

# Exhibit A

# **Exhibit A-1**

[logo] OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET  
(TRADEMARKS, DRAWINGS AND MODELS)  
The Chambers of Appeal

**DECISION**  
**of the Second Chamber of Appeal**  
**of June 16, 2011**

In the case R 2272/2010-2

**Christian Louboutin**  
1, rue Volney  
FR-75002 Paris  
France

Petitioner/Petitioner on appeal

represented by Thierry van Innis, L'Arsenal, 29, Boulevard Louis Schmidt, BE-1040  
Brussels, Belgium

APPEAL concerning the community trademark application No. 8,845,539

THE SECOND CHAMBER OF APPEAL

made up of T. de las Heras (President), U. Wennermark (Rapporteur) and G. Bertoli  
(Member)

Clerk: P. López Fernández de Corres

renders this



Language of the proceedings: French

## Decision

### Summary of the facts

- 1 On January 29, 2010, Christina Louboutin (hereinafter “the petitioner”) filed with the Office a community trademark application requesting the registration of the trademark reproduced below (of the “other” trademark type) and including the description “the trademark consists of the color red (Pantone code No. 18.1663TP) applied on the sole of a shoe as represented (consequently, the contour of the shoe is not part of the trademark but its purpose is to stress the location of the trademark),” as well as the claim for the red color (Pantone 18-1663TP)



for the following products:

Class 25 – Shoes (except for orthopedic shoes).

- 2 By letter dated March 5, 2010, the examiner informed the petitioner that his trademark application did not meet the conditions for registration because it was not in accordance with the provisions of article 7, paragraph 1, point b) of the RMC to the extent that the red color Pantone 18-1663TP lacked a distinctive character for the products claimed.
- 3 By letter of May 4, 2010, the petitioner contested the notice of the examiner, sustaining that the trademark application did not consist of a color in itself, but of a color delimited in space by the sole of a shoe and presented a *prima facie* distinctive character, because it diverged from the standard or the habits of the industry that want the sole of a shoe to be traditionally dull in color, black or beige, and was very easily memorable. In addition, the petitioner provided excerpts from the international press

showing that the red sole had been perceived right away as a trademark.

- 4 On July 13, 2010, a third party presented observations against the registration of the trademark application.
- 5 On September 15, 2010, the examiner sent a copy of the observations of the third party to the petitioner for information, specifying that they will not be taken into consideration, because the Office had already issued an objection concerning the registration of the trademark application.
- 6 By letter of September 20, 2010, the examiner communicated to the petitioner her decision ("the decision challenged") by which she indicated that the trademark was rejected pursuant to article 7, paragraph 1, point b) of the RMC and the exhibits produced to demonstrate the acquisition of a distinctive character by use were not sufficient. In answer to the arguments of the petitioner, the examiner essentially pointed out that:
  - Contrary to the arguments brought by the petitioner, he requests the protection of the color red (Pantone code No. 18.1663TP) applied to a certain shape, in this case that of a shoe sole, and not to the shape itself, which is red in color. The protection requested consequently refers indeed to the color red mentioned above, without requesting protection for the shape. Yet, as indicated above, the Office cannot give exclusivity to the color red for the manufacture of shoes, or their soles. Since the shoe market is a creative market, going hand in hand with fashion trends, it would be against the general interest of the other producers to restrict the availability of this color, for a precise part of the shoe, in this case the sole. In addition, there are, on the market, besides models of the most classic shoes with beige or black soles, shoes in an infinity of colors and shapes, coming from countless designers, whose soles are red, yellow, blue, white, etc.
  - Such being the case, the consumer will not perceive in the color red (Pantone code No. 18.1663TP) applied to a certain shape a sign indicating that the products come from the same company, but will rather perceive it as a simple element of the finish of the products in question.
  - Concerning the arguments that the trademark requested would have acquired distinctiveness by use, the petitioner provided exhibits in paper version as well as a CD. When examining the evidence, it was impossible to read the CD. Obviously, there is a problem with the recording of the data which caused the Office not to have access to the data contained therein. Such being the case, only the documents produced in paper version were taken into account.
  - The products concerned are mass consumption products. Consequently, the petitioner must demonstrate the market share held by the trademark, the intensity, the duration of the use of this trademark, the importance of the investments made by the company to promote it, the proportion of the

interested circles that identify the product as originating from a certain company, thanks to the trademark, as well as the declarations of the chambers of commerce and industry or other professional associations throughout the territory of the European Union.

- Yet, the documents in annex 1 concern excerpts from the French, English, Spanish, German, Dutch and Italian press. Annex 2 shows photographs of “people” and female personalities wearing shoes with red soles. Finally, annex 3 shows articles, especially of social events, which mention the “Louboutin” brand shoes and not the sign for which the application was filed.
  - No document or element demonstrates that such use was sufficient or sufficiently extended in time for the trademark to have been able to acquire generalized recognition of the products by the consumers of the European Union. The Office considers that the consumer targeted will perceive the requested trademark rather as a simple element of the finish of the products in question.
  - In order to be able to prove the distinctiveness acquired by use of a trademark consisting of a color, it is necessary to be able to place it in the corresponding market in the territory concerned (the European shoe market) in the sense that opinion polls concerning, on the one hand, the level of recognition of the trademark by the public of the European Union and, on the other hand, the place occupied by said trademark in the market in question versus the competing companies, as well as the attestations coming from public services, such as the chambers of commerce. Yet, the petitioner did not produce any such elements that would have allowed judging the importance of the scope and presence of the trademark in the European Union shoe market.
- 7 On November 18, 2010, the petitioner filed an appeal against this decision. A brief presenting the reasons for the appeal was received on January 19, 2011.
  - 8 The appeal was submitted to the examiner for review, pursuant to article 61 of the RMC. It was forwarded to the Chambers of Appeal on January 28, 2011.
  - 9 After studying the file, the Rapporteur found that the petitioner did not have an opportunity to comment on the observations of the third party of July 13, 2010, referring to high heel shoes with red soles that would have been marketed on the Internet.
  - 10 Consequently, by communication of March 10, 2011, the Rapporteur invited the petitioner to present observations in answer to the observations of the third party presented on July 13, 2010.
  - 11 On the other hand, in his communication, the Rapporteur indicated that he considered that the products claimed, namely “shoes (except for orthopedic shoes),” did not exactly coincide with the representation of the trademark that represents a high heel shoe for women. The Rapporteur suggested

that the description “high heel shoes (except for orthopedic shoes)” would better match the trademark applied for and also invited the petitioner to present his observations on the limitation proposed, within a term of two months from the notification of the communication.

### Means of appeal

- 12 The petitioner requests the annulment of the decision challenged. After presenting the legal framework and the jurisprudence, the petitioner mainly stresses, to support his appeal, that:
- The trademark applied for does not consist of a color in itself within the meaning of the “Libertel” decision. It is delimited in space, namely the space delimited by the drawing of a shoe sole.
  - The affirmation of the Office that there are, on the market, shoes whose soles are red is not supported by any element, even though the petitioner submitted to the Office a voluminous file that makes it uncontestable that the trademark significantly diverges from the standard or habits of the industry, and that the use already made of the trademark confirms its ability to be perceived right away, *ab initio*, by the relevant public as a trademark.
  - The Office dedicates the second half of its decision to comments “concerning the argument that the trademark applied for would have acquired a distinctiveness by use”; yet, in this case, the petitioner does not make this argument.
  - An examination *in concreto* establishes that the trademark not only diverges, in a very significant manner, from the standard or habits of the industry, which require the sole of a shoe to be, traditionally, dull in color, namely black or beige, but also that it is so striking when seen that it can very easily be perceived and memorized.
  - In fact, it is unanimously recognized that the petitioner had a genius idea, when he thought of affixing, in particular contrast with the uses and customs of the industry, the most distinctive sign of his shoes not inside the shoes but outside, so that this sign can be recognized at first glance by the public concerned, be it on the street, in stores or in the written and/or audiovisual press.
  - These two facts characterizing the sign – the fact that it diverges, in a very significant manner, from the standard, and the fact that it is very easily memorized – are certainly only indicators, certainly very serious ones, of its ability to be perceived by the relevant public as a trademark, but the examination *in concreto* demonstrates, secondly, that the red of the sole of the shoes concerned was perceived right away as the indication that these shoes come from a certain company, therefore distinguishing these shoes from those of other companies.

- The international press has multiplied the comments, all tending to recognize the incontestable power of the red sole to operate as a trademark, so much so that it is systematically considered explicitly as “the signature” of the shoes so “marked.” Numerous excerpts from the press are provided.
- The petitioner also provides statement from fashion professionals.
- The even more numerous comments printed in the so-called “people” press go in the same direction. The shoes bearing this trademark are worn for the most part by stars and the “paparazzi” cannot resist the temptation to take photos stressing the fact that they wear this brand; these photos, equally countless, often go around the world, accompanied by comments which in substance are identical, as shown by the information available on the Internet, as well as annex 3 containing, as an example, some of these photos of customers of the petitioner who are, among other persons, Queen Rania of Jordan, Princess Caroline of Monaco, Princess Maxima of the Netherlands, Carla Bruni, Catherine Deneuve, Meryl Streep, Angelina Jolie, Madonna, Eva Mendez, Jennifer Lopez, Sarah Jessica Parker, Gwyneth Paltrow, Gwen Stefanie, Katie Holmes, Penelope Cruz, Reese Witherspoon, Maria Sharapova, Naomi Campbell, Bar Rafaeli, Beyoncé Knowles, Dita von Teese, Anne Hathaway, Victoria Beckham, Gisèle Bündchen, Kate Moss, Rihanna, Charlotte Gainsbourg, Halle Berry, Nicole Kidman, Heidi Klum, Monica Bellucci and Scarlett Johansson.
- As illustrated by annex 4, the Internet reveals the existence of hundreds of thousands of sites, blogs and images which obviously confirm how much the public concerned actually perceives the trademark in its function of indication of origin.
- At the beginning of 2010, the search engine Google provided about two million hits in images using the keyword “Louboutin,” almost all of these images representing shoes bearing the trademark quite visibly, with the understanding that each of these images is accompanied by a link to a site or a blog which generally contains a comment which just confirms the *ab initio* ability of the trademark.
- The trademark was used in various extremely publicized events, among others in Europe, and each time, its function of indication of origin was spontaneously stressed by the public concerned. Thus, we can refer to the following events, repeated in annex 5 and being the object of numerous equally revealing comments: the launch, in collaboration with Mattel, of a Barbie wearing shoes with the famous red sole, the interpretation by Jennifer Lopez of a new song titled “Louboutins,” a vast advertising campaign in Europe in collaboration with a brand of Champagne, the world event that has, in the famous film “Sex and the City 2,” being shot since the fall of 2009, the main actress Sarah Jessica Parker wearing shoes with the red sole.



- The examination *in concreto* of the distinctive character of the trademark establishes its incontestable ability *ab initio* to be perceived by the public concerned in its essential function of indication of origin.
13. In answer to the communication of the Rapporteur, on May 6, 2011, the petitioner accepted the suggestion of limiting the claim through the description “high heeled shoes (except for orthopedic shoes)” which would better match the trademark. As to the observations of the third party of July 13, 2010, the petitioner stresses that:
- In substance, the observations of this third party are intended only to stress a single affirmation: in the [European] Union, the trademark would be usual and even extremely banal, so that it would obviously not have the (minimum) distinctive power required. Yet, this affirmation is sufficiently belied by the file submitted by the petitioner, which strongly demonstrates that, if the public concerned sees right away in the trademark an indication, in fact quite precise, of the origin of the products concerned, it is precisely because of its unusual character, which all observers are pleased to say and repeat.
  - The exhibits produced by the third party to support his allegation are just offers to sell high heeled shoes with a red sole, which were posted (in 2010) on the Internet and come almost exclusively from private persons. Yet, given the nature of the products concerned and the manner in which they are distributed within the Union – namely, for the most part, always in traditional boutiques or stores – it is not such offers posted on the Internet that would establish what is and what is not banal in the vast market of high heeled shoes in the Union.
  - All these ads, except one, were posted on eBay, often by Internet users outside the Union, for products which are not circulating in the sole market. Yet, it is well known that the eBay platform attracts counterfeiters who abuse the facility offered by our information society to post counterfeit offers on such platforms, hoping that the illegality of their offers will not be revealed too soon to the beneficiaries and denounced in order to be removed by the host concerned.
  - The petitioner adhered to the eBay VeRO program – a “notice and take down” program – intended to quickly remove, upon complaint, the counterfeit ads. The petitioner is quite vigilant and active, as testified by the report of April 15, 2011 of the law firm McCarter & English, in charge of coordinating said “notice and take down” procedures. Thus, no less than 2,841 illegal ads were removed from the European sites of eBay between August 1, 2009 and April 11, 2011.
  - A selection of a few dozens ads posted in 2010 on eBay says nothing about the reality of the market. Such selection illustrates at best the scourge of this type of counterfeiting on the Internet.
  - Concerning the only ad not posted on eBay, it confirms the distinctive

character of the petitioner's trademark. Trying to suggest that there is a common origin of the shoes offered and the shoes of the petitioner by placing themselves in the wake of the latter, the ad contains the following advertising message: *Wir lieben sie, die hippen Pumps mit den roten Sohlen. Top-Models und Hollywood Stars gehen ohne sie nicht mehr über den roten Teppich. Und Männer unterbrechen beim Anblick dieser Schuhe verzückt Ihre Gespräche.* [We love the trendy pumps with red soles. Top models and Hollywood stars will no longer go without them on the red carpet. And men interrupt their conversations at the sight of them.]

- The counterfeits so praised are the "Konstantin Starke" brand. Yet, as soon as they appeared on the traditional market, more precisely in a "Konstantin Starke" boutique in Brussels, the petitioner opposed it successfully, obtaining from the President of the Commercial Court of Brussels an order of seizure invoking its trademark already registered in Benelux. The dispute was resolved by a settlement under which the defendant conceded. Exhibits are enclosed to support these allegations.

#### **Reasons for the decision**

- 14 The appeal is pursuant to articles 58, 59, and 60 of the RMC and rule 48 of the REMC. Consequently, it is admissible.
- 15 It must be remembered that the distinctive character of a sign must be assessed, on the one hand, in light of the products for which the registration is requested and, on the other hand, in light of the perception of the relevant public.
- 16 Concerning the specific arrangement claimed at the time of the registration application, it was indeed the red color Pantone No. 18.1663TP applied to a high heel shoe and not the color red *per se*.
- 17 In addition, the registration is requested, after limitation, for "high heel shoes (except for orthopedic shoes)."
- 18 In the case of nonverbal trademarks, it must be presumed that the assessment of the distinctive character is the same throughout the entire Union, unless there are concrete indications otherwise (see decision of December 17, 2010, T-395/08, "Goldhase," point 53 and the jurisprudence cited). The territory to be taken into consideration must expand to all Member States of the European Union.
- 19 The products concerned are potentially targeted at any consumer, especially women. Such being the case, the reference consumer is the average consumer, normally informed and reasonably attentive and knowledgeable in any country of the European Union.
- 20 As it results from the generally acquired, practical experience, the soles of high heel shoe are generally black, brown or beige, and not "in an infinity of colors," contrary to the affirmation of the examiner, who actually did not demonstrate it. We find, on the market, sports shoes with a brightly colored sole, but this is not traditionally the case of high heel shoes. Yet, the trademark application, as represented and

according to the limited description of the products, does not cover all types of shoes and soles, but only the soles of high heel shoes.

- 21 The color red Pantone No. 18.1663TP applied to a sole of high heel shoes consequently diverges significantly from the standard and the habits of the industry (see decision of October 7, 2004, C-136/02 P, "Torches," point 31; decision of June 22, 2006, C-24/05 P, "Karamelbonbon," point 26). The trademark requested will therefore be perceived as fantasy, surprising and unexpected. In this regard, it is so striking that it will be easily memorable. It must be pointed out that, although the existence of such characteristics does not constitute a condition necessary to establish the distinctive character of a trademark, it is still true that their presence is, in principle, likely to give them such character (see decision of January 21, 2010, C-398/08 P, "Vorsprung durch Technik," point 47).
- 22 In addition, this conclusion is corroborated by the evidence of use provided by the petitioner. According to jurisprudence, "to the extent that a plaintiff claims the distinctive character of a trademark requested, in spite of the analysis of the OHMI, it is up to it to provide the concrete, supported indications establishing that the trademark requested has either an intrinsic distinctive character or a distinctive character acquired by use" (see decision of October 25, 2007, C-238/06 P, "Plastikflaschenform," point 50). In the case at hand, the documentation provided by the petitioner and, in particular, the excerpts from the international press demonstrate that the trademark requested is actually perceived on the market as an indicator of commercial origin.
- 23 Finally, the petitioner demonstrated that he successfully conducts an active policy of fighting against counterfeiting and that the observations of the third party presented on July 13, 2010 presenting products offered for sale on eBay just reflect the counterfeit ads against which the petitioner fights. In addition, the fact that there are so many counterfeit ads (2,841 removed from eBay between August 1, 2009 and April 11, 2011) is also an indication that the red sole of the petitioner functions as a trademark.
- 24 We must, therefore, conclude that the examiner was wrong in considering that the sign requested was, for the products concerned, lacking the intrinsic distinctive character required under article 7, paragraph 1, point b) of the RMC. On the other hand, since the petitioner did not invoke the provisions of article 7, paragraph 3 of the RMC, there was no need to examine whether the conditions of this article had been met.
- 25 In light of the above, the appeal is admitted and the decision challenged is cancelled.

**Holding**

On these grounds,

**THE CHAMBER**

- 1. Takes note of the limitation of the products claimed, namely:  
“high heel shoes (except for orthopedic shoes);”**
- 2. Cancels the decision challenged;**
- 3. States that the trademark application is accepted for publication purposes.**

Signed

T. de las Heras

Signed

U. Wennermark

Signed

G. Bertoli

Registrar:

Signed

P. López Fernández de  
Corres

[logo]




**TRANSPERFECT**


- ALBANY
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- ATLANTA
- AUSTIN
- BARCELONA
- BERLIN
- BOGOTA
- BOSTON
- BRUSSELS
- CHARLOTTE
- CHICAGO
- CLEVELAND
- COLUMBUS
- DALLAS
- DENVER
- DUBAI
- DUBLIN
- DUESSELDORF
- FRANKFURT
- GENEVA
- HONG KONG
- HOUSTON
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- MIAMI
- MILAN
- MINNEAPOLIS
- MONTREAL
- MUNICH
- NEW YORK
- PARIS
- PHILADELPHIA
- PHOENIX
- PORTLAND
- PRAGUE
- RESEARCH TRIANGLE PARK
- SAN DIEGO
- SAN FRANCISCO
- SAN JOSE
- SEATTLE
- SINGAPORE
- STOCKHOLM
- STUTTGART
- SYDNEY
- TOKYO
- TORONTO
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- ZURICH

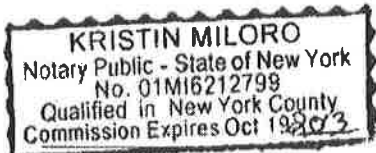
City of New York, State of New York, County of New York

I, Elissa Feldman, hereby certify that the document "Decision of the Second Chamber of Appeal, June 16, 2011 – R 2272/2010-2" is, to the best of my knowledge and belief, a true and accurate translation from French to English.

  
 \_\_\_\_\_  
 Elissa Feldman

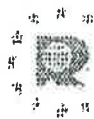
Sworn to before me this  
July 18, 2011

  
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 Signature, Notary Public



Stamp, Notary Public

## **Exhibit A-2**



OFFICE DE L'HARMONISATION DANS LE MARCHÉ INTÉRIEUR  
(MARQUES, DESSINS ET MODÈLES)

Les Chambres de recours

**DÉCISION**  
**de la Deuxième Chambre de recours**  
**du 16 juin 2011**

Dans l'affaire R 2272/2010-2

**Christian Louboutin**

1, rue Volney  
FR-75002 Paris  
France

Demandeur / Demandeur au recours

représenté par Thierry van Innis, L'Arsenal, 29, Boulevard Louis Schmidt, BE-1040  
Bruxelles, Belgique

RECOURS concernant la demande de marque communautaire n° 8 845 539

**LA DEUXIÈME CHAMBRE DE RECOURS**

composée de T. de las Heras (Président), U. Wennermark (Rapporteur) et G. Bertoli  
(Membre)

Greffière: P. López Fernández de Corres

rend la présente



Langue de procédure: français

DÉCISION DU 16 JUIN 2011 – R 2272/2010-2 – SMPLIJK ROUGH (MARQUE FIGURATIVE)

## Décision

### Résumé des faits

- 1 Le 29 janvier 2010, Christian Louboutin (ci-après, « le demandeur ») a présenté à l'Office une demande de marque communautaire sollicitant l'enregistrement de la marque reproduite ci-dessous (de type « autre » marque) et comportant la description « la marque consiste en la couleur rouge (code Pantone n° 18.1663TP) appliquée sur la semelle d'une chaussure telle que représentée (le contour de la chaussure ne fait donc pas partie de la marque mais a pour but de mettre en évidence l'emplacement de la marque) », ainsi que la revendication de couleur rouge (Pantone 18-1663TP)



pour les produits suivants :

Classe 25 – Chaussures (à l'exception des chaussures orthopédiques).

- 2 Par lettre en date du 5 mars 2010, l'examinatrice a informé le demandeur que sa demande de marque ne répondait pas aux conditions d'enregistrement parce qu'elle n'était pas conforme aux dispositions de l'article 7, paragraphe 1, point b) du RMC dans la mesure où la couleur rouge Pantone 18-1663TP était dépourvue de caractère distinctif pour les produits revendiqués.
- 3 Par lettre en date du 4 mai 2010, le demandeur a contesté l'avis de l'examinatrice en soutenant que la demande de marque ne consistait pas en une couleur en elle-même mais en une couleur délimitée dans l'espace par la semelle d'une chaussure et présentait un caractère distinctif *prima facie* car elle divergeait de la norme ou des habitudes du secteur qui veulent que la semelle d'un soulier soit traditionnellement de couleur terne, noir ou beige, et était très facilement mémorisable. En outre, le demandeur fournissait des extraits de la presse



internationale montrant que la semelle rouge avait été perçue d'emblée comme une marque.

- 4 En date du 13 juillet 2010, un tiers a présenté des observations à l'encontre de l'enregistrement de la demande de marque.
- 5 En date du 15 septembre 2010, l'examinatrice a communiqué une copie des observations du tiers au demandeur à titre d'information, en précisant que celles-ci ne seront pas prises en considération car l'Office avait déjà émis une objection à l'égard de l'enregistrement de la demande de marque.
- 6 Par lettre en date du 20 septembre 2010, l'examinatrice a notifié au demandeur sa décision (« la décision attaquée ») par laquelle elle indiquait que la marque était rejetée en application de l'article 7, paragraphe 1, point b) du RMC et que les pièces produites pour démontrer l'acquisition d'un caractère distinctif par l'usage n'étaient pas suffisantes. En réponse aux arguments du demandeur, l'examinatrice faisait essentiellement valoir que :
  - Contrairement aux arguments avancés par le demandeur, celui-ci demande la protection de la couleur rouge (code Pantone n° 18.1663TP) appliquée à une forme déterminée, en l'occurrence celle d'une semelle de chaussure, et non pas à la forme en soi de couleur rouge. La protection demandée se rapporte donc bel et bien à la couleur rouge mentionnée ci-dessus, sans demander la protection de la forme. Or, tel que repris ci-dessus, l'Office ne peut donner l'exclusivité de la couleur rouge pour la fabrication de chaussures, ni de leurs semelles. Le marché de la chaussure étant un marché de création, allant de pair avec les tendances de la mode, il serait contre l'intérêt général des autres producteurs de restreindre la disponibilité de cette couleur, pour une partie précise de la chaussure, en l'occurrence, la semelle. De plus, il existe sur le marché, hormis les modèles de chaussures les plus classiques avec des semelles beiges ou noires, des chaussures d'une infinité de couleurs et de formes, provenant d'une multitude de créateurs, dont les semelles sont de couleur rouge, jaune, bleue, blanche, etc.
  - Dès lors, le consommateur ne percevra pas dans la couleur rouge (code Pantone n° 18.1663TP) appliquée à une forme déterminée, un signe indiquant que les produits proviennent d'une même entreprise, mais la percevra plutôt comme un simple élément de finition des produits en cause.
  - Concernant l'argument selon lequel la marque demandée aurait acquis une distinctivité par l'usage, le demandeur a fourni des annexes en version papier ainsi qu'un CD. Lors de l'examen des preuves, la lecture du CD s'est avérée impossible. Il existe manifestement un problème d'enregistrement des données qui fait que l'Office n'a pu avoir accès aux données y figurant. Dès lors, n'ont été pris en compte que les documents apportés en version papier.
  - Les produits concernés sont des produits de consommation de masse. Le demandeur est donc tenu de démontrer la part de marché détenue par la marque, l'intensité, la durée de l'usage de cette marque, l'importance des investissements faits par l'entreprise pour la promouvoir, la proportion des

milieux intéressés qui identifie le produit comme provenant d'une entreprise déterminée grâce à la marque ainsi que les déclarations de chambres de commerce et d'industrie ou d'autres associations professionnelles dans tout le territoire de l'Union européenne.

- Or, les documents de l'annexe 1 concernent des extraits de presse française, anglaise, espagnole, allemande, hollandaise, et italienne. L'annexe 2 montre des photographies de « people » et de personnalités féminines portant des chaussures à semelles rouges. Enfin, l'annexe 3 montre des articles, notamment d'événements moudains, dans lesquels sont mentionnées les chaussures de la marque « Louboutin » et non pas du signe demandé.
  - Aucun document ou élément ne démontre que cette utilisation a été suffisante ou suffisamment étendue sur la durée pour que la marque ait pu acquérir une reconnaissance généralisée de ses produits de la part des consommateurs de l'Union européenne. L'Office considère que le consommateur visé percevra la marque demandée plutôt comme un simple élément de finition des produits en cause.
  - Afin de pouvoir prouver la distinctivité acquise par l'usage d'une marque consistant en une couleur, il est nécessaire de pouvoir la situer dans le marché correspondant dans le territoire concerné (le marché européen de la chaussure) dans le sens où des sondages d'opinion concernant, d'une part, le niveau de reconnaissance de la marque de la part du public de l'Union européenne et, d'autre part, de la place qu'occupe ladite marque sur le marché en question par rapport aux entreprises concurrentes, ainsi que des attestations émanant de services publics, tels les chambres de commerce. Or, le demandeur n'a apporté aucun de ces éléments qui auraient pu permettre de juger l'importance de la portée et la présence de la marque sur le marché de la chaussure de l'Union européenne.
- 7 Le 18 novembre 2010, le demandeur a formé un recours à l'encontre de cette décision. Un mémoire exposant les motifs du recours a été reçu le 19 janvier 2011.
  - 8 Le recours a été soumis à l'examinatrice pour révision conformément à l'article 61 du RMC. Il a été déféré aux Chambres de recours le 28 janvier 2011.
  - 9 Après avoir étudié le dossier, le Rapporteur a constaté que le demandeur n'avait pas eu l'opportunité de commenter les observations du tiers du 13 juillet 2010 faisant référence à des chaussures à talons hauts comportant des semelles rouges qui seraient commercialisées sur Internet.
  - 10 En conséquence, par communication du 10 mars 2011, le Rapporteur a invité le demandeur à présenter des observations en réponse aux observations du tiers présentées le 13 juillet 2010.
  - 11 D'autre part, dans sa communication, le Rapporteur indiquait qu'il considérait que les produits revendiqués, à savoir les « chaussures (à l'exception des chaussures orthopédiques) », ne coïncidaient pas exactement avec la représentation de la marque qui représente un soulier féminin à talons hauts. Le Rapporteur suggérait

que le libellé « chaussures à talons hauts (à l'exception des chaussures orthopédiques) » serait en meilleure adéquation avec la marque déposée et invitait également le demandeur à présenter ses observations sur la limitation proposée, dans un délai de deux mois à compter de la notification de la communication.

#### Moyens du recours

12. Le demandeur sollicite l'annulation de la décision attaquée. Après avoir exposé le cadre légal et la jurisprudence, le demandeur fait essentiellement valoir, à l'appui de son recours, que :
- La marque demandée ne consiste pas en une couleur en elle-même au sens de l'arrêt « Libertel ». Elle est délimitée dans l'espace, à savoir l'espace délimité par le dessin d'une semelle de chaussure.
  - L'affirmation de l'Office qu'il existe sur le marché des chaussures dont les semelles sont rouges n'est étayée par aucun élément, alors même que le demandeur a soumis à l'Office un volumineux dossier rendant incontestable que la marque diverge d'une manière très significative de la norme ou des habitudes du secteur et que l'usage déjà fait de la marque confirme son aptitude à être perçue d'emblée, *ab initio*, par le public pertinent comme une marque.
  - L'Office consacre la seconde moitié de sa décision à des commentaires « concernant l'argument selon lequel la marque demandée aurait acquis une distinctivité par l'usage » ; or, en l'espèce, le demandeur n'avance pas cet argument.
  - Un examen *in concreto* établit que la marque non seulement diverge d'une manière très significative de la norme ou des habitudes du secteur qui veulent que la semelle d'un soulier soit traditionnellement d'une couleur terne, à savoir le noir ou le beige, mais aussi qu'elle frappe à ce point le regard qu'elle peut être très facilement appréhendée et mémorisée.
  - Il est d'ailleurs unanimement reconnu que le demandeur a eu une idée géniale en songeant à apposer, en singulier contraste avec les us et coutumes dans le secteur, le signe le plus distinctif de ses chaussures non pas à l'intérieur de ces dernières, mais à l'extérieur, ce signe pouvant être reconnu au premier coup d'oeil par le public concerné, que ce soit dans la rue, dans les boutiques ou encore dans la presse écrite et/ou audiovisuelle.
  - Ces deux faits caractérisant le signe – celui de diverger d'une manière très significative de la norme et celui d'être très facilement mémorisable – ne constituent sans doute que des indices, certes très sérieux, de son aptitude à être perçu par le public pertinent comme une marque, mais l'examen *in concreto* démontre en second lieu que le rouge de la semelle des souliers concernés a été perçu d'emblée comme l'indication que ces souliers provenaient d'une entreprise déterminée, distinguant dès lors ces souliers de ceux d'autres entreprises.

- La presse internationale a multiplié les commentaires tendant tous à reconnaître à la semelle rouge l'incontestable pouvoir de fonctionner comme une marque, jusqu'à être systématiquement considérée explicitement comme « la signature » des souliers ainsi « marqués ». De nombreux extraits de la presse sont fournis.
- Le demandeur fournit également des déclarations de professionnels de la mode.
- Les commentaires encore plus nombreux parus dans la presse dite « people » vont dans le même sens. Les souliers frappés de cette marque sont portés par la plupart des stars et les « paparazzis » ne résistent pas à la tentation de faire des photos mettant en exergue le port de cette marque, ces photos, innombrables également, faisant souvent le tour du monde, accompagnées de commentaires en substance identiques, comme en témoignent les informations à disposition sur Internet ainsi que l'annexe 3 contenant, à titre exemplatif, quelques unes de ces photos de clientes du demandeur que sont, entre autres, la Reine Rania de Jordanie, la Princesse Caroline de Monaco, la Princesse Maxima des Pays-Bas, Carla Bruni, Catherine Deneuve, Meryl Streep, Angelina Jolie, Madonna, Eva Mendez, Jennifer Lopez, Sarah Jessica Parker, Gwyneth Paltrow, Gwen Stefanie, Katie Holmes, Penelope Cruz, Reese Witherspoon, Maria Sharapova, Naomi Campbell, Bar Rafaeli, Beyoncé Knowles, Dita von Teese, Anne Hathaway, Victoria Beckham, Gisèle Bündchen, Kate Moss, Rihanna, Charlotte Gainsbourg, Halle Berry, Nicole Kidman, Heidi Klum, Monica Bellucci et Scarlett Johansson.
- Comme l'annexe 4 l'illustre, Internet révèle l'existence de centaines de milliers de sites, de blogs et d'images confirmant d'une manière éclatante combien le public concerné perçoit effectivement la marque dans sa fonction d'indication d'origine.
- Le moteur de recherche Google donnait au début de l'année 2010 environ deux millions de résultats en images à l'aide du mot clef « Louboutin », la quasi-totalité de ces images représentant des souliers portant très visiblement la marque, étant entendu que chacune de ces images est accompagnée d'un lien vers un site ou un blog contenant généralement un commentaire ne faisant que confirmer l'aptitude *ab initio* de la marque.
- La marque a été utilisée lors d'événements divers très médiatisés, entre autres en Europe, et, à chaque fois, sa fonction d'indication d'origine a été spontanément mise en exergue par le public concerné. Il peut ainsi être renvoyé aux quelques événements suivants, repris à l'annexe 5 et ayant fait l'objet de nombreux commentaires tout aussi révélateurs : le lancement, en collaboration avec Mattel, d'une Barbie portant des souliers à la fameuse semelle rouge, l'interprétation par Jennifer Lopez d'une nouvelle chanson intitulée « Louboutins », une vaste campagne publicitaire en Europe en collaboration avec une marque de Champagne, l'événement mondial qui veut que, dans le fameux film « Sex and the City 2 », en cours de réalisation depuis l'automne 2009, l'actrice principale Sarah Jessica Parker porte des souliers marqués de la semelle rouge.

- L'examen *in concreto* du caractère distinctif de la marque établit son incontestable aptitude *ab initio* à être perçue par le public concerné dans sa fonction essentielle d'indication d'origine.
- 13 En réponse à la communication du Rapporteur, le 6 mai 2011, le demandeur a accepté la suggestion de limiter la revendication par le libellé « chaussures à talons hauts (à l'exception des chaussures orthopédiques) » qui serait en meilleure adéquation avec la marque. Quant aux observations du tiers du 13 juillet 2010, le demandeur fait valoir que :
- Les observations de ce tiers ne tendent, en substance, qu'à étayer une seule affirmation : la marque serait, dans l'Union, usuelle et même d'une grande banalité, de sorte qu'elle n'aurait évidemment pas le (minimum de) pouvoir distinctif requis. Or, cette affirmation est démentie à suffisance par le dossier présenté par le demandeur, ce dossier démontrant avec force que, si le public concerné voit d'emblée dans la marque une indication, d'ailleurs très précise, de l'origine des produits concernés, c'est précisément en raison de son caractère inusité, ce que tous les observateurs se plaisent à dire et répéter.
  - Les pièces produites par le tiers à l'appui de son allégation ne sont que des offres en vente de chaussures à hauts talons munies d'une semelle rouge, qui furent postées (en 2010) sur Internet et émanent presque exclusivement de particuliers. Or, compte tenu de la nature des produits concernés et de la manière dont ils sont distribués au sein de l'Union – à savoir, pour la plupart, toujours en boutique ou magasin traditionnels – ce ne sont pas de telles offres postées sur Internet qui établissent ce qui serait banal ou non sur le vaste marché des chaussures à hauts talons dans l'Union.
  - Toutes ces annonces, sauf une, ont été postées sur eBay, souvent d'ailleurs par des internautes à l'extérieur de l'Union pour des produits ne se trouvant pas en circulation dans le marché unique. Or, il est notoire que la plate-forme d'eBay attire les contrefacteurs qui abusent de la facilité offerte par notre société de l'information pour poster des offres contrefaisantes sur de telles plates-formes en espérant que l'illicéité de leurs offres ne sera pas trop vite révélée aux ayants droit et dénoncée en vue de leur retrait par l'hébergeur concerné.
  - Le demandeur a adhéré au programme VeRO d'eBay – un programme de « notice and take down » – tendant à faire retirer rapidement, sur dénonciation, les annonces contrefaisantes. Le demandeur est très vigilant et actif, ce dont témoigne le rapport du 15 avril 2011 du cabinet d'avocat Mc Carter & English, chargé de coordonner lesdites procédures de « notice and take down ». Ainsi, pas moins de 2 841 annonces illicites ont été retirées des sites européens d'eBay entre le 1er août 2009 et le 11 avril 2011.
  - Une sélection de quelques dizaines d'annonces postées en 2010 sur eBay ne dit rien de la réalité d'un marché. Une telle sélection illustre tout au plus le fléau de ce type de contrefaçon sur Internet.
  - S'agissant de la seule annonce non postée sur eBay, elle confirme le caractère

distinctif de la marque du demandeur. Tentant de faire croire à une origine commune des chaussures offertes et des chaussures du demandeur en se plaçant dans le sillage de ce dernier, l'annonce contient le message publicitaire suivant : « *Wir lieben sie, die hippen Pumps mit den roten Sohlen. Top-Models und Hollywood-Stars gehen ohne sie nicht mehr über den roten Teppich. Und Männer unterbrechen beim Anblick dieser Schuhe verzückt ihre Gespräche.* »

- Les contrefaçons ainsi vantées sont de la marque « Konstantin Starke ». Or, dès qu'elles sont apparues sur le marché traditionnel, plus précisément dans une boutique « Konstantin Starke » à Bruxelles, le demandeur s'y est opposé avec succès en obtenant du Président du tribunal de commerce de Bruxelles une ordonnance de saisie en invoquant sa marque déjà enregistrée au Benelux. Le litige a été réglé par une transaction aux termes de laquelle le défendeur s'est incliné. Des pièces sont jointes à l'appui de ces allégations.

#### Motifs de la décision

- 14 Le recours est conforme aux articles 58, 59 et 60 du RMC et à la règle 48 du REMC. Il est dès lors recevable.
- 15 Il convient de rappeler que le caractère distinctif d'un signe doit s'apprécier, d'une part, par rapport aux produits pour lesquels l'enregistrement est demandé et, d'autre part, par rapport à la perception qu'en a le public pertinent.
- 16 S'agissant de l'arrangement spécifique revendiqué lors du dépôt, il s'agit bien de la couleur rouge Pantone n° 18.1663TP appliquée à une semelle de chaussure à talons hauts et non la couleur rouge *per se*.
- 17 En outre, l'enregistrement est demandé, après limitation, pour des « chaussures à talons hauts (à l'exception des chaussures orthopédiques) ».
- 18 Dans le cas des marques non verbales, il y a lieu de présumer que l'appréciation du caractère distinctif est la même dans toute l'Union, à moins qu'il n'existe des indices concrets en sens contraire (voir arrêt du 17 décembre 2010, T-395/08, « Goldhase », point 53 et la jurisprudence citée). Le territoire à prendre en considération doit s'étendre à tous les États membres de l'Union européenne.
- 19 Les produits visés s'adressent potentiellement à tout consommateur, en particulier aux femmes. Dès lors, le consommateur de référence est le consommateur moyen, normalement informé et raisonnablement attentif et avisé de n'importe quel pays de l'Union européenne.
- 20 Ainsi qu'il résulte de l'expérience pratique généralement acquise, les semelles de chaussures à talons hauts sont généralement noires, marron ou beiges, et non « d'une infinité de couleurs » contrairement à ce qu'affirme l'examinatrice, sans d'ailleurs le démontrer. On trouve, sur le marché, des chaussures de sport ayant une semelle de couleur vive, mais cela n'est traditionnellement pas le cas des chaussures à talons hauts. Or, la demande de marque, telle que représentée et

selon le libellé des produits limité, ne couvre pas tous types de chaussures et de semelles mais uniquement les semelles de chaussures à talons hauts.

- 21 La couleur rouge Pantone n° 18.1663TP appliquée à une semelle de chaussure à talons hauts diverge donc d'une manière significative de la norme et des habitudes du secteur (voir arrêt du 7 octobre 2004, C-136/02 P, « Torches », point 31 ; arrêt du 22 juin 2006, C-24/05 P, « Karamelbonbon », point 26). La marque demandée sera donc perçue comme fantaisiste, surprenante et inattendue. Elle frappe à ce point le regard qu'elle sera facilement mémorisable. Il y a lieu de relever que, si l'existence de telles caractéristiques ne constitue pas une condition nécessaire pour établir le caractère distinctif d'une marque, il n'en demeure pas moins que leur présence est en principe de nature à conférer à celle-ci un tel caractère (voir arrêt du 21 janvier 2010, C-398/08 P, « Vorsprung durch Technik », point 47).
- 22 De plus, cette conclusion est corroborée par les preuves d'usage fournies par le demandeur. Selon la jurisprudence, « dans la mesure où une requérante se prévaut du caractère distinctif d'une marque demandée, en dépit de l'analyse de l'OHMI, c'est à elle qu'il appartient de fournir des indications concrètes et étayées établissant que la marque demandée est dotée soit d'un caractère distinctif intrinsèque, soit d'un caractère distinctif acquis par l'usage » (voir arrêt du 25 octobre 2007, C-238/06 P, « Plastikflaschenform », point 50). En l'espèce, la documentation fournie par le demandeur et, en particulier, les extraits de la presse internationale démontrent que la marque demandée est effectivement perçue sur le marché comme un indicateur d'origine commerciale.
- 23 Enfin, le demandeur a démontré qu'il mène avec succès une politique active de lutte contre la contrefaçon et que les observations du tiers présentées le 13 juillet 2010 présentant des produits offerts en vente sur eBay ne font que refléter les annonces contrefaisantes contre lesquelles le demandeur lutte. En outre, le fait qu'il y ait tant d'annonces contrefaisantes (2 841 retirées d'eBay entre le 1<sup>er</sup> août 2009 et le 11 avril 2011) est aussi une indication que la semelle de couleur rouge du demandeur fonctionne en tant que marque.
- 24 Il convient donc de conclure que c'est à tort que l'examinatrice a considéré que le signe demandé était, pour les produits concernés, dépourvu du caractère distinctif intrinsèque requis au sens de l'article 7, paragraphe 1, point b), du RMC. D'autre part, le demandeur n'ayant pas invoqué les dispositions de l'article 7, paragraphe 3, du RMC, il n'y avait pas lieu d'examiner si les conditions de cet article étaient remplies.
- 25 A la lumière de ce qui précède, le recours est accueilli et la décision attaquée annulée.

**Dispositif**

Par ces motifs,

**LA CHAMBRE**

1. Prend acte de la limitation des produits revendiqués, à savoir :  
« chaussures à talons hauts (à l'exception des chaussures orthopédiques) » ;
2. Annule la décision attaquée ;
3. Dit que la demande de marque est acceptée aux fins de publication.

Signed

T. de las Heras

Signed

U. Wennermark

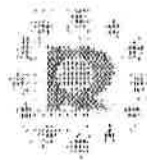
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G. Bertoli

Registrar:

Signed

P. López Fernández de  
Corres





## **Exhibit B**

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HIGHLY CONFIDENTIAL  
UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

CHRISTIAN LOUBOUTIN SA; CHRISTIAN  
LOUBOUTIN, LLC; and CHRISTIAN  
LOUBOUTIN,  
Plaintiffs

v. CIVIL ACTION No. :  
11 CIV 2381

YVES SAINT LAURENT AMERICA, INC;  
YVES SAINT LAURENT AMERICA  
HOLDING, INC; YVES SAINT LAURENT  
SAS; YVES SAINT LAURENT (an  
unincorporated association); JOHN AND JANE  
DOES A-Z (UNIDENTIFIED); and XYZ  
COMPANIES 1-10 (UNIDENTIFIED),  
Defendants.

VIDEOTAPED DEPOSITION OF CHRISTIAN LOUBOUTIN

Monday, June 13, 2011 at 10:04 a.m.

Held at: Offices of Debevoise & Plimpton

42 Old Broad Street

London

United Kingdom

TSG JOB NO. 39323



Page 2

1                   **HIGHLY CONFIDENTIAL**  
 2                   **A P P E A R A N C E S**  
 3   **For the Plaintiff:**  
 4       **HARLEY I LEWIN**  
 5       **McCarter & English**  
 6       **245 Park Avenue**  
 7       **27th Floor**  
 8       **New York, NY 10167**

10  
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 12  
 13       **XAVIER RAGOT, General Counsel**  
 14       **Christian Louboutin**  
 15       **19, rue Jean-Jacques Rousseau**  
 16       **75001 Paris, France**

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Page 3

1                   **HIGHLY CONFIDENTIAL**  
 2   **For the Defendants:**  
 3       **JYOTIN HAMID**  
 4       **JILL VAN BERG**  
 5       **Debevoise & Plimpton**  
 6       **919 Third Avenue**  
 7       **New York, NY 10022**

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Page 4

1                   **HIGHLY CONFIDENTIAL**  
 2   **Also present:**  
 3  
 4   **Court Reporter:**  
 5       **FIONA FARSON**  
 6       **TSG Reporting**  
 7   **Videographer:**  
 8       **SIMON ADDINSELL**  
 9       **TSG Reporting**  
 10   **Interpreter:**  
 11       **BRIGITTE BERKAINE-TONGUE**

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Page 5

1                   **HIGHLY CONFIDENTIAL**  
 2  
 3                   **I N D E X**  
 4   **EXAMINATION**  
 5   **BY MR. HAMID**                    8  
 6   **BY MR. LEWIN**                    135

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HIGHLY CONFIDENTIAL

1 Q. You know that dress?

2 A. Yes, I know the -- it exists, the dress exists.

3 Q. Did you tell Glamour Magazine last year that the first  
4 thing that comes to mind when you hear "YSL" is pride  
5 for France?

6 MS. VAN BERG: (French spoken.)

7 MR. RAGOT: (French spoken.)

8 A. I don't remember.

9 BY MR. HAMID:

10 Q. Do you think YSL is a pride for France?

11 MR. LEWIN: Objection.

12 You can answer.

13 A. What is "YSL"?

14 BY MR. HAMID:

15 Q. Yves Saint Laurent.

16 A. Is that Mr. Yves Saint Laurent?

17 Q. I'm asking you just "YSL." When you hear "YSL," do you  
18 think pride for France?

19 A. No.

20 Q. Did you give an interview to Latin America Glamour  
21 Magazine last year?

22 A. I have -- I can't remember.

23 Q. Okay. I'll show you, and we'll mark as defendants'  
24 exhibit 35, a document -- you don't need to translate  
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HIGHLY CONFIDENTIAL

1 this -- bearing the Bates numbers CL005807 through 5810.  
2 (Defendants' exhibit 35 marked for identification.)

3 BY MR. HAMID:

4 Q. Do you recognize exhibit 35?

5 A. That?

6 Q. Yes. It's an email attaching a magazine article.

7 A. I don't -- what is the question?

8 Q. Do you recognize this magazine article?

9 A. I see the head, but apart from that ...

10 Q. Have you ever seen it before?

11 A. I have no idea. I have seen this photo, but not the  
12 article.

13 Q. Would you agree that YSL is a reputable fashion house?

14 A. Yes.

15 Q. Would you agree that it's a prestigious fashion house?

16 A. Yes.

17 Q. In 2002, you collaborated with Yves Saint Laurent,  
18 correct?

19 A. I don't remember the date precisely, but -- yes, I have  
20 collaborated with him. Would it be -- I can't remember  
21 if it was 2002; I can't remember for sure if it was  
22 2002.

23 Q. Do you remember that you contributed a shoe to Mr. Yves  
24 Saint Laurent's final runway show?  
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HIGHLY CONFIDENTIAL

1 A. In Paris?

2 Q. Wherever?

3 No, the -- it was an answer, "in Paris."

4 MS. VAN BERG: I believe his answer was "in Paris."

5 A. In Paris, yes. (French spoken.)

6 INTERPRETER: (French spoken.)

7 MR. LEWIN: You can't do this. You can't. It's between the  
8 two of them.

9 MR. HAMID: Mr. Ragot is helping as well.

10 MR. LEWIN: I've cautioned Mr. Ragot not to do that unless  
11 he's called upon to do that.

12 INTERPRETER: Pardon.

13 MR. LEWIN: Don't worry about the translation on this. It's  
14 between counsel.

15 BY MR. HAMID:

16 Q. I'm sorry; we'll start over.

17 Do you recall contributing a shoe to Mr. Yves Saint  
18 Laurent's final runway show?

19 A. In Paris.

20 Q. Yeah.

21 A. Yes.

22 Q. Now, you've collaborated with other prestigious fashion  
23 houses as well, right?

24 A. Yes, I have collaborated with other houses, yes.

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HIGHLY CONFIDENTIAL

1 Q. For example, Jean Paul Gaultier?

2 A. Yes.

3 Q. Chloe?

4 A. Yes.

5 Q. You've turned down the opportunity to collaborate with  
6 H&M, is that right?

7 A. It's up to me, isn't it? As long as I have not  
8 collaborated with them -- I have not collaborated with  
9 them. That's it.

10 Q. Yes. You didn't want to?

11 A. It's up to me.

12 Q. I understand; I'm just asking the question.

13 A. I don't know. I did not do it.

14 Q. Why not?

15 A. For reason that is up to me.

16 Q. I'd like you to explain the reason.

17 A. Because I cannot collaborate with all the houses.

18 Q. And why not H&M?

19 A. For different reasons.

20 Q. What are they?

21 A. The principal reason, it was taking me time that I do  
22 not have.

23 Q. Are there any other reasons?

24 A. Not particularly.

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1  
2 **Q. Did you have a concern about how it would reflect on**  
3 **your brand, to be associated with H&M?**

4 A. Not particularly.

5 **Q. Let me show you what we'll mark as defendants'**  
6 **exhibit 36, which for the record is a three-page**  
7 **document consisting of Bates numbers CL004506, 4507, and**  
8 **4520.**  
9 **(Defendants' exhibit 36 marked for identification.)**

10 BY MR. HAMID:

11 **Q. Do you recognize this shoe depicted in exhibit 36?**

12 A. Yes.

13 **Q. Is this the shoe that you created in collaboration with**  
14 **YSL?**

15 A. I think so, but you can't see the whole of the shoe.

16 **Q. There are three separate images?**

17 A. The answer is yes.

18 **Q. It has a red outsole?**

19 A. Yes.

20 **Q. It has the Christian Louboutin name on the insole and on**  
21 **the outsole, yes?**

22 A. Yes, inside, yes, I see it. And outside -- yes.

23 **Q. It also has the Yves Saint Laurent name on the insole,**  
24 **yes?**

25 A. It is written "Yves Saint Laurent" -- written inside,  
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HIGHLY CONFIDENTIAL

1 **Q. Do you have any opinion about Mr. Ford as a designer?**

2 A. Yes.

3 **Q. And what is your opinion?**

4 A. It's someone very nice.

5 **Q. Do you -- do you think he has -- do you think of him as**  
6 **creative?**

7 A. Who? Mr. Ford?

8 **Q. Right.**

9 A. Yes.

10 **Q. Do you think of him as original, as a designer?**

11 A. I don't know that.

12 **Q. Innovative? Do you think of him as innovative as**  
13 **a designer?**

14 A. He's intelligent.

15 **Q. Do you think he's a counterfeiter?**

16 A. I don't think so.

17 **Q. Who is Stefano Pilati.**

18 A. It's also a designer.

19 **Q. And you know that he's -- he is currently the creative**  
20 **director at YSL, right?**

21 A. Yes.

22 **Q. And do you have an opinion about him as a designer?**

23 A. Yes.

24 **Q. What's your opinion?**

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1 "haut couture, 1962" in the inside.

2 MR. HAMID: Could you please try to let him finish before  
3 speaking, because I think it's going to be very confused  
4 on the tape.

5 INTERPRETER: Oh. Sorry. Sorry.

6 A. I'm repeating.

7 So what is written inside is Yves Saint Laurent haut  
8 couture -- haut couture, 1962.

9 **Q. Are you proud of this shoe?**

10 A. Yes.

11 **Q. Do you believe that you tarnished your brand by creating**  
12 **a shoe that was associated with the YSL brand?**

13 A. No.

14 **Q. Who's Tom Ford?**

15 MR. LEWIN: Objection.

16 BY MR. HAMID:

17 **Q. You can answer.**

18 A. Tom Ford is a designer.

19 **Q. You know that he was the creative director of YSL?**

20 MR. LEWIN: Objection.

21 A. Oui.

22 BY MR. HAMID:

23 **Q. Do you know when?**

24 A. No, not particularly. No.

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HIGHLY CONFIDENTIAL

1 A. He does his job well.

2 **Q. Do you think of him as creative?**

3 A. Yes.

4 **Q. Do you think of him as original as a designer?**

5 A. (In English.) What is "original"?

6 MR. LEWIN: Okay. Let's go back that way.

7 MR. RAGOT: (French spoken.)

8 MR. LEWIN: No, no, no, no, no. No. No. Excuse me.

9 Excuse me.

10 INTERPRETER: I beg your pardon.

11 MR. LEWIN: Just hang on one second.

12 INTERPRETER: Sorry.

13 MR. LEWIN: Ms. Interpreter, please do not have a private  
14 dialogue --

15 INTERPRETER: I'm sorry. I don't.

16 MR. LEWIN: -- with the witness. When he questions --

17 INTERPRETER: Sorry.

18 MR. LEWIN: -- take the question back --

19 INTERPRETER: Yes. Sorry.

20 MR. LEWIN: -- and let -- and let the questioner come back  
21 again --

22 INTERPRETER: Yes. Yes.

23 MR. LEWIN: -- please. Thank you.

24 The question that the -- Mr. Louboutin said is,

25 TSG Reporting - Worldwide 877-702-9580

## **Exhibit C**

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

----- -X

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

Plaintiffs,

-against-

YVES SAINT LAURENT AMERICA, INC.; YVES SAINT  
LAURENT AMERICA HOLDING, INC.; YVES SAINT LAURENT  
S.A.S.; YVES SAINT LAURENT (an unincorporated  
association); JOHN AND JANE DOES A-Z  
(UNIDENTIFIED); and XYZ COMPANIES 1-10  
(UNIDENTIFIED),

Defendants.

----- -X

DEPOSITION OF FRANCESCO RUSSO

New York, New York

Friday, June 17, 2011

REPORTED BY:

DANIELLE GRANT

JOB NO. 5664



Page 2

1  
2  
3  
4  
5 June 17, 2010  
6 2:47 p.m.  
7  
8  
9  
10  
11 Deposition of FRANCESCO RUSSO, held at  
12 the offices of Debevoise & Plimpton, LLP, 919  
13 Third Avenue, New York, New York pursuant to  
14 Notice before DANIELLE GRANT, a Shorthand Reporter  
15 and Notary Public of the State of New York.  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25

Page 4

1  
2 FEDERAL STIPULATIONS  
3 IT IS STIPULATED AND AGREED by  
4 and between the attorneys for the  
5 respective parties herein that the  
6 filing, sealing, and certification of  
7 the within deposition be waived.  
8 IT IS FURTHER STIPULATED AND  
9 AGREED that all objections, except as  
10 to the form of the question, shall be  
11 reserved to the time of the trial.  
12 IT IS FURTHER STIPULATED AND  
13 AGREED that the within deposition may  
14 be sworn to and signed before any  
15 officer authorized to administer an  
16 oath, with the same force and effect  
17 as if signed to before the court.  
18  
19  
20 - oOo -  
21  
22  
23  
24  
25

Page 3

1  
2 APPEARANCES:  
3  
4 McCARTER & ENGLISH, LLP  
5 Attorneys for Plaintiffs  
6 BY: HARLEY I. LEWIN, ESQ.  
7 245 Park Avenue  
8 27th Floor  
9 New York, New York 10167  
10  
11 DEBEVOISE & PLIMPTON, LLP  
12 Attorneys for Defendants  
13 BY: JYOTIN HAMID, ESQ.  
14 JILL van BERG, ESQ.  
15 919 Third Avenue  
16 New York, New York 10022  
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Page 5

1  
2 VIDEOGRAPHER: This is Tape No. 1  
3 of the videotaped deposition of  
4 Francesco Russo, in the matter of  
5 Christian Louboutin versus Yves Saint  
6 Laurent America, Inc., on June 17,  
7 2011.  
8 The time on the record is 2:47.  
9 My name is Rocio Bravo. I am the  
10 videographer. The court reporter is  
11 Danielle Grant.  
12 Will counsel please introduce  
13 themselves beginning with the party  
14 noticing this proceeding.  
15 MR. LEWIN: Yes. Harley Lewin;  
16 McCarter and English for the  
17 plaintiffs.  
18 MS. SHYAVITZ: Lori Shyavitz --  
19 Lori Shyavitz; McCarter and English for  
20 the plaintiffs.  
21 MR. HAMID: Jyotin Hamid;  
22 Debevoise and Plimpton for Yves Saint  
23 Laurent.  
24 MS. van BERG: Jill van Berg;  
25 Debevoise and Plimpton for Yves Saint



Page 10

1 Mr. Russo  
 2 Q Okay. Did you review any documents  
 3 in connection with your meeting with counsel?  
 4 A Not specifically.  
 5 Q Did you review any documents  
 6 generally?  
 7 A No.  
 8 Q Did you look at any paper  
 9 whatsoever?  
 10 A No.  
 11 Q Okay. You're familiar with the  
 12 dispute between Christian Louboutin and YSL that  
 13 brings you into a deposition today?  
 14 A I do.  
 15 Q All right. And you understand that  
 16 that dispute surrounds Mr. Louboutin's claim of  
 17 infringement of his Red Sole trademark.  
 18 Do you understand that?  
 19 A I do.  
 20 Q Okay. And do you understand Mr.  
 21 Louboutin to have a trademark claim based on his  
 22 Red Sole?  
 23 A I did not understand the question.  
 24 Q All right. Let me -- let me  
 25 withdraw that.

Page 11

1 Mr. Russo  
 2 You know who Christian Louboutin  
 3 is, do you not?  
 4 A I do.  
 5 Q How -- what -- how would you  
 6 describe him?  
 7 A It's a shoe specialist for high-end  
 8 woman shoes, a French designer. I have no more  
 9 words to describe it.  
 10 Q And are you familiar with the Red  
 11 Sole that is used by Mr. Louboutin on his  
 12 footwear?  
 13 A As any person who works in the  
 14 fashion industry, yes.  
 15 Q When did you first become familiar  
 16 with his Red Sole?  
 17 A I cannot recall exactly.  
 18 Q Okay. A moment ago you said as any  
 19 person in the fashion industry. What did you  
 20 mean by that?  
 21 A I mean that the Red Sole in the  
 22 fashion industry became a distinctive mark for  
 23 Christian Louboutin.  
 24 Q Did you -- were you aware of Mr.  
 25 Louboutin's use of the Red Sole on his shoes

Page 12

1 Mr. Russo  
 2 before joining YSL?  
 3 A No.  
 4 Q So you became aware of him during  
 5 the time you were at YSL?  
 6 A As I said, I cannot recall exactly  
 7 since the distinction of Red Sole it is  
 8 something that happened through the year. So I  
 9 cannot say exactly what date it was or what  
 10 year.  
 11 Q Okay. All right. Would you call  
 12 the Red Sole a visual cue?  
 13 A As I said, through the year,  
 14 through the timing it became --  
 15 Q Right.  
 16 A -- visual cue, yes.  
 17 Q Right. And at some point -- well,  
 18 withdrawn.  
 19 You were employed in the design  
 20 group for what I believe YSL called the studio.  
 21 A I was the head of the studio for  
 22 shoes.  
 23 Q The studio for shoes?  
 24 A Yes.  
 25 Q And the studio would receive from

Page 13

1 Mr. Russo  
 2 the marketing people, would they not, a  
 3 direction or a form of written direction to  
 4 guide the studio in its development of products  
 5 from year to year?  
 6 MR. HAMID: Objection to form.  
 7 You can answer.  
 8 A It's not correct. The  
 9 merchandising team prepare a document which is  
 10 called the merchandising rate, where is done an  
 11 analyze of the market and of the previous  
 12 season. So in a specific for Yves Saint  
 13 Laurent, to give sort of a structure of  
 14 collection in term of typology of product, heel  
 15 height. So it's something extremely functional.  
 16 Q Right. I understand.  
 17 A Merchandising never give that  
 18 actual concerning design or the definition of  
 19 the style.  
 20 Q Okay. I apologize if I misstated  
 21 that. It wasn't my intention to indicate that  
 22 they were telling you what to design.  
 23 But would it be fair to say that  
 24 the studio would receive the grid?  
 25 A Um-hmm.

1 Mr. Russo  
 2 Q Right. I understand that. But  
 3 just -- what -- what -- I'm just asking you what  
 4 you can remember about the colors of the  
 5 outsoles.  
 6 A I don't remember the color.  
 7 Q Okay. But you do remember they  
 8 weren't monochrome shoes?  
 9 A I do remember there were no  
 10 monochrome.  
 11 Q Okay. Do you remember whether the  
 12 non-monochrome shoes had red soles?  
 13 A No.  
 14 Q Okay. No, they didn't, or no, you  
 15 don't remember?  
 16 A No, they didn't.  
 17 Q Okay. And there came a time when  
 18 you decided to make a monochrome Tribute shoe,  
 19 right?  
 20 A Um-hmm.  
 21 Q You recall when that was?  
 22 A It was the cruise collection after  
 23 the -- after the first summer we did the  
 24 Tribute.  
 25 Q Do you remember which cruise

1 Mr. Russo  
 2 the collection, do you know whether the  
 3 monochrome version of the Tribute was continued  
 4 from collection to collection thereafter?  
 5 A I don't remember.  
 6 Q Okay. Where are YSL shoes made?  
 7 A Today?  
 8 Q Um-hmm.  
 9 A I don't know exactly.  
 10 Q When you were the director of  
 11 design, where were the shoes being made at that  
 12 time?  
 13 A Sergio Rossi.  
 14 Q In Italy?  
 15 A In Italy.  
 16 Q And were you familiar with the  
 17 factories that were making the shoes at that  
 18 time?  
 19 A Yes.  
 20 Q Were -- do you know whether those  
 21 factories also made the outsoles for those  
 22 shoes?  
 23 A No.  
 24 Q You don't know?  
 25 A No, they don't.

1 Mr. Russo  
 2 collection that was?  
 3 A No, I don't remember the cruise  
 4 collection.  
 5 Q You don't.  
 6 And why did you decide to add a  
 7 sole that was the color of the upper?  
 8 A Because in that specific collection  
 9 we had many product developed around the idea of  
 10 colors. And since monochrome historically has  
 11 become something recurring in the design choice  
 12 for Yves Saint Laurent, it was naturally a  
 13 selection in that specific shoes.  
 14 Q Do you -- was that -- maybe this  
 15 would refresh your recollection. Do you  
 16 remember whether your effort that you've just  
 17 described was for Tom Ford?  
 18 MR. HAMID: Objection to form.  
 19 Go ahead.  
 20 A No, it was for Pilati.  
 21 Q So it -- was it after Mr. Ford's  
 22 departure?  
 23 A It was after Mr. Ford's departure.  
 24 Q All right. After you designed the  
 25 monochrome Tribute shoe, and that became part of

1 Mr. Russo  
 2 Q So do the factories outsource to  
 3 another factory the making of outsoles?  
 4 A Ask me again the question.  
 5 Q All right. Let me see if I can  
 6 rephrase that.  
 7 Would you agree with me that many  
 8 factories that make footwear do not make the  
 9 outsoles of shoes?  
 10 A I'm sorry, but the question doesn't  
 11 make any sense to me, because the sole is not  
 12 even produced inside the factory of the shoes.  
 13 The sole is an element which is produced to  
 14 external supplier that works many brands, and  
 15 each brand define and decide what to do with it.  
 16 Q All right. Do you know who  
 17 would -- the supplier, the external supplier for  
 18 the outsoles of color were?  
 19 A There are many.  
 20 Q There are many?  
 21 A Yes.  
 22 Q Did YSL use more than one during  
 23 the time that you were there?  
 24 A I don't know.  
 25 Q You don't know.