



Neutral Citation Number: [2015] EWHC 1405 (Ch)

Case No: CH/2014/0331

IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION
(APPEAL FROM THE UNITED KINGDOM
INTELLECTUAL PROPERTY OFFICE,
TRADE MARK REGISTRY)

The Rolls Building,
Fetter Lane,
London, EC4A 1NL

Date: 19/05/2015

Before :

MRS JUSTICE ROSE

Between :

GO OUTDOORS LIMITED

Applicant

- and -

SKECHERS USA INC II

Respondent

Simon Malynicz (instructed by **DLA Piper**) for the Applicant
Jeremy Reed (instructed by **D Young & Co**) for the Respondent

Hearing date: 23 April 2015

Approved Judgment

I direct that pursuant to CPR PD 39A para 6.1 no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

.....
MRS JUSTICE ROSE

MRS JUSTICE ROSE DBE :

1. The Applicant ('GO Outdoors') appeals against the decision dated 7 May 2014 of Mr George Salthouse, a Hearing Officer of the Intellectual Property Office ('the Decision'). In the Decision Mr Salthouse upheld one of the grounds on which the Respondent ('Skechers') opposed the proposed registration of two trade marks by GO Outdoors and rejected another ground of opposition. He therefore refused registration of the marks. GO Outdoors appeals against that refusal. Skechers have served a Respondent's notice arguing that his order should be upheld on the additional ground of opposition that he dismissed.
2. GO Outdoors is the United Kingdom's largest specialist retailer of camping equipment, tents, outdoor clothing and footwear. It was established in 1998 and now has 49 outlets across the country with about 1,500 employees. In the year to January 2014, it achieved total sales of over £170 million including sales online. Its shops are generally of the 'superstore' kind comprising large retail spaces. Skechers is a US based footwear manufacturer.
3. On 19 June 2012, GO Outdoors applied for two series trade marks, No 2625133 for GO WALKING and No 2625150 for GO RUNNING. Both applications relate to the words in non-stylised form and in one stylised form in a particular font like this:

GO WALKING **GO Walking**

GO RUNNING **GO Running**

4. The classes in respect of which the Hearing Officer considered the marks were Classes 18 (rucksacks and bags) and 35 (retail services connected with the sale of a wide range of clothes, accessories and other goods) for the GO WALKING and Class 35 in respect of the GO RUNNING mark. There is no dispute that these were marks which GO Outdoors had been using over many years in signage outside and inside its stores as well as in marketing literature and radio and TV advertising throughout the UK. On 18 February 2012, following publication of the two trade marks, Skechers brought an opposition based on section 3(1)(b) and (c) of the Trade Marks Act 1994. By the time of the hearing before the Hearing Officer, the objection was focused on the registration in respect of part of Class 35, namely

"Retail services connected with the sale of protective clothing for use in sporting and outdoor pursuits activities, insulated/protective gloves, clothing, footwear, headgear, thermal clothing, jackets, trousers, over trousers, breeches, sweatshirts, knitwear, shirts, balaclavas, mitts, gloves, thermal underwear, socks, gaiters, boots, sporting articles for wear adapted for use in a specific sport of outdoor pursuits (other than helmets)

Electronic shopping retail services connected with the sale of protective clothing for use in sporting and outdoor pursuits activities, insulated/protective gloves, clothing, footwear, headgear, thermal clothing, jackets, trousers, over trousers,

breeches, sweatshirts, knit wear, shirts, balaclavas, mitts, gloves, thermal underwear, socks, gaiters, boots, sporting articles for wear adapted for use in a specific sport of outdoor pursuits (other than helmets)”

The legislation and case law on its interpretation

5. Sections 3(1)(b) and (c) of the Trade Marks Act 1994 read as follows so far as relevant:

“The following shall not be registered -

(a)

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d)

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

6. Section 3(1)(c) raises the question whether a trade mark is descriptive or not. If a trade mark is descriptive then it cannot be registered. Section 3(1)(b) raises the issue whether a trade mark is distinctive or not; it must be distinctive in order to be registered. Much of the case law on the application of these two tests is from the Court of Justice of the European Union in respect of the parallel provisions of the Trade Mark Regulation, Council Regulation (EC) 40/94 on the Community Trade Mark,¹ (*Official Journal* L11 14 January 1994 p 1). Article 7 of the Trade Mark Regulation provides:

“7 (1). The following shall not be registered:

(a) ...

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;

¹ This Regulation has been superseded by Council Regulation 207/2009/EC (OJ 2009 L 78 p 1) of which Article 7 is identical in all material respects.

...

(2) Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community.

(3) Paragraph 1 (b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it.”

7. The relationship between the distinctiveness test and the descriptiveness test was considered in Case C-51/10 P *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* [2011] ECR I-1541 (*‘Technopol’*). The Court of Justice stated there (para [46]) that if signs are descriptive for the purposes of article 7(1)(c) of Regulation 40/94 they are also necessarily devoid of any distinctive character for the purposes of article 7(1)(b) of that Regulation. But article 7(1)(b) goes wider than article 7(1)(c) because a sign may fail to be distinctive for some reason other than by being descriptive. The *Technopol* case also considered the purpose of the descriptiveness test in article 7(1)(c). In that case Technopol wanted to register the sign ‘1000’ as a Community trade mark in respect of the class of goods ‘brochures, periodicals including periodicals containing crossword puzzles and rebus puzzles, newspapers’. The examiner refused the registration on the basis of article 7(1)(b) and (c) on the grounds that the sign did not have any distinctive character and that it was a description of the contents or other features of the goods concerned. The Court stated that when examining the parties’ arguments, due account must be taken of the objective pursued by article 7(1)(c) and that each ground of refusal must be interpreted in the light of the general interest underlying it. As to what general interest underlies article 7(1)(c) the Court said (citations omitted):

“37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services

38 With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (...).

39 By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (...). It is, furthermore, irrelevant whether there are other, more usual,

signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (...).

40 It follows from the foregoing that the application of Article 7(1)(c) of Regulation No 40/94 does not require the sign at issue to be the usual means of designation.”

8. The Court then considered the overlap between (b) and (c) and stated that it was important to limit the application of (c) to the situations specifically covered by that ground:

“50 The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

9. The Court applied those principles to the use of ‘1000’ in respect of the goods sought to be protected. The Court held that at the very least the finding of the General Court in the judgment under appeal that the sign ‘1000’ is descriptive in relation to puzzles contained in those goods was not incompatible with the scope of article 7(1)(c). The General Court had found that on a book of puzzles, the sign ‘1000’ will be perceived as an indication that it contains 1,000 crossword puzzles. The mark therefore could not be registered in relation to the class of goods sought by Technopol.
10. The same test was applied in Case C-191/01P *OHIM v WM Wrigley JR. Company* [2003] ECR I-12447 (*‘Wrigley’*). In that case OHIM had refused the registration of the word ‘DOUBLEMINT’ for chewing gum on the grounds that the words were descriptive of the mint based composition and mint flavour of the gum. The General Court overturned this on the grounds that the word ‘DOUBLEMINT’ was not exclusively descriptive but the CJEU held this was the incorrect test; a sign must be refused registration if at least one of its possible meanings designates a characteristic of the goods or services concerned.
11. The purpose of the test of distinctiveness in article 7(1)(b) of the Trade Mark Regulation (and in section 3(1)(b) of the Trade Marks Act) was considered by the Court of Justice in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co. KG*. [2010] ECR I-8265 (*‘BORCO’*). There the respondent sought to register the single letter α being the Greek letter alpha in respect of alcoholic beverages (except beers) wines, sparkling wines and beverages containing wine. Registration was refused on the grounds that the sign lacked distinctive character. This was because Greek-speaking purchasers would not realise, when they saw the sign attached to the

product, that it was intended to be a trade mark indicating that the goods were from a particular origin. The Court stated that for a trade mark to possess distinctive character for the purposes of article 7(1)(b), it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings. The principles that can be derived from *BORCO* and from the other cases such as Case T-130/01 *Sykes Enterprises, Incorp v OHIM (Real People, Real Solutions)* [2002] ECR II-5179 are:

- i) It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public;
 - ii) That method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans;
 - iii) However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to certain kinds of mark than others;
 - iv) Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark;
 - v) A sign is only distinctive for the purposes of article 7(1)(b) if it may be perceived immediately as an indication of the commercial origin of the goods or services in question so as to enable the relevant public to distinguish without any possibility of confusion the goods or services of the owner of the mark from those of a different commercial origin.
12. The question of distinctiveness has also arisen in relation to slogans. In Case C-398/08 P *Audi AG v OHIM* [2010] ECR I-535 ('*Audi*') the Court of Justice was considering the registrability of the advertising strap line 'Vorsprung durch Technik' for a wide range of goods and services under various classes from Christmas tree decorations to business administration services. The Court held that the same criteria used for assessing the distinctiveness of a mark in the form of, say, a logo are applicable when assessing a slogan. Thus, an advertising slogan cannot be required to display imaginativeness. The Court noted that the expression was a widely known slogan that Audi had been using for years to promote the sale of its cars. It was entitled to be registered for Class 12 (cars and other motor vehicles) because it had acquired distinctiveness by use. As regards goods and services in other classes for which Audi had sought to register the mark, the Board of Appeal had based its refusal of registration on the fact that the slogan conveyed an objective message to the effect that technological superiority enables the manufacture and supply of better goods and services. According to the Board of Appeal, a combination of words which limits itself to that banal objective message is, in principle devoid of any inherently

distinctive character and therefore cannot be registered unless it is shown that the public has come to perceive it as a trade mark. The Court of Justice held that this constituted a misapplication of the test by the Board of Appeal. The Court held that:

- i) As regards marks made up of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by those marks, registration of such marks is not excluded as such by virtue of such use.
 - ii) As regards the assessment of the distinctive character of such marks, the Court has already held that it is inappropriate to apply to slogans criteria which are stricter than those applicable to other types of sign. Although it may prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories that does not justify laying down specific criteria supplementing or derogating from the criterion of distinctiveness.
 - iii) An advertising slogan cannot be required to display ‘imaginativeness’ or even ‘conceptual tension which would create surprise and so make a striking impression’ in order to have the minimal level of distinctiveness required under Article 7(1)(b).
 - iv) The mere fact that a mark is perceived by the relevant public as a promotional formula, and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that that mark is devoid of distinctive character.
13. The Court in *Audi* held that the General Court had not substantiated its finding to the effect that the mark applied for would not be perceived by the relevant public as an indication of the commercial origin of the goods and services in question; rather, it had merely highlighted the fact that that mark consists of, and is understood as, a promotional formula. The Court held that the General Court had therefore erred in its assessment of the Board of Appeal’s decision.
14. Having annulled the lower court’s decision, the CJEU went on to decide the case itself. It held:

“56 In that regard, it must be stated that all marks made up of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by those marks convey by definition, to a greater or lesser extent, an objective message. It is clear, however, from the case-law set out in paragraphs 35 and 36 of the present judgment that those marks are not, by virtue of that fact alone, devoid of distinctive character.

57 Thus, in so far as those marks are not descriptive for the purposes of Article 7(1)(c) of Regulation No 40/94, they can express an objective message, even a simple one, and still be capable of indicating to the consumer the commercial origin of the goods or services in question. That can be the position, in

particular, where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public.

58 Even if it were to be supposed that the slogan ‘Vorsprung durch Technik’ conveys an objective message to the effect that technological superiority enables the manufacture and supply of better goods and services, that fact would not support the conclusion that the mark applied for is devoid of any inherently distinctive character. However simple such a message may be, it cannot be categorised as ordinary to the point of excluding, from the outset and without any further analysis, the possibility that that mark is capable of indicating to the consumer the commercial origin of the goods or services in question.

59 In that context, it should be pointed out that that message does not follow obviously from the slogan in question. As Audi observed, the combination of words ‘Vorsprung durch Technik’ (meaning, inter alia, advance or advantage through technology) suggests, at first glance, only a causal link and accordingly requires a measure of interpretation on the part of the public. Furthermore, that slogan exhibits a certain originality and resonance which makes it easy to remember. Lastly, inasmuch as it is a widely known slogan which has been used by Audi for many years, it cannot be excluded that the fact that members of the relevant public are used to establishing the link between that slogan and the motor vehicles manufactured by that company also makes it easier for that public to identify the commercial origin of the goods or services covered.”

15. The *Audi* decision referred to the possibility that the public may come to perceive a slogan as a trade mark even if it does not start out as a clear indication of origin. Article 7(3) of the Trade Mark Regulation, and the proviso in section 3(1) of the Trade Marks Act refer to a mark acquiring distinctiveness. A banal phrase which starts out as having no particular connection to the goods or services of a particular commercial entity can acquire distinctiveness if it is used extensively in a way which causes the public to associate that phrase with a particular commercial origin.

The Decision

16. Mr Salthouse considered first the ground of opposition under section 3(1)(c) – descriptiveness. He cited *Technopol* and *Wrigley*. He stated that the ‘relevant class of persons’ for the purpose of these tests is composed primarily of consumers and end users of the services, that is the general public. This was common ground. He held that the terms GO Walking or GO Running do not describe the basic activity of walking or running. The words ‘walking’ or ‘running’ describe the basic activity – ‘The addition of the word ‘go’ to either alters its state to being an order/exhortation to carry out the activity’: para [19]. He went on to say:

“20) There is no doubt in my mind that, *prima facie*, GO RUNNING/ GO WALKING when used on the retailing of running/walking shoes or clothing does not create a descriptive impression of the retailing service. To my mind the mark is *prima facie* acceptable and does not fall foul of section 3(1)(c). The marks do not form a sign or indication “which may serve, in trade, to designate.... characteristics of goods or services.”

17. Mr Salthouse then referred to the evidence that Skechers had produced to show that the terms were already in use by other commercial entities. Their internet searches had thrown up three uses:
- i) A screen shot of a webpage arrived at by entering ‘go running’ in a search engine – the webpage is part of the site of a rival outdoor clothes retailer and shows a pair of ladies tights referred to as ‘New Balance Go Running Tights Ladies’. The Hearing Officer accepted that this was an instance of the use of the term ‘Go Running’ but noted that there was no evidence of when this use began or its extent.
 - ii) A screen shot from the Amazon web site of a tee shirt made by Nike with the slogan ‘JOGGING SUCKS go running’ on the front. The screen shows the tee shirt as ‘Currently unavailable, We don’t know when or if this item will be back in stock’. Mr Salthouse said that this was clearly not trade mark use and that the whole slogan was being used not just the ‘Go Running’ part.
 - iii) A screen shot of a pair of gloves made by a company called ‘Stow and Go’ and were described on their website as Stow and Go Running gloves. Although the website had therefore come up in response to a search of the phrase Go Running, Mr Salthouse said that this was not in fact a use of that phrase.
18. Mr Salthouse therefore held that there was no need to exclude the marks from registration in order to ensure that the marks could be freely used by all traders offering such goods or services. He rejected the section 3(1)(c) ground of opposition.
19. Turning to the ground of opposition under section 3(1)(b) Mr Salthouse dealt separately with inherent distinctiveness and acquired distinctiveness. As to inherent distinctiveness he said this:

“(27) I fully accept the applicant’s view that the mark must be assessed in terms of distinctiveness irrespective of whether it is a promotional formula. Clearly in the instant case both marks consist of words that are well known and which together form an exhortation to exercise. However, when used in, broadly speaking, relation to the retailing of clothing, footwear and headgear for use when running or walking I do not believe that the marks meet the criteria in *Audi* (paragraph 57) that the mark must “possess a certain originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public”. The marks are a normal way of offering shoes and clothing for use when running or walking. They do not contain any degree of

originality, nor do they require any interpretation and are not indicative of one particular undertaking. **The opposition under Section 3(1)(b) succeeds.”**

20. He then went on to consider acquired distinctiveness. He referred to the evidence put forward by GO Outdoors of their use of the signs including photographs of the stores both inside and outside and of advertising brochures. He said “It is clear that the marks in suit are used to highlight the area of the store or part of the brochure where goods for running/walking etc can be found”. He also referred to the sales figures that GO Outdoors had produced and he said that he accepted those figures, despite criticism of them by Skechers. He went on to hold:

“28. ... However, I am mindful that use does equate to distinctiveness. If the average consumer does not perceive that marks in suit as an indication of origin, but merely an indicator of where certain goods can be found within the store then the marks cannot acquire distinctiveness. The opponent pointed out that these marks are not used on swing tags on the goods within these areas of the store. It also points out that no evidence has been filed as to the perceptions of the average consumer of the marks in suit. The opponent contends that the uses made by the applicant are either to indicate the intended purpose of the goods that they are retailing, or to indicate the area of the store where goods for the intended purpose are being sold. To my mind, the evidence filed does not show that the marks have acquired distinctiveness through use.”

The role of the Court in this appeal

21. GO Outdoors accepted that the court’s role in an appeal is limited in the way described by Arnold J in *Shanks v Unilever plc & Ors* [2014] EWHC 1647 (Pat). The learned judge referred to the judgment in *Fine & Country Ltd v Okotoks Ltd* [2013] EWCA Civ 672 where Lewison LJ emphasised that the Court of Appeal was not there to retry the case but rather to review the judgment and order of the lower court to see if it is wrong. Where the judge has been called upon to make a value judgment or multi-factorial assessment, an appeal court ‘must be especially cautious about interfering’ with the decision. Mr Malynicz, appearing for GO Outdoors, also accepted that this is a case where the well-known warning given by Baroness Hale of Richmond in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49 about the need for ordinary courts to approach appeals to them from expert tribunals applies.

Lack of distinctiveness under section 3(1)(b)

22. GO Outdoors accept that they would normally face a serious obstacle in overturning the Hearing Officer’s multi-factorial assessment of the inherent distinctiveness of the marks. However Mr Malynicz said that there were clear errors in the Decision in relation to initial and acquired distinctiveness.
23. The first error was that in dealing with inherent distinctiveness, the Hearing Officer wrongly treated *Audi* as deciding that the mark must possess a certain originality or

resonance requiring at least some interpretation by the relevant public or setting off a cognitive process in the minds of that public in order to have inherent distinctiveness.

24. I agree that the Hearing Officer would have been wrong to hold that *Audi* establishes that slogans cannot be distinctive unless they have originality or resonance. I agree that although the Court in *Audi* found that the slogan there exhibited “a certain originality and resonance which makes it easy to remember”, that was no more a requirement for a slogan to be distinctive than it is for any other form of mark. However I do not consider that the Hearing Officer in fact applied the wrong test. The Hearing Officer set out the relevant paragraphs of the *Audi* judgment including those in which the Court emphasised, referring to earlier case law, that there was no additional requirement for slogans that they be original or resonant. The Court found in *Audi* that the slogan did exhibit originality and resonance and that it required a measure of interpretation on the part of the public. That was part of the Court’s reasoning in concluding that the slogan should be registered. It was legitimate therefore for the Hearing Officer in this case to address first the question whether the GO Running/GO Walking marks exhibited the same characteristics as ‘Vorsprung durch Technik’ or not. Having found that they do not, it would have been wrong for the Hearing Officer to stop his conclusions there since it is necessary to go on to consider whether even without those characteristics, they are nevertheless distinctive. The Hearing Officer did not stop there. He had referred in paragraph 26 of the Decision to Skechers’ submissions that the marks by themselves are simply non-distinctive exhortations to the reader to ‘Go walking’ or ‘Go running’ and that these ‘will not be perceived as being distinctive of an entity that is manufacturing and selling those goods’. He also recorded Skechers’ submissions that the combination of two ordinary words in a natural sequence would not enable the average consumer to distinguish boots and shoes being retailed by one undertaking from those of another undertaking. His conclusion at the end of paragraph 27 accepted these submissions because the phrases did not contain any degree of originality, did not require any interpretation and were not indicative of one particular undertaking. I do not consider therefore that he fell into the error that GO Outdoors allege.
25. The second ground on which GO Outdoors challenges the findings on section 3(1)(b) was that the Hearing Officer made findings that were inconsistent with his findings in relation to descriptiveness for section 3(1)(c). That criticism is not well founded because the findings are in answer to very different questions. In relation to section 3(1)(c) he was asking whether the terms are descriptive of the retail services for which GO Outdoors was seeking registration. He held that they were not descriptive of that service. The question he was asking under section 3(1)(b) was whether the public would recognise those marks as an indication of origin either because they are inherently distinctive or because they have acquired distinctiveness through use. He held that the public would not recognise the marks as being used in that way. He thus rejected the claim to distinctiveness of the marks not on the basis that the marks were descriptive of the retail services but because the public would perceive them as merely pointing to where the goods are to be found in the store, not as indicating that the goods are from a particular source. In my judgment, therefore there was no inconsistency between his treatment of the use of the signs in relation to section 3(1)(b) and 3(1)(c).

26. Finally, GO Outdoors complain that the Hearing Officer failed to give proper weight to the evidence of use provided by GO Outdoors. GO Outdoors devoted considerable effort and expense in gathering information and photographs about the use made by them of the marks over the years. Mr Salthouse, they say, rejected all this in a few short sentences in paragraph 28. Mr Malynicz referred to the judgment of the Court of Justice in Cases C-217/13 & C-218/13 *Oberbank AG and others v Deutscher Sparkassen- und Giroverband eV*, judgment of 19 June 2014. There the Court said that as regards the question how to determine whether a mark has acquired distinctive character through use, the competent authority must carry out an examination by reference to the actual situation and ‘make an overall assessment of the evidence that the mark has come to identify the goods or services concerned as originating from a particular undertaking’. Moreover that evidence must relate to the use of the mark as a trade mark, that is to say for the purposes of such identification by the relevant class of persons: paragraph 40. The Court went on to describe the kinds of evidence that might be relevant: such as how intensively, geographically widespread and long-standing the use of the market has been and how much has been invested in promoting the market.
27. I reject this criticism of the Decision. Mr Salthouse described the evidence that had been put forward in the witness statement of Mr Graham on behalf of GO Outdoors and in the exhibits to that statement in paragraph 8 of the Decision. He referred to the range of photographs exhibited to Mr Graham’s statement – photographs of the outside and inside of the stores, of the banners and posters used in stores and copies of advertising material. The reasons he gives for concluding that this evidence does not show the kind of use that would cause the marks to acquire distinctiveness are set out concisely but clearly in paragraph 28 of the Decision and I see nothing wrong with the conclusion he has reached.
28. Mr Malynicz sought to counter the points that the Hearing Officer records Skechers as having made in paragraph 28 of the Decision. He accepts that the marks are not used on swing tags but argued that since GO Outdoors is not seeking to register the marks in respect of goods but only services this is irrelevant. On this point the Hearing Officer was considering whether the marks were being deployed in a way in which mark owners often deploy a mark that they want the public to learn to associate with their goods or services. Putting the mark on swing tags is one such use and that is not a use that GO Outdoors has made. As to the use of the marks on signage within the stores, Mr Malynicz argues that this ignores the evidence of the use of the phrases in large letters on the outside of the shops where it cannot be said they are pointing the customer to a particular part of the shop. However, in my judgment, the public is more likely to perceive that use as indicating the range of goods that are available in the store rather than as a mark of origin in addition to the prominent GO Outdoors mark. Finally GO Outdoors complain that the Hearing Officer referred to the lack of survey evidence, even though parties are generally discouraged from adducing such evidence and it would have been disproportionate for them to do so in this case. I do not read the Decision as doing anything other than recording that there was no such evidence – a point that was relevant in his overall note of the material on which he based his conclusions.
29. I therefore dismiss the GO Outdoors’ appeal against the decision not to register the marks.

30. In the light of that finding I do not strictly need to consider Skechers' argument that the Hearing Officer should have upheld their challenge based on section 3(1)(c). However, in my judgment the Hearing Officer's decision on this point was clearly correct. The phrases do not describe the activity of shopping for outdoor clothes or shoes and they do not comprise a sign or indication which may designate characteristics of that service.
31. I therefore dismiss the appeal.