

Seeing red

THE CASE:

Christian Louboutin SAS v Abubaker & Ors
 High Court of New Delhi
 25 May 2018

India’s rejection of Louboutin’s sole colour mark shows that many jurisdictions are grappling with the issue of single colour registrations, **Bisman Kaur** and **Raashi Jain** explore




Luxury shoes by celebrated designer Christian Louboutin bear a signature ‘red lacquer sole’. Such is their fame and significance that throughout the world, trademark registration for the colour ‘red’ with respect to shoes has either been acquired by Louboutin or is in the midst of being obtained. But seeking monopoly rights by trademarking a single colour has always proved a difficult feat and Louboutin has met his share of opposition – in the US, the EU and quite recently, in India as well.

The ‘red sole’ is registered as a trademark in India (see table 1) and a December 2017 judgment of the Delhi High Court recognised it as a ‘well-known’ trademark (*Christian Louboutin SAS v Pawan Kumar & Ors*). However, on 25 May 2018 in *Christian Louboutin SAS v Abubaker & Ors*, a different bench of the same court ruled that a single colour is not entitled to trademark protection in India.

Both cases had similar facts – third parties were found selling women’s shoes bearing red soles, though in the latter case, the trademark ‘Veronica’ was also affixed to the shoes. In each instance, Christian Louboutin alleged, *inter alia*, infringement of its registered trademarks, passing off and dilution of trademark rights.

So, what led the court to arrive at a different conclusion the second time around? Under Section 2(m) of the Indian Trade Marks Act, 1999 (‘the Act’), a ‘mark’ includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof. In the court’s opinion, the legislature had intentionally preceded the term ‘colours’ with ‘combination of’, thus disentitling a single colour from passing muster as a ‘mark’. Further, the Act defines a ‘trademark’ as a ‘mark’ capable of being represented graphically and distinguishing the goods or services of one person from those of others. The court reasoned that if a single colour did not qualify as a ‘mark’, it could, under no circumstance, progress to being recognised as a ‘trademark’. Thus,

Table 1: Louboutin’s India TM applications

Registration no	Trademark	Class
1922048		25
2341890		03
2341891		14

Louboutin could not ‘exclusively appropriate’ a single colour and assert trademark rights over it. Using this logic, arguments of a single colour acquiring distinctiveness and serving a trademark function through strong use over time were also dismissed.

Louboutin cited the earlier December ruling in its favour and also the decision in *Deere & Company & Anor v Malkit Singh & Ors*, wherein a single colour ie, green, had been granted protection by the Delhi High Court in respect of agricultural machinery. However, the court said the previous rulings were not binding since they were pronounced without an in-depth analysis of relevant legal provisions. As to whether the registrations in favour of Louboutin could be enforced as ‘device trademarks’, this argument too was dismissed stating that since the ‘soles’ had no standalone existence, interpreting ‘device’ to include ‘colour’ would amount to circumvention of the law.

Section 30(2)(a) of the Act, under which a registered trademark is not infringed if a third party uses it to indicate, *inter alia*, the ‘characteristics of its goods’, was also discussed.

Per the court, the defendants had used ‘red coloured soles’ to enhance the appeal of their shoes; such application of colour functioned as a ‘characteristic’ of the defendants’ shoes and was non-trademark, non-infringing use. ‘Non-trademark use’ was further made clear by the defendants’ use of the word mark ‘Veronica’ to sell their products. Moreover, ‘Veronica’ and ‘Christian Louboutin’ were so dissimilar as trademarks that the possibility of confusion/deception was ruled out. Finding no cause of action, the suit was dismissed.

Summary

The December 2017 decision was hailed as a step forward in the jurisprudence of colour trademarks, but the subsequent ruling has once again raised uncertainty. A parallel development in the EU, where the CJEU has, in a rare disagreement with the Advocate General, recognised Louboutin’s trademark rights in the ‘red sole’ (see p55), outlines how the issue of single colour trademarks is one that many jurisdictions are grappling with. On a positive note, the definition of a trademark has, many a time, been interpreted by the Indian judiciary to be an ‘inclusive’ one; but clarity on the issue will emerge only when more and more colour mark disputes arise before the courts.

Authors



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