

PEARLS OF LAW

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The Louboutin Story: Lessons for the Nigerian Fashion Industry

find it rather interesting that the red soles of Louboutin shoes are protected by trade mark law in some countries. Christian Louboutin described the moment he created the red soles, he grabbed the nail polish his assistant was holding and it made the shoes he was working on pop. All this is history as the red soles have become associated with luxury and celebrity. Louboutin sold 700,000 pairs of shoes in 2012. According to *The New Yorker*, he sells more than 500,000 pairs of his footwear each year. This is quite remarkable for a brand that had its beginnings in 1992 in a boutique at 19 Jean Jacques Rousseau in Paris.

Louboutin's success is not only as a result of the sophisticated and unique design of his footwear but is also directly linked to Christian Louboutin's efforts to jealously guard his brand, particularly his brand identity. Since 2011 he has initiated several trademark infringement claims against various designers and fashion houses for imitating his red soles.

One of such claims involved the famous American designer Yves Saint Laurent (YSL), the dispute arose when YSL launched a collection of shoes of different colours, each with a sole that matched its upper – end including red shoes with red soles. YSL argued that Louboutin could not prevent other brands from creating red shoes with red soles. Initially, the Federal Circuit Court rejected Louboutin's claim that a single colour could be protected by copyright law. The district judge stated that in fashion design, aesthetics are important. To give trademark protection to a colour in the fashion context, would be to give Louboutin an advantage over its competitors: "Louboutin's claim would cast a red cloud over the whole industry, cramping what other designers do, while allowing Louboutin to paint with a full palette." Judge Marrero also stated



that, "Louboutin is unlikely to be able to prove its red outsole brand is entitled to trademark protection, even if it has gained enough public recognition in the market to have acquired secondary meaning." Furthermore, The Court observed that: "The law should not countenance restraints that would interfere with creativity and stifle competition by one designer, while granting another a monopoly invested with the right to exclude use of an ornamental or functional medium necessary for free and most productive artistic expression by all engaged in the same enterprise."

In my opinion the trial judge failed to look beyond the issue of functionality, to realise that the red-soles have become so closely associated with the brand, that any similar design might confuse customers and dilute Louboutin's brand identity, this is similar to the distinctiveness of the blue used by Tiffany for packaging its jewellery

and accessories which is protected under US trademark law. Interestingly, Tiffany filed an amicus curiae brief in support of Louboutin's position dealing with the right to trademark a colour.

Thankfully, the decision of the trial court in the Louboutin and YSL case was overturned on appeal, the 2nd US Circuit Court of Appeals held that the red soles were a "distinctive symbol that qualifies for trademark protection." The protection given by the court only applied to shoe designs where the upper soles contrasted with the red soles, and did not apply when the soles of the shoes were the same colour with the upper part of the shoes, this might led to confusion for customers.

Other infringement claims instituted by Louboutin include **BELGIUM - LOUBOUTIN v DR. ADAMS FOOTWEAR** In 2013, Louboutin filed a suit based on the infringement of the Benelux trademark against Dr.

Adams. Although, the Court of First Instance of Brussels declared the trademark invalid. The decision was reversed by the Brussels Court of Appeal, who prohibited the sale of shoes with red soles by Dr. Adams. In **NETHERLANDS - LOUBOUTIN v VAN HAREN** Louboutin sought an injunction from the court to prevent a Dutch designer from selling shoes from its collection called "5th Avenue by Halle Berry" Which had red soles. In April 2013, the District Court of The Hague granted Louboutin a preliminary injunction against Van Haren stating that it should stop manufacturing and selling black and blue shoes with red-soles, and pay Louboutin's court costs and legal fees. The court held that Louboutin used in a consistent and sustainable way the red soles on all its high heel shoes. Therefore, the public associated the red sole mark with Louboutin and the Van Haren design was likely to cause confusion among members of the public.

The narrative above leads to this pressing question; what are African Designers doing to protect their designs from copyright infringement. African designs are becoming increasingly popular in the global fashion industry for example singers Beyonce and Rihanna as well as Hollywood actress Kerry Washington have worn outfits by Nigerian designers. American First Lady Michelle Obama wore a blouse by Nigeria's Maki Oh once on a trip to South Africa once. Oh, was discovered by New York fashion editors, at the tender age of 26. Another international recognised brand is Jewel by Lisa owned by Lisa Folawiyi, which combines luxury embellishments with traditional fabrics to deliver unique pieces, her designs have been displayed in New York and sold at Selfridges. Her clothes have been worn by African and international celebrities including Genevieve Nnaji, Solange Knowles, Lala Vasquez, Catt Sadler of E! News; and attracted international media such as, BBC, Essence Magazine, Marie Claire amongst others. It appears African designers are not doing much in terms of protecting their designs from copyright infringement, to be fair this might be due to a low-level of awareness of their intellectual property rights.

The next question is what form of protection is available to Nigerian designers under Nigerian Intellectual Property Law. A sketch of a design may be protected as Artistic work under the copyright Act 2004 but if it is intended to be used as a model or pattern or to be multiplied by any industrial process it loses its protection. under the Trade Marks Act fashion designs and creative works are hardly catered for as section 67 defines a Trade mark as a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section 43 of this Act;

Contrary to the Louboutin story designers in Nigeria might not be able to protect their footwear under the Trade Marks Act because of the restricted definition of trademarks under section 67 of the Act. Going forward, Intellectual property law experts should advocate for an amendment of the Trade Marks Act and Copyrights Act, to enable them address emerging issues in the fashion industry. Meanwhile, fashion designers should devise ingenious means to protect their designs.

RIGHT OF REPLY

Re: The Case for Solid Minerals Development

I read with great pleasure your exposé on the Solid Minerals Sector.

However, you dwelled briefly on the plight of Entrepreneurs and the Starting Up of a Solid Minerals Business. Not every Nigerian can steal money or acquire wealth by dubious means.

We all agree Entrepreneurship must be encouraged to boost the economy as well as create jobs. However, there are no provisions to fund Start Ups in Nigeria. The commercial Banks require a collateral equivalent to the value of funds sought.

The Bank of Industry and International Finance Corporation require a minimum of 30% Project completion (Acquisition of 1000000% of the

Mineral deposit and a great Business Plan, with all the required Government Permits and Licenses). And the NEXIM Bank needs a 150% Collateral. How does one get these?

International Investors shy away from such Non-government Projects in Nigeria; they have the fear of Fraudsters (419) and Boko Haram to quote.

I have a Quarry License for the production of Pearl Granite (Exotic and sought after worldwide) for Tiles, Slabs and Blocks.

The Project can add about \$20m USD annually to the Nigerian economy and prevent Foreign Exchange drain through the importation of lower quality Tiles. It will provide employment. I have

had this project set for funding for 3 years now. I am required to renew my unused license annually. I require about \$17.2m USD to set this project up and running.

Government and the Solid Minerals Ministry in conjunction with Banks and other Financial Institutions must enact policies that will provide Start-Up funding for Projects verifiable as genuine and capable of adding value to the economy as practised in most developed and developing Economies.

Thanks
Mr. Ahammadu Dako
CEO, Ahammadu International Ventures Limited

TRIBUNAL OF INQUIRY VISITS VILLAGES AFFECTED BY LEKKI FREE TRADE ZONE CIVIL UNREST CONTINUED FROM PAGE 5

and led to the death of the Managing Director of Lekki Worldwide Investment Limited, Alhaji Tajudeen Disu.

Disu was reportedly killed while resolving a land dispute between members of Okunraye Community and some private companies involved in various projects within the Lekki Free Trade Zone.

The governor had on October 22 inaugurated a five-member tribunal of Inquiry

to investigate the cause of the incident in order to forestall a future recurrence.

Justice Olateru-Olagbegi urged the communities to maintain peace and present a united front to the government so it can better respond to their grievances.

The communities visited include Tiye, Imobido, Idasho, Elekuru, Imagbon, Itoke, Idotun, Olomowewe, Imopa, Okuniraye and Abejoye villages.

The leaders of the communities proclaimed their peoples' innocence in the incident leading to the death of Disu and lamented the disruption of their lives by the police since the day of the disturbance.

They also lamented the activities of some companies operating in the LFZDC, alleging that activities of these companies are severely damaging their land and taking away their livelihood.