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What Do You Care What the Color of my Sole Is?: Analyzing if Copyright Law is a Better Solution for the Those Seeking Protection for Color in the Fashion Industry

Sara Falk
Comment

What Do You Care What the Color of my Sole Is?: Analyzing if Copyright Law is a Better Solution for the Those Seeking Protection for Color in the Fashion Industry

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Abstract

Intellectual property law in the United States offers very limited protection for color elements in fashion design. Recently, the Second Circuit decided that Christian Louboutin, a high-end designer known for shoes with red lower soles, could seek protection under trademark law for a red lower sole that contrasted with the shoe’s upper sole. However, this decision limited Louboutin’s original trademark.

Historically, there has never been a court case dealing with copyrighting color in the fashion industry in the Second Circuit. The Second Circuit noted that this case should have actually been litigated under copyright law and not trademark law. Historically, the usual avenue for seeking protection for color is under trademark law. This Comment applies United States copyright law to the Louboutin case to establish that color should be protected under copyright law. This Comment argues that fashion designers should now seek protection under copyright law, rather than trademark law, to protect their use of color in their designs since copyright law offers more legal rights and protection. Additionally, this Comment will refute the shade confusion and color depletion theories, which legal scholars and courts have used to argue that color should not be afforded protection at all.
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I. Introduction

"It became visually apparent from 50 feet that someone was wearing [Christian] Louboutin; it was a detail recognizable not just to the fashionista but the husband of the fashionista."¹ Christian Louboutin (Louboutin), a high-end fashion designer, uses red lacquer on the lower soles of all his shoes.² The latest reports show that Louboutin’s retail sales exceeded $250 million in 2010 and that Louboutin sells 600,000 pairs of shoes a year.³


² See Kevin Perry, The Secret of my Success: Christian Louboutin, British GQ (Dec. 6, 2012), http://www.gq-magazine.co.uk/style/articles/2012-12/06/christian-louboutin-shoes-interview (discussing how Louboutin paints all of the lower soles of his shoes red).

³ See Sole Provider, Elle (Oct. 28, 2011), http://www.elle.com/fashion/spotlight/christian-louboutin (inquiring why Louboutin has been so successful for 20 years).
As a result of Louboutin’s success, he registered a trademark, shoes with red lower soles, in 2008 with the United States Patent and Trademark Office.\(^4\) Louboutin sued Yves Saint Laurent (YSL) for trademark infringement for selling shoes that also had red lacquer on the bottom soles of their shoes.\(^5\) Louboutin lost their trademark infringement suit in the Southern District of New York and appealed the decision to the Second Circuit.\(^6\)

In September 2012, the Second Circuit in *Christian Louboutin v. Yves Saint Laurent* modified Louboutin’s trademark.\(^7\) Louboutin’s new trademark is now for a red lacquered bottom sole that contrasts with the color of the adjoining upper portion of


\(^7\) Id. at 228 (limiting the mark to a red lacquered outsole that contrasts with the color of the adjoining upper).
the shoe. Therefore, YSL and other companies do not violate Louboutin’s trademark when they manufacture a shoe with red soles when the entire shoe is also red. In footnote 19, the court notes the more appropriate vehicle would have been to use copyright law instead of trademark law. However, because the parties only brought a trademark infringement claim, the court limited their review to trademark law.

In the United States, the Lanham Act governs trademark law. Trademark law offers protection for a word, term, name, symbol

\[\text{Id.} \text{ (changing Louboutin's trademark).}\]

\[\text{Id. at 229 (reversing in part the order of the District Court insofar as it purported to deny trademark protection to Louboutin's use of contrasting red lacquered outsoles).}\]

\[\text{Id. at 223 ("It is arguable that, in the particular circumstances of this case, the more appropriate vehicle for the protection of the Red Sole Mark would have been copyright rather than trademark").}\]


or device that is likely to cause consumer confusion.\textsuperscript{13} In contrast to trademark law, copyright law offers protection for creative expressions.\textsuperscript{14} To establish copyright infringement, a plaintiff must prove two elements: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.\textsuperscript{15} Fashion elements fall under the pictorial,\textsuperscript{17}

\textsuperscript{13} See 15 U.S.C. §§ 1051, 1125(a)(1)(A)(1947) (allowing trademark protection for a mark that is likely to cause consumer confusion, consumer mistake, or consumers to be deceived of the product’s origin); Two Pesos Inc. v. Taco Cabana Inc., 124 F.3d 137, 143 (2d Cir. 1997) (discussing how trademark law allows a merchant to identify its goods and to distinguish those goods from those made or sold by another).

\textsuperscript{14} See, e.g., Lee B. Burgunder, Trademark and Copyright: How Intimate Should the Close Association Become?, 29 Santa Clara L. Rev. 89, 91 (1989) (asserting that original expression is not spontaneously generated, but rather requires human investment).

graphic, and sculptural works category under copyright law, and may be copyrighted if they do not have a utilitarian function.\footnote{See id. at § 101 ("the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article"); see also Kieselstein-Cord v. Accessories by Pearl Inc., 632 F.2d 989, 995 (2d Cir. 1980) (Weinstein, J. dissenting) (stating that a useful article is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information).}

Finally, courts and legal scholars have been hesitant to offer protection under copyright or trademark law for color at all.\footnote{See Christian Louboutin. v. Yves Saint Laurent Am. Inc., 778 F. Supp. 2d 445, 451 (S.D.N.Y. 2011) (arguing that whatever commercial purposes may support extending trademark protection for a single color for industrial goods do not easily fit the unique characteristics that define an article of fashion).} Legal scholars argue that under the shade confusion and color
depletion theories, color should not be protected.\textsuperscript{18} The shade confusion theory is based on the idea that since there are so many external factors than can determine how individuals view color, color cannot be protected.\textsuperscript{19} The color depletion theory is constructed around the idea that if the law starts protecting color, the available colors will eventually run out.\textsuperscript{20}

\textsuperscript{18} See Laura R. Visintine, The Registrability of Color Per Se As A Trademark After Qualitex Co. v. Jacobson Products Co., 40 \textit{St. Louis U. L.J.} 611, 621 (1996) (discussing how courts use the color depletion theory to automatically bar protection for color and the shade confusion theory to assert that discerning whether two shades are similar enough is too difficult for the courts).


\textsuperscript{20} See Campbell Soup Co. v. Armour & Co., 175 F.2d 795, 798 (3d Cir. 1949) (discussing how one cannot trademark red and white alone since it would monopolize red in all of its shades along with other colors and the list of colors will soon run out).
Generally, the fashion industry does not utilize copyright law protection.\(^2\) As a result, there are a limited number of court decisions related to copyright law in fashion. Therefore, this Comment analyzes the Christian Louboutin v. Yves Saint Laurent (hereafter the Louboutin case) under copyright law to determine if that is a better avenue for protection of color in the fashion industry for future cases. It then argues that copyright law in the United States should protect color in the fashion industry. Part II of this Comment analogizes the recent Louboutin case’s court decision with past fashion cases that were decided under United States copyright law as a basis for analyzing the Louboutin decision under copyright law. Part III of this Comment applies United States copyright law and fashion

copyright cases to the Louboutin case. Furthermore, in its application of past fashion copyright cases, this Comment establishes that color should be protected under copyright law by refuting the shade confusion and color depletion theories. Part IV of this Comment recommends that fashion designers use copyright law, rather than trademark law, to protect their use of color. Part V concludes that if the Louboutin case were decided under copyright law, the red sole would have been protected completely; and in the future the fashion industry should use copyright law to protect color in their designs.

II. Understanding Past Fashion Copyright Cases to Establish Copyright Protection for Color in the Future

Traditionally, companies have sought intellectual property protection for color under trademark law.22 However, Judge Jose

22 See Brief of Amicus Curiae Tiffany LLC and Tiffany and Company in Support of Appellants' Appeal Seeking Reversal of the District Court's Decision Denying Appellants' Motion for Preliminary Injunction, Christian Louboutin v. Yves Saint Laurent Am. Inc., 696 F.3d 206, 207 (2d Cir. 2012) (discussing how Tiffany owns trademarks for the robin's egg blue color used on boxes, and on shopping bags); see also McCarthy on Trademarks and Unfair Competition § 8:4.50 (4th ed.) (demonstrating
A. Cabranes of the Second Circuit stated in footnote 19 of the *Louboutin* case that Louboutin should have sought protection for his red sole under copyright law rather than trademark law. To evaluate the *Louboutin* case under copyright law, it is necessary to discuss what is required to receive protection under United States copyright law. Then, it is necessary to analogize protecting color with past court decisions concerning the fashion industry with the *Louboutin* case.

A. Traditional Protection for Color Under the Lanham Act

*Qualitex Co. v. Jacobson Products Co.* is the seminal Supreme Court decision in 1995 that established there was not a special legal rule preventing color alone from serving as a trademark. In this case, Qualitex registered as a trademark the green-gold color of their dry cleaning press pads. Jacobson started producing dry cleaning press pads with the same examples of trademarks such as the “G” shape of the frame of a GUCCI watch, and the shape of Hermès handbags).

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23 See Christian Louboutin v. Yves Saint Laurent Am. Inc., 696 F.3d 206, 223 (stating copyright law should have been used).


color.\textsuperscript{26} Qualitex sued Jacobson for trademark infringement and Qualitex was granted trademark protection.\textsuperscript{27}

B. Protecting Intellectual Property Under United States Copyright Law

Copyright law in the United States is established in the United States Constitution\textsuperscript{28} and codified in the Federal Copyright Act of 1976.\textsuperscript{29} The Federal Copyright Act establishes six rights for the owner of the copyright, and any violation of those six rights is a copyright infringement.\textsuperscript{30}

\textsuperscript{26} See Qualitex, 514 U.S. at 160 (alleging Jacobsen started coloring pads a similar green-gold that Qualitex used).

\textsuperscript{27} See id. at 173 (holding that Qualitex’s use of the green-gold color on its pads meets the basic trademark requirements).

\textsuperscript{28} See U.S. Const. art. I, § 8, cl. 8 (“to promote 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”).


\textsuperscript{30} See id. at § § 107-122 (establishing the right to reproduce the work into copies, the right to create derivative works of the original work, the right to distribute copies of the work to the public by sale, lease, or rental, the right to perform the
1. The Work Must be Original and Creative

In order for an individual to receive copyright approval, the work must be original and creative.\textsuperscript{31} Copyright protection subsists in original works of authorship that are in any tangible medium.\textsuperscript{32} Thus, there is no copyright protection for an idea.\textsuperscript{33}

2. The Finding of Copyright Infringement

An individual’s copyright is infringed upon when their work is actually copied.\textsuperscript{34} A work is actually copied when a defendant admits that he or she copied the work,\textsuperscript{35} the tangible objects look identical, or the objects are substantially similar.\textsuperscript{36}

\textsuperscript{31} Id. at § 102(a).
\textsuperscript{32} Id.
\textsuperscript{33} 17 U.S.C. § 102(b) (1976).
\textsuperscript{34} Id. at § 102(a).
\textsuperscript{35} See Knitwaves Inc. v. Lollytags Ltd., 71 F.3d 996, 1000 (2d Cir. 1995) (discussing how defendant admitted that he used no other design references than the plaintiff’s sweaters).
\textsuperscript{36} See id. at 1002 (establishing that in most cases, the test for substantial similarity is the ordinary observer test, which asks
Thus, an individual must intentionally make significant changes to their item to avoid similarity between other protected items.\(^{37}\)

C. Traditional Protection for Fashion Under the United States Copyright Act

1. Useful Articles are not Eligible for Copyright

The design of a useful article is not eligible for copyright protection.\(^{38}\) A useful article has an intrinsic utilitarian function.\(^{39}\) Additionally, a useful article that has whether an average lay observer would recognize the alleged copy as having been derived from the copyrighted work).

\(^{37}\) See id. (stating that a defendant may avoid infringement by intentionally making changes so the works are not similar).

\(^{38}\) See 17 U.S.C. § 101 (1976) (codifying that features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article are copyrightable).

\(^{39}\) See Inwood Lab. Inc. v. Ives Lab. Inc., 456 U.S. 844, 850 (1982) (discussing that utilitarian functionality is essential to the use, purpose, or cost of the article). C.f. Kieselstein-Cord v. Accessories by Pearl Inc., 632 F.2d 989, 993 (2d Cir. 1980) (holding that if something is physically or conceptually separable, this can be copyrighted).
an aesthetic function cannot be copyrightable. However, an article’s pictorial, graphic, or sculptural features are eligible for copyright protection if they are capable of existing independently from the article’s utilitarian aspects. Historically, courts have identified clothing as useful articles that are not copyrightable since it is generally not possible to separate the utilitarian and design elements.

40 See Coach Leatherware Co. v. Ann Taylor Inc., 933 F.2d 162, 171 (2d Cir. 1991) (declaring that the test for aesthetic functionality is when the court finds the ornamental features would significantly limit the competitive designs available).

41 See U.S. Copyright Office, Compendium II: Copyright Office Practices, Copyrightable Matter: Pictorial, Graphic, and Sculptural Works (1984) at §§ 505.02, 505.03 (describing that the determination of separability may be made on either a physical or conceptual basis) (hereinafter Compendium II).

42 See Wong, supra note 21 at 1145 (discussing how an article of clothing cannot receive copyright protection because clothing is utilitarian in nature). See generally, Susan Scafidi, Intellectual Property and Fashion Design (Peter K. Yu ed. 2007) (describing the interplay of different forms of intellectual property protection for fashion designers).
2. The Pictorial, Graphics and Sculptural Aspects of Useful Articles may be Copyrightable if they are Separate from the Article Physically or Conceptually

The Copyright Office periodically publishes a Compendium, which is the general guide on registration, recordation, and related practices consulted by the Copyright Office staff and the public.\footnote{See Compendium II, supra note 41 (describing the Compendium).} According to the Copyright Office in Compendium II, conceptual separability is described as the "the pictorial, graphic, or sculptural features, while physically inseparable by ordinary means from the utilitarian item, are never the less clearly recognizable as a pictorial, graphic, or sculptural work which can be independent of the shape of the useful article."\footnote{See Compendium II, supra note 41 at §505.03.} In addition, according to the manual, physical separability "derives from the principle that a copyrightable work of sculpture which is later incorporated into a useful article retains its copyright protection."\footnote{See Compendium II, supra note 41 at § 505.05.} Design elements of fashion articles find both of these tests very difficult to meet.\footnote{See Christine Cox and Jennifer Jenkins, Between the Seams, A Fertile Commons: An Overview of the Relationship Between Fashion and Intellectual Property, (Jan. 29, 2005)}
Chosun Int’l Inc. v. Chrisha Creations Ltd. discusses the physical and conceptual tests in the Second Circuit. In this case, Chosun, a designer and manufacturer of Halloween costumes, sued Chrisha for infringement of original animal-themed children’s costumes. Physical separability is when a component of a useful article can be removed from the original item and separately sold, without impacting the article’s functionality. Conceptual separability is where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences. Under copyright protection, color will be categorized as a

http://learcenter.org/pdf/RTSJenkinsCox.pdf at 6 (asserting that copyrights generally are not granted to apparel because articles of clothing are considered useful articles as opposed to works of art). C.f. Barnhart v. Economy Cover Corp., 773 F.2d 411, 418 (2d Cir. 1985) (holding that mannequins used to display clothing were useful articles).

See generally Chosun Int'l Inc. v. Chrisha Creations Ltd., 413 F.3d 324 (2d Cir. 2005) (discussing how an article can be separate from its utilitarian function under copyright law).

Id. at 328 (alleging trademark infringement).

Id. at 329 (describing the elements of physical separability).

Id. (stating the elements for conceptual separability).
conceptually separate element since it cannot be physically separated from the useful article.

D. Fashion Fabric Design Cases Offer the Best Comparison for Future Fashion Color Cases

Comparing past fabric design cases with color is the best way to understand protection since there are not any cases that deal with copyrighting color in the fashion industry.\(^{51}\)

1. Fabric Designs are Considered Writings under Copyright Law

Copyright law was first established in the United States Constitution.\(^{52}\) The word “writings” is broadly construed; it includes all its forms that may be used to the end that the author's ideas are tangibly expressed.\(^{53}\) Fabric designs are


\(^{52}\) See U.S. Const. art. I, § 8 cl. 8 (showing definition for writings under the United States Constitution).

\(^{53}\) See, e.g., Folio Impressions Inc. v. Byer California, 937 F.2d 759, 763 (2d Cir. 1991) (asserting that among those forms of writings entitled to copyright protection are fabric designs).
considered writings for copyright law purposes and are protectable.\footnote{See Whimsicality Inc. v. Rubies’ Costume Co., 891 F.2d 452, 455 (2d Cir. 1989) (asserting that fabric designs are distinguished from dress designs as being copyrightable).} Therefore, color designs should be considered writings because color is used in the same way as fabric designs are. The courts have articulated three tests to find copyright infringement. These include the average lay observer test, the substantial similarity test, and the aesthetics appeal test.\footnote{See generally Danielle E. Gorman, Protecting Single Color Trademarks in Fashion After Louboutin, 30 Cardozo Arts & Ent. L.J. 369 (2012) (discussing the three tests in copyright law).} These tests have factors that the courts use to evaluate copyright infringement.

2. The Average Lay Observer Test

One test for copyright infringement is whether an average lay observer would find a substantial similarity in the designs.\footnote{See Soptra Fabrics Corp. v. Stafford Knitting Mills Inc., 490 F.2d 1092, 1093 (2d Cir. 1974) (establishing that the underlying test for infringement as being whether an average lay observer would find a substantial similarity in the design).} In Soptra Fabrics Corp. v. Stafford Knitting Mills Inc. Soptra sued Stafford for copyright infringement of its
colored geometric fabric design. The judge stated that if one examined the designs up close, one could see slight variations in the design. However, the underlying test for infringement is whether an average lay observer would find a substantial similarity in the designs, and those small differences could not be observed without a rigorous analysis. This case establishes that courts need to look at the average lay observer, and not focus on what can be observed under strict judicial scrutiny.

3. The Substantial Similarity Test

In addition to the average lay observer test, there is copyright infringement if the two items are substantially similar to one another. In Knitwaves, Inc. v. Lollytogs Ltd. In Knitwaves, Inc. v. Lollytogs Ltd.

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57 See id. at 1093 (adjudicating whether the design was merely inspired, or was flatly pirated).
58 See id. (noting the designs’ differences was only obviously dissimilar from a few feet away).
59 See id. at 1094 (discussing how it was important that the two colors used in the dresses were the same).
60 See Concord Fabrics Inc. v. Marcus Bros. Textile Corp., 409 F.2d 1315 (2d Cir. 1969) (holding that even though the patterns in question had some difference in their color and design, the average observer would find them substantially similar).
61 See generally Victoria Elman, From the Runway to the
Knitwaves sued Lollytog for copyright infringement of their Leaf and Squirrel sweaters. The court established that it must examine the work’s total concept and feel when comparing articles to determine if there are substantial similarities between the two items.

The court in Knitwaves also cited Folio Impressions that established a more discerning test when comparing products that

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62 See Knitwaves Inc. v. Lollytogs Ltd., 71 F.3d 996, 997 (2d Cir. 1995) (stating that defendant contends the design was altered so that the sweaters are not substantially similar).

63 See Eden Toys Inc. v. Marshall Field & Co., 675 F.2d 498, 501 (2d Cir. 1982) (holding that two snowmen were not substantially similar since their scarves were different colors, the buttons were the same color but of different sizes, and the snowmen’s heads were different); see also Soptra Fabrics Corp. v. Stafford Knitting Mills Inc., 490 F.2d 1092, 1093 (2d Cir. 1974) (explaining that Lollytogs' sweaters are substantially similar to Knitwaves' since Lollytogs used the same two fall color symbols in the same manner on similar backgrounds).
contain both protectable and unprotectable elements.\textsuperscript{64} In this case, Folio Impressions claimed infringement for their rose fabric design.\textsuperscript{65} The court held that only the roses on the fabric design were copyrightable, but the background was not because it was not original.\textsuperscript{66} However, the court held that the roses were not substantially similar to one another; therefore, there was no infringement.\textsuperscript{67} This case established that a court, when examining a design that has protectable and unprotectable

\textsuperscript{64} See Folio Impressions Inc. v. Byer California, 937 F.2d 759, 766 (2d Cir. 1991) (establishing that when only parts of the design is eligible for copyright protection, the observer's inspection must be more discerning).

\textsuperscript{65} See id. at 762 (alleging copyright infringement of their Baroque rose pattern).

\textsuperscript{66} See id. at 764 (stating a reasonable juror could hold the background was not original).

\textsuperscript{67} See id. at 766 (holding that the roses themselves are not substantially similar since each of the roses in defendant’s pattern are identical, while the roses in the plaintiff’s pattern differ from each other in their details).
elements, may choose to employ a more discerning test in determining if the articles are substantially similar. 68

4. The Aesthetic Appeal Test

Another element in proving copyright infringement is if two designs have the same aesthetic appeal so the ordinary observer could not tell the difference between the two designs. 69 In Peter Pan Fabrics Inc. v. Martin Weiner Corp. Peter Pan sued Weiner for copying the ornamental designs on their fabric. 70 The court observed that the distribution of the symbols on each patterns were not identical. 71 Despite the patterns not being identical, the court held that Peter Pan’s fabric design was

68 See id. (establishing that since only some of the design enjoys copyright protection, the observer's inspection must be more discerning).

69 See generally Elman, supra note 61 at 706 (discussing the ordinary observer test).

70 See Peter Pan Fabrics Inc. v. Martin Weiner Corp., 274 F.2d 487, 488 (2d Cir. 1960) (establishing that Peter Pan registered their Byzantium with the Copyright Office).

71 See id. at 489 (observing that both designs have the same general color, and the symbols resemble each other).
infringed upon since the ordinary observer would not see the disparities, and regard their aesthetic appeal as the same.\textsuperscript{72}

5. Design and Color Elements in Fashion

Certain design elements that are separable from the utilitarian function of the article can be copyrighted.\textsuperscript{73} In \textit{Kieselstein-Cord v. Accessories by Pearl Inc.} Kieselstein-Cord manufactured belts with unique belt buckles.\textsuperscript{74} Pearl Inc. admitted to copying the belt buckle design and selling its imitations.\textsuperscript{75} The court held that the belt buckles were conceptually separable from their subsidiary utilitarian function; therefore, they could be copyrightable.\textsuperscript{76}

\textsuperscript{72} See id. at 489 (holding it is enough the people on the street would think the dresses were the same).

\textsuperscript{73} See \textit{Mazer v. Stein}, 347 U.S. 201, 218 (1954) (holding that artistic designs, not their utilitarian aspects, are protected).

\textsuperscript{74} See \textit{Kieselstein-Cord v. Accessories by Pearl Inc.}, 632 F.2d 989, 990 (2d Cir. 1980) (describing the two belt buckles as having rounded corners, a sculpted surface, and a rectangular cut-out at one end for the belt attachment).

\textsuperscript{75} See id. at 991 (describing how order forms referred to Barry K copy, BK copy, and Barry Kieselstein Knock off).

\textsuperscript{76} Compare \textit{Mazer}, 347 U.S. at 218 (allowing copyright protection for a statute as a base of a lamp) with \textit{Kieselstein-Cord}, 632
Furthermore, the court in Chosun Int’l Inc. v. Chrisha Creations Ltd. held that sculpted animal heads of costumes could potentially be protected. The court stated that Chosun might be able to show that the animal heads evoke in the observer a concept separate from that of the costume’s function.

F.2d at 990 (holding that belt buckles are utilitarian objects which are generally not copyrightable, but these buckles are decorative in nature and used principally for ornamentation).

See Chosun Int'l Inc. v. Chrisha Creations Ltd., 413 F.3d 324, 329 (2d Cir. 2005) (stating that it is at least possible that elements of Chosun's plush sculpted animal costumes are separable from the overall design of the costume).

See id. at 330 (discussing how a jury could find separability from the facts).
Color arrangements in fabric designs are copyrightable.\textsuperscript{79} In \textit{L.A. Printex Indus. Inc. v. Aeropostale Inc.} LA Printex filed action against Aeropostale alleging infringement of a stylized pattern of flowers and branches in their textile designs.\textsuperscript{80} The court followed the Second Circuit’s idea that a court should not dissect the fabric designs into component parts and compare only copyrightable elements in the context of fabric designs, but

\textsuperscript{79} See Greeff Fabrics Inc. v. Spectrum Fabrics Corp., No. 81 CIV. 5426 (RLC), 1981 WL 1384, at *4 (S.D.N.Y. Oct. 23, 1981) (stating that the same design in different colors may give rise to separate copyrights); 1 Melville B. Nimmer & David Nimmer, \textit{Nimmer on Copyright} § 2.14 (Matthew Bender rev. ed. 2011) (asserting that an original combination or arrangement of colors should be regarded as an artistic creation capable of copyright protection, and similarity of color arrangements may create an inference of copying). \textit{But see} Satava v. Lowry, 323 F.3d 805, 811 (9th Cir. 2003) (holding that a sculptor may not prevent others from depicting jellyfish in bright colors, because many jellyfish are brightly colored).

\textsuperscript{80} See \textit{L.A. Printex Indus. Inc. v. Aeropostale Inc.}, 676 F.3d 841, 845 (9th Cir. 2012) (suing for copyright infringement).
rather look at the overall appearance between the articles.\textsuperscript{81} Taking into account the similar color arrangements, the court noted that, although mere variations of color are not copyrightable, similarities in color arrangements are probative of copying.\textsuperscript{82} Therefore, color elements in a design, especially their placement, are copyrightable.\textsuperscript{83}

    Designs elements that are combined in an original way are copyrightable.\textsuperscript{84} In \textit{Yurman Design Inc. v. PAJ Inc.} Yurman claimed that PAJ had infringed five Yurman copyrighted jewelry

\textsuperscript{81} See \textit{id.} at 849 (arguing that the court might have to decide that there can be no originality in a painting because all colors of paint have been used somewhere in the past).

\textsuperscript{82} See \textit{id.} at 851 (holding that the color arrangement of the design is markedly similar to the color arrangement of defendants' design). But see 37 C.F.R. § 202.1(a) (2012) (stating that color is one of the examples of works that are not subject to copyright and applications for registration).

\textsuperscript{83} See \textit{generally} \textit{Yurman Design Inc. v. PAJ Inc.}, 262 F.3d 101, 109 (2d Cir. 2001) (discussing that copyright law may protect a combination of elements that are unoriginal in themselves).

\textsuperscript{84} See \textit{id.} at 112 (establishing that Yurman's position on the copyright claims is that its designs, which express original combinations of unprotectable elements, were infringed upon).
designs. The Second Circuit upheld the jury’s findings that the designs were substantially similar to one another and that the average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.

6. Protecting the Fashion Pattern that Identifies a Brand

Patterns on a designer’s articles that identify the designer’s brand are eligible for copyright protection under the average lay observer, aesthetic appeal and substantially similarity tests. In Coach Inc. v. Horizon Trading USA Inc. Coach sued Horizon Trading for selling counterfeit Coach sunglasses with their “Signature C” design. The court held that the pattern was able to receive copyright protection since

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85 See id. at 107 (alleging infringement of jewelry designs).
86 See id. at 111 (applying the court’s common sense to each design, the jury could have reached that conclusion).
87 See Coach Inc. v. Horizon Trading USA Inc., 11 CIV. 3535, 2012 WL 5451274 at *3 (S.D.N.Y. Nov. 7, 2012) (holding there was substantial similarity between the patterns).
88 See id. at *1 (explaining how Coach has registered copyrights for variations of the “Signature C” design on different items).
an ordinary observer would overlook the disparities between the two items, and regard their aesthetic appeal as the same.  

E. Concerns for Protecting Color Under Intellectual Property

Courts have also relied on legal scholars’ shade confusion and color depletion theories to suggest that color should not be protected under copyright or trademark law at all.

1. Competition will Suffer From Shade Confusion

Shade confusion is a concern in determining whether to grant registration rights to color since many factors other than the product color itself influence a person’s perception of color.  

The combination of wavelengths in sunlight changes throughout the day, which causes individuals to view the object’s color differently.  

Additionally, no color looks alike to the same two people, and in reality most colors are too close

89 See id. at *6 (asserting that the defendants’ products and marks were not distinguishable from Coach products); see also Coach Inc. v. Abner’s Fashion, No. CV 08-8191, 2009 WL 4810179 at *3 (C.D. Cal. Dec. 7, 2009) (upholding the claim since the defendants' configured their marks to resemble Coach's marks).


91 See id. (asserting how sunlight affects color perception).
to be indistinguishable. Finally, there is the argument that courts are unable to analyze the perception of color.

2. The Fashion Industry will Suffer from Color Depletion

Another argument for denying protection for color is the limited supply of colors available. The color depletion theory was described in Campbell Soup Co. vs. Armour & Co. The court held that the red and white background of Campbell’s soup cans

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92 See id. (articulating why color looks different to people and why people cannot actually distinguish between too many colors).

93 See Thompson Medical Co. v. Pfizer Inc., 753 F.2d 208, 213 (2d Cir. 1985) (arguing the judiciary is unable to distinguish between marks). But see J. Christopher Carraway, Color As A Trademark Under the Lanham Act: Confusion in the Circuits and the Need for Uniformity, Autumn Law & Contemp. Probs. 243, 264 (1994) (explaining that courts are able to make decisions distinguishing colors).


95 See Campbell Soup Co. vs. Armour & Co., 175 F.2d 795, 798 (3d Cir. 1949) (asserting a color depletion argument). But see id. at 799 (clarifying that trademark protection is available when the color is combined with other things in a distinctive
were not entitled to trademark protection since this would cause the colors available to eventually run out.\textsuperscript{96}

III. Applying Copyright Law to the Christian Louboutin Court Decision and How This Will Affect Future Color Copyright Cases in the Fashion Industry

Both Louboutin and YSL considered the Louboutin case a victory.\textsuperscript{97} However, the court modified Louboutin’s trademark to include protection only for shoes with a red sole with a contrasting upper sole.\textsuperscript{98} On the surface, this seems to be a simple distinction. However, this is not necessarily true in reality since this raises questions on how contrasting the upper

\begin{footnotesize}
\textsuperscript{96} See id. at 798 (reasoning that if Campbell may monopolize red in all of its shades, another manufacturer could monopolize other colors, the list of colors would soon run out).

\textsuperscript{97} Benjamin Weiser, Shoe Designer Can Protect Its ‘Pop’ of Red, Court Says, \textit{N.Y. Times}, Sept. 5, 2012, at A23 (reporting that Harry I. Lewin, a lawyer for Louboutin, said, “We consider this a significant win for Louboutin”). But see id. (reporting that David H. Bernstein, a lawyer for YSL, said, “For us, it’s a complete victory because it confirms that YSL has the right to use the color red”).

\textsuperscript{98} See \textit{Christian Louboutin v. Yves Saint Laurent Am. Inc.}, 696 F.3d 206, 217 (2d Cir. 2012) (limiting the trademark).
\end{footnotesize}
sole has to be. Take the example of the YSL shoe design that was at issue in this case. The upper sole of the shoe was completely red and so was the lower sole of the shoe; therefore, it did not infringe on Louboutin’s trademark. Yet, what if YSL modifies that design and adds one or a few black accents to the shoe (some black piping, a black buckle, or black rhinestones), is that a contrasting upper sole? This is the question left open by the Second Circuit’s decision. This confusion can be reconciled by applying copyright law to this case. Moreover, even though this case has already been decided, examining it under copyright law will establish that


100 See Louboutin, 696 F.3d at 229 (allowing YSL to produce shoes with a red upper and lower sole).

101 See id. at 219 (discussing how copyright law instead of trademark law would have been more appropriate in this case).

102 Accord Vicki M. Young, Christian Louboutin, YSL Suit Dismissed, Women’s Wear Daily (Dec. 28, 2012),
in the future Louboutin should seek protection under copyright law for their red sole.\textsuperscript{103} Furthermore, by analyzing this case under copyright law, this will guide future fashion designers to seek protection for color under copyright law.

A. The Language of the Copyright Act Allows for Color to be Copyrighted

The language of the Copyright Act does not specifically mention color as being protected; however, courts interpret the

\begin{verbatim}
http://www.wwd.com/fashion-news/fashion-scoops/finally-done-6556656 (reporting that the Manhattan federal district court entered a final order confirming that Louboutin has no further claims against YSL).
\end{verbatim}

\textsuperscript{103} See Weiser, supra note 97 (noting that Harry I. Lewin, a lawyer for Louboutin, said he believed Louboutin might be able to return to court someday and argue that it deserved protection for its red sole, even on monochrome-colored shoes). See generally Stop Fake Christian Louboutin, http://www.stopfakelouboutin.com (last visited Jan. 3, 2013) (showing Louboutin’s commitment to stopping forgeries of his shoes internationally).
Act to decide what is protected.\textsuperscript{104} Therefore, there is nothing that initially precludes the protection of color.

1. Color is Included in the Category of Pictorial, Graphic, and Sculptural Works of the Copyright Act\textsuperscript{105}

Color would be considered a sculptural or graphic element under the Copyright Act. Color is not a pictorial element since it does not depict a picture.\textsuperscript{106} One could argue that a picture could just be a solid color, but the stronger argument can be

\textsuperscript{104} See Kieselstein-Cord v. Accessories by Pearl Inc., 632 F.2d 989, 993 (2d Cir. 1980) (interpreting what is a pictorial, graphic, or sculptural object under the Copyright Act).

\textsuperscript{105} See 17 U.S.C § 101 (1978) (“Pictorial, graphic, and sculptural works include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans”).

\textsuperscript{106} See Merriam-Webster Dictionary 1711 (3d ed. 1981) (defining pictorial as “pertaining to, expressed in, or of the nature of a picture; illustrated by or containing pictures; of or pertaining to the art of painting and drawing pictures, the pictures themselves, or their makers”).
made for color being a graphic element. Color could be considered a sculptural element if it was used in a clothing item that has a three dimensional sculptural elements attached to the article. Yet, the best argument is that color is a graphic element since it demonstrates a clear and effective picture of what brand the designer article is.

A designer’s unique work includes their choice and placement of color; and is therefore a graphic element of a design. Color is both a graphic in the terms of being an

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107 See id. at 990 (giving the dictionary definitions for graphic).

108 See id. at 2044 (defining sculptural as “art of carving, modeling, welding, or otherwise producing figurative or abstract works of art in three dimensions”).


adjective\(^{111}\) and a noun.\(^{112}\) A specific color is an adjective, especially when consistently placed, when it conveys a clear and effective picture of what designer brand an item is.\(^{113}\) Additionally, color could be construed as a noun since placing color on a fashion article is a technique of placing a graphic on an article. Therefore, color is best protected under the graphic element of the Copyright Act.

\(^{111}\) See id. (defining graphic as an adjective as “giving a clear and effective picture; vivid; pertaining to the use of diagrams, graphs, mathematical curves, or the like; diagrammatic; of, pertaining to, or expressed by writing: written, inscribed, or drawn; depicted in a realistic or vivid manner”).

\(^{112}\) See id. (defining graphic as a noun as “the arts or techniques, as engraving, etching, drypoint, woodcut, lithography, and other methods, by which copies of an original design are printed from a plate, block, or the like”).

Further support for why color should be included under copyright law can be seen in the Chosun Int’l, Inc. v. Chrisha Creations, Ltd. case. In this case, the design elements in question were sculpted animal heads of children’s costumes that could be considered conceptually separate elements. This is similar to the Louboutin case where color, like the animal heads, could be considered a graphic element that can be conceptually separated under the Copyright Act. Louboutin proves that the red sole is now equated with the Louboutin brand. Therefore, the addition of the red sole is a graphic element that does not enhance the shoe’s functionality; it is used solely to invoke in the consumer and public the concept that the individual is wearing a Louboutin designed shoe.

114 See generally Chosun Int’l Inc. v. Chrisha Creations Ltd., 413 F.3d 324, 329 (2d Cir. 2005) (discussing conceptually separate elements within in a copyright case).

115 See id. at 328 (holding that Chosun may be able to show that they invoke a concept separate from the clothing’s function).

116 See generally Louboutin, 696 F.3d at 229 (discussing how in pop culture the red sole is linked with the Louboutin brand).

117 See id. at 228 (stating that the court does not need to analyze if the red sole mark is functional).
2. Color is Not Always Part of the Useful Article

As long as one can physically or conceptually remove the color aspect of the article, the Copyright Act will protect color.\textsuperscript{118} As will be discussed below, the red sole on Louboutin’s shoes can be conceptually separated from the useful part of the article because it invokes in the ordinary observer the Louboutin brand. It is true that the use of color could not be removed from the article in every case,\textsuperscript{119} but there is not a complete bar of this in the United States Copyright Act.\textsuperscript{120}

B. The Red Lower Sole is an Original and Creative Design

The use of the red lacquer sole is an original and creative design since no other footwear designer has used a red sole on

\textsuperscript{118} See Chosun, 413 F.3d at 330 (discussing that design elements that can be conceptualized as existing independently of their utilitarian function are eligible for copyright protection).

\textsuperscript{119} E.g. Blue Dresses, Frugal Fashionista Blog (2009), http://frugal-fashionistas.com/2009/01/blue-dresses/ (displaying eight blue dresses to show that blue itself is not protectable).

\textsuperscript{120} See generally 17 U.S.C. § 101 (1976) (stating that pictorial, graphic, or sculptural works can be protected as long as they are not useful articles).
the bottom of their shoes consistently to identify its brand.\textsuperscript{121} In the copyright context, originality means the work was independently created by its author, and not copied from someone else's work.\textsuperscript{122} The level of originality and creativity that must be shown is minimal.\textsuperscript{123} Louboutin has been using his red lacquer sole since he started his business in 1992.\textsuperscript{124}

\textsuperscript{121} See Perry, supra note 2 (quoting Louboutin, “My red soles are a part of my identity because people relate them to me, to my shoes and to my work); Searching for red sole shoes, Google, http://google.com, (search “red sole shoes”) (showing that when one searches red sole shoes every website relates to Louboutin).

\textsuperscript{122} See 17 U.S.C. § 1309(f) (1976) (codifying how the party seeking protection has the burden of establishing originality).

\textsuperscript{123} See, e.g., Alfred Bell & Co. v. Catalda Fine Arts Inc., 191 F.2d 99, 103 (2d Cir. 1951) (determining that all that is required in terms of originality is that the author contributed something more than a merely trivial variation). See Burgunder, supra note 14 (stating that the originality barrier is an easy hurdle because it is met merely by showing that there is some spark of creativity).

\textsuperscript{124} See Marianna Mairesse and Katie L. Connor, Christian Louboutin: In his Shoes, Marie Claire (Feb. 27, 2012), http://www.marieclaire.com/celebrity-
Furthermore, the red sole was used intentionally as part of the design.\textsuperscript{125} YSL argues that they have been making all red shoes since the 1970s, which is before Louboutin even started his brand.\textsuperscript{126} However, the use of the all red shoe was sporadic over the years and the all red shoe has never been solely associated with YSL.\textsuperscript{127} Even if experts in the fashion field recognized

\begin{flushright}
\textit{...lifestyle/celebrities/christian-louboutin-interview (stating that its been twenty years since Louboutin splashed red nail polish on the sole of a shoe and created his design signature).}
\end{flushright}

\textsuperscript{125} See Perry, supra note 2 (quoting Louboutin, “I painted the sole red and it made the colors really pop. From then on, I decided to paint all my soles red”).

\textsuperscript{126} See Defendants/counterclaim-plaintiffs’ Memorandum of Law in Opposition to Motion for Preliminary Injunction at 6, Christian Louboutin v. Yves Saint Laurent Am. Inc., 778 F. Supp. 2d 445, 447 (S.D.N.Y. 2011) asserting that the monochrome style are offered in a line-up of colors that are used on the entire shoe, which has been in existence for years).

\textsuperscript{127} See Brief for Plaintiffs-Counter-Defendants-Appellants and Special Appendix at 9, Christian Louboutin v. Yves Saint Laurent Am. Inc., 696 F.3d 206, 207 (2d Cir. 2012) (establishing that since 1992 all models of Louboutin’s high fashion women’s designer footwear have borne the red outsole mark, and the mark
YSL’s all red shoe as being part of the YSL brand, this has never reached the level of universal recognition in the ordinary observer as Louboutin’s red sole.

Furthermore, Louboutin’s design is original because of his unique combination of elements. This is similar to the Yurman case since Louboutin has taken an element not available for

has become Louboutin's signature and the identifier of Louboutin footwear in the minds of consumers).


copyright protection, a shoe, and arranged it in a unique way by having all of his shoes’ lower soles painted red.\(^{130}\)

Additionally, Louboutin is not seeking protection for the idea of painting lower soles with the color red, but for the express original combination of the color red on the lower sole.\(^{131}\)

Since, Louboutin has originally used the combination of a red sole on all of his shoes, this expression would be available or copyright protection.

C. The Red Lower Sole is not a Useful Article

The only functional use of the red sole is to convey to the consumer and public that the shoe is part of the Louboutin brand. In the Kieslstein-Cord case, the court held that belt buckles were able to receive copyright protection.\(^{132}\)

\(^{130}\) See Yurman Design Inc. v. PAJ Inc., 262 F.3d 101, 111 (2d Cir. 2001) (explaining that what makes Yurman’s design original is the way he recast and arranged those constituent elements).

\(^{131}\) Accord id. at 112 (stating that Yurman’s does not seek protection for their jewelry idea, but the expression of combining those original elements).

\(^{132}\) See Kieselstein-Cord v. Accessories by Pearl Inc., 632 F.2d 989, 993 (2d Cir. 1980) (holding that the primary ornamental aspect of the buckles were conceptually separable).
behind the court’s holding can be equated to Louboutin’s red sole. The red soles would be categorized as graphic elements under copyright law and not as sculptural elements like the belt buckles were here.\textsuperscript{133} However, the court held that the belt buckles could be copyrighted since they were used principally for ornamentation, which is why the red sole is used.\textsuperscript{134}

Additionally, the belt buckles in \textit{Kieselstein-Cord} were equated to jewelry\textsuperscript{135} and creative art\textsuperscript{136}. In the \textit{Louboutin} case, the red

\textsuperscript{133} \textit{See id.} at 990 (stating that the belt buckles are sculptured designs, which allows them to be eligible for protection).

\textsuperscript{134} \textit{See} Interview by Sara Sidner with Christen Louboutin, in Paris, France (Aug. 10, 2012) ("Strangely enough, I really think that shoes are a communication tool between people. And I have been having many examples of that through people"); Irene Rubaum-Keller, \textit{Are Louboutins Really Worth the Splurge? An Investigative Report (Sort of), The Blush Blog} (Mar. 27, 2012) (discussing how she has multiple pairs of Louboutin shoes and gets so many compliments when she wears them).

\textsuperscript{135} \textit{See Kieselstein-Cord}, 632 F.2d at 990 (stating that pieces of applied art, these buckles may be considered jewelry, the form of which is subject to copyright protection).

\textsuperscript{136} \textit{See id.} at 994 (discussing how expert witnesses assert that the buckles rise to the level of creative art).
sole could be considered jewelry or creative art. Even though the red sole is not the classic way that people think about jewelry; jewelry is defined as “any ornament for personal adornment.” Therefore, the red sole can be considered an ornament for personal adornment since women purchase Louboutin shoes for their status symbol, and to be noticed. Owners of Louboutin shoes want the public to notice their red sole when they are walking past them; they are adorning their feet with the red sole. Furthermore, the red sole could be considered a

138 See Mairesse and Connor, supra note 124 (quoting author Simon Doonan, "Louboutins are a total drug, and there is no methadone. The first time you slip into a pair of his shoes with their bright-red soles, you're hooked. More alchemist than cobbler, Louboutin transforms women with the flirtatious peep of a toe and click of a sculpted heel. It's that magic that keeps women coming back — often handing over rent money and savings. Why do women fork it over? Because what they walk away with isn't just a pair of shoes, it's a priceless feeling of feminine power").
piece of creative art since the red sole meets the basic element of originality and creativity as discussed above. \(^{140}\) Moreover, there is further evidence that body ornamentation has been considered an art form since the earliest days. \(^{141}\) The red sole, even though a solid color, could be considered an art form. \(^{142}\) Additionally, individuals want to express to others that they are wearing Louboutin shoes, which could be considered body ornamentation. \(^{143}\) It is true that all individuals wear shoes, so

20, 2011), http://escapeofanartist.wordpress.com/2011/01/20/who-are-you-wearing-golden-globes-red-carpet-watch/ (showing that the only zoomed in pictures of actresses’ shoes on the red carpet are those wearing Louboutin shoes).

\(^{140}\) See Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991) (holding that even a minimal amount of creativity will suffice to deem a work original).

\(^{141}\) See Knitwaves Inc. v. Lollytogs Ltd., 71 F.3d 996, 994 (2d Cir. 1995) (discussing how the ancient Egyptians used various body ornamentation as art).

\(^{142}\) E.g. Yves Klein, Blue Monochrome. Dry pigment in synthetic polymer medium on cotton over plywood, 6' 4 7/8" x 55 1/8", New York, New York (showing a painting as a solid color).

\(^{143}\) See Mairesse and Connor, supra note 124 (discussing why women choose to wear Louboutin shoes).
the definition could be stretched so that everyone is adorning their body with the choice of shoes they wear. However, individuals chose to wear Louboutin’s shoes consistently because of the red sole specifically and what that conveys to the public.\(^{144}\) Individuals wearing Louboutin shoes on the red carpet, in magazine photo shoots, and in their personal lives establish the power of the red sole as ornamentation.\(^{145}\)

The sole of the shoe itself is the useful article of the shoe, not the red sole. The sole of a shoe itself has the utilitarian purposes of keeping the shoe together.\(^{146}\) The red sole could not

\(^{144}\) See id. (articulating the feeling women get while wearing Louboutin shoes).

\(^{145}\) See Hadley Freeman, Christian Louboutin: How killer heels conquered fashion, The Guardian, (Mar. 19, 2010) (stating that seemingly every celebrity under the paparazzi sun has proclaimed their love of the Louboutin); Cat Burglar Barbie by Christian Louboutin, Net-a-Porter, http://www.net-a-porter.com/product/60586 (showing a Barbie doll that Louboutin designed which includes different shoe colors with red soles); Who are You Wearing? Golden Globes Red Carpet Watch, supra note 139 (showing pictures of celebrities on the red carpet).

\(^{146}\) E.g. Desiree Stimpert, Outsole, (2013), http://shoes.about.com/od/choosingtherightstyle/g/outsole.htm
be physically separable since it is not possible to physically remove the color of the sole itself. It is in a conceptual manner that one could separate the color of the sole from the shoe.\textsuperscript{147} The court did not address the functionality question directly in the \textit{Louboutin} case, but the red sole does not serve a utilitarian function since one could remove the red color from the sole of the shoe and the shoe would work exactly the same.\textsuperscript{148} This is similar to the belt buckles in \textit{Kieselstein-Cord} since the belt would work the same if the creative ornamental belt buckle were replaced with an ordinary belt buckle.\textsuperscript{149} The difference is that the ornamental belt buckle, like the red sole, is\

\footnotesize{(discussing how the sole maintains the shape of the shoe, and maintains stability when walking).}

\textsuperscript{147} \textit{Accord} Burgunder \textit{supra} note 14 at 101 (discussing ways to conceptually separate functional and nonfunctional features).

\textsuperscript{148} \textit{See} Christian Louboutin v. Yves Saint Laurent Am. Inc., 696 F.3d 206, 228 (2d Cir. 2012) (showing that the sole is not functional).

\textsuperscript{149} \textit{See} Kieselstein-Cord v. Accessories by Pearl Inc., 632 F.2d 989, 990 (2d Cir. 1980) (describing how the details of the belt buckles are not functional).
conceptually separable from its utilitarian function.\textsuperscript{150} This can be extended to other cases where color could be separated from the utilitarian aspects of the object.\textsuperscript{151}

Furthermore, color arrangements within fabric designs, are subject to copyright protection. In \textit{L.A. Printex Indus. Inc. v. Aeropostle, Inc.} the court held that the idea of a floral pattern is not protectable, but the original selection, coordination, and arrangement of such elements were protectable.\textsuperscript{152} This is similar to the red sole in the \textit{Louboutin} case because the idea of using the color red on a shoe cannot be copyrighted; however, the way Louboutin uses the color red is.\textsuperscript{153} Louboutin’s consistent original placement of the

\textsuperscript{150} See \textit{id.} at 993–94 (holding that decorative belt buckles that were used principally for ornamentation could be copyrighted).

\textsuperscript{151} \textit{C.f. Animal Fair Inc. v. Amfesco Indus. Inc.}, 620 F.Supp 175, 192 (D. Minn. 1985) (holding that a slipper in the shape of a bear’s paw was eligible for copyright protection).

\textsuperscript{152} See \textit{L.A. Printex Indus. Inc. v. Aeropostale Inc.}, 676 F.3d 841, 850 (9th Cir. 2012 (stating that copyright protection is broad, and floral elements in fabric designs can be protected since there are many ways this can be expressed).

\textsuperscript{153} See \textit{Campbell Soup Co. v. Armour & Co.}, 175 F.2d 795, 799 (3d Cir. 1949) (stating that sometimes color alone can meet the
color red on the sole of shoes allows the red sole to be copyrighted. This is similar to fashion patterns that are copyrightable since the pattern can be removed from the object and the object still functions exactly the same. Furthermore, if fashion patterns that contain non-protectable elements are eligible for copyright based on how they are arranged, then color in general should be eligible for copyright protection as long as the color in question meets the tests below.

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See generally Perry, supra note 2 (establishing that the red sole is synonymous with the Louboutin brand).

See L.A. Printex, 676 F.3d at 851 (concluding that stylized fabric designs are entitled to broad copyright protection).

See Soptra Fabrics Corp. v. Stafford Knitting Mills Inc., 490 F.2d 1092, 1094 (2d Cir. 1974) (stating that the quantum of originality in the textile pattern field is not very high).
D. The Red Lower Sole is Synonymous with the Christian Louboutin Brand

The average lay observer would view a red sole shoe and believe that it is a Louboutin shoe.\textsuperscript{157} In Soptra Fabrics Corp. v. Stafford Knitting Mills Inc. Soptra’s geometric fabric design was held to be copyrightable.\textsuperscript{158} The first fact that the court emphasized was that the dress fabric designs notoriously last one year, but this design was in its third successful season.\textsuperscript{159} The fashion industry traditionally has two seasons: spring and fall where designers present new looks at fashion shows across the world.\textsuperscript{160} Therefore, an important element in analyzing the ordinary observer test is if the article in question has been in

\textsuperscript{157} See Defendant/Counterclaim-plaintiffs’ Memorandum of Law, supra note 126 at 10 (describing how Louboutin shoes have become so popular by their widespread media exposure which strengthens the red sole mark with Louboutin in the minds of consumers).

\textsuperscript{158} See Soptra, 490 F.2d at 1094 (asserting that the use of identical colors in both fabrics is a factor in determining that the aesthetic appeal of the fabrics is the same).

\textsuperscript{159} See id. at 1093 (discussing fashion seasons).

\textsuperscript{160} Accord Fashion Calendar, (last visited Jan. 26, 2012), http://www.fashioncalendar.net/content/important-fashion-week-dates (showing the dates for fashion weeks around the world).
consistent use.\textsuperscript{161} Thus, Louboutin’s consistent use of the red sole on the bottoms of all his shoes coupled with the longevity and the consistency of this design needs to be taken into account.\textsuperscript{162} This shows that unlike designs that are “in fashion” for six months and then disappear, the red sole has been a consistent element in all of Louboutin’s shoe designs.\textsuperscript{163}

\textsuperscript{161} See Kieselstein-Cord v. Accessories by Pearl Inc., 632 F.2d 989, 990 (2d Cir. 1980) (using the fact that the Winchester buckle had great success in the marketplace as a reason to give copyright protection to the belt buckle).

\textsuperscript{162} See Christopher Muther, Celebrating 20 years of Heels in Boston, The Boston Globe, Oct 17, 2012
http://www.bostonglobe.com/lifestyle/style/2012/10/17/christian-louboutin-celebrates-years-heels-boston/jbejxx8EGn9qxpTJoqRp30/story.html (describing how for Louboutin’s 20 year anniversary there was retrospective of his work at London’s Design Museum, and a $150 coffee table book).

\textsuperscript{163} See generally Maysa Rawi, ‘Wearing high heels is like having an orgasm’: Christian Louboutin on why his shoes are so popular with women, Daily Mail, Oct. 17, 2011
http://www.dailymail.co.uk/femail/article-2050182/Christian-Louboutin-shoes-popular-women.html#ixzz2J6nPuele

(“Either way, Louboutin, who has been making shoes for 20 years
Therefore, since there has been a twenty-year history of the red sole in the Louboutin brand, it is easier to establish that an ordinary observer would recognize a red sole of a shoe as representative of the Louboutin brand.\footnote{See Muther, supra note 162 (discussing that Louboutin started painting the soles of his shoes red twenty years ago).}

Continuing, in \textit{Soptra}, the court also emphasized that the court needs to look at the color elements to determine copyright infringement.\footnote{See \textit{Soptra Fabrics Corp. v. Stafford Knitting Mills Inc.}, 490 F.2d 1092, 1094 (2d Cir. 1974) (stating that the district judge made an error by only looking to the black and white photos, since the color schemes were not to be overlooked).} Therefore, even though color was not the main element in question in \textit{Soptra}, the court still recognized the importance that color can have when applying the ordinary observer test.\footnote{See \textit{id.} at 1094 (“The designs are enough alike so that a woman wearing plaintiff's (design) in brown and green would exclaim 'There goes my dress' if she saw a woman wearing (defendant's design) in the same color scheme”).} This can be analogized to the \textit{Louboutin} case, where even though the court held that the Louboutin had a trademark for a shoe with a contrasting upper and lower sole, \textit{and has sold 600,000 pairs, certainly knows his market”}.\footnote{See \textit{id.} at 1094 (“The designs are enough alike so that a woman wearing plaintiff's (design) in brown and green would exclaim ‘There goes my dress' if she saw a woman wearing (defendant's design) in the same color scheme”).}
the court should have examined the color element more methodically.\textsuperscript{167} If the court in the Louboutin case had carefully applied the ordinary observer test, they would find that an observer would believe that the red sole on the shoe was indicative of the Louboutin brand regardless if the shoe was all red.\textsuperscript{168} This is important because the courts have emphasized that even if there are variations between the objects, if the


\textsuperscript{168} See, e.g., Essence, http://photos.essence.com/galleries/trend-alert-christian-louboutin-love#119808_119785 (showing many photos of celebrities wearing Louboutin shoes that are not black); Christian Louboutin, http://eu.christianlouboutin.com/de_en/homepage-1/shopby/color_shopby-red.html (showing Louboutin shoes that have red upper and lower soles).
ordinary observer would not see those differences, then the original owner of the copyright is entitled to protection.\footnote{See Knitwaves Inc. v. Lollytogs Ltd., 71 F.3d 996, 1002 (2d Cir. 1995) (discussing the ordinary observer test).}

In the \textit{Louboutin} case, YSL argued that individuals who are purchasing expensive footwear should/would know the difference between an YSL shoe and a Louboutin shoe, yet, this argument is moot.\footnote{See Brief for Defendants-Counter-Claimants at 52, Christian Louboutin. v. Yves Saint Laurent Am. Inc., 696 F.3d 206, 207 (2d Cir. 2012) (“These are expensive products, generally costing around $800 or more per pair, and, as Mr. Louboutin himself has acknowledged, consumers are sophisticated and generally exercise care before making so substantial a purchase”); Hermès Int’l v. Lederer de Paris Fifth Ave. Inc., 219 F.3d 104, 108 (2d Cir. 2000) (discussing how high-end customers are not likely to be confused about the origin of expensive fashion items at the point of sale).} The test is not if a sophisticated buyer would know the difference between the two shoe brands, but if an ordinary observer would.\footnote{See Knitwaves, 71 F.3d at 1002 (stating the court is looking at an ordinary observer).} Therefore, when an ordinary observer sees a shoe with a red bottom, that observer believes it is a Louboutin
shoe, regardless of what color the upper sole of the shoe is.\textsuperscript{172} This is especially true when Louboutin shoes are being worn since an observer sees the red sole in a flash as someone is walking.\textsuperscript{173} Additional support for this can be seen in the recent Footwear News and Saks Fifth Avenue's third annual "Sexy Shoes" contest which named Louboutin’s red studded patent leather pumps as the sexiest shoes of 2012.\textsuperscript{174} These shoes have a completely red upper sole.\textsuperscript{175} Therefore, it is clear that

\textsuperscript{172} See Interview by Sara Sidner (quoting an unidentified female "He's really known for famous red sole"); Usher, \textit{Hot Thing} (RCA Records 2012) ("I am a show hog Christian Louboutins red bottoms"); Jennifer Lopez, \textit{Louboutins} (Epic Records 2009) ("I’m throwing on my Louboutins, watch these red bottoms").

\textsuperscript{173} See Interview by Sara Sidner ("And so, she explained me that one day she was walking in the street and this man looked at her. And then, two minutes after, the man was in front of her and said, "Do you know that you have red soles").


\textsuperscript{175} E.g. id. (showing a picture of the Louboutin shoe).
since Louboutin has become famous by the use of red lower soles, it does not matter what the upper sole’s color is.\textsuperscript{176}

Furthermore, since it has been established that the average lay observer identifies the red sole with the Louboutin brand, this is another reason why the red sole should be copyrightable. In \textit{Coach Inc. v. Horizon Trading USA Inc.}, Coach was able to register an original and creative design with the letter “C” as a copyright.\textsuperscript{177} Obviously, the letter “C” is not a unique design in itself since the letter “C” is used countless times a day in languages across the world. However, since Coach used the letter “C” in a unique and consistent way, it was copyrightable.\textsuperscript{178} This is similar to the use of the red sole. The color red itself is not unique, like the letter “C”, but the

\textsuperscript{176} See \textit{id.} (stating how inescapable the red-soled pumps have been lately with stars wearing them for a good portion of their appearances, while non-celebrity women are painting their off-brand soles red to get the look at a fraction of the price).

\textsuperscript{177} See \textit{Coach Inc. v. Horizon Trading USA Inc.}, 11 CIV. 3535, 2012 WL 5451274 at *1 (S.D.N.Y. Nov. 7, 2012) (establishing that Coach had registered copyrights for several variations of the “Signature C” design on various products).

\textsuperscript{178} See \textit{id.} (stating that the sunglasses use a design consisting of the stylized letter “C” in various combinations).
color red on the Louboutin shoes is used in a unique and consistent way.\textsuperscript{179} Additionally, the court in Coach held that even though the defendants' marks use either combinations of "G"s and "C"s or just "C"s, these letter combinations and the styling of the letters closely resemble the marks held to infringe on Coach's copyright.\textsuperscript{180} Therefore, even though there would be a difference under close judicial scrutiny, this was not enough to hold in the defendant's favor since this would result in consumer confusion because the "Signature C" pattern is so indicative of the Coach brand.\textsuperscript{181}

This is similar to the Louboutin case in which there may be a difference looking closely at the color reds used on the lower soles of the YSL and Louboutin shoes, or by looking at the designs of the shoe.\textsuperscript{182} However, an ordinary observer would

\textsuperscript{179} See Muther, supra note 162 (discussing Louboutin's success).

\textsuperscript{180} See Coach, 2012 WL 5451274 at *2 (holding that some of those marks used combinations of "C"s and "O"s, others used "G"s, but all were held to infringe Coach's marks).

\textsuperscript{181} See id. at *6 (allowing copyright protection since an ordinary observer would overlook the disparities between the two items, and regard the aesthetic appeal as the same).

\textsuperscript{182} See Wolf, supra note 99 (showing pictures of the Louboutin and YSL shoes in dispute).
never notice the difference between a slight red shade
difference or if a certain design of the shoe was more
suggestive of an YSL or a Louboutin shoe.\footnote{183 Accord Soptra Fabrics Corp. v. Stafford Knitting Mills Inc.,
490 F.2d 1092, 1093 (2d Cir. 1974) (discussing how an ordinary
observer would not see the difference in similar patterns).}
One may argue that this means that the color red on the shoes should not be
copyrightable since an ordinary observer cannot see the
difference between subtle shades of red. However, the argument
is not that a designer, including Louboutin, should be granted a
color copyright at the first instance they produce a design.
Rather, once it has been proven that that the specific color and
the placement of that color becomes recognizable of a certain
brand by the ordinary observer, then copyright protection should
be granted. Furthermore, the court in the Louboutin case did
not even discuss that there may be differences in the color red
of the shoes.\footnote{184 See generally Christian Louboutin v. Yves Saint Laurent Am.
Inc., 696 F.3d 206, 219 (2d Cir. 2012) (analyzing both arguments
whether the red sole should be granted protection).}
The court only discussed that there could be

trademark protection for Louboutin if the upper and lower red

soles were contrasting.\textsuperscript{185} The holding of this case actually leads an ordinary observer to be more confused since the design element in question is a red sole, it does not have anything to do with the upper sole.\textsuperscript{186} When an observer sees a red sole, they hardly ever see the upper sole color.\textsuperscript{187} Therefore, the line that the court in the \textit{Louboutin} case drew does not seem to fit into reality of what an actual observer sees. Instead, the court seems to be using a strict judicial scrutiny test, instead of the established ordinary observer test.

Finally, similar to the “Signature C” design that is so synonymous with the Coach brand, the red sole should be protected since the red sole is so representative of the Louboutin brand.\textsuperscript{188} The popularity of the Louboutin brand can be seen in the extraordinary number of counterfeits that are sold

\textsuperscript{185} See id. at 228 (holding that the red sole mark pursuant to Section 37 of the Lanham Act, to a red lacquered outsole that contrasts with the color of the adjoining upper).

\textsuperscript{186} See id. at 215 (focusing the attention in this case on the red sole mark).


\textsuperscript{188} See Hudgens, \textit{supra} note 133 (showing Louboutin’s popularity).
each year. Therefore, if the letter “C” when designed in a
certain way can be copyrighted, then the color red should be
copyrighted when used consistently over a period of time. This
can then be extended to all future potential uses of color in
the fashion industry under United States Copyright Law.

E. The Yves Saint Laurent All Red Shoe Copied Louboutin’s
Shoes with Red Soles

There is a substantial similarity between Louboutin’s shoes
and the YSL shoes in question. In Knitwaves Inc. v. Lollytogs

See Louboutin Red Soles Inspire Women To Paint Their Own
Shoes, Huffington Post, July 10, 2012,
http://www.huffingtonpost.com/2012/07/10/louboutin-shoes-red-
soles_n_1662364.html (discussing how sales of red paint in the
UK have increased because women are painting the bottom of their
shoes red); CBP Seizes More than 18 Million in Fake Women's
Fashion Shoes, Newsodrome, Nov. 17, 2012,
http://newsodrome.com/crime_news/cbp-seizes-more-than-18-
million-in-fake-women-s-fashion-shoes-33133904 (reporting of a
recent seizure by the USCBP of over 20,000 counterfeit Louboutin
shoes with an estimated retail value of $18 million); supra note
108 (illustrating Louboutin’s campaign to stop counterfeiters).

See Knitwaves Inc. v. Lollytogs Ltd., 71 F.3d 996, 1002 (2d
Cir. 1995) (stating that to prove infringement, a plaintiff with
Lollytogs infringed on Knitwaves copyright since they used substantially similar elements on their sweaters.\textsuperscript{191} The elements of the sweaters not only contained design elements of the fall motif, but the designs used innovative color schemes.\textsuperscript{192} The use of the innovative color scheme can be compared to the Louboutin case since the YSL shoes used an almost identical color scheme compared to the Louboutin shoes.\textsuperscript{193} Therefore, since the overall impression of the shoes, like the sweaters in Knitwaves, is due to the unique color scheme (red lower soles on the shoe), the

\begin{footnotesize}
\begin{itemize}
  \item \textsuperscript{191} See \textit{id.} at 1004 (holding that an observer viewing the sweaters side by side cannot help but perceive them as coming from one creative source).
  \item \textsuperscript{192} See \textit{id.} at 997 (using fall colors instead of bright colors that are usually used in children’s clothing).
  \item \textsuperscript{193} See Christian Louboutin v. Yves Saint Laurent Am. Inc., 696 F.3d 206, 213 (2d Cir. 2012) (discussing that the YSL shoes in the monochrome style feature the same color on the entire shoe, so that the red version is all red).
\end{itemize}
\end{footnotesize}
red sole should be copyrighted.\textsuperscript{194} Furthermore, the court in \textit{Knitwaves} recognized that there were differences between the sweaters by how the appliques were placed, but that these differences were not enough to hold that there was not copyright infringement.\textsuperscript{195} This is similar to the \textit{Louboutin} case where the differences in detail, which requires considerable scrutiny to describe, do not lessen a viewer’s overwhelming impression of the two brands of shoes.\textsuperscript{196} YSL makes the argument that since both YSL and Louboutin are expensive brands, individuals will be educated about the two brands before choosing which shoe to purchase.\textsuperscript{197} However, this argument actually adds to the idea that the shoes have the same total feel and concept since buyers are making a choice between shoes that both have a red sole, are both very expensive, and both have similar design elements.\textsuperscript{198}

\textsuperscript{194} See \textit{id.} (stating that Louboutin is best known for his emphasis on the otherwise largely ignored outsole of the shoe).

\textsuperscript{195} See \textit{Knitwaves Inc. v. Lollytogs Ltd.}, 71 F.3d 996, 1001 (2d Cir. 1995) (observing that \textit{Knitwaves’} and \textit{Lollytogs’} sweaters had different arrangements of leaves).

\textsuperscript{196} \textit{C.f. id.} at 1004 (requiring the overall impression).

\textsuperscript{197} See Brief for Defendants-Counter-Claimants, \textit{supra} note 175 (asserting that educated buyers are buying designer shoes).

\textsuperscript{198} See \textit{Wolf, supra} note 99 (showing pictures of both shoes).
In addition, the court in Folio Impressions discussed a more discerning ordinary observer test.\textsuperscript{199} This discerning test would also uphold the red sole as being copyrightable since the court held that how the stylized roses were arranged is what made them copyrightable.\textsuperscript{200} This can be analogized to the Louboutin case since it is not the color itself that is copyrightable, as red is not an original or unique design, but what is copyrightable is the placement of the red of the sole of the shoe.\textsuperscript{201}

Finally, the Louboutin shoes and YSL shoes with red soles have the same aesthetic appeal. In Peter Pan Fabrics, Inc. v. Martin Weiner Corp. the court examined the two fashion patterns and determined that they resembled each other, but were not

\textsuperscript{199} See Knitwaves, 71 F.3d at 1002 (stating that when the court compares products that contain both protectable and unprotectable elements, the inspection must be more discerning).

\textsuperscript{200} See Folio Impressions Inc. v. Byer California, 937 F.2d 759, 765 (2d Cir. 1991) (stating that what is protected is the rose itself and the way in which that rose is arranged).

\textsuperscript{201} See Hamil America Inc. v. GFI, 193 F.3d 92, 103 (2d Cir.1999) (holding the arrangement of the floral patterns were substantially similar).
identical. This is similar to the Louboutin case, since unless one sets out to detect the disparities between the two shoes, these disparities would be overlooked and an individual would regard their aesthetical appeal as the same. Both the Louboutin and YSL shoes have a red upper and lower sole with very high heels and a stacked platform. Both shoes appear to have a logo on their lower sole, but it is not clear what that logo is unless one picks up the shoe and looks at it closely. The YSL shoe in question has a suede upper sole with seam lines, whereas the Louboutin shoe has a seamless patent leather upper sole. There is also a thicker heal on the YSL shoe with a black bottom as compared to the Louboutin shoe’s thinner heel with a tan bottom. However, the issue in this case is not whether the designs of the shoes have a difference, which they

202 See Peter Pan Fabrics Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960) (observing that both designs have the same general color and symbols that resemble one another).
203 See Wolf supra note 99 (viewing the pictures of the two shoes in question side by side).
204 Id. (looking at the two shoes at different angles).
205 Id. (viewing bottom of the two shoes).
206 Id. (examining the two shoes).
207 Id. (assessing the lower sole of the two shoes).
do, but whether their aesthetic appeal is the same such that
that the ordinary observer would believe that the same designer
designed these two shoes.\textsuperscript{208} This is similar to the fabric
pattern in \textit{Peter Pan Fabrics} in which copyright infringement was
found when both fabric designs had the same general color, and
the symbols resembled each other but were not identical.\textsuperscript{209} In
the \textit{Louboutin} case, when looking at the YSL and Louboutin shoes
side by side, one cannot tell which designer designed either
shoe since they have so many of the same aesthetic qualities, as
discussed above. The characteristic that makes the aesthetic
appeal the same is the red lower sole that both shoes have.\textsuperscript{210}
Obviously, there are countless designers that make shoes with

\textsuperscript{208} See \textit{Inwood Lab., Inc. v. Ives Lab., Inc.}, 456 U.S. 844, 851
(1982) (asserting that a mark has secondary meaning when that
product feature is used to identify the source of the product
rather than the product itself).

\textsuperscript{209} See \textit{Peter Pan Fabrics Inc. v. Martin Weiner Corp.}, 274 F.2d
487, 489 (2d Cir. 1960) (discussing the differences and
similarities of the two fabric designs).

\textsuperscript{210} See \textit{Soptra Fabrics Corp. v. Stafford Knitting Mills Inc.}, 490
F.2d 1092, 1094 (2d Cir. 1974) (asserting that defendant's
fabrics having identical colors to plaintiff’s helps lead to the
conclusion that the aesthetic appeal is the same).
upper red soles.\textsuperscript{211} Therefore, what makes the aesthetic appeal of the shoes the same to an ordinary observer is the lower red sole. Louboutin is entitled to copyright protection, but YSL is not since both red sole shoes the same aesthetic appeal, and it has been established that the red sole elicits recognition of the Louboutin brand in the ordinary observer.\textsuperscript{212}

F. The Shade Confusion and Color Depletion Theories should not Apply to all Color Aspects of Fashion Design

The major criticisms against copyrighting color are the shade confusion and color depletion theories.\textsuperscript{213} The shade confusion theory asserts that there are so many external factors that determine how an individual views color, and that a court should not be making distinctions between colors.\textsuperscript{214} Therefore, there should not be any copyright protection for color.\textsuperscript{215} Yet, this

\textsuperscript{211} See generally Nordstrom, http://shop.nordstrom.com/(showing many different types of red shoes).

\textsuperscript{212} See generally part III.

\textsuperscript{213} See Visintine, supra note 18 (discussing the theories of why color should not be protected under intellectual property law).

\textsuperscript{214} See U.S. Resp. Brief, supra note 19 (explaining the shade confusion theory and why this should ban protection for color).

\textsuperscript{215} See Visintine, supra note 18 (stating color should not be protected).
theory should not apply to every aspect of color copyright in the fashion world. In any fashion pattern case, the pattern can be viewed different by each individual or depending on the lighting. Yet, these are eligible for copyright protection as long as they meet the average lay observer, substantial similarity and aesthetic appeal tests established above.\textsuperscript{216} Additionally, any object at all that can be offered copyright protection can look different depending on the time of day, lighting available, and the individual viewing it.\textsuperscript{217} Therefore, there should be no difference for color copyrights.

Furthermore, courts have asserted in past fashion copyright cases that they need to decide each case \textit{ad hoc}.\textsuperscript{218} Therefore, courts have the ability to look at the facts of each case. The court during its analysis can weigh various factors in determining whether or not the copyright should be granted.

\textsuperscript{216} \textit{Accord} Yurman Design Inc. v. PAJ Inc., 262 F.3d 101, 110 (2d Cir. 2001) (discussing the tests for copyright protection).


\textsuperscript{218} \textit{See} Elman, supra note 61 ("the decisions will be \textit{ad hoc}").
Also, since when have courts not taken a case because it would involve the judge(s) looking at specific details? Therefore, if they are able to evaluate other intellectual property cases, including fashion design cases, with a discerning eye, it does not seem farfetched that this same attention is applied to cases involving color copyright.

The color depletion theory asserts that there are only a limited number of colors available, so if the law allows color to be copyrighted, then the world will eventually run out of colors. However, there are numerous cases where color is

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219 See, e.g., Qualitex Co. v. Jacobson Products Co. Inc., 514 U.S. 159, 167 (1995) ("We do not believe, however, that color, in this respect, is special. Courts traditionally decide quite difficult questions about whether two words or phrases or symbols are sufficiently similar, in context, to confuse buyers. They have had to compare, for example, such words as “Bonamine” and “Dramamine” (motion-sickness remedies), and “Huggies” and “Dougies” (diapers)"). See generally Yurman, 262 F.3d 101 (examining pattern of “Cs” on handbags); Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co., 292 F. Supp. 2d 535, 539 (S.D.N.Y. 2003) (examining dragon designs on pants).

Furthermore, in fabric design cases, those patterns are copyrightable. For example, in the Coach case, the signature “C” design was deemed to be copyrightable. However, there are only twenty-six letters in the alphabet, far less than the number of colors there are. Competition in the fashion world has not been hindered because a company cannot use

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221 Currently Register Color Trademarks, Patents+TMS, P.C. Blog, 2008 http://blog.patents-tms.com/?p=52 (giving examples of color trademarks such as orange for Home Depot, and red for Target).

222 See generally Malden Mills Inc. v. Regency Mills Inc., 626 F.2d 1112, 1114 (2d Cir. 1980) (holding that fabric which comprised of a large tree leaning over a body of water could be copyrighted); Soptra Fabrics Corp. v. Stafford Knitting Mills Inc., 490 F.2d 1092, 1094 (2d Cir. 1974) (holding a copyright valid for a design printed upon cloth).


the “C” design.\textsuperscript{225} This actually promotes creativity since individuals have to come up with new designs.\textsuperscript{226} Therefore, it is not the color itself that would “run out”, but the specific placement of that color.\textsuperscript{227} The competition will not be hindered since they cannot use red on the lower sole of the shoe anymore than a brand that cannot use “Cs” in the specific way that Coach does. Additionally, in the Folio Impressions case and the Knitwaves case, there was copyright protection available to a rose pattern and a leaf/squirrel pattern respectively.\textsuperscript{228} If one

\textsuperscript{225} See The Glossy Posse, \textit{The Economist}, (Oct. 1, 2011) http://www.economist.com/node/21530989 (reporting that LVMH, a French group which owns 60 brands boasts that its sales have risen by 13% in the first half of this year, to $14.4 billion).

\textsuperscript{226} Kevin Tu, \textit{Counterfeit Fashion: The Interplay between Copyright and Trademark Law in Original Fashion Designs and Designer Knockoffs} \textit{Tex. Intell. Prop. L.J.} 419, 446 (2010) (asserting that without copyright protection, the incentives to create new designs greatly diminish).

\textsuperscript{227} C.f. Coach, 2012 WL 5451274 at *6 (showing how designers cannot use the letter “C” in the same manner as Coach does).

\textsuperscript{228} See Knitwaves Inc. v. Lollytogs Ltd., 71 F.3d 996, 1003 (2d Cir. 1995) (establishing the roses could be copyrighted); Soptra
equates the color depletion theory to an “object depletion theory”, both these objects are seemingly common objects that
would now never be able to be used again. However, it is not
the objects themselves in fashion pattern cases that are deemed
copyrightable, but the placement and arrangement of these
objects. This would be the criterion for copyrighting color.
Therefore, the red sole is copyrightable not because of the use
of the color red, but because of the consistent and recognizable
placement of the color red on the lower soles of shoes.

IV. The Fashion Industry Should Now Seek Protection Under
Copyright Law To Protect their Use of Color in their Designs

It is more advantageous for fashion designers to seek
protection under United States copyright law for their use of
color in their designs. The most basic reason is that copyright
law offers more protection for the creator of the design
compared to trademark law both domestically and

Fabricics Corp. v. Stafford Knitting Mills Inc., 490 F.2d 1092,
1094 (2d Cir. 1974) (finding copyright infringement).

229 See generally Folio Impressions Inc. v. Byer California, 937
F.2d 759, 763 (2d Cir. 1991) (establishing the placement of the
rose was the reason the copyright would be upheld).
internationally.\textsuperscript{230} When one obtains a copyright domestically for works created after January 1, 1978, the copyright protection lasts for the life of the author plus an additional 70 years.\textsuperscript{231} These works do not have to be renewed.\textsuperscript{232} Therefore, a designer does not have to worry about their copyright for their lifetime and the company can use it for an additional 70 years after the designer dies.

Contrastingly, in trademark law, the mark must be continuously used to maintain rights in relation to that mark.\textsuperscript{233} A trademark can be abandoned or its registration can be cancelled or revoked if the mark is not continuously used.\textsuperscript{234} However, copyrights cannot be abandoned.\textsuperscript{235} A copyright owner can generally enforce their rights without taking any particular

\textsuperscript{231} 17 U.S.C. § 302(a) (1976).
\textsuperscript{232} Id. at § 102.
action to maintain the copyright.\textsuperscript{236} Thus, copyright law is more advantageous for the fashion industry to seek protection for color since fashion designers could not use their copyrighted color element for a few seasons and not worry about the intellectual property rights being revoked.\textsuperscript{237} Furthermore, many design houses may not have huge legal teams that can actively police violations of their color trademark; therefore, it would be more beneficial to have a color copyright since it is not necessary to actively police the copyright.\textsuperscript{238}

\textsuperscript{236} See generally 17 U.S.C. § 101 (1976); Berne Convention, infra note 239 at 229 (showing that in all countries where the Berne Convention standards apply, copyright is automatic, and need not be obtained through official registration with any government office).

\textsuperscript{237} Emily S. Day, Double-Edged Scissor: Legal Protection for Fashion Design, 86 N.C. L. Rev. 237, 249 (2008) (asserting how trademark law provides little protection against copying since designer’s logos are usually very subtle).

In the international context, it is more advantageous for an individual to seek protection under copyright law. The Berne Convention is an international agreement governing copyright law.\textsuperscript{239} The Madrid Agreement is an international agreement governing trademark law.\textsuperscript{240} There is more protection globally for a copyright registered under United States law under the Berne Convention since 165 countries have agreed to it.\textsuperscript{241} Whereas, the Madrid Agreement offers a more harmonious way of filing for a trademark internationally and only has 86 countries as parties to the agreement.\textsuperscript{242} Since so many successful fashion

\textsuperscript{239} See Berne Convention, June 30, 1972, 25 U.S.T. 1341, 828 U.N.T.S. 11850 (showing an international copyright agreement).

\textsuperscript{240} See Madrid Agreement, June 30, 1972, 106 U.S.T. 41, 828 U.T.T.S. 11852 (showing an international treaty for trademarks).

\textsuperscript{241} See Berne Convention, supra note 239 at 223-27 (listing all the countries that are members of the Berne Convention).

\textsuperscript{242} See Madrid FAQs, United States Patent and Trademark Office, http://www.uspto.gov/trademarks/law/madrid/index.jsp (discussing that the protocol is a filing treaty and not a substantive harmonization treaty since while an international registration may be issued, it remains the right of each country or contracting party designated for protection to determine whether or not protection for a mark may be granted).
design companies have their products sold internationally, especially if they have gained recognition to register color as a copyright, the Berne Convention would be more advantageous.\textsuperscript{243}

Additionally, courts have established that a design element is not able to obtain a trademark under the Lanham Act if protecting this trademark would significantly limit the range of competitive designs available.\textsuperscript{244} It would probably be difficult to establish under trademark law that protecting a color in a designer’s object would not significantly limit the range of competitive designs available since color is more limiting than a fabric pattern. The shade depletion theory is more likely to be held valid under trademark law because of this reason.\textsuperscript{245}

Yet, copyright law does not have the requirement that the copyrightable element not significantly limit the range of


\textsuperscript{244} See Coach Leatherware Co. v. Ann Taylor Inc., 933 F.2d 162, 171 (2d Cir. 1991) ("We are concerned that the grant of such broad relief chills competition excessively").

\textsuperscript{245} See Visintine, supra note 18 at 615 (discussing why courts have banned registration for color trademarks).
competitive designs available.\(^{246}\) Therefore, as long as color can meet the tests established above for copyright law, color would be eligible for copyright protection.

The advantages of using copyright law to protect color are evident in the different outcomes of the Louboutin case. If Louboutin had copyrighted his lower red sole, instead of trademarked it, then the court would have upheld the copyright of a lower red sole for all shoe designs regardless of the upper soles color.\(^{247}\) The court changed Louboutin’s trademark to a red sole mark with a contrasting upper sole only, since it would preclude competitors’ use of red outsoles in all situations.\(^{248}\) However, the use of the red sole under copyright law does not preclude other designers from making a red shoe. The copyright just precludes the use of a red upper sole with a red lower sole. Furthermore, the modification of the trademark in the Louboutin case not only affects Louboutin’s business, but will


\(^{247}\) See generally part III.

\(^{248}\) See Christian Louboutin v. Yves Saint Laurent Am. Inc., 696 F.3d 206, 222 (2d Cir. 2012) (stating that the court needs to look at if granting the right to use the mark exclusively would put competitors at a significant disadvantage).
affect future designer’s businesses as well.\textsuperscript{249} The definition of a contrasting upper sole is not definitive. Hence, companies trying to litigate this difference could spend an unknown amount of capital in litigation costs.\textsuperscript{250} Therefore, fashion companies should seek protection under copyright law for color in the future instead of trademark law.

V. Conclusion

The Christian Louboutin case against Yves Saint Laurent will start a new trend in protecting color in the fashion industry. At this point, most fashion companies seek protection for color under trademark law.\textsuperscript{251} However, Judge Jose A.

\textsuperscript{249} See Benton, supra note 238 at 108-111 (discussing how much money companies spend to curb infringement).

\textsuperscript{250} See Litigation Cost Survey of Major Companies: Statement Submitted by Lawyers for Civil Justice Civil Justice Reform Group U.S. Chamber Institute for Legal Reform, Duke Law School May 10–11, 2010, at 2 (demonstrating that the average outside litigation cost per respondent was nearly $115 million in 2008, up 73 percent from $66 million in 2000).

\textsuperscript{251} See Brief of Amicus Curiae Tiffany, supra note 22 at 15 (explaining how Tiffany’s is now using its trademark blue in handbags and apparel). See generally Heyman, supra note 233
Cabranes’ footnote suggested that companies should now seek protection under copyright law. After analyzing the case under copyright law, it is clear that fashion companies should now look into copyrighting their original color designs and placements in the future.

(discussing how companies are using trademark law more than copyright law).