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SCALING RED AND THE HORROR OF TRADEMARK

Constantine V. Nakassis

OWNING THE SOLE OF ANOTHER

. . . I see a red shoe with my red sole. I can't see anything else.

—CHRISTIAN LOUBOUTIN DEPOSITION, JUNE 13, 2011, CHRISTIAN LOUBOUTIN V. YVES SAINT LAURENT (2011)

In 1992, Christian Louboutin was a well-known, if still up-and-coming, women's shoe designer. The now famous, and much repeated, story of his success was one of the material contingencies of quality. Inspecting one day a factory prototype made from a design sketch of his, he was disappointed. The color was different on leather than it was on paper. It had a "black thickness" to it that wasn't in his original drawing. Attempting to make the color on the shoe match the color on the paper, he commandeered the bright red nail polish of his nearby assistant (who was busily doing her nails) and began to paint the outsole of the shoe (Christian Louboutin v. Yves Saint Laurent 2011, doc 32–1, p. 9).[1] This lacquered red sole immediately became, so the story goes, Louboutin's signature design element. Indeed, since 1992, Louboutin has made almost none of his popular and expensive shoes without it. As Lauren Collins (2011, 83) wrote in the *New Yorker,* the red sole "render[ed] an otherwise indistinguishable product instantly recognizable." The "lacquered red sole" on "women's high fashion designer footwear" was finally trademarked in the United States in 2008, recognized by the government as a source-indexing sign of Louboutin's authorial production, of his brand, his identity (see figure 7.1).

Two years later, in the fall of 2010, legendary French fashion house Yves Saint Laurent (YSL) released its 2011 Cruise collection (see figure 7.2). Among many other clothing items and accessories, the Cruise collection featured YSL's signature

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United States Patent and Trademark Office

Reg. No. 3,361,597

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TRADEMARK
PRINCIPAL REGISTER

CHRISTIAN LOUBOUTIN (FRANCE INDIVIDUAL)
24 RUE VICTOR MASSÉ
PARIS, FRANCE 75009

FOR: WOMEN'S HIGH FASHION DESIGNER FOOTWEAR, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 0-0-1992; IN COMMERCE 0-0-1992.

THE COLOR(S) RED IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF A LACQUERED RED SOLE ON FOOTWEAR. THE DOTTED LINES ARE NOT PART OF THE MARK BUT ARE INTENDED ONLY TO SHOW PLACEMENT OF THE MARK.

SEC. 2(F).

SER. NO. 77-141,789, FILED 3-27-2007.

NORA BUCHANAN WILL, EXAMINING ATTORNEY

FIGURE 7.1. Christian Louboutin's U.S. Patent and Trademark Office–registered trademark for "a lacquered red sole on footwear."

monochromatic Tribute, Tribtoo, Palais, and Woodstock women's shoe designs. One of the colors used was red (in fact, four different reds). The overall color palette (the so-called DNA of the brand) of the Cruise collection, and the use of reds in particular, was a citational *renvoi* to the 1960s signature wear of the house founder, Yves Saint Laurent, including to his first advertising campaign in color, which featured a bright red dress (CL v. YSL 2011, doc 34, p. 3).

In January 2011, Louboutin became aware of YSL's all-red shoes, shoes whose sole was, he claimed, "virtually identical" to his own (CL v. YSL 2011, doc 1, p. 15). On April 7, 2011, after a series of communiqués that failed to resolve what Louboutin saw as YSL's attempt "to take unfair advantage" of his brand's "goodwill," Louboutin filed for a preliminary (and, if successful, thereafter permanent) injunction in the southern district of New York against YSL's production of its all-red shoes, arguing that it was likely that the case, if it went to trial, would prove trademark infringement and dilution (under state law and the federal Lanham

FIGURE 7.2. Yves Saint Laurent's "DNA of the Brand—YSL Colors" (from CL v. YSL 2011, doc 34–1, p. 6).

Act), and unfair competition and false designation of origin (under the federal Lanham Act). YSL, Louboutin's lawyers argued to the district court, had to be stopped. Otherwise, the very basis of Louboutin's identity—his red sole—would be crushed under the weight of so many others' soles.

Central to this case was a confounding question: can the color red be trademarked? Can it be owned, enclosed from the commons and tied to a brand identity, transformed into a distinguishing mark on commodities circulating in the market under the name of their source, Christian Louboutin? Or would claiming the red of the outsole constitute an unfair monopoly? Would it stifle "the market" and impoverish "the commons" by allowing Louboutin's brand name to encompass both, contracting the space for competition by disallowing others to use "his" color on their shoes?

The district court of southern New York was called on to draw the line between the commons and intellectual property, between what should be available to all and what can be owned by some, between the market (and the commodity designs that compete within it) and the mark, between Yves Saint Laurent and Christian Louboutin. Not only did Christian Louboutin's and Yves Saint Laurent's brand identities, and thus businesses, depend on where that line was drawn, so did the very contours of the fashion market itself, a domain that turns both on the free play, and availability, of particular qualities (e.g., color as design element) and on the intelligibility of brand identity (e.g., Louboutin, YSL). As this case demonstrates, deciding on a trademark is a decision on what a market is, just as it is a decision on what the extent of the commons is.

In this chapter I show how these questions and decisions are fundamentally scalar in nature, as are the entangled terms upon which they turn: *market, commons, monopoly,* and *trademark*. I demonstrate how central to trademark law, to the adjudication of the red of a high-heeled shoe, are the pragmatics, and metapragmatics, of scale.

METAPRAGMATICS OF SCALE

Scales, as geographers and anthropologists have argued, are *made* through social practices (Carr and Lempert this volume; Latour 2005; Moore 2008; Agha 2011; Lempert 2012). There is always a social project, and thus a pragmatics, of scale. As linguistic anthropologists have suggested, the pragmatics of any social activity are mediated through their *metapragmatics,* the particular ideologies and reflexive practices that construe and regiment, mediate and materialize, that very activity (Silverstein 1993; Agha 2007). Studying scale-making practices requires us to attend to those ethnographic sites where scale itself is reflexively attended to, where the pragmatics of scale are themselves the object of concern and action. As I show in this chapter, trademark law is both a site of scale-making and is characterized

by reflexive worry about itself as a site of scale-making, a (metapragmatic) worry that is part and parcel of how the law (pragmatically) makes scale. The play of this dialectic, I further suggest, is how the law makes claims to speak authoritatively. That is, the reflexivity of the law to its scalar practices and their effects is central to the law's attempts to constitute its jurisdiction (Richland 2013) *as* a site for scale-making.

QUALITY OF SCALE, SCALING OF QUALITY

To speak of practices of (meta)scaling is to speak of the categories and relations between categories that constitute the scale in question (Moore 2008, 215). Such categories and relations are always fleshed out by particular *qualities,* whether these are the qualities of "verticality," "hierarchy," or "spatiality" that (early) geographers used in scaling their objects of inquiry (Moore 2008, 206 and references therein); the "star-shaped" "flatness" described by Latour (2005, 171–2); the "empty, homogenous time" of the scaling of the nation-state (Anderson 2008) or the durative, continual unfolding of other modes of sovereignty and (national) belonging (Eisenlohr 2006); or even the "real-time" quality of discursive interaction (Silverstein 1997; Wortham 2006).

There is a *quality of scale* and a *scaling of quality,* the way in which, say, U.S. case law constitutes the scale of trademarks and the market (according to what the law calls "functionality," as I discuss below) and the way in which such a quality of scale is imbricated in scaling a quality—say, the red of a shoe's outsole.[2] In the pages below, I explore the ways in which trademark case law attunes itself to the qualities of the scales that it draws on in the process of adjudication, and how such attunement is caught up with the project of scaling qualities and the anticipated effects therein. In doing so, I focus on two types of (meta)scaling: first, that of determining the *extent* of particular categories like trademark vis-à-vis the commodities and markets with respect to which they operate, and how the constitution of those categories may engender certain desired or undesired scalar effects. In particular, I show how courts are concerned with how their adjudication of categories like trademark may alternatively create a healthy market wherein competition is encouraged, or an unhealthy one where pernicious monopolies reign and competition is hindered. Second, I focus on legal practices that reflect on scalar relations internal to the law—that is, on the relationship *between* particular qualities of trademarks and commodities (e.g., as representational, functional, source-indexing) and types of intellectual property (copyright, patent, and trademark). The law attempts to keep such relations distinct and, thus, such categories pure and coherent. However, as I show, the qualities that characterize different kinds of intellectual property continually threaten to migrate *across* these categories, creating paradoxes that play into courts' reflexive worries about their scalar

performativity (e.g., to allow unfair monopolies and thus hamper markets). Such problematical interscalarities, as I suggest later in the chapter, threaten to undermine the very justification of trademark law and, thus, are horrific to it. And yet, they follow from a contradiction that resides at the very heart of intellectual property: namely, that intellectual property law demands that trademarks simply index their source and do no more even as every trademark, as a material, aesthetic (de)sign, is necessarily more than a source-designating index. This contradiction follows, as I argue in the conclusion, from the very distinction of trademark and commodity.

FUNCTIONALITY AND TRADEMARK

> *These boots are made for walkin', and that's just what they'll do. One of these days these boots are gonna walk all over you.*
>
> —LEE HAZLEWOOD, "THESE BOOTS ARE MADE FOR WALKIN'," 1966, AS SUNG BY NANCY SINATRA

Trademark law is a scalar project, one that attempts to determine simultaneously the extent of "the market" (and to increase its size through limited monopolies) and the extent of "the commons" (and to maintain, and even increase, it through protections against unfair monopolies). This is based on a particular scalar logic that is equal parts pragmatic and ideological.

In the U.S. legal context, the default assumption is that free competition in the market is founded on a "right to copy" (McKenna 2011). Such a right is, in some sense, what constitutes a market, that domain of comparable goods that, by virtue of their differentiable sameness vis-à-vis some aspect or use value, compete. Against this right to copy, intellectual properties like copyright and patent are partial exceptions, granted precisely because the unhindered play of the market distorts the public good that accrues through such "free" organization of economic activity. Intellectual property, so goes its justification, provides limited monopoly rights precisely so as to *encourage* market activity. Without such exceptions, the market would suffer. The incentive for producers to invest in product creation and innovation would be undermined by the ability of other producers to cheaply copy such goods. Such copying would stifle economic growth and efficiency, disincentivize innovation and creativity, and thus dampen the ability of the market to serve the larger public. The "market" here is construed by the law as both the effect and limit of intellectual property protection.

The ideological stakes of American intellectual property law, then, turn on a tension between market and monopoly, a tension that materializes in the category of intellectual property, that which can be justifiably withdrawn from the "commons" and yet does not also constitute an unfair, and hence illegal, monopoly. This tension is a result of the law as much as it is the law's object of jurisdiction. The

quality that mediates this tension, and thus this scalar project, is what is called, in legal discourse, "functionality."[3]

Intellectual property categories of copyright and patent are determined on the (impossible) distinction between the aesthetics or representational "content" of some commodity (or aspect thereof)—which may be protected by copyright—or by its utility or "function," which may be protected by patent.[4] "Function" here has a double valence. On the one hand, it appeals to commonsense notions of utility, the good as something that is bought or sold so as to perform some function (e.g., a shoe that protects the foot), as opposed to representing an idea or a concept (e.g., a book that expresses a method for accounting). On the other hand, function is also routed through the detour of the market, which is to say that function denotes that which is inherent to a good qua commodity, that which defines a good such that it competes with other (similar) goods in a market.

In contrast to copyright and patent rights, which protect (aspects of) the commodity itself, trademark rights protect the semiotic relation that the mark mediates. Trademarks protect, or rather instate, the indexical relation—more specifically, the rigid-designating relation (Kripke 1981; Nakassis 2012)[5]—between a commodity and its nominal production source for some relevant social domain of consumers (Coombe 1998); or, in a more modern idiom where "source" is often anonymous and perhaps irrelevant to consumer activity (Klein [1999] 2000), trademarks protect the iconic indexical relationship between commodity and brand image (Nakassis 2013a). The trademark distinguishes goods not by their commodity type or "market" (the functional category within which competitors compete—say, "shoes") but by the entity that stands as their putative origin (say, Louboutin). The trademark, then, is defined by the law as a transparent medium that allows consumers to rationally navigate otherwise opaque markets where origin and source are unclear, thereby protecting them against fraud and "confusion."[6] The trademark thus is not functional (in the sense of patent), nor does it represent (in the sense of copyright). Rather, it is a supplement to the commodity, a sign independent from it that merely acts as a relay of the good's origin and, as far as the law is concerned, no more.[7]

And indeed, the trademark, *as* a trademark, should *not* be representational or functional. Hence, if one can show that some putative mark is representational with respect to the market within which it circulates, as in the case of "generic" trademarks that denotationally describe the commodity type to which they are appended (e.g., "Shoe" brand shoes; see Coombe 1998; Nakassis 2012), then such a mark may be canceled. And if a putative mark can be shown to be functional—that is, if some quality of it is essential to the purpose or use of a good (if it is critical to the commodity genus within which firms compete, which is also to say if it constitutes the relevant market) and thus disadvantages other firms and "unfairly" distorts competition (e.g., by raising their costs to compete or by forcing them to

lower the quality of their goods)—then it should not be protected as a trademark. Function, in trademark law, then, draws the line where the commodity begins and the trademark ends, and this, again, not simply to define the extent of the category of trademark but also to prevent the limited monopoly afforded by the mark from distorting the market within which commodities compete.

Of course, the lines between representationality and functionality,[8] and thus copyright, patent, and trademark, are far less clear than the law would seem to require. This lack opens up the potential for "mutant" forms that operate across categories (Ginsburg 2008), as well as for forms that fall "between the seams" (Cox and Jenkins 2008). The design of fashion items like designer shoes, to take an example of the latter, have historically been excluded from both copyright and patent (Schmidt 1983, 864; Raustiala and Sprigman 2006; 2012).[9] On the one hand, this is because the design of shoes presumably has an "intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information" (17 USC §101). On the other hand, it is because, even as "useful articles," fashion designs rarely fit the criteria for patenting—that is, that the innovation be nontrivial and nonobvious (Hagin 1991, 354–356; Tsai 2005, 455–458; Scafidi 2006, 122–123).

Whatever we think of the ideological work that goes into making such distinctions—for example, the assumption that high-heeled shoes are bought and worn because they are functional for walking, that the work of fashion designers isn't truly innovative, or even that the world is parsable into things and signs[10]—what is of interest to me here is that in such situations where commodity design falls "between the seams," trademark rights are often invoked precisely because, as noted above, trademarks are legally defined as distinct from the (functional) commodities with which they comingle. And indeed, without easy appeal to copyright and patent, fashion brands have increasingly depended on trademark to protect their designs. This creates a conundrum since trademark law is not intended to protect design (in fact, quite the opposite, as noted above), a conundrum strategically materialized in goods whose trademarks *are* their designs and whose designs *are* their trademarks, in trademarks whose qualities are difficult, if not impossible, to distinguish from the commodity designs to which they are appended.[11] Think, for example, of Louboutin's red outsole (cf. Louis Vuitton v. Dooney & Bourke 2008).

SCALING A MARK

> *Never has a red sole meant so much.*
>
> —FASHION CONSULTANT ROBERT BURKE, COMMENTING ON LOUBOUTIN'S SHOES (QUOTED IN *FOOTWEARNEWS.COM* 2010, CITED IN CL V. YSL 2011, DOC 22–37, P. 2)

Single colors have historically been considered untrademarkable. For nearly a century, the law held that colors could never function as trademarks, except as part of

some otherwise trademarkable symbol. To trademark color alone would give rise to unfair monopoly because, it was variously argued, the number of distinguishable colors is limited, and for any one competitor to "own" a color would "deplete" the colors available to other competitors, thereby disadvantaging them in commodity design, production, and sale. It would also discourage new entrants to the market and thus adversely affect market vitality (e.g., see Campbell Soup Co. v. Armour & Co. 1949 and references therein; Life Savers Corp. v. Curtiss Candy Co. 1950; Summerfield 1993).

In 1995, however, the Supreme Court, in *Qualitex v. Jacobson,* definitively argued that single colors could be trademarks under two conditions. First, single colors could be trademarked if they were shown to have "secondary meaning" (that is, that an *appreciable* number of consumers associated the color in question exclusively with a particular brand [as we will see below, the scale of the mark's recognizability is one important basis upon which courts adjudicate trademark cases—see, e.g., EMI Catalogue P'ship v. Hill et al. 2000]).[12] Second, a single-color mark could be trademarked if protection wouldn't significantly put other competitors at a "non-reputation-related" (i.e., non-brand-related) disadvantage (e.g., by increasing the cost of the good or by decreasing its quality)—that is, if the colors in question weren't "functional" with respect to the market, or commodity type, in question.[13]

Turning to *Christian Louboutin v. Yves Saint Laurent,* where it was a single color qua trademark that was at issue, critical to Louboutin's claim was the scale of the semiotic relation between the red outsole and his brand (the first condition noted above). Indeed, Louboutin's initial 2001 application to the U.S. Patent and Trademark Office (USPTO) for trademark registration was rejected precisely because the red outsole was decided to be "merely an ornamental feature of the good"—that is, part of the shoe's design. And this, further, was because Louboutin failed to show that his putative mark had "secondary meaning," which is also to say that he failed to show that enough people associated red outsoles with his brand. Louboutin's 2008 application (CL v. YSL 2011 doc 22–7, 22–8, 28), which provided a preponderance of evidence (from advertising, sales, and press coverage) of the wide scale of the red outsole *as* an exclusive sign of Louboutin, by contrast, succeeded. No longer commodity design, given the demonstrated scale of association of the red outsole as an index of his production, the red outsole was now officially a trademark (see figure 7.1).

In attempting to protect the Louboutin mark from YSL, Louboutin's lawyers rehashed much of the same ground covered in his USPTO application. Louboutin's lawyers submitted copious affidavits, reports, and declarations from lawyers (CL v. YSL 2011, doc 1, 18), survey experts (doc 21), fashion industry insiders (doc 46), and corporate honchos (doc 22–24) to demonstrate the popularity of his shoes, as evinced by sales (240,000 shoes sold in the United States in 2011, worth

upward of $135 million), fan websites, and numerous public awards honoring his success. Multitudes of press clippings were submitted by the lawyers describing the red outsole as an exclusive and distinctive sign of Louboutin (doc 22–2, 22–9 to 22–25). Lengthy corporate documents (doc 22–30, 22–33) detailed the enormous media coverage of Louboutin's red shoes (e.g., in celebrity events where celebrities wore his red-soled shoes, in films and television shows that featured them, and even pop songs about them). All of this was to demonstrate the sheer scale of Louboutin's mediatized presence, the sheer size of the social domain that took the red sole *as* a rigid designator for Louboutin. All of this was, like Melville's description of the whale's carcass discussed by Carr and Lempert in this volume's introduction, to invoke, and create, the leviathan of his brand. Louboutin's lawyers wrote to the court:

> Each article and product placement results in attention from tens of thousands, and often millions of individuals for the Louboutin Footwear and especially its Red Sole Mark. By reason of the remarkable unsolicited media coverage of Louboutin Footwear, product placements, celebrity appreciation and Plaintiffs' marketing strategy, the Red Sole trademark is known to relevant consumers throughout the United States and the world. . . . The Red Sole has become synonymous with Christian Louboutin and high fashion. (CL v. YSL 2011, doc 1, p. 9; my underlining)

Or, as they wrote in a later document: "Massive and *undisputed* evidence of broad media coverage and public recognition demonstrate that the Red Sole Mark is distinctive, protectible [*sic*], and even famous. From Oprah to Barbie's special Louboutin shoes and Louboutin's half-million fans on Facebook, luxury goods consumers and the general public have overwhelming exposure to the Red Sole Mark" (ibid., doc 40, p. 6; original italics, my underlining). Everyone (who mattered) knew about the "flash of red," which is why it was critical that competitors like Yves Saint Laurent not imitate and steal that which allowed consumers to identify a shoe as a Louboutin.

In their defense, YSL's lawyers took a number of tacks. For example, they argued that consumers did not exclusively associate a red outsole with Louboutin; indeed many other designers had used red outsoles on shoes before Louboutin, including YSL. They also argued that Louboutin's surveys, which purported to show that consumers were likely to be confused by YSL's shoes (that is, take them to be Louboutin shoes), were flawed. Their own survey data showed little likelihood of consumer confusion (CL v. YSL 2011, doc 36). Moreover, the absence of any evidence reported by Louboutin of any actual consumer being confused, especially given that YSL had sold thousands of its monochromatic red shoes over the years, indicated that Louboutin's move for preliminary injunction would likely fail. The scale of the infringement wasn't enough, YSL's lawyers argued, to carry Louboutin's case forward.

But the most fundamental question YSL's lawyers raised was whether the very use of red in a shoe obviated protection as such: that is, was Louboutin's red a "functional" element of the shoe's design and thereby untrademarkable? Was red part of the commodity per se? Was red part of the commons, something public that anyone should be able to use in a design, something that was part of the market and not anyone's exclusive property? Asking these questions, YSL hit back against Louboutin with a counterclaim that Louboutin's mark didn't even qualify for protection at all (CL v. YSL 2011, doc 8). They wrote, "Louboutin claims to have the exclusive right to use red outsoles on women's footwear—even on shoes, like all the YSL models challenged in this lawsuit, that are entirely red. Louboutin's attempt to monopolize the use of red outsoles—even to the extent of claiming that no other designer can make an all-red shoe—is unsupported by law, defies common sense and would unduly restrict the design options available to competitors in this market" (CL v. YSL 2011, doc 8, p. 2; my underlining). At the heart of YSL's counterclaim was that the red outsole was, to return to the USPTO's rejection of Louboutin's original trademark application, merely an "ornamental design feature" of the shoe—that is, that the trademark was "aesthetically functional" and thus shouldn't be able to serve as a source-designator.

Here we see how functionality, definitionally excluding of trademark, reappears through the trope of the "aesthetically functional." That which excludes fashion from copyright (functionality) is merged with that which is irrelevant to patent (aesthetics), manifesting in a chimerical noun phrase that specifies the functional quality of fashion commodities *as being their aesthetics.* Red—as an aesthetic design feature of the shoes—is a tool in the color palette of all designers aiming to compete in the fashion market for women's designer shoes. Hence, to concede a monopoly in a context where the "aesthetic use of color is literally the function of the productions" would "[impoverish] other designer's palettes" (CL v. YSL 2011, doc 33, p. 8, citing Jay Franco and Sons v. Clemens Franek 2010, p. 11) and thus unfairly disadvantage them in the market. Louboutin's lawsuit, then, YSL's lawyers argued, was "part of an anti-competitive campaign to monopolize use of a common design feature and thereby inappropriately limit the design options available to competitors" (CL v. YSL 2011, doc 8, p. 4; my underlining).[14] It was an attempt to rescale, unjustly, YSL's lawyers argued, the market by appropriating those qualities that should be part of the commons (the color red) to a brand identity (Louboutin).

YSL also argued that their own use of red on the outsole was not as a trademark at all but as part of a more general design concept: monochromaticity (CL v. YSL 2011, doc 33, p. 29). Their design, in that sense, was a "fair use."[15] It "expressed" and "described" a concept rather than designated a source (CL v. YSL 2011, doc 33, p. 29, also see doc 8, p. 4) and, thus, was of a different ontology than Louboutin's use of red as a mark. It was an expression of an idea and hence was not an infringement.

Rather than address the scale of Louboutin's mark (which they implicitly conceded), YSL's arguments addressed the courts' concerns regarding the law's performative power to make scale, contending that protecting a single color as a mark would in effect constitute a monopoly on a commodity type, contracting the market (in this case, women's designer shoes) and the commons (in this case, colors available for fashion design). Moreover, YSL's lawyers argued, affording Louboutin's red sole trademark protection would not simply unfairly and deleteriously rescale the market and commons, it would also contradict the very legal conditions of possibility for trademarkability. YSL's lawyers articulated and anticipated, and thus provoked, the court's reflexive attunement to its own scale-making powers by appealing to the very logics that organize the law itself—that is, by invoking the quality of functionality.

Scaling a quality turned on the law's quality of scale. YSL attempted to shift the scale in question, away from the scale of the mark and toward the question of "aesthetic function." This was a gambit to change the legal category of the semiotic form in question (the color red), to shift from the idiom of recognition and confusion to monopoly and function—that is, from mark to market, property to commons.

The threat and danger to Louboutin was real, for these arguments had recently held traction in a similar type of case in the French courts (Christian Louboutin v. Zara 2012; see CL v. YSL 2011, doc 32–2, pp. 5ff.).[16] Indeed, without a trademark, Louboutin would lose the main legal instrument he had to police his brand, to stay the qualities that made it intelligible in the marketplace, that made it unique and desirable to consumers. As Louboutin's lawyers anxiously noted, designers like Christian Dior, and legions of unnamed counterfeiters and midgrade copy brands, were awaiting the outcome of this case so as to unleash their own red-soled shoes (CL v. YSL 2011, doc 40, p. 14, and fn. 11, p. 10). The court stood as the sole dam holding back a flood of goods that would drown Louboutin. Palpably worried, Louboutin's lawyers wrote, "But when YSL ignores countless color choices, including other reds, and apes the famous signature of the LOUBOUTIN brand, it infringes and exposes Louboutin to irreparable harm via a loss of control over its own brand identity and ravaging of the goodwill painstakingly built in the Red Sole Mark. Other competitors will likely join YSL with their own red soles. Unless this court enjoins YSL, the floodgates will open, and the Louboutin business will be devastated" (CL v. YSL 2011, doc 40, p. 6; my underlining).[17] A single color controlled the fates of market and brand.

Two sides, two scalar arguments: on the one hand, not protecting Louboutin would wipe them off the fashion map by unleashing unbridled copying, by the proliferation of the qualities they claimed as their brand dominion; on the other hand, protecting Louboutin would create an unfair monopoly, allowing Louboutin to unfairly expand their control of the commons, thereby contracting the space for legitimate competition.

A WHITMANESQUE QUESTION

On August 10, 2011, Judge Victor Marrero issued his decision and order. Recognizing that Louboutin's use of red was indeed indexical of his brand, Marrero framed the main issue as such: "The issue now before the Court is whether, despite Christian Louboutin's acknowledged innovation and the broad association of the high fashion red outsole with him as its source, trademark protection should not have been granted to that registration" (CL v. YSL 2011, doc 53, p. 5; my underlining). Having dryly reviewed the facts of the case, Marrero continued:

> Hence, this case poses a Whitmanesque question. Paraphrased for adaptation to the heuristics of the law, it could be framed like this. A lawyer said *What is the red on the outsole of a woman's shoe?* And fetching it to court with full hands asks the judge to rule it is
>
> > [A] gift and remembrancer designedly dropt,
> > Bearing the owner's name someway in the corners, that we may
> > see and remark, and say *Whose?* (CL v. YSL 2011, doc 53, pp. 7–8, citing Whitman's *Leaves of Grass,* "Songs of Myself," poem 6; italics in my source)

Taking poetic license with both Whitman's poetry and YSL's arguments, Marrero posed Louboutin's request to rule its red outsole exclusively distinctive of its brand as an impossible task. Indeed, the opening of Whitman's poem—the second line of which is neither paraphrased nor quoted by Marrero—is filled with doubt:

> A child said What is the grass? fetching it to me with full hands;
> How could I answer the child [here, the lawyers]? I do not know what it [here, the red of a shoe] is any more than he.

Notwithstanding his initial skepticism and hesitation, Marrero went on in his decision, like Whitman in his poem, to offer some decisive judgments on the matter.

For Marrero, the fundamental question was whether a color could be a trademark in fashion *at all.* Or put otherwise, could color in fashion ever *not* be functional—that is, not be a quality of the good as such? Comparing fashion to painting, Marrero reasoned that color furthers the aim of the object itself, "to attract, to reference, to stand out, to blend in, to beautify, to endow with sex appeal—all comprise nontrademark functions of color in fashion" (CL v. YSL 2011, doc 53, p. 20). Citing *Qualitex v. Jacobson* (1995), citing G. K. Chesterton's *Simplicity and Tolstoy,* Marrero noted that "color serves an additional significant nontrademark function: 'to satisfy the "noble instinct for giving the right touch of beauty to common and necessary things"'" (CL v. YSL 2011, doc 53, p. 20). Red, Marrero suggested, was irreducibly aesthetic and, thus, in fashion at least, irreducibly functional. Marrero found that a red outsole was simply part of the shoe's design itself—part of its function as an aesthetic good—and, thus, part of the market within which such goods competed: women's designer footwear. Note that

Marrero's reasoning turned, not simply on rescaling Louboutin's mark vis-à-vis the market for women's shoes, but more fundamentally on rescaling the market and the commons vis-à-vis the question of color in fashion per se.

But perhaps a more troubling scalar conundrum to Marrero was the question of what exactly was the quality of Louboutin's particular red.[18] Could it be determined with sufficient specificity such that it wouldn't threaten to spill out of itself, bleeding into surrounding colors, shades, and hues, cannibalizing the fashion market by denying whole color swatches to other designers (cf. NutraSweet v. Stadt 1990; Summerfield 1993 on "shade confusion")? Voicing a concern about the potential effects of protecting Louboutin's red as a single-color mark (not simply in this case but in every future scenario where this case could be cited as precedent), Marrero apocalyptically warned of "fashion wars" (CL v. YSL 2011, doc 53, p. 457) and other dystopic futures where the color spectrum would be divvied up and owned by different brands. In short, Marrero asked whether the fuzzy quale of a single color could be disciplined enough to serve as a sign of identity. Or is color always blurry as to where its boundaries lie, a blurring that is also an expansive, monopolistic projection into the market, a menacing halo rendering contiguous shades and hues always potentially infringing?

And even if the red line of identity could be drawn, how would it be *registered* as a public fact?[19] As emphasized during oral arguments by YSL's lawyers (CL v. YSL 2011, doc 54, p. 10, 32) and taken up by Marrero in his decision (CL v. YSL 2011, doc 53, p. 455), the materiality of the quality of Louboutin's red—even if specified by Pantone color—rendered its referent problematic: the "same" Pantone color on a computer screen is noticeably distinct from its materialization of a piece of paper, and both are distinct from the "same" color materialized on a piece of leather (also see CL v. YSL 2012, doc 89, p. 21). (Remember here the founding myth of Louboutin's lacquered red shoes discussed at the outset of the chapter.) That is, Louboutin's particular red couldn't be a rigid-designating trademark precisely because, it was suggested, its referent couldn't be stably "fixed" (Kripke 1981); or to put it otherwise, it couldn't be reliably scaled in relation to other shades, hues, colors.[20]

In the end, Marrero decided that Louboutin was unlikely to succeed in his attempt to prove his claims, because his mark wasn't, well, actually a mark. This wasn't because it didn't have wide-scale recognition. It did. But to concede it protection would result in monopoly rights that contracted the space for competition. Marrero's decision, then, was as much about the (meta)pragmatics of scale as it was anything else: what scalar entailments would follow if protection was provided? On this basis Marrero denied Louboutin's motion for injunction. He further noted, regarding YSL's counterclaims, that Louboutin might not even have a valid mark, throwing the sign of their brand identity into question and threatening its cancelation.[21]

Here I would like to dwell on Marrero's invocation of Whitman, for it strikes upon the scandal and horror of the case (indeed, Marrero's decision scandalized and horrified many in the fashion world—including Tiffany and Company, with its trademarked blue box, and the International Trademark Association, both of whom wrote amicus curiae on behalf of Christian Louboutin), and trademark mark law more generally, as I discuss in the next section. In the original poem, the line that Marrero quotes is preceded by the line "Or I guess it is the handkerchief of the Lord"—that is, this gift and remembrancer, the grass, is the sign of God himself (*The* Source known to all true believers). Whitman next suggests, voicing the grass, that—like the bounty of God—the grass belongs to all: "Growing among black folks as among white, Kanuch, Tuchahoe, Congressman, Cutt, I give them the same, I receive them the same." We all know the grass's source, and yet it exists for all. Whitman's next line is beautifully ominous, forming the crux of the rest of the poem and retroactively framing its opening. Whitman writes, "And now it seems to me the beautiful uncut hair of graves." This is the horror and scandal of Marrero's decision for Louboutin: the death of his (brand) identity, the return of his mark to the commons. Marrero answers this "Whitmanesque question," then, like Whitman: a single color in fashion, like the green grass, cannot be owned. This ruling threatened all color marks (and implicitly all trademarks), making them no more than the beautiful adornments of their owners' now unmarked mass graves.

AVOIDING AESTHETIC FUNCTION

The Court of Appeals for the Second Circuit, on September 5, 2012, resoundingly rejected Marrero's decision (CL v. YSL 2012, doc 121). Underwriting their rejection was a sense of Marrero's impropriety in scale shifting. Marrero's decision operated at the wrong legal scales, covering whole types of marks ("single color marks") and entire economic-productive domains ("fashion"). His issuance of a blanket "per se rule" was, they argued, inappropriate and outside of the mandate of the district court (cf. Philips this volume). Rather, as they implied, a piecemeal, ad hoc approach must be followed, each case taken on its own merits and particularities (Summerfield 1993). The scale of any judgment within the citational entailments of future cases should be small, contained, particular (cf. Marrero's precedential concern with future "fashion wars").[22]

In its legal reasoning, the Second Circuit court's decision, written by Judge José A. Cabranes, followed a rather conservative path. Following the precedent of the Second Circuit's discussions about "aesthetic functionality," the court defined the test for aesthetic functionality as whether the putative trademark significantly limits the range of competitive designs available to other market actors. Would protection bar the use of features necessary to compete in the relevant market? Having laid out what counts as functionality, however, the court did *not* decide on the

question of whether a red outsole was functional per se, or whether a functional *use* of a trademark (like YSL's) should be protected in general. Rather, following the ad hoc method necessitated by their rejection of Marrero's "per se rule," they concluded that the Louboutin trademark—as defined in the USPTO's trademark registry—was overbroad. It didn't accurately describe Louboutin's *actual* trademark as understood by the public (which is to say, how the court's methodological individualism construed how "consumers" evaluated the trademark). They noted that Louboutin's trademark was *not,* in fact, "a lacquered red sole on footwear" but a "red outsole contrasting with the remainder of the shoe" (CL v. YSL 2012, doc 121, p. 11).

The court, in effect, canceled and rewrote Louboutin's trademark at once. Note the result: for with the trademark modified, YSL's monochromatic red shoe—now defined by fiat as an exception to Louboutin's trademark ("'The use of a red lacquer on the outsole of a red shoe of the same color is not a use of the Red Sole Mark,' the court intoned [CL v. YSL 2012, doc 121, p. 11])—ceased to infringe. The court complexified the mark so that it was no longer a single color, but a *contrast* of colors (red/nonred) between parts of the shoe (outsole versus "upper").[23] This judgment, in effect, found for both parties. Christian Louboutin got to keep his trademark (now modified), and YSL got to keep its monochromatic shoe (now noninfringing).

Like Marrero in the district court, the Second Circuit engaged in its own scale-making, this time, though, to rather different effect. By redefining the qualities that constituted the trademark, the Second Circuit redefined the market for designer women's shoes itself, redrawing the line between the space of exception (red outsoles + nonred uppers = Louboutin monopoly) and the space of free competition, "functionality," and the "right to copy" (i.e., everything else—namely, women's designer shoes that do not have a red outsole contrasting with the rest of the shoe). This was accomplished by the court nimbly navigating the interscalar entanglement between, on the one hand, the constitutive *quality* of the law's internal scalar organization (functionality) and, on the other hand, the scalar *effects* of the law vis-à-vis that very quality (e.g., to create monopolies and contract the commons, or to demolish corporate futures). Through deft definitional footwork, the Second Circuit managed to sidestep this entanglement, "dodg[ing] the functionality issue"—as Rebecca Tushnet (2012) put it[24]—by avoiding a decision that framed Louboutin's mark as functional while also avoiding the implication that Louboutin's mark constituted an unfair monopoly on the market. The court's redefinition obviated the very arguments and tests for aesthetic functionality that it so meticulously reviewed, in fact, reviewing them precisely so that their redefinition would make them nonissues.

With a repressing silence, the Second Circuit met the scandal that Marrero had raised. By dodging the issue of aesthetic functionality, the court dodged the

conundrums of scale that constitute the very intelligibility of its practices (viz., the question of functionality) and thus the internally contradictory pragmatics of its scale-making. Such conundrums, I suggest below, threaten to unearth the difficult, and perhaps impossible, to resolve legal relation between the trademark's source-indexicality and its aesthetics. This insolubility, I argue, puts trademark law's very coherence and authority into question.

UNAVOIDABLE AESTHETIC FUNCTION

As noted earlier, the trademark as an ideal legal type is supposed to be, relative to the commodity it marks, a pure index, a transparent medium that simply points to, and invokes, the commodity's source. And yet, every trademark in order to do so must be materially embodied and thus must itself have its own qualities and aesthetics (cf. Keane 2003; Nakassis 2013b).[25] This was, of course, Marrero's point: in domains like fashion—where aesthetics *is* consumer desire, *is* the market, *is* competition, and thus *is* function, insofar as the trademark is part of the aesthetics of the good (or, put in reverse, insofar as design can be[come] source-indexing)—the distinction of source-designation and aesthetics/function is rendered permanently problematic. The challenge that lurks under the surface of this case, then, is precisely this: what do we make of the fact that a trademark can and perhaps must also be, unto itself, a site of aesthetics and desire, and that this—the law notwithstanding—might simply be its function (cf. Nakassis 2012; 2016, 33–86)? The challenge of "aesthetic functionality" points to an internal contradiction within trademark law: that the unavoidable aesthetics of a mark are necessarily possibly functional, that a trademark always is itself a design and, by being contiguous with the so-marked commodity, part of *its* design. The quality that negatively defines the mark (functionality), curiously undermines the mark's very identity through its return in the mark's necessary aesthetics, in its inhering qualities.

The law attempts to work around and manage this internal contradiction in various ways. In this case, and others like it (e.g., Louis Vuitton v. Dooney & Bourke 2008; Fleischer Studios, v. A.V.E.L.A. 2011), this self-contradictory quality of scale appears as silence, elision, avoidance, and ad hoc–istry, as noted above. This is because to face up to the self-contradiction of this founding quality would constitute trademark law's very negation. Such a scene of self-reckoning, as I suggest below, is horrific to the law.[26] It is avoided when possible (as in CL v. YSL 2012) and, when impossible, met with explicit disavowal.

Consider the Ninth Circuit case *Au-Tomotive Gold v. Volkswagen et al.* (2006).[27] Au-Tomotive Gold (also referred to as Auto Gold) produced key chains and license plate holders featuring the names and logos of well-known car companies. One of the facts of the case was that consumers bought such goods because they wanted their license plate holders and key chains to match the logos of their cars.

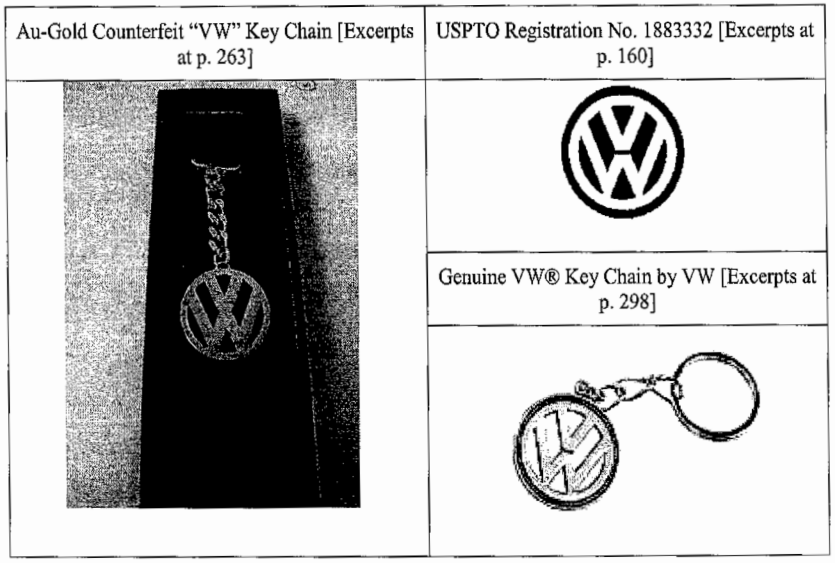

FIGURE 7.3. Au-Tomotive Gold keychain compared with the VW registered trademark and a VW key chain (from Au-Tomotive v. Volkswagen et al. 2007, doc 165, p. 3).

While the trademarks on such goods invoked brands like Volkswagen or Audi, they explicitly did not function as indexicals of the source of the key chain or license plate holder itself (i.e., Au-Tomotive Gold) and, thus, did not impute the production source of the goods to Volkswagen or Audi.

While Au-Tomotive Gold had gotten licensing rights from many of the car companies whose logos they reproduced on their accessories, they hadn't gotten permission from Volkswagen and Audi. Arguing against the idea that their products were infringing, Au-Tomotive Gold noted that the marks were being used not *as* trademarks but as functional elements in an aesthetics of trademarkedness (cf. Nakassis 2013c; 2016, 33–86). In order to cater to this market and to consumers' desires ("the actual benefit that the consumer wishes to purchase," Au-Tomotive v. Volkswagen et al. 2006, p. 9515, citing Auto-Tomotive's arguments)—that is, in order to operate as matching elements within a total car gestalt—trademarks had to be used in the design of these goods. Otherwise, how could Au-Tomotive Gold compete in the market for car accessories, a market defined by consumers' demand for logo bejeweled accessories (see figure 7.3)?

The district court found in favor of Au-Tomotive Gold. The court noted that the "VW and Audi logos are used not because they signify that the license plate or key ring was manufactured or sold (i.e., as a destination of origin) by Volkswagen or Audi, but because there is a[n] aesthetic quality to the marks that purchasers

are interested in having" (as cited in Au-Tomotive v. Volkswagen et al. 2006, p. 9519)—namely, the marks themselves. Here we see most clearly, and threateningly, the trademark as both trademark *and* aesthetic bundle of qualities. The qualities that the trademark comprises overwhelm it, allowing it to be refunctioned to new purpose by new economic actors, allowing Au-Tomotive Gold to appropriate Volkswagen's mark as a design element in its car accessories.

The case was appealed to the Ninth Circuit; and like the Second Circuit, the appellate court of the Ninth Circuit decisively reversed the district court's finding, remanding the rest of the case back to the district court for infringement and dilution charges. In its judgment, the Ninth Circuit stared into the abyss and saw only death and destruction. In its decision, the court wrote, "Accepting Auto Gold's position would be the death knell for trademark protection. It would mean that simply because a consumer likes a trademark, or finds it aesthetically pleasing, a competitor could adopt and use the mark on its own products. Thus, a competitor could adopt the distinctive Mercedes circle and tri-point star or the well-known golden arches of McDonald's, all under the rubric of aesthetic functionality" (Au-Tomotive v. Volkswagen et al. 2006, p. 9515). In the next paragraph, the court noted, "Taken to its limits, as Auto Gold advocates, this doctrine would permit a competitor to trade on any mark simply because there is some 'aesthetic' value to the mark that consumers desire. This approach distorts both basic principles of trademark law and the doctrine of functionality in particular" (Au-Tomotive v. Volkswagen et al. 2006, p. 9515). That is, the qualities of the trademark—its aesthetics unto itself—always threaten to suspend the trademark's identity as a proxy of the brand. The shifty promiscuity of the trademark as a (de)sign that may change function across contexts,[28] its duality as a sign of elsewhere *and* as an aesthetic object unto itself, potentially subordinates its status as a trademark to its aesthetics and thus augurs its negation. This passing bell, this desire for the mark as such, threatens to kill the trademark and have it resurrected as an undead object, possessable and revivifiable by anyone, a body with no mind. And indeed, this "aesthetic functionality defense" has been termed by certain legal commentators as a "zombie apocalypse" (Heavner 2012; also Fletcher 1985, 2011), an exanimate threat that continually rises to cannibalize trademark law, a horror that can never quite be, but must be, buried.[29]

The Ninth Circuit court, of course, recognized that "consumers sometimes buy products bearing marks . . . for the appeal of the mark itself, without regard to whether it signifies the origin or sponsorship of the product" (Au-Tomotive v. Volkswagen et al. 2006, p. 9521). And yet, the registering of this fact in trademark law could *not* come to pass. Indeed, in the face of this horror, this death knell, the court responded by disavowal: We know, and yet we act as if we don't. It continued: "As a general matter courts have been loathe to declare unique, identifying logos and names as functional" (Au-Tomotive v. Volkswagen et al. 2006, p. 9522).[30] And indeed, like the Second Circuit, the Ninth Circuit could only respond by normative

fiat, writing (note the shifts in modality, which I have underlined): "While that may be so, the fact that a trademark is desirable does not, and should not, render it unprotectable" (Au-Tomotive v. Volkswagen et al. 2006, p. 9530). Later in its decision, the court reissued the following abnegation: "We [the Ninth Circuit] have squarely rejected the notion that 'any feature of a product which contributes to the consumer appeal and saleability [*sic*] of the product is, as a matter of law, a functional element of that product' [citing Vuitton, 644 F.2d at 773]. Such a rule would eviscerate the very competitive policies that functionality seeks to protect" (Au-Tomotive v. Volkswagen et al. 2006, p. 9531).[31]

Why would it "eviscerate" trademark law, gutting it and leaving it permanently incontinent? Because it implies a performative contradiction and paradox immanent in the heart of the quality of scale through which trademark is defined: being a trademark entails the necessary possibility of others desiring the trademark and thus "aesthetically" consuming it, thereby rendering the trademark "functional" and obviating its protection. Being a trademark, then, would negate the mark's very ontology as a trademark. This result is, not surprisingly, anathema to the court, for this would discourage the investment in and use of trademarks and, thus—as the Ninth Circuit put it—negate the "competitive policies" that functionality serves. It would negate trademark law as such.

The contradiction immanent to the mark, then, is the performativity of its aesthetics. Trademarks performatively open up aesthetic spaces, functional spaces, markets. Consider again the "flash of red" of Louboutin's shoes. As reported in the case's files, Louboutin's red-soled shoe *created* an aesthetic space in the market for women's shoes where there was none before. Louboutin's mark established a space of citational possibility for other designers, the very space for competition, for copying, for aesthetic function:

> Louboutin took a part of the shoe that had previously been ignored and made it not only visually interesting but commercially useful. (Elizabeth Semmelhack, curator at Bata Shoe Museum in Toronto, quoted in Collins 2011, p. 83, reproduced in CL v. YSL 2011, doc 22–2, p. 4)

> Louboutin made a colored outsole into a trend with his red lacquer mark and built the Red Outsole Mark over twenty years into an iconic identifier. (Lewin et al. [Louboutin's lawyers], CL v. YSL 2012, doc 99, p. 16; my underlining)

The fashionable use of the outsole for aesthetic purposes was, on these accounts, *brought into being* by Louboutin's mark. This performativity is precisely the contradiction faced by the Ninth Circuit in *Au-Tomotive v. Volkswagen et al.* (2006) and "dodged," by the Second Circuit in *Christian Louboutin v. Yves Saint Laurent* (2012; cf. Flagg Mfg. v. Holway 1901, cited by McKenna 2011, 837).[32] Function and aesthetics are not distinct from source-indexicality (or commodity/market from mark, or quality from identity) but, in a very real sense, performatively follow from it.

THE TRANSMIGRATION OF SOLES

In this chapter I have explored the interscalar relationship that mediates, and is mediated by, trademark law: on the one hand, the law's reflexivity to its own scale-making effects within and beyond the law; on the other hand, the law's self-contradictory scalar infrastructure, that undead quality of scale, "functionality." In concluding, I suggest that this interscalarity, its conundrums, and its horrors follow from the rather banal and uncontroversial opposition of trademark and commodity. The death knell of trademark follows from the cut into the market that *is* the trademark, the impossible foundation of a finite identity amid a world of infinite qualities, an impossibility created by the paradoxes that result from the untenable division between sign and metasign, and from the ideological fantasy that semiotic function (e.g., source-indexicality) and the sign-vehicle's materiality can be kept distinct.[33] Indeed, as I have suggested, trademarks are not merely indexes of the source of commodities in the market but are elements of/in the market itself. They are not simply meta-commodities, or rather, if they are, then they too partake in the commodity worlds that they are meant simply to hover above. The line between trademark and commodity is far from clear. In short, the (meta)pragmatics of scale in these cases is linked to foundational, if internally contradictory, semiotic ideologies inherent to the law: oppositions of word and thing, representation and function, trademark and good.

This cut, which is also a purification, makes possible trademarks and brand identities. It also makes them impossible. This purification abstracts identity out of quality. It elicits the authoritative force of necessity out of the impishness of possibility. But how can quality be stayed, stabilized, and held steady, and can it? How can a shifty aesthetic form be made into a rigid designator of brand identity? And for how long? The court (re-)creates the very line between identity and quality, and thus between mark and market/good, by arbitrating it. And yet every such arbitration is tinged with danger and possibility.

Identity is a tenuous achievement, where the proliferation of difference and indifference is attempted to be stayed and kept at bay. And yet qualities of sameness and difference always slip away, undermining those identity projects even as they constitute them as sites of desire and semiotic potency. No trademark can be without its qualities and aesthetics, even as a trademark's legal definition turns on the very denial of the significance of that very fact. This fantasy of the pure designator and its rigid reference constantly gives way to copies and citations, flaccid commodities like an all-red shoe or a "VW" keychain, commodities that elicit and detach those qualities that constitute the identity of that which they (are taken to) cite, materializing them in a novel, if uncannily familiar, form. Such forms continually threaten to extinguish that identity by promising to open the floodgates of quality, by breeching the bounds that keep legal categories like trademark

coherent and continent. The law's scalar logics and practices found, and find themselves in, this leaky space.

But if this is so, perhaps the death knell heard by the Ninth Circuit and avoided by the Second is no death at all, but simply another occasion for life. Beyond the question of identity and essence, of ownership and origin, is another world of possibility, a world beyond the trademark. Whitman finished the poem, which Judge Marrero elliptically cited in his ruling on the *Christian Louboutin v. Yves Saint Laurent* case, thusly:

> The smallest sprouts show there is really no death,
> And if ever there was it led forward life, and does not wait at the end to arrest it,
> And ceased the moment life appeared.
> All goes onward and outward . . . and nothing collapses,
> And to die is different from what any one supposed, and luckier.

NOTES

This chapter is based on a presentation given at the 2013 American Anthropological Association meetings for the panel "The Pragmatics of Scale" and on an earlier essay written for the Michicagoan faculty seminar in January 2013. It has benefited from discussion in both forums, as well as from readings by and discussions with E. Summerson Carr, Michael Lempert, Justin Richland, Julie Chu, Jennifer Cole, Rebecca Tushnet, Nancy Munn, and Julie Cousin. John Acevado provided able research assistance.

1. In this chapter I abbreviate this case as CL v. YSL, for both the 2011 district hearing (SDNY) and the 2012 appeal (Second Circuit). Documents from the courts' case files, downloaded from www.pacer.gov, are referred to by the document (doc) number listed in the docket and the page number of the file. Unless otherwise specified, all other citations to other court cases are to published opinions.

2. I thank Justin Richland for the stimulating conversation from which this relationship was made clear to me.

3. This isn't to say that functionality is the only such quality, of course. Another important quality of this scale-making is the temporality of such protections, which are historically limited precisely so that protected innovations and creative products may be "returned" to the (now-enlarged) commons after allowing sufficient time to encourage investment in their production in the first place. Trademarks, in an important contrast to copyright and patent, have no such time limit.

4. For discussion of utility and functionality in intellectual property law, see Knitwaves v. Lollytags 1995, 1002; Hagin 1991, 349; Bharati 1996, 1693; Firth 2008, 517.

5. Indexical relations, following Peirce (1998), are semiotic relations where the sign-vehicle and its object are articulated causally, by copresence, or by contiguity. Indexical signs "point to" their objects, not simply or only by convention or similarity, but also by a relation of contextual association (where that context may be of larger or smaller extent). Rigid designators (e.g., proper names, cf. personal pronouns) are particular kinds of indexical signs whose indexical relation is "fixed" so that it inheres across contexts of use by always indexically returning to a particular imputed event, or source, of "baptism" (Kripke 1981).

6. More recently and secondarily, trademark law has been expanded to explicitly protect producers' brand image (and their marketing investment in it) as such, regimenting and guarding the semiotic capacity of marks to distinguish goods and producers, in addition to, or rather than, protecting against consumer "confusion." Such an expansion of the law protects marks from being "diluted" or "tarnished"

by marks whose similarity erodes the distinctiveness and uniqueness of the to-be-protected mark (Coombe 1998, 41–87; Arvidsson 2005; Bently 2008). In the cases I discuss, while dilution was alleged, because the question of the mark itself was problematized dilution never emerged as a significant issue. For this reason I don't discuss this important expansion, and partial reorientation, of trademark law away from its putatively original mandate to protect against consumer confusion.

7. Notice how, in this way, what distinguishes a trademark from a commodity mirrors, and reapplies, the differentiation of commodities into utilitarian or representational forms. See note 10.

8. Such a distinction has long raised for courts the sticky issue of what it means for an object to be defined by *either* its "intrinsic" utility or its representationality (or its aesthetics). In legal discussions of copyright, this comes under the legal doctrine of "separability" (Mazer v. Stein 1954), wherein qualities inextricable from the utility-conferring form of the article are excluded from copyright (see Raustiala and Sprigman 2006, 1699–1700; Marshall 2007, 315ff.; Cox and Jenkins 2008, 7ff.; H. R. Rep. No. 94–1476, p. 9, cited in Tu 2010, 426). Courts, however, have been reluctant to recognize the conceptually separable aspects of fashion design, except in certain cases: notably, fabric/print design that can be replicated in other media while maintaining its conceptual/aesthetic identity. (On separability and fabric design, see Peter Pan Fabrics v. Brenda Fabrics 1959; Knitwaves v. Lollytags 1995; Scafidi 2006, 120; Cox and Jenkins 2008, 9.) While extractability of quality from form is one way that copyright can be used to police copying, it practically applies only in a limited number of cases and, when it does apply, often so does the more powerful, and temporally unlimited, trademark law.

9. U.S. law has generally not been supportive of increased intellectual property rights over fashion design. There have been numerous attempts to pass legislation to protect fashion design in the United States. Over seventy different bills have been proposed since 1914 (see Weikart 1944; Schmidt 1983; Tu 2010; and Raustiala and Sprigman 2012, for discussion). No such proposed bill has, to date, succeeded, though some hold out hope for the 2012 Innovative Design Protection Act, which, as of the time of writing, is stuck in congressional limbo.

10. The distinction of utility and representation instates an Enlightenment language ideology of "words" and "things." Hence, the law distinguishes useful objects (functions for patent) versus expressive signs (ideas for copyright), and further between that which is functional or representational (and hence untrademarkable but potentially patentable or copyrightable) and that which is properly source designating (and thus trademarkable). Note the fractal recursion: things versus signs, and within the latter category of signs, denoting texts versus referential marks, where this latter opposition replays the former. Also see note 7.

11. This has been enabled by the historical expansion of what counts as trademarkable (e.g., the extension of rights to colors [Qualitex v. Jacobson 1995], not to mention sounds and smells [Ginsburg 2008] and even whole commodified experiential envelopes [Two Pesos v. Taco Cabana 1992; see also Wal-Mart v. Samara Brothers 2000; Abercrombie & Fitch v. American Eagle 2002; Adidas-Salomon AG v. Target 2002; for discussion see Bharathi 1996; Wong 1998; Cox and Jenkins 2008, 14) and the increasingly blurry boundaries between the domains of intellectual properties (see Moffat 2004; McKenna 2011, 2012).

12. The term *secondary meaning* diagrams the disavowed tension at the heart of trademark law's semiotic, for while it recognizes that every trademark is also something else (i.e., its "primary" meaning—e.g., Nike is the name of a Greek goddess, red is a color), as far as the law is concerned it is the arbitrary or fanciful secondary meaning (the association with the commodity's source) that is primary. It is, however, the perpetual primacy of the nontrademark status of trademarks that enables the tensions and contradictions that I discuss in this chapter.

13. This decision came after a number of lower courts argued that color alone could be protected, a broadening that followed from the Lanham Act of 1946 (Summerfield 1993). Before the Lanham Act, colors alone were generally refused trademark protection by definition (see Owens-Corning Fiberglas Corp. 1985 for discussion). Following the Lanham Act, where colors were not subject to a blanket

disbarring, courts that allowed the trademarking of colors have advocated judicious avoidance of "per se" rulings, an issue that comes up, as we see, in the Second Circuit's response to the district court's ruling in CL v. YSL 2011.

14. Part of YSL's allegation that Louboutin waged an "anti-competitive" campaign also included the claim that Louboutin unfairly forced retailers of YSL (who also did business with Louboutin) to pull YSL's shoes off their racks (CL v. YSL 2011, doc 8, p. 4).

15. Following from the First Amendment, fair use doctrine in trademark law covers, to varying extents, so-called parodic uses, nominative uses (i.e., mere mention), and descriptive uses (i.e., uses of the "primary" meaning of the trademark rather than its rigid-designating "secondary meaning").

16. As with the U.S. case, the French case involved the lack of clarity of Louboutin's trademark. The French court of appeals canceled the mark, though Louboutin quickly reregistered—an action allegedly approved by an European Union appellate court (appellate because YSL contested this reregistration) on June 16, 2011—using a new description of the mark that added a level of clarity (e.g., rendering the model in 3-D, specifying its use only with high-heeled shoes, and designating the particular shade of red, Pantone 18–1663 TP, or "Chinese red"; see CL v. YSL 2011, doc 40, p. 6, fn. 1; also doc 48–1).

17. Compare the scalar rhetoric here of "countless" color choices to that of "limited" color choices, as typically voiced by proponents who argue against trademarking single colors (Summerfield 1993; see discussion in the main text below).

18. Note, incidentally, that the issue isn't simply with the color red, for what do we make of the adjective "lacquered" used to describe the mark? Does it describe the quality of glossiness of the red or the type of red? And where would we draw the lines of either? (See CL v. YSL 2011, doc 54, doc 61, p. 28, where Marrero addresses these questions.)

19. Marrero's concern here turned on the ability of a mark to be registered such that its registration could communicate to other market actors what is, and is not, already protected.

20. Louboutin's lawyers pointed out, however, that the fixation of color is no different than that of any other kind of sign. It is accomplished by whatever token-exemplar of red is registered with the USPTO (CL v. YSL 2011, doc 54; cf. Summerfield 1993). *That* red is the trademark. And whatever that red is, the measure for infringing similarity is consumer confusion, obviating the problem of designating (e.g., by Pantone reference) *what* the red is as such. Of course, whether this solves the issue that USPTO marks are registered so as to warn off competitors (see note 19), or whether it addresses the fundamental epistemological question of the gap between a quality and its materialization, is unclear.

21. Marrero refused to cancel Louboutin's mark then and there, however, since procedurally Louboutin should have the right not simply to appeal—which they did—but also to argue why the mark should not be canceled.

22. Here we see another kind of metapragmatics of scale—in fact, a second-order, or meta-metapragmatics of scale—that is oriented to the scalar performativity of the law through the detour of the citational futures of precedence. And, of course, the Second Circuit's decision is oriented to the district courts' own meta-metapragmatic worry, making it a third-order metapragmatics.

23. This finding was prefigured from the first letter sent by YSL to Louboutin's lawyers, before the complaint was even registered (CL v. YSL 2011, doc 22–63; doc 89, fn. 4, p. 41), and was repeated throughout the trial. Indeed, YSL early on noted that its monochromatic shoes didn't infringe, because Louboutin's signature shoes involve the contrast of red bottoms with nonred uppers. This complexification, following a long line of legal reasoning about color (Summerfield 1993), made Louboutin's mark more distinctive and less generic and, thus, less likely to be seen, in the law's eyes, as functional or constraining of the market.

24. In its efforts to avoid the issue, the court, as Tushnet (2012) points out, also sidestepped the fact that the change in definition didn't address the possibility that the monochromatic shoe, even if excluded by the definition of the trademark, could still be similar enough to "confuse" consumers (thereby raising the issue of color and functionality again). The court passed over this in silence. The

court also avoided the question of whether a feature (such as a color) could be functional in one context but a trademark in another (see note 28 for more discussion).

25. The point isn't that the law is unable to recognize this fact, for it certainly does (see McKenna 2011). Rather, it is that it cannot resolve this tension between source-designation and aesthetics except in an ad hoc, and often contradictory, way. While some courts emphasize that the functionality of an alleged mark bars it from serving as a mark despite its secondary meaning (e.g., Au-Tomotive v. Volkswagen et al. 2006; see McKenna 2011, 856), others recognize that marks will, of necessity, have aesthetic properties (that make them desirable), though such aesthetics do not, or should not, interfere with their status *as* marks (see CL v. YSL 2011, doc 61, p. 17, 19; doc 45, p. 36ff.; Fabrication Enter v. Hygenis 1995).

26. This horror is why the Second Circuit, in *Christian Louboutin v. Yves Saint Laurent* (2012), advocates a piecemeal method and finds Judge Marrero's "per se rule" anathema. It is also, perhaps, why it makes no mention of the amicus curiae written by Rebecca Tushnet, which pressed the court to confront precisely this issue. In the face of foundational challenge, ad hoc–istry is a necessity for life, for without it trademark law is rendered incoherent. The irony, of course, is that this putative inherence of value, aesthetics, and "function" in the body of the trademark is the very reason that trademarks are so valuable on the market (Klein [1999] 2000; Lury 2004; Arvidsson 2005)—and thus, a reason that corporate interests have pushed the law to protect the trademark and brand as such (e.g., through dilution laws; see note 6). The ontological complexity and tension of the trademark as both a sign of origin and a (non-source-designating) aesthetic object presents the frightening and exciting possibility that the trademark may simply be desired because it *is* a trademark, not because of what it stands in for. In such situations, should the trademark be protected? Or does such desire permanently decenter the trademark by rendering it aesthetically functional?

27. Au-Tomotive was the plaintiff in this case, because in 1996 they were sued by BMW for trademark infringement. Afraid that they would get sued by Volkswagen, they acted first so as to make the case that their activities didn't constitute infringement or counterfeiting.

28. McKenna (2011) and Tushnet (CL v. YSL 2012, doc 92 [amicus curiae]) argue that marks, and their aesthetic functionality, are inherently contextual. While the law often recognizes different "markets" as different contexts for marks (so that Delta Airlines is not infringed by Delta Dental)—so that these are, in effect, different semiotic types (*Delta* being homonymic here)—McKenna and Tushnet are interested in the multiplicity and unbecoming of the trademark as an ontological form across contexts (e.g., *Delta* as a proper name, common noun, and graphic form). Note that the idea that trademarks may be contextually shifty doesn't square with trademark law, which, as an institution tasked with keeping source-designation rigid, protects the mark across *all* contexts (or "possible worlds," we might say, analogizing Kripke 1981 on proper names). The mark, if protected, is *necessarily,* rather than contingently, protected. This ideological and normative commitment to a particular semiotics of the mark, however, flies in the face of the empirical realities of how marks are construed, used, and consumed, as McKenna and Tushnet powerfully show (also see Nakassis 2012; 2013c; 2016, 33–86, and references therein). Tushnet, moreover, argues that while the Second Circuit avoided the issue of contextuality by redefining the Louboutin mark, it also implicitly endorsed just such a contextualist view, creating an internal contradiction in its decision. As Tushnet (2012) asks, what indeed was the basis for the cancelation of the original Louboutin mark if not that a *use* of a red outsole was aesthetically functional (e.g., on a monochromatic shoe), even if it was nonfunctional in other contexts (e.g., on a nonmonochromatic shoe)? Compare this with *Louis Vuitton Malletier, S.A., v. Hyundai Motor America* (2012), where a reference to the Louis Vuitton mark—even if not used *as* a mark—was found to be infringing.

29. For a review of the history of the aesthetic functionality defense, see Fletcher 1985, 2011; and CL v. YSL 2012, section 3 and references therein.

30. Note the metapragmatic verb phrase "loathe to declare," which implicitly admits the potential aesthetic function of a mark (a fact that courts "loathe") while performatively disavowing that very possibility (in this case, by refusing to "declare").

31. Also see the Fifth Circuit's decision in *Pebble Beach Company v. Tour 18 I, Limited* (1998, 539).

32. The Second Circuit went out of its way to avoid this death knell in the *Christian Louboutin v. Yves Saint Laurent* case (even if YSL lawyers attempted to resurrect the zombie threat of aesthetic functionality in their defense; see CL v. YSL 2011, doc 28). The Second Circuit wrote, "Therefore, in determining whether a mark has an aesthetic function so as to preclude trademark protection, we take care to ensure that the mark's very success in denoting (and promoting) its source does not itself defeat the markholder's right to protect that mark" (CL v. YSL 2012, doc 120, p. 8).

33. A parallel problematic, of course, is the expression–idea distinction in copyright law.

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