conclusion, albeit merely in dicta, the court seemed to eschew the rigorous functionality analysis that the district court considered required under the *Qualitex* test.

## II. CREATIVITY, COMPETITION, AND THE RED SOLE MARK

### A. Creative Freedom and Competition in Fashion

The interplay among creative freedom, copying, and competition in fashion is complex. To be successful on the commercial market, a designer must both establish himself as creative enough to distinguish his products from those of his competitors, and still embrace a certain level of copying to fit into the season’s trends.<sup>75</sup> Several scholars have sought to explain this tension between creative freedom and copying. One article, for example, characterized fashion as a lottery where cooperation through some level of imitation provides collective insurance against complete failure for each season by ensuring a certain level of similarity in designs.<sup>76</sup> In an important article on the subject, Professors Kal Raustiala and Christopher Sprigman argued that fashion depends on a paradoxical reliance on copying: to sell new designs, designers need old designs to fall out of fashion.<sup>77</sup> Copying, they argued, helps to ensure this turnover by transmitting trends to the majority of buyers who cannot afford to buy from “top” designers.<sup>78</sup> In this regard, copying plays an essential role in fashion as it ensures the continued existence of a market for new designs. This explanation is also supported by sociological analyses of the fashion industry, which describe fashion as a grouping mechanism in a stratified society—allowing members of different groups to associate themselves with each other through their clothing.<sup>79</sup>

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<sup>74</sup> *Id.* at 223.

<sup>75</sup> See Hemphill & Suk, *supra* note 16, at 1161 (“Fashion reflects the desire for the new, for movement with the collectivity, for contact with the spirit of the times.”).

<sup>76</sup> Jonathan M. Barnett et al., *The Fashion Lottery: Cooperative Innovation in Stochastic Markets*, 39 J. LEGAL STUD. 159 (2010).

<sup>77</sup> Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687 (2006); see also George B. Sproles, *Analyzing Fashion Life Cycles: Principles and Perspectives*, 45 J. MARKETING 116, 116 (1981).

<sup>78</sup> See Raustiala & Sprigman, *supra* note 77, at 1718–22.

<sup>79</sup> Georg Simmel, *Fashion*, 10 INT’L Q. 130 (1904). For more sociological and economic explanations of the fashion industry, see Sushil Bikhchandani et al., *A Theory of Fads, Fashion, Custom, and Cultural Change as Informational Cascades*, 100 J. POL. ECON. 992 (1992); Philip R.P. Coelho & James E. McClure, *Toward an Economic*

These interpretations all suggest that some level of copying is not only tied into the creative work of the designers, but may also be beneficial to the industry as a whole and thus relevant to any attempt to protect intellectual property in fashion.

### B. *The Red Sole and Aesthetic Functionality*

The case of the “red sole” provides a powerful lens through which to consider the place of intellectual property protection in an industry so driven by aesthetics. Color plays a unique role in fashion, unlike other industries for which courts have previously evaluated the aesthetic functionality of colors.<sup>80</sup> The success of a fashion item often depends on its aesthetic appeal, in which color plays a large part. While the Second Circuit’s decision in the *Louboutin* case criticized the district court for adopting an industry-specific rule, the language of *Qualitex* does not preclude such an approach. The Second Circuit relied on part of the holding in *Qualitex*, which stated that “no special legal rule prevents color alone from serving as a trademark.”<sup>81</sup> However, this language does not foreclose the possibility of an industry-specific analysis of functionality.<sup>82</sup> It merely states that color is not *per se* functional. And indeed, as the district court’s analysis demonstrated, applying the test of aesthetic functionality both to the particular case of the red sole and to the fashion industry as a whole yields the conclusion that the trademark should be barred as aesthetically functional.

The district court discussed in detail the ornamental function of the red sole, recognizing the unique role that color plays in fashion designs. Several law professors who wrote an *amicus* brief for the appeal before the Second Circuit also emphasized the manner in which color becomes functional in fashion designs. The *amici* suggested that in evaluating the red sole under the doctrine of aesthetic functionality, the court should focus on whether there is an aesthetic value to the color beyond its role as a source identifier.<sup>83</sup> “[R]ed is an appealing color for shoes, and at least in some

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*Theory of Fashion*, 31 ECON. INQUIRY 595 (1993); Harvey Leibenstein, *Bandwagon, Snob, and Veblen Effects in the Theory of Consumers’ Demand*, 64 Q.J. ECON. 183 (1950).

<sup>80</sup> See, e.g., *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062 (9th Cir. 2006) (automobile logos); *Villeroy & Boch Keramische Werke K.G. v. THC Sys., Inc.*, 999 F.2d 619 (2d Cir. 1993) (hotel china).

<sup>81</sup> *Louboutin*, 696 F.3d at 223 (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 161 (1995)).

<sup>82</sup> See Brief of Amicus Curiae Law Professors in Support of Defendants-Counter-Claimants-Appellees and Urging Affirmance, *Louboutin*, 696 F.3d 206 (2012) (No. 11-3303), 2012 WL 59424, at \*10 [hereinafter *Professors Amicus*].

<sup>83</sup> *Id.*

circumstances can increase the appeal of the overall shoe when applied to the sole of the shoe,” the *amici* wrote.<sup>84</sup> The fact that Yves Saint Laurent made red shoes long before Louboutin started painting his soles red provides further support for this contention.<sup>85</sup> Indeed, Yves Saint Laurent, a high-end luxury brand that long predates Christian Louboutin, undoubtedly chose the color red for its aesthetic appeal, not to cause customers confusion over the source of the product. The aesthetic value of red soles, which multiple designers have recognized, should thus bar Louboutin’s trademark.

Looking beyond the red sole, color should generally be considered functional in the context of the fashion industry. While the district court did not explicitly state that color could never be trademarked in fashion, Judge Marrero was correct in his reluctance to allow fashion designers to trademark single colors.<sup>86</sup> Color is in fact one of the most important tools available to designers in creating clothing.<sup>87</sup> In a world that revolves around matching outfits, seasonal trends, and aesthetic appeal, color may often be the centerpiece of any design. Fashion designs are defined by their cut, color, and fabric. By allowing designers to gain a monopoly on one of these three elements, the Second Circuit has severely limited the design possibilities for other designers. Judge Marrero’s analogy to painting may have been imperfect,<sup>88</sup> but it highlighted the essential function of color for the designer. Color is one of the primary expressive tools for designers, as it is for painters. And in the fashion business, like in the art world, the commercial value of a design often depends on its aesthetic appeal, which in turn depends on its color. Given this special role of color in designs, single-color trademarks in the fashion industry should be subject to a more stringent functionality analysis than color marks in other industries.

### C. *Aesthetic Functionality and Competition in the Fashion Industry*

Allowing trademarks like the red sole on fashion designs can result in the type of trademark monopoly against which the doctrine of functionality is designed to protect. Aesthetic functionality exists precisely to ensure that

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<sup>84</sup> *Id.*

<sup>85</sup> *Id.*

<sup>86</sup> *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 451 (S.D.N.Y. 2011) (“[T]here is something unique about the fashion world that militates against extending trademark protection to a single color.”).

<sup>87</sup> See, e.g., PANTONE FASHION COLOR REPORT SPRING 2012, <http://www.pantone.com/pages/fcr.aspx?pg=20910&ca=4> (last visited Feb. 13, 2013).

<sup>88</sup> Comparing fashion to art in the context of intellectual property protection is slightly deceptive because art pieces receive much broader protection through copyright because they are not “useful articles.” See *infra* notes 150–156.



manufacturers do not gain unfair market advantages by trademarking features of an article that affect the ability of others to compete fairly.<sup>89</sup> The decision of the Second Circuit, by permitting the trademark to remain, has restricted the color palette available to designers and has put at risk an important aspect of creative freedom for designers. This decision could thus have significant effects on competition in the fashion industry. Although Louboutin has undoubtedly invested significant time and money into ensuring that his red sole would acquire secondary meaning,<sup>90</sup> there is now no obstacle to other designers attempting to gain similar monopolies on single colors in fashion. Should the Second Circuit's decision stand, different designers could soon come to monopolize every color of the rainbow—with effective marketing, a designer could acquire secondary meaning on not just the soles of shoes, but also on the green interior of a bag, or even on a blue shirt.<sup>91</sup> Designers could thus convert public recognition and strong market shares into secondary meaning for the color palettes they use and subsequently into trademark rights. Taken to the extreme, trademarks on single colors would, over time, effectively render it impossible to enter certain segments of the fashion market as every color could come to be trademarked in some way or another. Colors are not infinite. Indeed, permitting trademarks on single colors might rapidly narrow the spectrum of usable colors.

Furthermore, implicit in the statement that a color can contribute to the aesthetic appeal and value of a design is the recognition that copying a color may also be beneficial in the creation of a trend. Color is thus functional to designers not only because it is an important tool in their creative palette, but also because using a certain color may be essential to a designers' ability to partake in a season's trend and survive in the competitive market. Allowing trademarks on single colors in fashion could limit the available options to new designers and jeopardize their ability to enter into the market for fashion and participate in seasonal trends, often defined by color.<sup>92</sup>

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<sup>89</sup> See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995) (quoting *Inwood Labs. Inc. v. Yves Labs. Inc.*, 456 U.S. 844, 851 n.10 (1982)) (defining a functional feature as one where “exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage”).

<sup>90</sup> See Collins, *supra* note 7.

<sup>91</sup> The law professors, as *amici*, discussed that this phenomenon already occurs in the context of shoes. They cite several such trademarks: “Supplemental Registration No. 3,659,582 (green inner heel for women's high-heel shoes); Serial No. 85/335,704 (green outsoles on high-heel women's shoes); Serial No. 85/288,621 (blue outsoles on high-heel women's shoes); Serial No. 85/149,118 (pink heel tips on women's shoes).” *Professors Amicus*, *supra* note 82, at \*15 n.8.

<sup>92</sup> See, e.g., PANTONE FASHION COLOR REPORT SPRING 2012, *supra* note 87 (describing the season's trends in terms of the *colors* that designers are using).

For example, if red were to become the “color of the season,” with runways showcasing red bags, red jackets, red skirts, and just about every other item in red, preventing a designer from using red on shoes, even if only on the sole, would significantly affect his creative options for that season.

This gradual monopolization of colors is exactly the hindrance on competition that the doctrine of aesthetic functionality seeks to avoid. As discussed in Part I, cases like *Inwood* and *Qualitex* established the test for functionality and also articulated its purpose: to preserve healthy competition in the market. Specifically, *Qualitex* held a mark functional if “exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.”<sup>93</sup> To further explain the meaning of unfair competition, the decision quoted from the Restatement (Third) of Unfair Competition, stating that, “if a design’s ‘aesthetic value’ lies in its ability to ‘confe[r] a significant benefit that cannot practically be duplicated by the use of alternative designs,’ then the design is ‘functional.’”<sup>94</sup> This definition of aesthetic value applies to the red sole and to other single-color marks in fashion. The trademark on the red sole puts other designers at a disadvantage because it enables Louboutin to monopolize, even if in one specific use, one color of the limited spectrum available to designers, precluding them from duplicating the aesthetic appeal and dramatic effect best achieved by the red sole. As Judge Marrero acknowledged, color and competition are intertwined in the world of fashion.<sup>95</sup> He said:

Placing off limit signs on any given chromatic band by allowing one artist or designer to appropriate an entire shade and hang an ambiguous threatening cloud over a swath of other neighboring hues, thus delimiting zones where other imaginations may not veer or wander, would unduly hinder not just commerce and competition, but art as well.<sup>96</sup>

Colors in fashion cannot be separated from the commercial competition between designers. Single-color trademarks in fashion are thus precisely the type of useful features affecting competition that fall within the doctrine of aesthetic functionality. To protect the creative process and the competitive market in fashion, single-color trademarks should not be allowed.

Precedent, both in the Second Circuit and in other circuits, also suggests that aesthetic functionality should bar trademarks on aesthetic features

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<sup>93</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995).

<sup>94</sup> *Id.* at 170 (quoting the RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17).

<sup>95</sup> See *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 452–53 (S.D.N.Y. 2011).

<sup>96</sup> *Id.* at 453.

in situations where consumers are choosing products for their aesthetic appeal.<sup>97</sup> For example, in *Wallace International Silversmiths, Inc. v. Godinger Silver Art Co.*,<sup>98</sup> the Second Circuit found a particular design of silverware to be functional because “effective competition in that market” requires the availability of “essentially the same” design.<sup>99</sup> As such, the court recognized that aesthetic functionality might apply to “purely ornamental features” that are “essential to effective competition.”<sup>100</sup> While the Second Circuit quoted *Wallace* in the *Louboutin* decision, it did so only to demonstrate the fact-specific inquiry required.<sup>101</sup> However, the reasoning in *Wallace* may be applied more broadly to the fashion industry, where competition depends almost entirely on aesthetic appeal.<sup>102</sup> Other circuits have similarly recognized the value of aesthetic functionality to protect competition in industries driven by aesthetics.<sup>103</sup>

Even in industries where aesthetic appeal does not play as central a role, courts have recognized the functionality of aesthetic features, and in particular, of color. The district court cited several such decisions in its *Louboutin* opinion.<sup>104</sup> For example, in *Brunswick Co. v. British Seagull Ltd.*,<sup>105</sup> the Federal Circuit upheld the Trademark Trial and Appeal Board’s decision not to grant a trademark on the color black for outboard boat motors in part because the color “easily coordinate[s] with the wide variety of boat col-

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<sup>97</sup> See *Professors Amicus*, *supra* note 82, at \*3.

<sup>98</sup> 916 F.2d 76 (2d Cir. 1990).

<sup>99</sup> *Id.* at 80.

<sup>100</sup> *Id.* at 80–81.

<sup>101</sup> *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 222 (2d Cir. 2012).

<sup>102</sup> The Second Circuit emphasized that *Wallace* cautions against a *per se* rule on aesthetic functionality of colors. *Id.* However, the language of *Wallace* does not require that each mark be evaluated on a case-by-case basis. While the court did take notice of the extensive record from the lower court on the functionality of the feature, the principles it emphasized, mainly the promotion of “effective competition” can be used to find that aesthetic functionality broadly bars single-color marks in the fashion industry. See 916 F.2d at 80.

<sup>103</sup> *Amici* cite to another relevant case, *Rogers v. Keene*, 778 F.2d 334, 343 (7th Cir. 1985). They quote from it “Beauty is function. . . . A feature can be functional not only because it helps the product achieve the objective for which the product would be valued by a person indifferent to matters of taste, charm, elegance, and beauty, but also because it makes the product more pleasing to people not indifferent to such things.” *Professors Amicus*, *supra* note 82, at \*3–\*4. Notably, *Keene* was cited approvingly by the Supreme Court in *Qualitex*. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 170 (1995).

<sup>104</sup> *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445, 453 (S.D.N.Y. 2011).

<sup>105</sup> 35 F.3d 1527 (Fed. Cir. 1994).

ors.”<sup>106</sup> Similarly, in *Deere & Co. v. Farmhand, Inc.*,<sup>107</sup> the Southern District of Iowa, later affirmed by the Eighth Circuit, denied John Deere’s effort to enforce a trademark on the company’s shade of green for loaders, because the court found that “farmers prefer to match their loaders to their tractor.”<sup>108</sup> Indeed, *Qualitex* even cited both these decisions approvingly as correct applications of the doctrine of aesthetic functionality.<sup>109</sup> Beyond color trademarks, courts have recognized that aesthetic features may be found functional when aesthetic appeal, or even basic matching between different objects, is an important element of market competition.<sup>110</sup> Such is undoubtedly the case in the fashion industry.<sup>111</sup> Indeed, fashion revolves around matching and the interplay of colors. Aesthetics, and particularly colors, are often primary features of the design. The willingness of courts to find aesthetic features functional in industries where aesthetics are only secondary indicates that courts should also recognize single-color marks as aesthetically functional in fashion, an industry that is defined by aesthetics.

#### D. *Beyond Louboutin Red: Other Single-Color Marks in the Fashion Industry*

The *Louboutin* case launched a broader discussion in the fashion industry about the protection of single-color marks in fashion. Specifically, the jewelry company Tiffany & Co. expressed concern in the aftermath of the district court decision that the ruling might affect the brand’s famous robin-egg blue and gave public support to Louboutin’s effort to protect his red sole.<sup>112</sup> Fashion commentators suggested that the *Louboutin* district court decision could go so far as to jeopardize Hermès orange, famously used on its packaging and fashion items, and Valentino red, used frequently in Valen-

<sup>106</sup> *Id.* at 1532.

<sup>107</sup> 560 F. Supp. 85 (S.D. Iowa 1982), *aff’d*, 721 F.2d 253 (8th Cir. 1983).

<sup>108</sup> *Id.* at 98.

<sup>109</sup> 514 U.S. at 169.

<sup>110</sup> *See, e.g., Keene Corp. v. Paraflex Indus., Inc.*, 653 F.2d 822, 826 (3d Cir. 1981).

<sup>111</sup> *See Professors Amicus, supra* note 82, at \*11 (“What is true for outboard motors is even more so for fashion goods. The number of people who want a red (or pink or purple or orange) shoe *because of the color* is so substantial that it is logical to find, as the District Court here did, that the color serves an important non-source identification role as part of the appeal of the fashion product itself.” (emphasis in original)).

<sup>112</sup> *See* Brief of Amicus Curiae Tiffany (NJ) LLC and Tiffany and Company in Support of Appellants’ Appeal Seeking Reversal of the District Court’s Decision Denying Appellant’ Motion for Preliminary Injunction, *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206 (2d Cir. 2012), (No. 11-3303), 2011 WL 5126167 [hereinafter *Tiffany Amicus*]. Tiffany has only registered robin-egg blue to protect its packaging.

tino designs.<sup>113</sup> Under the doctrine of aesthetic functionality, however, it may indeed be the right outcome to prevent these companies from monopolizing certain single colors on fashion items. Recognizing broad trademark rights on colors that have come to be associated with certain designers would reach far beyond the confines of the Second Circuit's *Louboutin* decision. It would expand the protection of single-color marks to any fashion item, not just its isolated use on the sole of a shoe. Enabling such color monopolization could significantly hinder competition, as fashion designers would each gradually gain ownership over a particular color, rapidly eliminating design options for new designers. The goal of aesthetic functionality is specifically to protect against such unfair advantages. Thus, the Second Circuit's *Louboutin* decision marks the beginning of a slippery slope, where colors famously associated with brands might become trademarkable as having acquired secondary meaning.

Tiffany & Co. wrote an *amicus* brief in support of *Louboutin* for its appeal to the Second Circuit.<sup>114</sup> The brief urged the court to reject the district court's *per se* rule against single-color trademarks for "fashion items,"<sup>115</sup> emphasizing the fame and value of robin-egg blue, which has come to be known as "Tiffany blue."<sup>116</sup> In its brief, Tiffany mentioned the recent expansion of its use of robin-egg blue, currently registered only for packaging,<sup>117</sup> into jewelry and fashion items, including "gloves, scarves and handbags."<sup>118</sup> While Tiffany did not directly encourage the protection of these uses, its brief generally advocated for the protection of single-color trademarks on fashion items, suggesting that the company would pursue broad rights for its use of robin-egg blue in fashion.<sup>119</sup>

Such broad rights, however, could interfere with the creative freedom of designers and with competition in fashion. In the past few years, robin-egg blue has appeared repeatedly on other designers' fashion items, including jewelry, scarves, and handbags, and has been prominently displayed on

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<sup>113</sup> Emily Cronin, *Louboutin and YSL Continue Colour Wars*, ELLE UK (Aug. 19, 2011), <http://www.elleuk.com/fashion/news/louboutin-and-ysl-continue-colour-wars#image=1>. These companies, however, did not intervene in the *Louboutin* case.

<sup>114</sup> *Tiffany Amicus*, *supra* note 112.

<sup>115</sup> *Id.* at \*7–\*13.

<sup>116</sup> *Id.* at \*2.

<sup>117</sup> *Id.* at \*3. Tiffany currently has four registrations with the USPTO: Reg. No. 2,184,128 on blue boxes with a white ribbon, Reg. No. 2,359,351 on boxes, Reg. No. 2,416,795 on shopping bags, Reg. No. 2,416,794 on the cover of catalogs. *Id.*

<sup>118</sup> *Id.* at \*2.

<sup>119</sup> *Id.* at \*7–\*13.

runways.<sup>120</sup> If Tiffany's theory is accepted, such uses of robin-egg blue could soon constitute trademark infringement, thereby completely eliminating the availability of that color to other designers, with colors like Hermès orange and Valentino red likely to follow. Tiffany's *amicus* for the *Louboutin* case thus vividly showcases the risks of allowing Louboutin's red sole mark to stand. It demonstrates one designer's attempt, even before the Second Circuit's decision had been made, to apply it more broadly. Such an expansion of trademark law would render practically meaningless the doctrine of aesthetic functionality in the context of the fashion industry.

Different, more robust, protections apply to Tiffany's robin-egg blue packaging, and other single-color trademarked packaging.<sup>121</sup> Packaging should, and traditionally has been, treated differently from the design of the articles themselves. The Supreme Court has repeatedly protected product packaging as a type of trade-dress.<sup>122</sup> As such, banning single-color trademarks for fashion items would not impact Tiffany's current registrations on its packaging boxes.<sup>123</sup> This different treatment makes sense in the context of fashion, because packaging is less of a creative exercise than fashion design. Instead, it is an effort to convey through the container the source of the product to increase public recognition of the product itself.<sup>124</sup> Because packaging serves a primarily sourcing role and is not part of the same creative enterprise as fashion design, it should not be barred as aesthetically functional.<sup>125</sup>

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<sup>120</sup> *Amici* compiled a list of uses of robin-egg blue, finding "handbags, shoes, boots, scarves, gloves, dresses, scrubs, necklaces, earrings, rings, pins" available in Tiffany's shade or shades closely resembling it. *Professors Amicus*, *supra* note 82, at \*19 n.10–20.

<sup>121</sup> For example, Hermès has also trademarked its orange packaging. HERMÈS ORANGE, Registration No. 4,000,067.

<sup>122</sup> See, e.g., *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28 (2001); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 206 (2000). See also *infra* notes 139–145.

<sup>123</sup> See *Tiffany Amicus*, *supra* note 112, at \*3 (describing Tiffany's current registrations).

<sup>124</sup> See I. Chaneta, *Marketing: Packaging and Branding*, 8 J. COMPREHENSIVE RES. 19 (2010), available at <http://jupapadoc.startlogic.com/compresearch/papers/JCR10-3.pdf>.

<sup>125</sup> In the context of promoting fair competition, it is also possible to distinguish packaging from fashion designs, as the trademarking of packaging has a less significant impact on the ability of designers to enter the market and showcase their creativity.

### III. THE RED SOLE AND INTELLECTUAL PROPERTY PROTECTION FOR FASHION

The dispute over trademark rights for the red sole is just one part of a broader discussion about the place of fashion in the American framework of intellectual property protection. Academics and attorneys in the industry have long lamented the fact that fashion has historically received very low intellectual property protection<sup>126</sup>; the utility of clothing items and other fashion products generally bars them from receiving copyright protection<sup>127</sup> and patent law protects only that which is truly “new.”<sup>128</sup> While fashion companies have employed trademark law to protect their brand value, its applicability to fashion is generally limited to marks or trade-dress indicative of sourcing. This section will first discuss the current intellectual property framework for fashion. Second, it will discuss the theoretical defects inherent in extending trademark protection to designs like the red sole. Finally, it will argue that this use of trademark law interferes with patent law and that a copyright bill would provide a better framework to protect fashion designs.

#### A. *The Current Framework of Intellectual Property Protection for Fashion*

##### 1. Trademark

The most extensive intellectual property protection in fashion already comes through trademark law.<sup>129</sup> Designers use trademarks to protect their brands by registering their logos, catch-phrases, and even sometimes their designs, when they play a source-identifying role.<sup>130</sup> For example, Chanel, a famous fashion brand, currently has over 200 trademark registrations that protect symbols ranging from the brand’s ‘CC’ monogram logo to the names

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<sup>126</sup> See, e.g., Aya Eguchi, *Curtailling Copycat Couture: The Merits of the Innovative Design Protection and Piracy Prevention Act and A Licensing Scheme for the Fashion Industry*, 97 CORNELL L. REV. 131, 143 (2011); Julie P. Tsai, *Fashioning Protection: A Note on the Protection of Fashion Designs in the United States*, 9 LEWIS & CLARK L. REV. 447, 448 (2005).

<sup>127</sup> See *infra* notes 150–156 and accompanying text.

<sup>128</sup> See *infra* notes 146–149 and accompanying text.

<sup>129</sup> Susan Scafidi, *Intellectual Property and Fashion Design*, in 1 INTELLECTUAL PROPERTY AND INFORMATION WEALTH: COPYRIGHT AND RELATED RIGHTS 115, 121 (Peter K. Yu ed., 2006).

<sup>130</sup> See, e.g., *Professors Amicus*, *supra* note 82, at \*15 n.8 (discussing existing trademark registrations in fashion).

of perfumes and bag collections.<sup>131</sup> Occasionally, trademark rights have also been used to protect patterns, notably including the Burberry plaid.<sup>132</sup> Trademark law thus affords designers extensive protection for the branding of their products, be it through logos, distinctive names, or any other markers of source. Recognizing that trademark law can provide them with the strongest claims to intellectual property protection by granting them a virtually permanent monopoly,<sup>133</sup> designers have increasingly sought to cover their clothes with designs that incorporate their registered source-defining marks so that the designs themselves may be protected.<sup>134</sup>

However, some courts have sought to curb this expansion of trademark law into design. For example, in *Louis Vuitton Malletier v. Dooney & Burke, Inc.*,<sup>135</sup> the Second Circuit denied Louis Vuitton's claim that Dooney & Burke violated Louis Vuitton's trademark when it created a line of bags with designs that featured multicolor, repeating 'DB' monograms, similar to Louis Vuitton's designs incorporating its own 'LV' monogram.<sup>136</sup> More recently, however, a Southern District of New York judge held that the clothing company Guess' use of a repeating 'GG' pattern caused a sufficient

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<sup>131</sup> The full extent of Chanel, Inc.'s trademark protections can be found using a "TESS" search for live trademarks owned by the company. See *Trademark Electronic Search System (TESS)*, U.S. PATENT & TRADEMARK OFFICE, [http://tess2.uspto.gov/bin/gate.exe?f=login&p\\_lang=english&p\\_d=trmk](http://tess2.uspto.gov/bin/gate.exe?f=login&p_lang=english&p_d=trmk).

<sup>132</sup> BURBERRY CHECK, Registration No. 1,241,222. Burberry has had a registration on its plaid pattern, the "Burberry Check," since 1996. See *United States v. Chong Lam*, 677 F.3d 190, 195 (4th Cir. 2012).

<sup>133</sup> Once registered, the mark's term is limited to a term of years (terms differ among states and federal registrations), but the registrant may keep renewing the registration. 15 U.S.C. § 1059 (2006). In addition, common law rights may grant broader protection.

<sup>134</sup> See Raustiala & Sprigman, *supra* note 77, at 1701 ("Increasingly, clothing and accessory designs incorporate a trademarked logo on the outside of the garment."); see also Scafidi, *supra* note 129, at 121.

<sup>135</sup> 454 F.3d 108 (2006).

<sup>136</sup> *Id.* Some academics interpreted the *Louis Vuitton* decision as an attempt to limit trademark protection in the fashion industry. See, e.g., Ashley E. Hofmeister, *Louis Vuitton Malletier v. Dooney & Bourke, Inc.: Resisting Expansion of Trademark Protection in the Fashion Industry*, 3 J. BUS. & TECH. L. 187, 200 (2008) (describing the court's "true holding" as "an implicit refusal to expand trademark protection in the American fashion industry"); Raustiala & Sprigman, *supra* note 77, at 1701 n.32 (recognizing the limits on the protection of the Louis Vuitton logo). For another decision recognizing the limits of trademark protection, see *People v. Rosenthal*, No. 2002NY075570, 2003 WL 23962174 (N.Y. Crim. Ct., Mar. 4, 2003), which noted that "while it is perfectly legal to sell merchandise that copies the design and style of a product often referred to as 'knockoffs,' it is against the law to sell goods that bear a counterfeit trademark."



likelihood of confusion, such that Guess had infringed Gucci's 'GG' trademark.<sup>137</sup> Nonetheless, in her decision, Judge Scheindlin noted that, "courts have uniformly applied this provision [of trademark law] to products that are stitch-for-stitch copies of those of another brand."<sup>138</sup> This statement highlights the difficulties in using trademark law to protect designs, because of the strong emphasis placed on similarity, requiring almost identical copies and a high likelihood of confusion.

Designers have also sought to extend the applicability of trademark law to fashion through trade-dress. Trade-dress allows the use of trademark law to protect not only symbols indicative of sourcing, but also packaging and product designs that are distinctive. For example, in *Two Pesos, Inc. v. Taco Cabana, Inc.*,<sup>139</sup> the Supreme Court held that the interior décor of a Mexican restaurant could be protected through trade-dress because of its inherent distinctiveness.<sup>140</sup> However, while the Court in *Two Pesos* seemed to extend trade-dress to any design with inherent distinctiveness,<sup>141</sup> in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*,<sup>142</sup> the Court limited the extent to which trade-dress doctrine could apply to fashion designs by requiring that a design have secondary meaning to make it distinctive.<sup>143</sup> Before the Court's *Wal-Mart* decision, scholars had suggested that trade-dress might be the best mechanism to protect designs and combat piracy in fashion.<sup>144</sup> How-

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<sup>137</sup> *Gucci Am., Inc. v. Guess?, Inc.*, 09 CIV. 4373 SAS, 2012 WL 2304247, at \*26-\*27 (S.D.N.Y. June 18, 2012).

<sup>138</sup> *Id.* at \*22.

<sup>139</sup> 505 U.S. 763 (1992).

<sup>140</sup> *Id.* at 767.

<sup>141</sup> *See id.* Before *Two Pesos*, many courts required a showing of secondary meaning to protect trade-dress, but *Two Pesos* eliminated such a requirement by focusing entirely on inherent distinctiveness. *See* Helen Jorda, *Law of Trade Dress Comes of Age: Two Pesos, Inc. v. Taco Cabana, Inc.*, 26 BEVERLY HILLS B. ASS'N J. 119, 120 (1992). The *Two Pesos* case holds that trade dress warrants strong protection under the Lanham Act "from the outset of its creation, without proof of secondary meaning, if that trade dress is inherently distinctive." *See* Karina K. Terakura, *Insufficiency of Trade Dress Protection: Lack of Guidance for Trade Dress Infringement Litigation in the Fashion Design Industry*, 22 U. HAW. L. REV. 569, 593 (2000) ("The *Two Pesos* case clearly finds that trade dress warrants strong protection under the Lanham Act 'from the outset of its creation, without proof of secondary meaning, if that trade dress is inherently distinctive'") (internal citations omitted).

<sup>142</sup> 529 U.S. 205 (2000).

<sup>143</sup> *Id.* at 212; *see also* Terakura, *supra* note 141, at 607 (explaining that the Court distinguished *Wal-Mart* from *Two Pesos* by limiting *Two Pesos* to product packaging as opposed to the product configuration at issue in *Wal-Mart*).

<sup>144</sup> *See, e.g.*, S. Priya Bharathi, *There Is More than One Way To Skin a Copycat: The Emergence of Trade Dress To Combat Design Piracy of Fashion Works*, 27 TEX. TECH L. REV. 1667, 1691-95 (1996).

ever, the Court's decision in *Wal-Mart* might severely limit the utility of trade-dress for fashion designers in a world where trends—and the designs accompanying them—often turn over in a matter of months.<sup>145</sup>

## 2. Patent

Patent protection is generally quite limited in the fashion industry because of the heightened level of innovation required and the time limit imposed on the protection of the intellectual property.<sup>146</sup> Designers may seek patent protection for “new, original, and ornamental design” of their products.<sup>147</sup> However, it is often difficult for designers to prove novelty in fashion designs given how often they borrow from past seasons or other collections.<sup>148</sup> Furthermore, the expensive bureaucratic requirements of patent applications, as well as the limited time period for which they offer protection, add further complications. Although patent law has been used to protect certain products in the fashion industry, including shoes, handbags, and eyeglasses,<sup>149</sup> its heightened novelty requirement and prohibitive application requirements make it unlikely that fashion designers will be able to fully protect their designs through patent law.

## 3. Copyright

Recent literature advocating for increased intellectual property protection for the fashion industry has focused greatly on the role—and current

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<sup>145</sup> See *id.* at 1691 (“Since the ‘style life’ of a garment is usually not more than three months, secondary meaning is difficult to prove.”); see also Jonathan M. Barnett, *Shopping for Gucci on Canal Street: Reflections on Status Consumption, Intellectual Property, and the Incentive Thesis*, 91 VA. L. REV. 1381, 1394 n.25 (2005) (discussing the difficulties in bringing suits for designs under trade-dress doctrine).

<sup>146</sup> See Emily S. Day, *Double-Edged Scissor: Legal Protection for Fashion Design*, 86 N.C. L. REV. 237, 251 (2007).

<sup>147</sup> 35 U.S.C. § 171 (2006).

<sup>148</sup> See Raustiala & Sprigman, *supra* note 77, at 1704 (“Because so many apparel designs are reworkings and are not ‘new’ in the sense that the patent law requires, most will not qualify for design patent protection.”).

<sup>149</sup> Julia Anne Matheson & Stephen L. Peterson, *Combine and Conquer: How the Synthesis of Design Patent and Trade Dress Achieve Maximum Protection for Your Product Design*, FINNEGAN (May 2009), <http://www.finnegan.com/resources/articles/articles-detail.aspx?news=74f843be-c63a-40cc-8ae0-007bc50fdd99> (cited in Elizabeth Ferrill & Tina Tanhehco, *Protecting the Material World: The Role of Design Patents in the Fashion Industry*, 12 N.C. J.L. & TECH. 251, 278 (2011)).

dearth—of copyright protection for fashion.<sup>150</sup> Copyright protection generally does not apply to a “useful article,” which is defined broadly in the copyright code as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”<sup>151</sup> Because of the functional role of fashion designs as clothing, they escape copyright protection. As scholars have recognized, this utility-based distinction has the seemingly perverse effect of protecting the two-dimensional drawing of a design but not its execution in three dimensions.<sup>152</sup>

For example, Professors Hemphill and Suk have suggested that separating the design element of designs from their utilitarian function may circumvent the lack of copyright protection for fashion.<sup>153</sup> Copyright law recognizes that the designs of useful articles may be copyrighted when they “can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”<sup>154</sup> The doctrine of “separability” could thus become a potential solution to fashion’s lack of copyright protection if courts were to interpret the concept broadly.<sup>155</sup> However, in practice, courts have a mixed record on “separability” and have recently been reluctant to separate design elements of clothing.<sup>156</sup> And indeed, in many circumstances—for example, where the design is defined only by a particular

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<sup>150</sup> See, e.g., Day, *supra* note 146; Shelley C. Sackel, *Art Is in the Eye of the Beholder: A Recommendation for Tailoring Design Piracy Legislation to Protect Fashion Design and the Public Domain*, 35 AIPLA Q.J. 473 (2007); Loni Schutte, *Copyright for Couture*, 2011 DUKE L. & TECH. REV. 11 (2011); Tsai, *supra* note 126; Lynsey Blackmon, Comment, *The Devil Wears Prado: A Look at the Design Piracy Prohibition Act and the Extension of Copyright Protection to the World of Fashion*, 35 PEPP. L. REV. 107 (2007); Lisa J. Hedrick, Note, *Tearing Fashion Design Protection Apart at the Seams*, 65 WASH. & LEE L. REV. 215 (2008); Laura C. Marshall, Note, *Catwalk Copycats: Why Congress Should Adopt a Modified Version of the Design Piracy Prohibition Act*, 14 J. INTELL. PROP. L. 305 (2007); Brandon Scruggs, Comment, *Should Fashion Design Be Copyrightable?*, 6 NW. J. TECH. & INTELL. PROP. 122 (2007); Megan Williams, Comment, *Fashioning a New Idea: How the Design Piracy Prohibition Act Is a Reasonable Solution to the Fashion Design Problem*, 10 TUL. J. TECH. & INTELL. PROP. 303 (2007).

<sup>151</sup> 17 U.S.C. § 101 (2006 & Supp. V 2011).

<sup>152</sup> See Raustiala & Sprigman, *supra* note 77, at 1699.

<sup>153</sup> Hemphill and Suk, *supra* note 16, at 1185–86.

<sup>154</sup> 17 U.S.C. § 101.

<sup>155</sup> Hemphill & Suk, *supra* note 16, at 1186.

<sup>156</sup> See, e.g., *Galiano v. Harrah's Operating Co.*, 416 F.3d 411, 422 (5th Cir. 2005) (refusing to protect casino uniform because the expressive element was not separable from the useful function). *But see* *Poe v. Missing Persons*, 745 F.2d 1238 (9th Cir. 1984) (finding that a swimsuit’s design may be separable from its utility); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) (holding that the design of belt buckles is separable from their function).

cut of fabric—it may be impossible to separate designs from the utility of clothing articles.

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Recognizing the dearth of current intellectual property protections, scholars have ardently debated whether, as a normative matter, fashion *should* be entitled to such protection.<sup>157</sup> The purpose of this Note, however, is not to argue that fashion designs should be protected. Instead, this Note aims to evaluate the *Louboutin* decision and its implications in the broader context of intellectual property for fashion by assessing the appropriateness of trademark law for protecting designs in comparison to copyright and patent laws.

### B. Trademark Law as a Backdoor to Design Protection

Trademark is the wrong avenue to protect the red sole, and fashion designs more broadly, because trademark focuses on sourcing rather than creativity. Christian Louboutin himself has stated that his choice of the red sole was the result of creative luck: “[t]his happened by accident as I felt the shoes lacked energy so I applied red nail polish to the sole of a shoe. This was such a success that it became a permanent fixture.”<sup>158</sup> While this statement does not necessarily suggest that Louboutin did not also intend for the red sole to serve as a source identifier,<sup>159</sup> the description captures the way by which most design aspects come to acquire secondary meaning. A designer has a creative idea for an original design and with time that design comes to identify the designer himself. So it is, for example, with Chanel’s diamond-quilted bags (inspired by the cushions in her home),<sup>160</sup> and Bottega Veneta’s famous “*intrecciato*” pattern of woven leather.<sup>161</sup> Yet, the fact that a design acquires so much fame that it becomes associated with its creator, thereby

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<sup>157</sup> See *supra* note 150 and accompanying text; see also Hemphill & Suk, *supra* note 16.

<sup>158</sup> Don Jeffrey & Cotton Timberlake, *Louboutin Wins Appeal Over Saint Laurent Red-Soles Shoes*, BLOOMBERG (Sept. 5, 2012, 3:17 PM) <http://www.bloomberg.com/news/2012-09-05/louboutin-wins-appeal-over-saint-laurent-red-soles-shoes.html>.

<sup>159</sup> In fact, when he applied for the trademark more than ten years after first painting soles red, Louboutin stated that, “the shiny red color of the soles has no function other than to identify to the public that they are mine.” Collins, *supra* note 7.

<sup>160</sup> JANET WALLACH, CHANEL: HER STYLE AND HER LIFE 158 (1999).

<sup>161</sup> The “*intrecciato*” pattern is a registered trademark (Serial No. 77/219, 184), but its validity has yet to be tested by the courts.

giving it secondary meaning, should not necessarily entitle it to trademark protection.<sup>162</sup>

The purpose of trademark law is to allow manufacturers to identify the source of their goods and to protect consumers from confusion between products.<sup>163</sup> As McCarthy's famous treatise on trademarks and unfair competition states, to merit trademark protection, "a designation must be proven to perform the job of identification: to identify one source and distinguish it from other sources."<sup>164</sup> Trademark law thus protects fair competition by ensuring that one manufacturer cannot free ride off of the reputation of another. A trademark is an identifier of quality to indicate to consumers the origin of the product, thus enabling them to rely on the marks in their purchase decisions.<sup>165</sup> Yet in protecting manufacturers who gain an advantage through branding on the competitive market, trademark law also seeks to strike a balance and ensure that they do not gain this advantage unfairly.<sup>166</sup> It is in this regard that the defense of functionality is essential. Functionality, by restricting the type of marks that may be protected, ensures that manufacturers gain monopolies on an identifying mark, *not* on a particular product or product feature.<sup>167</sup>

Louboutin's red sole undeniably serves the sourcing role of a trademark. With its fame, the red sole has come to symbolize its creator and to identify for fashion-savvy consumers the high-end luxury of Louboutin shoes. Because a color, like a descriptive word, is a non-distinctive mark, this secondary meaning is necessary to even allow the mark to be protectable.<sup>168</sup> And there are at least two reasons why a trademark on the red sole

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<sup>162</sup> The doctrine of dilution does take into account the fame of a mark and protects it against dilution. See 15 U.S.C. § 1125(c) (2012). Nonetheless, concerns over dilution should only enter the picture once a trademark has been held valid. In this case, aesthetic functionality should block the trademark, thus making concerns over dilution irrelevant.

<sup>163</sup> 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:3 (4th ed. 2013).

<sup>164</sup> *Id.*

<sup>165</sup> See Robert N. Klieger, *Trademark Dilution: The Whittling Away of the Rational Basis for Trademark Protection*, 58 U. PITT. L. REV. 789 (1997) ("[T]rademarks serve as markers of consistent source and quality").

<sup>166</sup> See *Professors Amicus*, *supra* note 82, at \*3.

<sup>167</sup> *Id.*

<sup>168</sup> Courts have traditionally demonstrated reluctance to enforce non-distinctive marks like colors, and have focused on the heightened requirements for such marks, particularly that they have secondary meaning. See, e.g., *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225 (3d Cir. 1978); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976).

might be beneficial to the industry: it protects a designer's creative work and encourages others to innovate with the assurance that such innovations will give them legal rights. These legal rights in turn provide assurance that designers will be able to profit from their work by ensuring that others cannot copy it. In the case of the red sole, trademark rights can ensure that Louboutin reaps the benefits of his creation and that other designers cannot free ride off his idea.

Yet, while these benefits might support a trademark on a red sole, the costs to the industry and to the broader public of allowing the trademark militate against its protection. First, the red sole is by no means Louboutin's only source identifier on his shoes. Louboutin uses multiple other marks on each pair of shoes to identify the brand.<sup>169</sup> Both the inside of the shoe and the sole bear the name of the designer.<sup>170</sup> As a result, it is unlikely that any buyer of an Yves Saint Laurent pair of monochromatic shoes, or even a pair of contrasting shoes, would be confused about the source of the product. These additional safeguards ensure that even without the red sole, trademark law could still serve its primary purposes of protecting Louboutin from unfair competition and consumers from confusion in their purchases. Through these trademarks, Louboutin may thus still benefit from the reputation he has built.

Furthermore, even if the red sole mark serves the sourcing purposes of trademark law, it goes directly against the broader goal of encouraging fair competition. Indeed, the red sole mark does not promote competition; rather, it limits it. As discussed in Part II, allowing single-color marks in fashion carries its own unique risks because of the importance of aesthetics to the industry and to the commercial value of designs.<sup>171</sup> Unlike with other features that merit trademark protection, allowing the red sole trademark protection bears significant social costs by affecting competition. Competition in fashion differs substantially from that in other industries, and non-distinctive marks, which may otherwise be worthy of trademark protection because of their secondary meaning, may still be inappropriate in

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<sup>169</sup> Louboutin owns several other trademarks, some of which he uses on his shoes. See, e.g., CHRISTIAN LOUBOUTIN, Registration No. 85,700,808; CHRISTIAN LOUBOUTIN, Registration No. 85,700,773; LOUBOUTIN, Registration No. 85,700,799.

<sup>170</sup> See, e.g., *Christian Louboutin – New Simple Pumps*, SAKS FIFTH AVENUE, [http://www.saksfifthavenue.com/main/ProductDetail.jsp?FOLDER%3C%3Efolder\\_id=2534374306418049&PRODUCT%3C%3Eprd\\_id=845524446200768&R=452504329499&P\\_name=Christian+Louboutin&N=4294912355+306418049&bmUID=jR0INSS](http://www.saksfifthavenue.com/main/ProductDetail.jsp?FOLDER%3C%3Efolder_id=2534374306418049&PRODUCT%3C%3Eprd_id=845524446200768&R=452504329499&P_name=Christian+Louboutin&N=4294912355+306418049&bmUID=jR0INSS) (last visited Mar. 6, 2013).

<sup>171</sup> See *supra* notes 89–110 and accompanying text.

fashion because of their negative effect on competition. Trademark law is tailored for such situations with the defense of functionality, and particularly of aesthetic functionality. Ensuring the robust strength of these doctrines thus serves to protect the industry as a whole. While the red sole mark may satisfy many formal requirements of trademark law, when looked at in the larger context of the fashion industry and the test of aesthetic functionality, such a trademark contravenes both the goal of promoting fair competition and the spirit of trademark doctrine.

Scholars advocating against increased intellectual property protection for fashion have worried that such a system would hinder innovation. Although certain trademark rights promote innovation by ensuring that creators will receive legal protection, when these rights are misapplied, they can lead to the opposite result. Professors Raustiala and Sprigman suggest that the low-intellectual property environment of fashion might promote innovation because the cyclical nature of fashion depends not only on constant change, but also on frequent borrowing of design elements.<sup>172</sup> Within this paradigm, more robust intellectual property rights may serve to stifle innovation by limiting not just the tools of designers, but also their incentives to create new designs. Protection of the red sole mark does precisely that. As the same professors wrote in an article published shortly after the Second Circuit's decision, intellectual property rights "can serve an important, even critical, function in our innovation-based economy. But they can also squelch competition and slow down innovation."<sup>173</sup> According to Raustiala and Sprigman, the Second Circuit's *Louboutin* decision essentially grants the designer a permanent monopoly on a particular design with no adequate justification. Not only does this obviously hinder competition, but in doing so, the red sole also stifles innovation by preventing designers from developing and improving off of each other's ideas, an essential component of innovation in fashion.

The intellectual property framework created by Congress seeks to ensure a careful balance between these competing interests—protecting manufacturers, while promoting competition and innovation. Trademark law grants extensive rights to marks that meet its requirements; only through trademark law can designers acquire virtually permanent rights to a mark. As such, its use should be carefully deployed to situations where it will not have severe effects on the market for competition. In the case of the red sole,

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<sup>172</sup> See Raustiala & Sprigman, *supra* note 77, at 1775–76.

<sup>173</sup> Kal Raustiala & Christopher Sprigman, *What Apple and Red Shoes Have in Common: Using Broad Design To Block Competition*, WIRED (Sept. 10, 2012, <http://www.wired.com/business/2012/09/opinion-apple-louboutin-design-competition>).

the harmful impact on the market is readily apparent. The protection of the red sole represents an overextension of trademark into the world of designs, which both patent and copyright, as will be discussed in sections C and D of this Part, are better suited to protect. While it is not surprising that designers are seeking to manipulate the scant framework of intellectual property rights for fashion to provide some protection for their creative works, validating the use of trademark law in this domain bears significant risks for the industry in the long-term.

### C. Trademarking Designs and Design Patent Law

Allowing trademarks in fashion like the trademark on the red sole expands trademark law into a domain of intellectual property protection better fit for other legal frameworks, including patent law. For example, the *amici* law professors argued that allowing trademarks on design features like the red sole interferes with design patents.<sup>174</sup> The professors drew on the broader idea that the trademark doctrine of utilitarian functionality, banning trademarks on useful features, exists to delineate the border between trademark law and utility patent law.<sup>175</sup> Similarly, they argued, aesthetic functionality prevents trademark from impeding into the territory of design patents.<sup>176</sup> Design patents, as discussed above, protect designs that fall within the statute's narrow definition of "novel" for a limited duration of time: fourteen years.<sup>177</sup> Aesthetic functionality is crucial, the professors suggested, because without it "trademark law would grant perpetual monopolies in desirable product features that, although associated by consumers with a particular producer, are not novel in the way that patent law requires for both utility and design patents."<sup>178</sup> The *amici* could have drawn on Justice Breyer's opinion in *Qualitex* for further support of this argument, as he also emphasized that trademark law should not be used to circumvent the heightened requirements of patent law.<sup>179</sup>

According to the *amici*'s argument, the doctrine of aesthetic functionality in trademark law thus serves to preserve the balance in intellectual property protection "between incentivizing the production of attractive new designs and permitting the widest possible competition consistent with that

<sup>174</sup> *Professors Amicus*, *supra* note 82, at \*2–\*9.

<sup>175</sup> *Id.* at \*6–\*8.

<sup>176</sup> *Id.* at \*8–\*9.

<sup>177</sup> *See id.* at \*7; *see also supra* notes 146–149 and accompanying text.

<sup>178</sup> *Professors Amicus*, *supra* note 82, at \*7.

<sup>179</sup> *See supra* notes 39–40 and accompanying text.



incentive.”<sup>180</sup> Patent law, because it allows for intellectual property protection for useful articles, could also risk interfering with competition, but the stringent requirements of patent protection serve to mitigate this risk.<sup>181</sup> In comparison to patent protection, the requirements for trademark protection are relatively low. As such, it is especially important that trademark not intrude into the domain of patent law by allowing for the protection of functional features.

In the case of the red sole, the *amici* go on to argue that allowing the trademark to stand causes exactly that type of interference with patent law.<sup>182</sup> As discussed in Part II of this Note, the red sole is functional by virtue of its aesthetic appeal. While the red sole may not meet the stringent requirements for a design patent, this does not mean that Louboutin should instead acquire a complete monopoly on it through trademark law. Indeed, as explained above, the red sole is exactly the type of design feature that can have a significant and damaging impact on competition. Intellectual property, through its balance between trademark law—and aesthetic functionality—and patent law, seeks to protect against this risk. In this case, respect for the doctrine of aesthetic functionality requires that the red sole not receive trademark protection, as such rights would interfere with the design of the patent law system.

#### D. *Why Copyright is Better Suited Than Trademark to Protect Fashion Designs*

Though trademark law may be the only tool currently available to designers to protect their designs, a copyright bill for fashion could provide more tailored rights to designers. The Second Circuit acknowledged in a footnote of its *Louboutin* decision that, “[i]t is arguable that, in the particular circumstances of this case, the more appropriate vehicle for the protection of the Red Sole Mark would have been copyright rather than trademark.”<sup>183</sup> The court supported this proposition by citing academic literature on the subject,<sup>184</sup> as well as *Kieselstein-Cord v. Accessories by Pearl, Inc.*,<sup>185</sup> where the Second Circuit held that the ornamental aspect of belt buckles “is concep-

<sup>180</sup> *Professors Amicus*, *supra* note 82, at \*7.

<sup>181</sup> *See id.*; see also Ralph S. Brown, *Design Protection: An Overview*, 34 UCLA L. REV. 1341, 1355–57 (1987) (discussing the difficulties of obtaining a design patent).

<sup>182</sup> *Professors Amicus*, *supra* note 82, at \*8–\*9.

<sup>183</sup> *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 223 n.19 (2d Cir. 2012).

<sup>184</sup> In support of the view that fashion may merit *sui generis* protection, the court cited *Hemphill & Suk*, *supra* note 16.

<sup>185</sup> 632 F.2d 989 (2d Cir. 1980).

tually separable from their subsidiary utilitarian function,”<sup>186</sup> thus making the buckles potentially eligible for copyright protection as creative art.<sup>187</sup> The prospect of copyright law providing a better system to protect such designs suggests that trademark law should not be manipulated, as it was in the *Louboutin* case, to try to fill this role.

Copyright law aims to protect not only the rights of individual creators, but also the broader progress of science and the arts. Indeed, the Constitution itself grants Congress the task of “promot[ing] the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>188</sup> The various mechanisms of intellectual property—patent, trademark, and copyright—all play a part in fulfilling this mission, but copyright law plays a particularly central role in promoting creativity and progress.<sup>189</sup> As the Register of Copyrights has stated, “the primary purpose of copyright is to stimulate the creation and dissemination of intellectual works, thus advancing ‘the progress of science and useful arts.’”<sup>190</sup> The Register goes on to explain that, “‘an important secondary purpose’ of copyright is to ‘give authors the reward due them for their contribution to society’ and compensate them for their labors and their contributions.”<sup>191</sup> The protection provided by copyright law thus encourages the creation of new works by guaranteeing legal protections for their authors.

In promoting innovation, however, copyright law also recognizes that the protection of works should not be all encompassing. As discussed in Part II, innovation can often grow out of the use of the ideas of others, including in the domain of fashion designs. Even beyond the fashion indus-

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<sup>186</sup> *Id.* at 993.

<sup>187</sup> *Id.* at 994.

<sup>188</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>189</sup> Patent law also serves to further this goal, as it too protects innovation. However, its heightened standard of novelty limits the range of features that may fall within its domain so as to exclude creative works that may nonetheless be meritorious of some intellectual property protection. Further, patent law in stark contrast to copyright law has as its aim the protection of useful features. See 35 U.S.C. § 101 (2006). Copyright law thus reaches where patent law does not, by providing broader intellectual property protection to works of art and their creators.

<sup>190</sup> C.T. Dreschler, Annotation, *Extent of Doctrine of “Fair Use” Under federal Copyright Act*, 23 A.L.R.3d 139 (Originally published in 1969) (quoting REP. OF THE REGISTER OF COPYRIGHTS ON THE GEN. REVISION OF THE UNITED STATES COPYRIGHT LAW, PREPARED FOR THE SUBCOMM. ON PATENTS, TRADEMARKS, & COPYRIGHTS, S. COMM. ON THE JUDICIARY, 86TH CONG. 2D SESS. 5–6 (Comm. Print 1960), reprinted in 2 STUDIES ON COPYRIGHT 1199, at 1205–06 (1963)).

<sup>191</sup> *Id.*

try, the “progress of science and useful arts” may depend on adequate access to existing work. To encourage such uses, copyright law includes safeguards to permit certain uses of works that fall within the “fair use doctrine.”<sup>192</sup> In addition, unlike trademark law, copyright law does not grant a permanent monopoly on protected works.<sup>193</sup> Copyright law thus plays an important role in promoting innovation: it incentivizes it by granting legal rights to the creators, while also recognizing that progress may depend on the interchange and “fair use” of the ideas of others.

Copyright law offers a better framework to protect fashion designs: its purposes match the fashion industry’s needs for intellectual property protection, while its limits ensure the rights it grants would not stifle innovation and creation. Copyright law can protect the creative processes of fashion by giving designers sufficient rights to protect their designs and the value of their work from illegitimate exact copies.<sup>194</sup> At the same time, however, the protection it provides is not absolute, as it permits certain uses, including potentially the necessary “borrowing” that occurs in fashion, and it limits the term of protection. With copyright law, designs may be protected for a much shorter term than other copyrighted works. For example, the European Union directive granting copyright protection for fashion designs allows for five-year terms of protection, which may be renewable up to 25 years.<sup>195</sup> Copyright law, because it aims to protect the creative process through a flexible and adaptable system of rights, can adequately represent the interests of designers without hindering the broader competitive market of the fashion industry.

The Innovative Design Protection Act (IDPA), which Senator Charles Schumer has proposed several times in Congress but which has never passed, can employ the advantages of copyright law to offer more tailored protection for the aspects of fashion that should be shielded from copying without hin-

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<sup>192</sup> *Id.*

<sup>193</sup> Copyright protection generally extends for the lifetime of the creator plus seventy years, although certain types of work may be subject to different protection. See 17 U.S.C. § 302 (2006).

<sup>194</sup> Hemphill and Suk describe manufacturers like Forever 21 and A.B.S. that often reproduce entire designs, rather than just particular features or trends as “fast-fashion copyists,” whose copies are the most damaging to innovation in the fashion industry. Hemphill & Suk, *supra* note 16, at 1172–74. See also Lauren Howard, *An Uningenious Paradox: Intellectual Property Protections for Fashion Designs*, 32 COLUM. J.L. & ARTS 333, 341–42 (2009).

<sup>195</sup> Council Regulation (EC) No. 6/2002 of 12 Dec. 2001, art. 111, on Community Designs 2001 O.J. (L 3), *amended* by Council Regulation (EC) No. 1891/2006 of 18 Dec. 2006 O.J. (L 386) [hereinafter *European Council Regulation*], available at <http://oami.europa.eu/en/design/pdf/6-02-CV-en.pdf>.

dering competition and creative freedom.<sup>196</sup> Scholars and commentators in the industry have ardently debated the proposed copyright bill and its potential effect on the fashion industry.<sup>197</sup> While some see it as a necessary reform to protect the creative works of designers and to promote innovation,<sup>198</sup> others worry that increased protection will restrict the market for clothing, thus raising prices, and will flood courts with frivolous lawsuits.<sup>199</sup> To guard against these potential effects denounced by the bill's opponents, the bill has been revised multiple times to narrow the breadth of protection. As it stands now, the bill enjoys broad support from most segments of the fashion industry, including the once-opposed American Apparel and Footwear Association.<sup>200</sup>

In its current form, the bill grants copyright rights in fashion to designs that are found to be sufficiently unique, by protecting against only "substantially identical" copies.<sup>201</sup> The bill essentially codifies an originality requirement by applying only to designs that "provide a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs for similar types of articles."<sup>202</sup> By limiting protected designs to those that satisfy uniqueness as defined in the bill, the IDPA ensures that copyright

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<sup>196</sup> S. 3523, 112th Cong. (2012) [hereinafter *Innovative Design Protection Act*], available at <http://www.govtrack.us/congress/bills/112/s3523/text>.

<sup>197</sup> See e.g., Day, *supra* note 146; Hemphill & Suk, *supra* note 16; Howard, *supra* note 194; Sackel, *supra* note 150; Blackmon, *supra* note 150; Marshall, *supra* note 150; Williams, *supra* note 150. *But see* Kari Heyison, *If It's Not Ripped, Why Sew It? An Analysis of Why Enhanced Intellectual Property Protection for Fashion Design Is in Poor Taste*, 28 *TOURO L. REV.* 255 (2012); Susanna Monseu, *European Design Rights: A Model for the Protection of All Designers from Piracy*, 48 *AM. BUS. L.J.* 27, 28 (2011); Jennifer E. Smith, *Flattery or Fraud: Should Fashion Designs Be Granted Copyright Protection?*, 8 *N.C. J.L. & TECH. ON.* 1, 2 (2007).

<sup>198</sup> See, e.g., Hemphill & Suk, *supra* note 16.

<sup>199</sup> See Cathy Horyn, *Schumer Bill Seeks To Protect Fashion Design*, *N.Y. TIMES* (Aug. 5, 2010, 10:43 PM), <http://runway.blogs.nytimes.com/2010/08/05/schumer-bill-seeks-to-protect-fashion-design/?partner=rss&emc=rss>; *Innovative Design Protection and Piracy Prevention Act (IDPPPA) and the Innovative Design Protection Act (IDPA) – What's Next for Protection of Fashion Design in the United States?*, *VENABLE LLP* (Oct. 18, 2012), <http://www.venable.com/innovative-design-protection-act-idppa-and-the-innovative-design-protection-act-idpa-what-next-for-protection-of-fashion-design-in-the-united-states-10-18-2012/>.

<sup>200</sup> See Horyn, *supra* note 199.

<sup>201</sup> *Innovative Design Protection Act*, *supra* note 196.

<sup>202</sup> *Id.* Notably, the bill excludes color as a consideration, stating, "[t]he presence or absence of a particular color or colors or of a pictorial or graphic work imprinted on fabric shall not be considered in determining the protection of a fashion design." *Id.* This suggests that an identical copy, whose only distinguishing difference is its color would also be considered an infringement. It also indicates

protection will not stifle the creative copying in fashion—and the innovation it leads to—which has been staunchly defended by many commentators on the subject.<sup>203</sup> In addition, the requirement that violating copies be “substantially identical” ensures that the protection of designs will not interfere with the process of “borrowing” which is so essential to innovation in fashion.<sup>204</sup> The bill defines “substantially identical” as “so similar in appearance as to be likely to be mistaken for the protected design, and contains only those differences in construction or design which are merely trivial.”<sup>205</sup> This heightened standard of similarity may limit the applicability of the bill, but it ensures that it will not overextend and stifle the creative process. Finally, the term of protection, unlike regular copyright protection, would generally be limited to three years.<sup>206</sup> This short term is similar to the standard five-year term offered by the European Union’s copyright protection<sup>207</sup> and guarantees that designers will not acquire permanent monopolies on designs, thereby promoting long-term competition in the industry. These provisions of the bill all help to ensure that while the IDPA will undoubtedly increase the intellectual property protection of fashion designs, it will do so in a limited way so as not to interfere with the creative and competitive processes that drive the industry. The IDPA thus offers a more narrowly tailored and carefully considered solution to protect the rights of designers without hindering the market as a whole.

#### IV. CONCLUSION

Over the past few years, commentators on the fashion industry and legal scholars have ardently debated the merits of the increased intellectual property protection that extending copyright to fashion designs would provide. The subject has gained widespread attention both in the mainstream media and in academic journals. However, as the bill granting copyright protection has stalled in Congress and industry specialists continue to disagree over the extent of protection needed, fashion designers have become

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that Louboutin’s red sole would most likely not be eligible for copyright protection under the IDPA.

<sup>203</sup> See, e.g., Raustiala & Sprigman, *supra* note 77.

<sup>204</sup> See *id.*

<sup>205</sup> *Innovative Design Protection Act*, *supra* note 196.

<sup>206</sup> *Id.*

<sup>207</sup> *European Council Regulation*, *supra* note 195.

increasingly frustrated with the current system, advocating vocally for more intellectual property rights.<sup>208</sup>

Christian Louboutin's suit against Yves Saint Laurent represents one designer's attempt to seek recognition for his designs, not through public advocacy or legislative action, but through litigation. Recognizing that the existing devices of intellectual property protection are insufficient to protect his designs, Christian Louboutin has sought to manipulate trademark law to his advantage. In demonstrating support for the red sole trademark, the Second Circuit has endorsed this back door approach to the protection of designs.

As a formalistic matter, the Second Circuit's application of trademark law may appear judicially sound. But in practice, it ignores the realities of the fashion industry and the broader purpose of trademark law in protecting fair competition. In fashion, competition and aesthetic appeal are inextricable. The success of designers depends on their creativity and on the full availability of design tools, including colors. And indeed, trademark law has recognized how aesthetic features may be essential to competition through the doctrine of aesthetic functionality. In the fashion industry, where commercial success depends on aesthetic appeal, a robust enforcement of aesthetic functionality is particularly important. As the district court emphasized in its opinion, single-color marks in fashion are almost always aesthetically functional.

Regardless of where they stand on copyright protection for fashion, commentators on the industry should recognize that the *Louboutin* decision goes too far in enabling trademark law to protect designs. Single-color marks in fashion pose significant risks to the industry by granting monopolies to individual designers on an essential tool that all designers require. In the long term, allowing single-color marks on fashion designs will hinder not only competition in the fashion industry, but also innovation and creativity, which continue to make fashion the object of fantasy and desire.

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<sup>208</sup> Prabal Gurung, Narciso Rodriguez, Proenza Schouler, and Jason Wu are among the designers who have spoken out, including testifying in Congress, in favor of more intellectual property protection for fashion. See Katherine Boyle, *Fashion Industry Testifies in Favor of Design Copyright Protection (Again)*, WASH. POST (July 18, 2011, 11:47 AM) [http://www.washingtonpost.com/blogs/arts-post/post/fashion-industry-testifies-in-favor-of-design-copyright-protections-again/2011/07/18/gIQA d2MuLI\\_blog.html](http://www.washingtonpost.com/blogs/arts-post/post/fashion-industry-testifies-in-favor-of-design-copyright-protections-again/2011/07/18/gIQA d2MuLI_blog.html).