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AMICUS BRIEF OF THE INTERNATIONAL TRADEMARK ASSOCIATION IN *CHRISTIAN LOUBOUTIN S.A. ET AL. v. YVES SAINT LAURENT AMERICA HOLDING, INC. ET AL.*

11-3303-CV

IN THE

United States Court of Appeals

FOR THE SECOND CIRCUIT

CHRISTIAN LOUBOUTIN S.A., CHRISTIAN LOUBOUTIN, L.L.C.,
CHRISTIAN LOUBOUTIN,

Plaintiffs-Counter-Defendants-Appellants,

v.

YVES SAINT LAURENT AMERICA HOLDING, INC., YVES SAINT LAURENT S.A.S.,
YVES SAINT LAURENT AMERICA, INC.,

Defendants-Counter-Claimants-Appellees,

YVES SAINT LAURENT, (an unincorporated association),
JOHN DOES, A TO Z, (Unidentified), JANE DOES, A TO Z, (Unidentified),
XYZ COMPANIES, 1 TO 10, (Unidentified),

Defendants-Appellees.

On Appeal from the United States District Court
for the Southern District of New York

BRIEF OF *AMICUS CURIAE* INTERNATIONAL TRADEMARK ASSOCIATION IN SUPPORT OF VACATUR AND REMAND

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CORPORATE DISCLOSURE STATEMENT

Pursuant to Fed. R. App. P. 26.1, *amicus curiae* International Trademark Association ("INTA") states that it is not a publicly-held corporation or other publicly-held entity. INTA does not have any parent corporation and no publicly held corporation or other publicly-held entity holds 10% or more of INTA's stock.

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INTRODUCTION

INTA submits this brief as *amicus curiae* to address the two legal errors in the District Court's analysis of the validity of the federally-registered Red Sole trademark of appellants Christian Louboutin S.A., Christian Louboutin S.A., L.L.C., and Christian Louboutin (collectively, "appellants") in its Decision and Order dated August 10, 2011 (*Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445 (S.D.N.Y. 2011) (hereinafter referred to as "Opinion")) finding them unlikely to succeed on their claims for trademark infringement and unfair competition under the Lanham Trademark Act. INTA urges vacatur and remand for the reasons discussed below. INTA only addresses the District Court's errors with respect to its analysis of the validity of the trademark, and expresses no view on the merits of appellants' claims for trademark infringement or dilution, or whether a preliminary injunction should be entered.[1]

First, the District Court erred in rejecting the presumption of validity attendant to the federal trademark registration of appellant Christian Louboutin

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[1] In accordance with Fed. R. App. P. 29(c)(5) and 2d Cir. R. 29.1(b), neither party is a member of INTA. The law firms representing the parties are associate members of INTA. The parties and their counsel have not participated in, nor contributed any funds toward, the preparation or submission of this brief. No person (other than the amicus, its members or its counsel) contributed money intended to fund the preparation or submission of the brief. This brief was authored solely by INTA and its counsel. The parties have consented to the filing of this brief.

("Louboutin"), No. 3,361,597 for its Red Sole Mark. The court incorrectly construed the registration as a broad "claim 'to the color red'" in general for women's designer shoes, Opinion at 454, instead of the narrower claim actually defined in the registration, namely "a *lacquered red sole* on footwear" (emphasis added). Overlooking the definition in the registration, the court then evaluated the mark as if it were merely a color that an artist or designer would use, rather than a valid trademark identifying the source of appellants' goods. Thus the District Court erred in failing to recognize the presumption of validity conferred on the Red Sole Mark under Section 7(b) of the Lanham Trademark Act, 15 U.S.C. § 1057(b), as a result of its examination by the Patent and Trademark Office and subsequent registration.

Second, the District Court erred in its analysis of the validity of the Red Sole Mark, finding it functional, and thus invalid. In that analysis, the District Court essentially applied the controversial, and limited, doctrine of aesthetic functionality, but did not correctly follow this Court's test for aesthetic functionality, which requires a finding that use of the design is essential to effective competition. Instead, proceeding on its erroneous conclusion that the mark at issue covered "the color red" in general, the court postulated that granting Louboutin "a monopoly on the color red" would thwart competition not only for high-fashion shoes, but potentially in the markets for "dresses, coats, bags, hats

and gloves." Opinion at 454. The court thus failed to consider the impact on competition of granting protection to the Red Sole Mark *as defined in the registration*.

Should the District Court's opinion stand uncorrected, both the presumption of validity conferred upon trademarks through the federal registration process and the bounds of the doctrine of aesthetic functionality will be called into question. The District Court's decision threatens to upend these key aspects of trademark and unfair competition law, making it easier for third parties to use the brands of others. That, in turn, would erode the protections trademark law affords consumers, increasing the potential for consumer confusion and causing damage to brand owners. It is vitally important to the development of trademark law that the District Court's opinion be vacated and remanded.

STATEMENT OF INTEREST OF THE AMICUS CURIAE

Founded in 1878, INTA is a not-for-profit organization dedicated to the support and advancement of trademarks and related intellectual property concepts as essential elements of trade and commerce. INTA has over 5,700 members in more than 190 countries. Its members include trademark owners, law firms, and other professionals who regularly assist brand owners in the creation, protection and enforcement of their trademarks. All of INTA's members share the goal of

promoting an understanding of the essential role trademarks play in fostering informed decisions by consumers, effective commerce, and fair competition.

INTA members are frequent participants in trademark litigation as both plaintiffs and defendants, and therefore are interested in the development of clear, consistent and fair principles of trademark and unfair competition law. INTA has substantial expertise and has participated as *amicus curiae* in numerous cases involving significant trademark issues, including in this Court. [2]

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[2] Cases in which INTA has filed amicus briefs include *Tiffany (NJ) Inc. v. eBay, Inc*., 131 S. Ct. 647 (2010) (mem.); *Contessa Premium Foods, Inc. v. Berdex Seafood, Inc.*, 546 U.S. 957 (2005) (mem.); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc*., 543 U.S. 111 (2004); *Dastar Corp. v. Twentieth Century Fox Film Corp*., 539 U.S. 23 (2003); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003); *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); *Wal-Mart Stores, Inc. v. Samara Bros. Inc.*, 529 U.S. 205 (2000); *Fla. Prepaid Postsecondary Educ. Expense Bd. v. College Sav. Bank*, 527 U.S. 627 (1999); *Dickinson v. Zurko*, 527 U.S. 150 (1999); *Qualitex Co. v. Jacobson Prods. Co*., 514 U.S. 159 (1995); *Two Pesos, Inc. v. Taco Cabana, Inc*., 505 U.S. 763 (1992); *K Mart Corp. v. Cartier, Inc*., 486 U.S. 281 (1988); *Rosetta Stone Ltd. v. Google, Inc*., No. 10-2007 (4th Cir. 2011); *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 636 F.3d 1115 (9th Cir.), *opinion withdrawn and superseded on denial of rehearing by* 654 F.3d 958 (9th Cir. 2011); *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.,* No. 09-16322 (9th Cir. Feb. 8, 2011); *Chloé v. Queen Bee of Beverly Hills, LLC,* 616 F.3d 158 (2d Cir. 2010); *Penguin Group (USA) Inc. v. American Buddha*, 609 F.3d 30 (2d Cir. 2010); *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2009); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007); *Test Masters Educ. Servs., Inc. v. Singh*, 428 F.3d 559 (5th Cir. 2005); *Playboy Enters., Inc. v. Netscape Commc'ns Corp*., 354 F.3d 1020 (9th Cir. 2004); *WarnerVision Entm't Inc. v. Empire of Carolina, Inc*., 101 F.3d 259 (2d Cir. 1996); *Preferred Risk Mut. Ins. Co. v. United States*, 86 F.3d 789 (8th Cir. 1996); *Conopco, Inc. v. May Dep't Stores Co*., 46 F.3d 1556 (Fed. Cir. 1994); *Ralston Purina Co. v. On-Cor Frozen*

(continued...)

INTA was initially founded as the United States Trademark Association, in part to encourage the enactment of federal trademark legislation after the invalidation on constitutional grounds of the United States' first trademark act. Since then, INTA has been instrumental in making recommendations and providing assistance to legislators in connection with all major pieces of federal trademark legislation, including the Lanham Act in 1946 and the Federal Trademark Dilution Act ("FTDA") in 1995, as well as international trademark laws and treaties such as the Madrid Protocol and the Trademark Law Treaty.

SUMMARY OF ARGUMENT

The District Court failed to give due deference to the federal trademark registration for the Red Sole Mark issued to appellant Louboutin and the presumption of validity the registration confers on the mark under the Lanham Act. Instead, it misconstrued the mark as consisting solely of "the color red" as opposed to "a lacquered red sole on footwear" as stated in the registration, and in equating it to just another color in an artist's palette, effectively presumed it *not* to be a valid trademark, and thus shifted from appellees the burden to prove the mark invalid.

(...continued)
Foods, Inc., 746 F.2d 801 (Fed Cir. 1984); *Anti-Monopoly, Inc. v. Gen. Mills Fun Group, Inc.*, 684 F.2d 1316 (9th Cir. 1982); *In re Borden, Inc.*, 92 F.T.C. 669 (1978), *aff'd sub nom. Borden, Inc. v. Fed. Trade Comm'n*, 674 F.2d 498 (6th Cir. 1982), *vacated and remanded*, 461 U.S. 940 (1983) (mem.); *Redd v. Shell Oil Co.*, 524 F.2d 1054 (10th Cir. 1975); *Century 21 Real Estate Corp. v. Nev. Real Estate Advisory Comm'n*, 448 F. Supp. 1237 (D. Nev. 1978), *aff'd*, 440 U.S. 941 (1979) (mem.); *ITC Ltd. v. Punchgini, Inc ,* 880 N.E.2d 852 (N.Y. 2007).

The District Court also erred in concluding that the Red Sole Mark is functional, again by misconstruing it as "the color red," and by not following the Supreme Court's test for functionality or this Court's test for determining aesthetic functionality.

ARGUMENT

I. THE DISTRICT COURT ERRED IN NOT CONSTRUING THE RED SOLE MARK AS DEFINED IN THE REGISTRATION, BUT AS A BROAD CLAIM TO "THE COLOR RED," AND IN FAILING TO RECOGNIZE THE STATUTORY PRESUMPTION OF VALIDITY CONFERRED BY REGISTRATION

In finding "serious doubts that Louboutin possesses a protectable mark," Opinion at 457, the District Court erroneously construed the mark as if it were a broad claim to "the color red," rather than what is stated in the trademark registration certificate, namely, a "lacquered red sole on footwear." The court further erred in failing to give sufficient deference to the statutory presumption of validity afforded to registered trademarks, by finding the mark invalid based on a "fanciful hypothetical" of the court's creation rather than on a preponderance of the evidence, as the case law requires.

Consistent with Section 7 of the Lanham Trademark Act, 15 U.S.C. § 1057, this Court has recognized that "a certificate of registration, once issued, is prima facie evidence that the registered mark is valid." *PaperCutter, Inc. v. Fay's Drug Co.*, 900 F.2d 558, 562 (2d Cir. 1990) (internal citation omitted). Accordingly,

"when a plaintiff sues for infringement of its registered mark, the defendant bears the burden to rebut the presumption of [the] mark's protectibility by a preponderance of the evidence." *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 192 F.3d 337, 345 (2d Cir. 1999) (citing *PaperCutter*, 900 F.2d at 563). In order to meet this burden, the defendant must "proffer evidence that the mark is not valid[.]" *Lemme v. Nat'l Broad. Co.*, 472 F. Supp. 2d 433, 443 (E.D.N.Y. 2007).

"Validity" means that the trademark is protectable, and "capable of distinguishing the products it marks from those of others." *Lane Capital Management* 192 F.3d 337, 344 (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992), citing 15 U.S.C. § 1052). If a proposed mark is merely descriptive or functional, it may not be registered (although a descriptive mark may be registrable on proof that the mark has become distinctive through use in commerce). Lanham Act §§ 2(e, f), 15 U.S.C. §§ 1052(e, f).

Registration is not merely clerical, but rather the result of a substantive examination process and opportunity for interested parties to be heard, in accordance with the Lanham Act and regulations promulgated thereunder. The fact of registration reflects that the claim for rights in the mark has been examined by a Patent and Trademark Office ("PTO") Examining Attorney in accordance with the agency's examining procedures and thereafter published in its Official

Gazette so that any interested party may oppose registration. *See* Lanham Act §§ 1, 2, 7, 12, 13, 15 U.S.C. §§ 1051, 1052, 1057, 1062, 1063.

Courts within this Circuit have recognized that "the presumption of validity is limited to the exact format of the mark as registered." 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 32:137 (4th ed. 2011) (hereinafter "McCarthy") (citing *Beneficial Corp. v. Beneficial Capital Corp.*, 529 F. Supp. 445 (S.D.N.Y. 1982)). In assessing the validity and distinctiveness of a composite mark, the mark must be "tested . . . by looking at it as a whole, rather than dissecting it into its component parts." 2 McCarthy § 11:27. Likewise, "[w]hen the thing claimed as trade dress or a trademark consists of a combination of individual design features, then it is the functionality of the overall combination that controls." 1 McCarthy § 7:76.

The registration certificate defines what the mark is and the goods and/or services it covers. Lanham Act Section 7(a) specifies that the registration "shall reproduce the mark, and state that the mark is registered on the principal register under this chapter, the date of the first use of the mark, the date of the first use of the mark in commerce, the particular goods or services for which it is registered, the number and date of the registration, the term thereof, the date on which the application for registration was received in the Patent and Trademark Office, and

any conditions and limitations that may be imposed in the registration." 15 U.S.C. § 1057(a).

The registration at issue, U.S. Trademark Registration No. 3,361,597, includes a line drawing of the mark showing color and position of the mark, as required at the time of the application by 37 C.F.R. § 2.52(b) (2003), and a verbal description of the mark, in accordance with 37 C.F.R. §2.37 (2003). The drawing and the description serve to provide an accurate description of the mark the applicant seeks to protect as its own, in order to enable the PTO's examination of whether the mark meets the requirements for registration, pursuant to 37 C.F.R. § 2.61.

The drawing and the description (subject to any amendments in the examination process) are included in the registration certificate. The drawing in the registration certificate for the Red Sole Mark is depicted below, the dotted lines not being part of the mark but simply to show position:

The description of the mark as stated in the certificate contains both a claim of color and a description of its position, thus:

> The color(s) red is/are claimed as a feature of the mark.
>
> The mark consists of a lacquered red sole on footwear. The dotted lines are not part of the mark but are intended only to show placement of the mark.

In considering the validity of the Red Sole Mark the District Court failed to analyze the mark as it is registered. Instead, after a glancing recitation of the description of the mark in the registration (Opinion at 448-49), the District Court repeatedly mischaracterized the mark as if it were a broad claim to the color red alone for shoes. *See* Opinion at 450 ("Color alone '*sometimes*' may be protectable as a trademark") (emphasis in original), Opinion at 450 (discussing cases where "courts have approved the use of a single color as a trademark for industrial products"), Opinion at 451 (discussion of "the use of color in a trademark" in the fashion industry), Opinion at 454 (reference to "Louboutin's claim to 'the color red'"), Opinion at 455 (reference to "Louboutin's registered 'the color red'"). This mischaracterization pervades the District Court's Order, tainting its analysis from its very framing of the issue:

> The narrow question presented here is whether the Lanham Act extends protection to *a trademark composed of a single color* used as an expressive and defining quality of an article of wear produced in the fashion industry. In other words, the Court must decide whether there is something unique about the fashion world that militates against extending trademark protection to *a single color*, although such registrations have sometimes been upheld in other industries.

Opinion at 451 (emphasis added).

Thus, rather than evaluate the trademark as registered, the District Court only considered it as "the color red," violating the fundamental principle that a mark must be "tested … by looking at it as a whole, rather than dissecting it into its component parts." 2 McCarthy § 11:27. As the Supreme Court explained 90 years ago, "[t]he commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety[.]" *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents,* 252 U.S. 538, 545-46 (1920); *see also Lane Capital Mgmt*., 192 F.3d at 346 ("[W]hen the mark at issue is a composite mark . . . the question becomes what the purchasing public would think when confronted with the mark as a whole."). Here, not only did the District Court separate the elements of the mark, it also considered just one of them – color – and ignored the remaining elements, namely, the color's positioning on the sole and lacquered finish.

That the District Court fundamentally misread the registration is evinced by its statement that "Louboutin's claim to 'the color red' is, without some limitation, overly broad and inconsistent with the scheme of trademark registration established by the Lanham Act." Opinion at 454. To the contrary, correctly read, the color claim is entirely consistent with the Lanham Act's examination and registration scheme.

The regulation governing drawings in trademark applications, 37 C.F.R. §

2.52, specifies various types of information that must be included to depict the mark sought to be registered. Marks that include "a two or three-dimensional design; color; and/or words, letters, or numbers or the combination thereof in a particular font style or size" require a special form drawing. 37 C.F.R. § 2.52(b). "If the mark includes color, the drawing must show the mark in color, and the applicant must name the color(s), describe where the color(s) appear on the mark, and submit a claim that the color(s) is a feature of the mark." 37 C.F.R. § 2.52(b)(1). If necessary, "a drawing that shows the placement of the mark by surrounding the mark with a proportionately accurate broken-line representation of the particular goods" may be required. 37 C.F.R. § 2.52(b)(4).

The color claim in Louboutin's registration, "The color(s) red is/are claimed as a feature of the mark," is exactly what this requirement calls for. It is not, as the District Court assumed, a broad claim to "the color red," but simply an explanation of one "feature" of the mark in accordance with the regulation – another being the placement of the mark on the outsole as depicted in the line drawing. The final registration issued by the PTO after examination recites each of these aspects of the mark.

Having erroneously construed the mark only as a broad claim to "the color red" for shoes, the District Court compounded its error by failing to grant appellants the "procedural advantage" conferred by the registration, by which "the

defendant bears the burden to rebut the presumption of [the] mark's protectibility by a preponderance of the evidence." *Lane Capital Management,* 192 F.3d at 345 (citing *PaperCutter*, 900 F.2d at 563). In order to meet this burden, the defendant must "proffer evidence that the mark is not valid[.]" *Lemme v. Nat'l Broad. Co.*, 472 F. Supp. 2d 433, 443 (E.D.N.Y. 2007).

But rather than consider evidence proffered by appellees on the question of the mark's invalidity, the District Court engaged in its own "fanciful hypothetical," isolating the red color component of the Red Sole Mark from its other elements, analogizing it to the artist Picasso's use of the color blue, and imagining a suit by Picasso to enjoin Monet from using the same shade. Opinion at 451-52.

This analogy is entirely flawed, because although Picasso did have a "blue period," he did not use blue as a *trademark,* which Lanham Act section 45 defines as a device used "to identify and distinguish [one's] goods . . . from those manufactured or sold by others and to indicate the source of the goods[.]" 15 U.S.C. § 1127. Rather, Picasso used blue as a generic color with which to paint. In equating the Red Sole Mark to Picasso's use of blue, therefore, the District Court necessarily presumed that the mark was *not* a distinctive identifier of appellants' goods, and thus not a valid trademark. Thus, although reciting that the certificate of registration gives rise to a presumption that the Red Sole Mark is valid, Opinion at 450, the court entirely disregarded the presumption.

To analyze the registration properly in accordance with the Lanham Act, the District Court would begin with the presumption that the Red Sole Mark is a distinctive identifier of Louboutin's goods and thus a valid trademark. The court would then consider and weigh the evidence proffered by the parties on the question of validity, and determine whether appellees had rebutted the presumption by a preponderance of the evidence.

According to the District Court, the "thrust and implications" of its analogy are clear: since "[n]o one would argue that a painter should be barred from employing a color intended to convey a basic concept because another painter . . . also staked out a claim to it as a trademark," then, ergo "[t]he law should not countenance restraints that would interfere with creativity and stifle competition by one designer." Opinion at 453.

The District Court based its ruling upon the fashion industry's "dependen[ce] on colors," and the imagined prospect of a "red cloud over the whole industry" that would "cramp[] what other designers could do, while allowing Louboutin to paint with a full palette." Opinion at 454. Had the District Court properly evaluated the mark as "a lacquered red sole on footwear" as specified in the registration, it could not logically have reached its conclusion that if the mark were given protection, "Louboutin would thus be able to market a total outfit in his red, while other designers would not." Opinion at 455.

Indeed, the District Court acknowledged that in the fashion industry, color plus "something more" can be registered as a trademark, noting the examples of the Louis Vuitton "LV" monogram in a pattern with 33 bright colors and the Burberry plaid pattern. Opinion at 451, citing *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 116 (2d Cir. 2006); *Burberry Ltd. v. Euro Moda, Inc.*, No. 08 Civ. 5781, 2009 WL 1675080, at *5 (S.D.N.Y. June 10, 2009). The Patent and Trademark Office has also recognized as valid other trademarks in the apparel industry comprising color plus "something more," such as the red longitudinal heel stripe of Prada S.A., (Reg. No. 2,851,315)[3] and the blue rectangle heel/sole design of Keds Corporation (Reg. No. 1,784,225)[4]. By ignoring the "something more" of the Red Sole Mark – the positioning of the color on the sole and the use of a lacquered finish – the court failed to recognize what the PTO recognized when it issued Louboutin's registration: that this mark, too, is presumptively distinctive and valid.

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[3] Available on the PTO Trademark Applications and Registrations Retrieval (TARR) online service at http://tarr.uspto.gov/tarr?regser=registration&entry=2851315&action=Request+Status

[4] Available on the TARR service at http://tarr.uspto.gov/tarr?regser=registration&entry=1784225&action=Request+Status

II. THE DISTRICT COURT ERRED IN ITS ANALYSIS OF FUNCTIONALITY OF THE RED SOLE MARK.

Having failed both to construe Louboutin's mark properly and to accord Louboutin's registration the presumption of validity, the District Court then proceeded to analyze the validity of the mark at issue; here, too, the court erred. The court asked the wrong question and applied the wrong analysis in finding appellants' Red Sole Mark invalid, framing the issue thus:

> The narrow question presented here is whether the Lanham Act extends protection to a trademark composed of a single color used as an expressive and defining quality of an article of wear produced in the fashion industry.

Opinion at 451.

The question is wrong because it (1) addresses only color, not a color as applied in a specific way (lacquered) to a particular location on shoes, and (2) characterizes the mark as an "expressive and defining quality" instead of giving proper weight to its federal registration and recognition as an indicator of source (the latter despite the fact that the District Court itself apparently acknowledged the Red Sole Mark's secondary meaning at Opinion at 449).

The analysis is wrong because, although framed in terms of "functionality," the District Court actually applied the doctrine of aesthetic functionality, which is among the most controversial of trademark defenses. Moreover, the court failed to use this Court's test for aesthetic functionality.

A. The Functionality Defense to Trademark Infringement Prevents Conflict Between Patent and Trademark Laws.

The functionality defense to trademark infringement was developed to prevent parties from using trademark law to obtain perpetual monopolies on useful articles that instead should be protected by limited-term patents. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 169 (1995). The bedrock of the doctrine is the legitimate need of competitors to use a utilitarian feature that is less expensive, of better quality, or more efficient to manufacture. By ensuring that competitors remain free to copy *useful* product features, the doctrine prevents trademark law from undermining its own and the patent law's pro-competitive objectives. *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001) (dual-spring design that keeps temporary road signs upright was functional and hence not protectable as trade dress).

The Supreme Court has established two tests for determining functionality. Under the first test, commonly referred to as the traditional test, "'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.'" *TrafFix*, 532 U.S. at 32 (quoting *Qualitex*, 514 U.S. at 165). Under the second test, which is commonly called the competitive necessity test, "a functional feature is one the 'exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage[.]'" *Id.* (quoting *Qualitex*, 514 U.S. at 165). Where the design is functional under the traditional

test, "there is no need to proceed further to consider if there is a competitive necessity for the feature." *Id.* at 33.

B. The Concept of "Aesthetic Functionality," Developed in the Ninth Circuit, Has Been Roundly Criticized and Sharply Curtailed Even By that Court.

In contrast to utilitarian functionality, the concept of "aesthetic functionality" considers whether purely aesthetic features might be considered "functional" because of a perceived competitive need to copy an ornamental (as distinguished from utilitarian) product feature. It has been substantially limited by many appellate decisions such as *Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc.*, 457 F.3d 1062 (9th Cir. 2006), in the Ninth Circuit, where the doctrine essentially began with the decision *Pagliero v. Wallace China Co.*, 198 F.2d 339 (9th Cir. 1952). *See* 1 McCarthy § 7:79. Recently, the Ninth Circuit in *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 636 F.3d 1115 (9th Cir.), *opinion withdrawn and superseded on denial of rehearing by* 654 F.3d 958 (9th Cir. 2011), issued an amended decision withdrawing the portion of its decision based on the aesthetic functionality doctrine, as INTA had urged that court to do in its amicus brief in that case.

In *Au-Tomotive Gold*, 457 F.3d at 1064-74, the Ninth Circuit traced the "somewhat checkered history" of aesthetic functionality. In the first case to apply the doctrine, *Pagliero*, the Court found china patterns "functional" because hotels

bought the china solely for its aesthetic characteristics, not because they relied on the patterns to indicate the source of the china.

In 1981, the Ninth Circuit reversed a district court finding that counterfeit handbags were permitted because their designs were aesthetically functional, thus acknowledging a design applied to a fashion accessory as a protectable mark:

> We disagree with the district court insofar as it found that any feature of a product which contributes to the consumer appeal and saleability of the product is, as a matter of law, a functional element of that product. Neither *Pagliero* nor the cases since decided in accordance with it impel such a conclusion.

Vuitton et Fils S.A. v. J. Young Enters., Inc., 644 F.2d 769, 773 (9th Cir. 1981).

The Ninth Circuit further narrowed the aesthetic functionality doctrine, nearly to the point of extinction. *See First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378, 1382 n.3 (9th Cir. 1987) and *Clicks Billiards, Inc. v. Sixshooters Inc.*, 251 F.3d 1252, 1260 (9th Cir. 2001).

Most recently, in *Au-Tomotive Gold*, the Ninth Circuit reiterated the extremely limited scope of the aesthetic functionality doctrine. Specifically, the Ninth Circuit held that purely aesthetic product features that are source-identifying and not functional are entitled to protection as trademarks. Thus, like the approach this Court has taken, the Ninth Circuit held that even aesthetic product features serving a significant non-trademark function are entitled to protection, unless granting trademark protection would stifle legitimate competition. *Au-Tomotive*

Gold, 457 F.3d at 1064. Applying that reasoning, the Ninth Circuit rejected the argument that the Volkswagen and Audi trademarks as applied to key chains and related items were aesthetically functional because the trademarks themselves were "'the actual benefit that the consumer wishes to purchase.'" *Id.* at 1064 (quoting *Vuitton*, 644 F.2d at 773). Rather, the court held:

> Volkswagen and Audi's trademarks undoubtedly increase the marketability of Auto Gold's products. But their "entire significance" lies in the demand for goods bearing those non-functional marks. . . . [S]uch poaching is not countenanced by the trademark laws.

Id. at 1074. Furthermore, if defendant's position were accepted, it

> would be the death knell for trademark protection. It would mean that simply because a consumer likes a trademark, or finds it aesthetically pleasing, a competitor could adopt and use the mark on its own products. Thus, a competitor could adopt the distinctive Mercedes circle and tri-point star or the well-known golden arches of McDonald's, all under the rubric of aesthetic functionality.
>
> . . . Taken to its limits, as Auto Gold advocates, this doctrine would permit a competitor to trade on any mark simply because there is some "aesthetic" value to the mark that consumers desire. This approach distorts both basic principles of trademark law and the doctrine of functionality in particular.

Id. at 1064. *Accord Bd. of Supervisors v. Smack Apparel Co.*, 550 F.3d 465, 487–88 (5th Cir. 2008); *Ferrari S.P.A. v. Roberts*, 944 F.2d 1235, 1246 (6th Cir. 1991); *American Greetings Corp. v. Dan-Dee Imps., Inc.*, 807 F.2d 1136, 1142 (3d Cir. 1986); *Univ. of Ga. Athletic Ass'n v. Laite*, 756 F.2d 1535, 1546 n.28 (11th Cir. 1985); *Chicago Bears Football Club, Inc. v. 12th Man/Tennessee LLC*, 83 U.S.P.

Q.2d 1073, 1084 (T.T.A.B. 2007); 1 McCarthy §7:81.

The same holds true for color marks. As summarized by the Federal Circuit: "Mere taste or preference cannot render a color—unless it is the best, or at least one, of a few superior designs—*de jure* functional." *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 1353 (Fed. Cir. 1999) (internal quotation omitted).

C. Aesthetic Functionality in the Second Circuit Is Confined to Features that Foreclose the Market to Competitors.

In this Court, the doctrine of aesthetic functionality was limited in 1990 and will deny trademark protection only where such protection "would significantly hinder competition by limiting the range of adequate alternative designs." *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76, 81 (2d Cir. 1990); *see also* 1 McCarthy § 7:80, at 7-245 to 7-248 (reviewing analysis of aesthetic functionality in the Second Circuit). To prevail on an argument that a mark is not valid because it is aesthetically functional requires "a finding of foreclosure of alternatives." *Id.* "Thus, in order for a court to find a product design functional, it must first find that certain features of the design are essential to effective competition in a particular market." *Landscape Forms, Inc. v. Columbia Cascade Co.*, 70 F.3d 251, 253 (2d Cir. 1995) (citing *Knitwaves, Inc. v. Lollytogs Ltd.,* 71 F.3d 996, 1005-06 (2d Cir.1995); *Villeroy & Boch Keramische Werke K.G. v. THC Sys., Inc.,* 999 F.2d 619, 621 (2d Cir. 1993); and *Wallace,* 916 F.2d at 79-81); *see also* Restatement (Third) of Unfair Competition § 17 cmt. c (1995) ("A design

is functional because of its aesthetic value only if it confers a significant benefit that cannot practically be duplicated by the use of alternative designs").

Among Second Circuit cases applying the *Wallace* formulation, the decision arguably most on point here is *Knitwaves v. Lollytogs*, although it (like many aesthetic functionality cases) concerns common-law rights in trade dress rather than the registered trademark presented here. The Court rejected defendant Lollytogs' aesthetic functionality defense with respect to the designs on plaintiff Knitwaves' sweaters:

> We find persuasive Lollytogs' contention that the primary purpose of Knitwaves' designs is aesthetic, but we do not agree that protecting the designs would restrict Lollytogs' ability to compete. Since functionality is a defense to a suit for trade dress infringement, "the burden therefore falls on the defendant to prove functionality." *Id.* [*LeSportsac, Inc. v. K Mart Corp.*, 754 F.3d 71 (2d Cir. 1985)] at 76. Lollytogs has adduced no evidence whatsoever that the number of designs available for "fall motif" sweaters is limited, and that consequently extension of trade dress protection to Knitwaves' two sweater designs would restrict Lollytogs' ability to produce alternative competitive designs. . . . Lollytogs thus cannot meet the market foreclosure requirement of functionality.

Id. at 1006; *see also Fabrication Enters., Inc. v. Hygenic Corp.*, 64 F.3d 53, 58 (2d Cir. 1995) ("[A] color or color code, even one that contributes to the function of the product, may be protected under the Lanham Act unless the costs to competition of precluding competitors from using the color are too high.").

Before finding a color or other trademark functional on the basis of aesthetic appeal rather than utility, therefore, a court in this Circuit must determine that the

mark is "essential to effective competition." *Landscape Forms*, 70 F.3d at 253. As explained below, the District Court failed to undertake this analysis properly with respect to the Red Sole Mark.

D. The District Court Failed to Apply the Test for Aesthetic Functionality.

This case presents no issue of *utilitarian* functionality. The District Court cited no evidence that the Red Sole Mark makes appellants' shoes work better, last longer, or cost less. *Cf. Vuitton Et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769, 776-77 (9th Cir. 1981) ("Vuitton luggage without the distinctive trademark would still be the same luggage. It would carry the same number of items, last just as long, and be just as serviceable.").

In this case, appellants cited evidence that the Red Sole Mark actually increases production costs and shows wear more readily than a traditional black or beige outsole. The Red Sole Mark thus conveys no utilitarian advantage. The District Court's novel suggestion that a feature which *increases* cost could be functional for luxury goods evinces the court's flawed conception of utilitarian functionality. *Cf. Stormy Clime Ltd. v. Progroup, Inc.*, 809 F.2d 971, 975 (2d Cir. 1987) ("[A] design feature 'affecting the cost or quality of an article' is one which permits the article to be manufactured at a lower cost . . . or one which constitutes an improvement in the operation of the goods.") (internal quotation omitted) (quoting *LeSportsac, Inc. v. K Mart Corp.*, 754 F.3d 71, 76 (2d Cir. 1985)).

Turning to aesthetics, in *Qualitex*, 514 U.S. at 166, the Supreme Court made clear that a single color which serves a source-identifying function may be registered and protected as a trademark. In the Second Circuit, successful assertion of the aesthetic functionality defense must be based on a showing of market foreclosure, i.e., "limiting the range of adequate alternative designs." Yet this is not what the District Court required; instead, it reached sweeping conclusions about the impact of protection of a color mark in the fashion industry. In fact, in conjecturing that protecting the Red Sole Mark would result in "fashion wars," the court acknowledged the availability to competitors of other colors – including the traditional beige and black – on shoe outsoles, or even placement of the same shade of red in other locations on shoes (although the court wrongly failed to recognize that use of a certain color in a particular location on shoes can serve to identify source, like Prada's red heel stripe registered trademark, discussed above).

Other cases from the apparel industry are precedent for protecting comparable marks consisting of color applied in a specific location or configuration, even to shoes, and even pre-*Qualitex*. For example, as correctly noted by appellants, the red tab on the pocket of Levi's jeans has been protected as a source-identifier. *See Levi Strauss & Co. v. Blue Bell, Inc.*, 632 F.2d 817 (9th Cir. 1980). So has the blue rectangular "kicker" placed on the heel or instep of KEDS sneakers. *See Keds Corp. v. Renee Int'l Trading Corp.*, 888 F.2d 215

(1st Cir. 1989). The District Court's holding that a single-color mark cannot serve as a valid source-indicator in the apparel industry is thus not only unsupported, but flies in the face of contrary decisions.

Finally, in their preliminary injunction briefing, appellees quoted *Jay Franco & Sons, Inc. v. Franek*, 615 F.3d 855 (7th Cir. 2010) in support of their aesthetic functionality argument. *Jay Franco* involved a question of trademark protection for a circular beach towel, a design covered by at least one utility patent and offering the advantage of allowing a sunbather to change positions to follow the sun's rays without adjusting the towel. *Id.* at 858. Although the Seventh Circuit addressed the plaintiff's claim that its round towel was a "fashion statement," the case turned on utilitarian functionality and thus is inapt here.

CONCLUSION

By erroneously construing the Red Sole Mark as merely "the color red," as opposed to the mark that is actually registered, and equating it to just another color in an artist's palette, the District Court ignored the presumption of validity conferred upon the mark by registration under the Lanham Act. By focusing on the aesthetic appeal of "the color red" rather than the likelihood of confusion or dilution with respect to the Red Sole Mark, the District Court's ruling runs afoul of the Supreme Court's teachings in *Qualitex* and *TrafFix*. If the District Court's opinion stands uncorrected, it will have far-reaching consequences for brand

owners and consumers alike. Rights granted as a result of the careful examination process of the Federal trademark registration system could be upended arbitrarily, making it easier for third parties to use the well-recognized brands of others, damaging brand owners and increasing the potential for consumer confusion.

INTA takes no position on whether appellees' monochromatic red shoe is likely to dilute or cause confusion with Louboutin's Red Sole Mark, nor as to which party should ultimately prevail. It asks only that this Court vacate and remand the case for consideration of those issues with a proper analysis of the validity of appellants' mark and a proper analysis of aesthetic functionality.

Dated: November 14, 2011

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to Fed. R. App. P. 32(a)(7)(C), the undersigned hereby certifies that:

1. This brief complies with the type-volume limitation of Fed. R. App. P. 32(a)(7)(B) because this brief contains 6,466 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(a)(7)(B)(iii), as determined by the word processing system used to generate the brief.

2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word 2003 in 14-point, Times New Roman font.

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I hereby certify that a true and correct copy of the foregoing Amicus Curiae Brief was served via ECF this 14th day of November, 2011, upon counsel listed below.

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