

## JUDGMENT OF THE COURT (Grand Chamber)

12 June 2018 (\*)

(Reference for a preliminary ruling — Trade marks — Absolute grounds for refusal or invalidity — Sign consisting exclusively of the shape of the product — Concept of ‘shape’ — Colour — Position on a part of the product — Directive 2008/95/EC — Article 2 — Article 3(1)(e)(iii))

In Case C-163/16,

REQUEST for a preliminary ruling under Article 267 TFEU from the Rechtbank Den Haag (District Court, The Hague, Netherlands), made by decision of 9 March 2016, received at the Court on 21 March 2016, in the proceedings

**Christian Louboutin,**

**Christian Louboutin SAS**

v

**Van Haren Schoenen BV,**

THE COURT (Grand Chamber),

composed of K. Lenaerts, President, A. Tizzano, Vice-President, L. Bay Larsen, T. von Danwitz, J.L. da Cruz Vilaça, C.G. Fernlund and C. Vajda, Presidents of Chambers, E. Juhász (Rapporteur), J.-C. Bonichot, A. Arabadjiev, C. Toader, S. Rodin, F. Biltgen, K. Jürimäe and C. Lycourgos, Judges,

Advocate General: M. Szpunar,

Registrar: M. Ferreira, Principal Administrator,

having regard to the written procedure and further to the hearing on 6 April 2017,

after considering the observations submitted on behalf of:

- Mr Louboutin, by T. van Innis, avocat,
- Christian Louboutin SAS, by J. Hofhuis, advocaat,
- Van Haren Schoenen BV, by W.J.G. Maas, M.R. Rijks, E.T. Bergsma and M. van Gerwen, advocaten,
- the German Government, by T. Henze, M. Hellmann and J. Techert, acting as Agents,
- the French Government, by D. Segoin, acting as Agent,
- the Hungarian Government, by M.Z. Fehér, G. Koós and E.E. Sebestyén, acting as Agents,
- the Portuguese Government, by L. Inez Fernandes, M. Figueiredo and T. Rendas, acting as Agents,
- the Finnish Government, by J. Heliskoski, acting as Agent,
- the United Kingdom Government, by N. Saunders, Z. Lavery and D. Robertson, acting as Agents,
- the European Commission, by J. Samnadda, T. Scharf and F. Wilman, acting as Agents,

after hearing the Opinion of the Advocate General at the sitting on 22 June 2017,

having regard to the order of 12 October 2017 reopening the oral part of the procedure and further to the hearing on 14 November 2017,

after hearing the additional Opinion of the Advocate General at the sitting on 6 February 2018,

gives the following

## Judgment

1 This request for a preliminary ruling concerns the interpretation of Article 3(1)(e)(iii) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25).

2 The request has been made in the course of infringement proceedings between, on the one hand, Mr Christian Louboutin and Christian Louboutin SAS (together, ‘Louboutin’) and, on the other, Van Haren Schoenen BV (‘Van Haren’) concerning the sale, by Van Haren, of shoes which allegedly infringe the trade mark owned by Mr Louboutin.

### Legal context

#### *EU law*

3 Article 2 of Directive 2008/95, entitled ‘Signs of which a trade mark may consist’, provides:

‘A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.’

4 Article 3 of that directive, entitled ‘Grounds for refusal or invalidity’, provides:

‘1. The following shall not be registered or, if registered, shall be liable to be declared invalid:

...

(e) signs which consist exclusively of:

(i) the shape which results from the nature of the goods themselves;

(ii) the shape of goods which is necessary to obtain a technical result;

(iii) the shape which gives substantial value to the goods;

...’

#### *Benelux Convention on Intellectual Property (Trade Marks and Designs)*

5 Article 2.1, entitled ‘Signs that may constitute a Benelux trade mark’, of the Benelux Convention on Intellectual Property (Trade Marks and Designs), signed in The Hague on 25 February 2005 by the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands, states:

‘1. The names, drawings, imprints, stamps, letters, numerals, shapes of goods or packaging and all other signs that can be represented graphically and that serve to distinguish the goods or services of an undertaking shall be considered as being individual trade marks.

2. However, signs consisting solely of a shape which results from the nature of the goods, which gives a substantial value to the goods or which is necessary to obtain a technical result, cannot be considered as being trade marks.

...’

### **The dispute in the main proceedings and the question referred for a preliminary ruling**

6 Christian Louboutin designs and produces shoes.

7 On 28 December 2009, Mr Louboutin filed an application for registration of a Benelux trade mark with the Benelux Office for Intellectual Property, leading to the registration, on 6 January 2010, under number 0874489, of a trade mark for goods in Class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and corresponding to the following description: ‘Footwear (other than orthopaedic footwear)’ (‘the mark at issue’).

8 That mark is reproduced below:



- 9 In the application for registration, the mark at issue is described as follows: ‘The mark consists of the colour red (Pantone 18-1663TP) applied to the sole of a shoe as shown (the contour of the shoe is not part of the trade mark but is intended to show the positioning of the mark)’.
- 10 On 10 April 2013, the registration was amended in such a way as to limit the goods covered to ‘High-heeled shoes (other than orthopaedic shoes)’.
- 11 In the course of 2012, Van Haren, which operates shoe retail outlets in the Netherlands, sold high-heeled women’s shoes with red soles.
- 12 On 27 May 2013, Christian Louboutin initiated proceedings before the Rechtbank Den Haag (District Court, The Hague, Netherlands), claiming that Van Haren had infringed the mark at issue. On 17 July

2013, that court delivered a default judgment upholding in part the claims of Christian Louboutin.

13 Van Haren challenged that judgment before the referring court, the Rechtbank Den Haag (District Court, The Hague), claiming that the mark at issue was invalid on the basis of Article 2.1(2) of the Benelux Convention. Van Haren maintains that that mark is a two-dimensional figurative mark that consists of a red coloured surface.

14 The Rechtbank Den Haag (District Court, The Hague) considers, first, having regard to the graphic representation and the description of the mark at issue, that the colour red is inextricably linked to the shoe sole and therefore that mark cannot be regarded merely as a two-dimensional figurative mark. In the view of the referring court, that assessment is not undermined by the fact that the description of that mark states that ‘the contour of the shoe does not form part of the mark’. The referring court states that, on the contrary, that assessment is confirmed by that specification, in particular since, according to the description, the shape of the shoe, as illustrated in the graphic representation of the mark at issue, is not intended to reduce the sign to a two-dimensional mark, but is intended rather to show the positioning of that mark.

15 The referring court also considers that, in autumn 2012, ‘a significant proportion of consumers of women’s high-heeled shoes in the Benelux States was able to identify [Christian Louboutin] shoes as goods originating from that producer and was thus able to distinguish them from women’s high-heeled shoes [from] other undertakings’. Therefore, at that time, the mark at issue was perceived as a trade mark in relation to those goods.

16 Furthermore, in the view of the referring court, the red sole gives substantial value to the shoes marketed by Christian Louboutin since that colour forms part of the appearance of those shoes and plays an important role in a consumer’s decision to purchase them. In that regard, the referring court notes that Christian Louboutin first used red colouring on soles for aesthetic reasons and only later started regarding it as an identifier of origin and using it as a trade mark.

17 Lastly, the referring court states that, since the mark at issue consists of a colour which is applied to the sole of a shoe and is thus also an element of the product, the question arises as to whether the exception set out in Article 3(1)(e)(iii) of Directive 2008/95 applies to that mark. In that regard, it is unsure whether the concept of ‘shape’, within the meaning of that provision, is limited solely to three-dimensional properties of a product, such as its contours, measurements and volume, or whether that concept also covers properties that are not three-dimensional.

18 In those circumstances, the Rechtbank Den Haag (District Court, The Hague) decided to stay the proceedings and to refer the following question to the Court of Justice for a preliminary ruling:

‘Is the notion of “shape”, within the meaning of Article 3(1)(e)(iii) of [Directive 2008/95] (respectively referred to in the German-, [Dutch-] and French-language versions of [that directive] as “Form”, “vorm” and “forme”), limited to the three-dimensional properties of the goods, such as their contours, measurements and volume (expressed three-dimensionally), or does it include other (non-three-dimensional) properties of the goods, such as their colour?’

### **Consideration of the question referred**

19 By its question, the referring court asks, in essence, whether Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that a sign consisting of a colour applied to the sole of a high-heeled shoe, such as that at issue in the main proceedings, consists exclusively of a ‘shape’, within the meaning of that provision.

20 Given that Directive 2008/95 provides no definition of the concept of ‘shape’, the meaning and scope of that concept must, as the Court has consistently held, be determined by considering its usual meaning in everyday language, while also taking into account the context in which it occurs and the purposes of the rules of which it is part (see, by analogy, judgment of 3 September 2014, *Deckmyn and Vrijheidsfonds*, C-201/13, EU:C:2014:2132, paragraph 19).

- 21 As noted by the European Commission, in the context of trade mark law, the concept of ‘shape’ is usually understood as a set of lines or contours that outline the product concerned.
- 22 It does not follow from Directive 2008/95, the case-law of the Court, or the usual meaning of that concept, that a colour per se, without an outline, may constitute a ‘shape’.
- 23 Nevertheless, the question arises as to whether the fact that a particular colour is applied to a specific part of the product concerned results in the sign at issue consisting of a shape within the meaning of Article 3(1)(e)(iii) of Directive 2008/95.
- 24 In that regard, it must be noted that, while it is true that the shape of the product or of a part of the product plays a role in creating an outline for the colour, it cannot, however, be held that a sign consists of that shape in the case where the registration of the mark did not seek to protect that shape but sought solely to protect the application of a colour to a specific part of that product.
- 25 As has been observed by the German, French and United Kingdom Governments, as well as by the Commission, the mark at issue does not relate to a specific shape of sole for high-heeled shoes since the description of that mark explicitly states that the contour of the shoe does not form part of the mark and is intended purely to show the positioning of the red colour covered by the registration.
- 26 In any event, a sign, such as that at issue in the main proceedings, cannot be regarded as consisting ‘exclusively’ of a shape, where, as in the present instance, the main element of that sign is a specific colour designated by an internationally recognised identification code.
- 27 In the light of the foregoing considerations, the answer to the question referred is that Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that a sign consisting of a colour applied to the sole of a high-heeled shoe, such as that at issue in the main proceedings, does not consist exclusively of a ‘shape’, within the meaning of that provision.

### Costs

- 28 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Grand Chamber) hereby rules:

**Article 3(1)(e)(iii) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that a sign consisting of a colour applied to the sole of a high-heeled shoe, such as that at issue in the main proceedings, does not consist exclusively of a ‘shape’, within the meaning of that provision.**

[Signatures]

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\* Language of the case: Dutch.