

O-505-16

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION 3070652

BY BIRKENSTOCK SALES GMBH

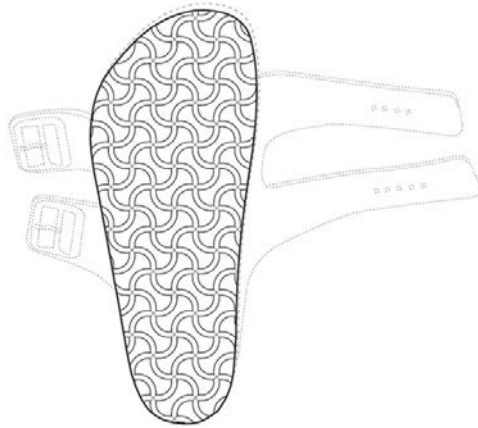
AND

APPLICATION FOR INVALIDATION UNDER NO. 500943

BY EUROGLORIA S.L.

BACKGROUND

1. On 1 September 2014 Birkenstock Sales GmbH (the proprietor) applied for the following trade mark:



2. It is described as follows:

“The mark consists of a pattern applied to the sole of footwear (especially sandals, clogs and slippers), as shown in the representation. The parts of the mark indicated in dotted lines do not form part of the mark and are included purely for illustrative purposes”.

3. The mark was subsequently registered for:

Class 10

Orthopaedic footwear, including orthopaedic footwear for rehabilitation, foot physiotherapy, therapy and other medical purposes, and parts therefor, including orthopaedic shoes, including orthopaedic shoes with footbeds, wedges, pads, foam padding, foam pads; Orthopaedic footwear, in particular orthopaedic sandals and slippers.

Class 25

Footwear, including comfort footwear and footwear for work, leisure, health and sports, including sandals, gymnastic sandals, flip-flops, slippers, clogs, including with footbeds, in particular with anatomically moulded deep footbeds, foot supports; Footwear, namely, shoes and sandals; Boots, shoes and sandals; Slippers.

4. Eurogloria S.L. (the applicant) filed an invalidation on 4 August 2015, in which it seeks invalidation of the registration under the provisions of section 47 of the Trade Marks Act 1994 (the Act). It does so on grounds under sections 3(1)(b), 3(1)(c), 3(1)(d) and 3(2) of the Act.

5. The applicant outlines its objections as follows:

3(1)(b)

“5. The Mark is clearly the textured sole of an item of footwear. All of the Class 10 and 25 goods covered by the Registration are items of footwear or parts of footwear. The Registration therefore essentially covers a mark that is the sole of footwear for footwear.

6. The Mark will not be seen as a trade mark; it is devoid of any distinctive character and is simply a common place adornment to the sole of footwear. This pattern that forms the Mark, or one highly similar to it, has appeared on the sole of footwear produced by a number of different companies throughout the world for at least the past 30 years.”

3(1)(c)

“8. The mark is descriptive as it is used to indicate both the quality and intended purpose of the footwear, namely demonstrating that it provides grip to the wearer and allows the footwear to be worn on a variety of surfaces. Furthermore, such adornment on the sole of a shoe is common in the trade and expected by consumers.”

3(1)(d)

“10. Such adornment on the sole of a shoe, identical or highly similar to the Mark, is customary in the bona fide and established practices of the trade as it has been used extensively by third parties for at least 30 years.”

3(2)

“12. The Mark is clearly the shape of the sole of footwear. Footwear is normally a standard shape to fit human feet and therefore the Mark is

essentially the shape which results from the nature of the goods themselves.

13. Furthermore, the Mark is essentially formed of a number of dissecting wavy lines that provide grip to the sole of the footwear. As such, the Mark does not consist of a trade mark but instead merely consists of a shape that is necessary to obtain a technical result, namely the wearer of the footwear is unlikely to slip when walking or moving in the footwear in question. There are no elements present in the Mark that are not functional.”

6. The proprietor filed a counterstatement defending its registration. The main points it made are as follows:

- *The trade mark is distinctive because it is unusual and memorable for the relevant public ‘such that it has at least some degree of distinctive character’.*
- *The mark does not provide any indication about the goods or their characteristics.*
- *The trade mark serves as a guarantor of origin of only the proprietor’s goods.*

7. With regard to the grounds pleaded under section 3(2) the proprietor states:

“7. It is denied that the trade mark is not registerable under Section 3(2)(a). The trade mark does not consist exclusively of the shape which results from the nature of the goods themselves. For example, whilst the trade mark includes a pattern, the pattern is not the shape which results from the nature of the goods themselves.

8. It is denied that the trade mark is not registerable under Section 3(2)(b). The trade mark does not consist exclusively of the shape of the goods which is necessary to obtain a technical result. For example, whilst the trade mark includes a pattern, the pattern does not obtain a technical result. The

Applicant submits that ‘the wearer of the footwear is unlikely to slip’. However, the trade mark contains no features that would obtain this technical result, or any other.

9. It is denied that the trade mark is not registerable under Section 3(2)(c). The trade mark does not consist exclusively of the shape which gives substantial value to the goods...”

8. The proprietor concludes that the trade mark is inherently distinctive and registerable and further (or in the alternative), the trade mark has ‘in fact’ acquired a distinctive character as a result of the use made of it before the date of application for registration and/or the date of application for cancellation.

9. Both parties filed evidence. A hearing took place on 26 July 2016, by video conference. The applicant did not attend or file submissions in lieu of attendance. The proprietor filed a skeleton argument and was represented by Mr Jonathan Moss of Counsel, instructed by Gill Jennings & Every LLP.

The evidence

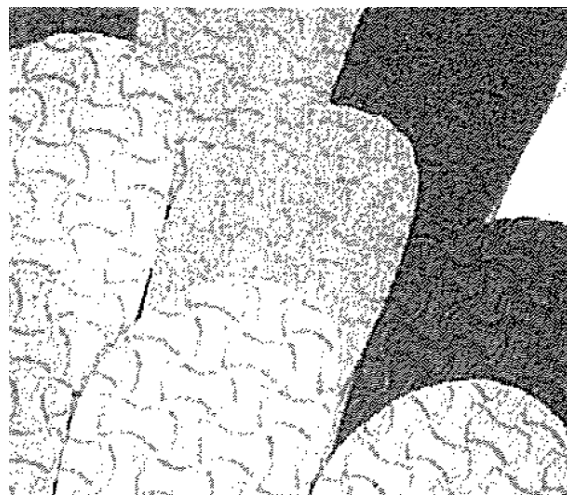
The applicant’s evidence

10. This comprises a witness statement from Francisco Mora Marti, CEO of the applicant. It is dated 11 December 2015. Attached to the witness statement are 19 exhibits, as follows:

11. FMM01 – FMM07 – These exhibits are copies of a number of decisions taken at the UK Registry, EUIPO and in France which relate to a mark which it considers similar to the one at issue here. The applicant sought to rely on the outcome of these decisions in these proceedings. These cases were decided on their own facts and were based upon the evidence before the decision maker in those cases. I must do the same and reach a decision based on the pleadings, evidence and submissions which are before me in this case. Consequently, I will give them no further consideration.

12. At paragraph 16 of his witness statement Mr Marti states that there is extensive evidence that third parties have used identical or highly similar patterns on footwear for over 30 years.

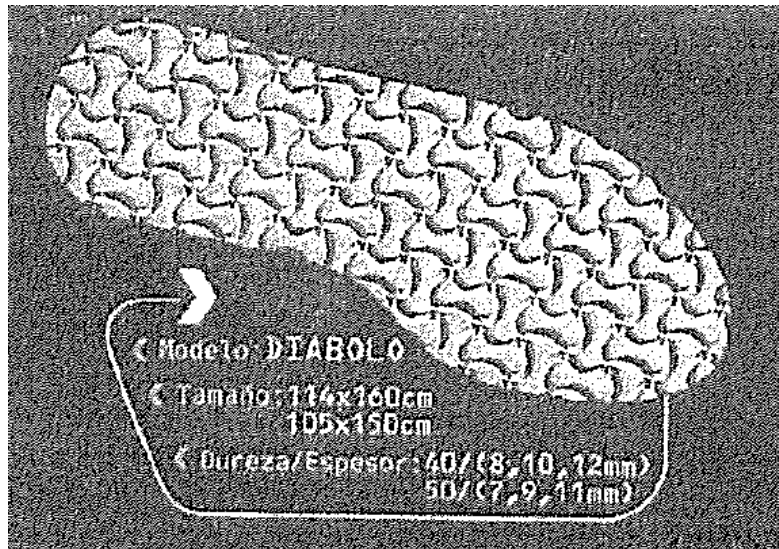
13. FMM08 – is described as ‘various examples of such use’. It comprises pages from three catalogues, each titled ‘Footwear Components From Spain’. The first is dated 2009/2010. The other two are not dated. Each front cover is followed by several pages showing material cut into a sole shape. The pattern shown on each of the soles is as follows:



14. Any text included on the pages is in Spanish and has not been translated. The last three pages of the exhibit are internet prints from www.calzadosconhuella.es. The first and third pages are not dated. The second shows a screen date of 2 April 2015. All three pages appear to be different views of the same shoe, priced at €25.00 with text in Spanish.

15. Mr Marti states that the pattern on the sole of the footwear shown in the registered mark is known in the industry as ‘Diavolo’. Exhibit FMM09 is a catalogue from Cauchos Karey S.A. (whose address shows them to be based in Alicante, Spain) in which the sole is referred to as ‘Diabolo’. Mr Marti submits that the difference in spelling is due to the fact that the letters ‘b’ and ‘v’ are pronounced the same in Spanish.

16. The catalogue is not dated and it is provided in Spanish without translation. The second page is headed, 'Plane EVA sheets' and looks to be examples of a number of textured and flat patterns. The third page shows some of the same textured patterns cut into the shapes of shoe soles. The first one on the page is described as DIABOLO and is shown as follows:

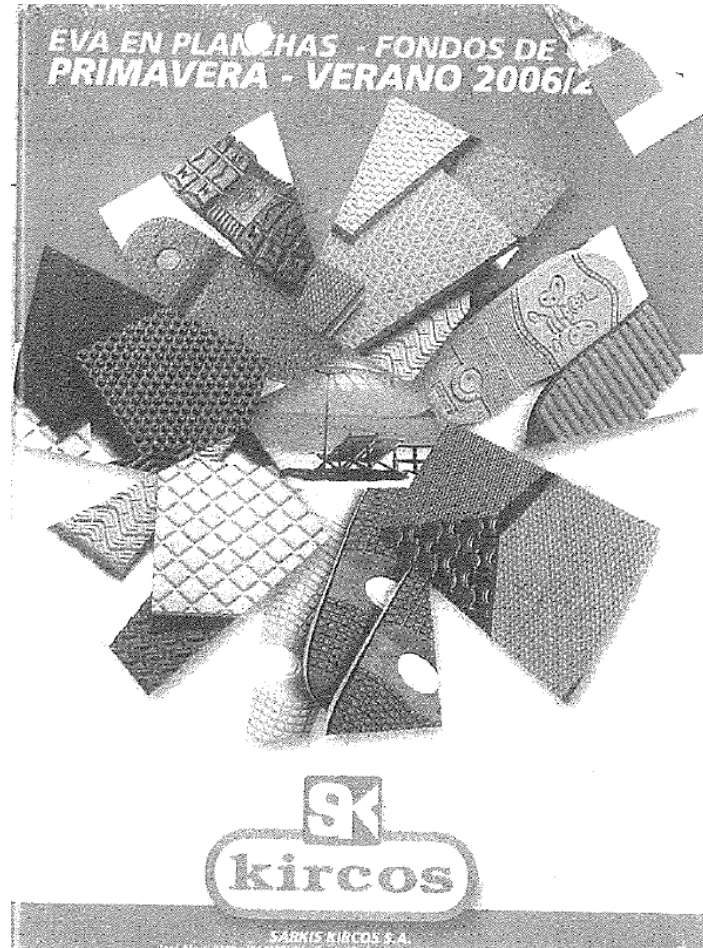


17. Exhibit FMM10 – comprises Invoices from Castor S.A. dated between 12 September 2008 and 13 March 2015. Each product description contains the word 'Diavolo', which Mr Marti states is, 'further confirmation of the use of the Diavolo sole in trade'. All of the sales are to businesses in Spain and Portugal and listed on the invoices in Spanish.

18. Exhibit FMM11 - invoices which Mr Marti states, 'refer to footwear with the identical or similar sole by reference to either Diavolo or Diabolo, the term that is commonly and widely used in the industry for the sole that forms the mark.' All of the invoices have the applicant's address at the top. All of the product descriptions include the word Diabolo or Diavolo. They are dated between 16 October 2009 and 16 July 2010 and are in Spanish.

19. Exhibit FMM12 - described as 'relevant pages from a specialised magazine called Serma dated from June/July 2006 which contains an image of the sole of footwear that is identical, or at least highly similar to the Mark'. The first has a picture of two

shoes, the soles of which cannot be seen. The second page has a picture of a shoe on the left and on the right of the page, pictures of shoe soles and flat sheets of textured material from which it appears those soles have been made. Text on the pages is in Spanish.



20. Exhibit FMM13 - a Notarial Act in which Mr Marti states, 'it is declared that the magazine reproduced therein dated from 1993 shows the relevant sole, namely one that is identical or highly similar to the Mark, featuring in several advertisements.' The document also includes several prints from websites which Mr Marti states, 'is offered with the relevant sole.' None of the pages from magazines shows the 'relevant sole'. The pages are advertisements for a number of footwear companies in Italy and Spain which show a number of shoes photographed from above, showing only the uppers.

21. The last five pages are prints taken from a German website showing the soles of shoes the same as those I have already shown above at paragraphs 13 and 16.

22. FMM14 – is a catalogue from a company in Istanbul. It is not dated or translated. Images show sheets of EVA material and sole shapes cut from that material.

23. FMM15 – consists of website prints which Mr Marti states are from 2005. They are in German. The first page does not show the soles of shoes. The next two pages are poorly reproduced so that the pattern on the shoe cannot be identified. The remaining pages show the sole of a shoe from a German website, the same as that included in exhibit FMM13.

24. FMM16 – Is described as orders from a German company dated 2007 and 2008 that refer to Diabolo. The word Diabolo is shown in the product description.

25. FMM17 – Is a copy of an application for a Spanish industrial model. A translation is provided. However, I do not propose to detail this exhibit as it is not relevant to the tests I must apply in reaching a decision in this case.

26. FMM18 – Is an invoice from a photography studio, dated November 2004 for the production of a shoe catalogue which Mr Marti states shows the ‘relevant patterned sole.’ The catalogue is in Spanish. The sole titled ‘Diabolo’ is shown at the bottom of page 4.

27. FMM19 – is described by Mr Marti as numerous sources of point of sale marketing from Birkenstock themselves and from independent third parties stating that the design which is the subject of Birkenstock’s trade mark registration is marketed as having a ‘SuperGrip’ function, and does not have an aesthetic purpose. The pages have a print date of 3 December 2015. The shoes shown in the exhibit which refer to ‘SuperGrip’ relate to a different sole from that which is the subject of these proceedings.

The registered proprietor’s evidence

28. This comprises a witness statement from Albert Wichmann, Brand Protection Manager for the proprietor. It is dated 22 March 2016. Attached to the witness statement are 10 exhibits, as follows:

29. AW1 – consists of examples of competitors’ marketing of their shoes on the internet. The prints have been taken from archived pages accessed using waybackmachine. Some of the images show the sole of a shoe which is plain in colour (such as the soles of the boots from ‘the natural shoe company’ at page 5), others are multi-coloured (see Asics training shoes shown at page 2 of the exhibit), some include the company logo on the sole (for example see *Etnies* shoes at page 14) and the example provided at page 22, which is the article from Grazia magazine, shows a promotion for D&G juniors. The sole of the shoes worn by the child in the photograph are made up of repeated D&G logos on a plain sole.

30. Mr Wichmann states that there is prominent reference to the sole of the footwear. He comments:

“It is submitted that the reason the soles are prominently featured is because consumers rely on them to signify trade origin.”

31. He states that the examples provided in the exhibit date back to 2002 to demonstrate that this is a long standing and well established practice. The exhibit also includes four examples of marketing for a number of shoes shown in Grazia in 2011 and Vogue in 1988, 2005 and 2011.

32. AW2 and AW3– comprise prints of 24 trade marks (depicting a sole or part of a sole) and 17 trade marks (for various patterns and logos). They have effect in the UK dating back to 1996. Mr Wichmann says of these exhibits:

“10...the longstanding and numerous registrations reflect that consumers are accustomed to seeing and recognising such sole devices as trade marks...”

11. Similarly, consumers are accustomed to regarding patterns as applied to footwear as distinctive guarantors of trade origin.”

33. I will not detail the contents of these exhibits here but will return to them later in the decision.

34. AW4 – is an article from ‘The Guardian’ from June 2003 which Mr Wichmann states, “documents the huge popularity and success” of the proprietor’s products at that time, with customers noted to be “lining up outside the shop”. The article is titled ‘Succès de sandal’ and focusses on an increase in sales of the proprietor’s goods in the UK in the summer of 2003.

35. At paragraph 32 of his statement, Mr Wichmann provides turnover figures for 2003 – 2014 for the UK. He states that 90% of the sales shown relate to products that incorporate the present trade mark.

Year	Turnover (€)	Sales quantity
2003	3.292.228	222.133
2004	6.411.149	468.606
2005	5.811.180	411.747
2006	6.186.117	435.496
2007	8.463.696	627.201
2008	6.321.371	475.723
2009	7.547.321	593.596
2010	9.471.288	715.796
2011	8.223.124	614.872
2012	5.906.009	384.641
2013	6.150.698	392.560
2014	12.883.815	823.516
TOTAL	86.667.997	6.165.887

36. AW5 – is described in Mr Wichmann’s statement as ‘advertising and marketing of the trade mark in the UK’. The first part of the exhibit is a Birkenstock catalogue from 1997. Page 2 of the catalogue has the patterned sole in the background behind some text. The fifth page includes ‘care tips’ for the goods and shows that replacement soles are available.

37. Pages 71 - 133 consist of a range of press articles about the Birkenstock brand. Within the articles a number of models and celebrities are shown wearing a wide range of the applicant's goods. The shoes are also shown in a number of product shots. None of the images shows the sole of a shoe or the sole pattern which is the subject of this registration.

38. Pages 134 – 148 are prints taken from waybackmachine which are dated between 12 October 1999 and 19 June 2013. Pages dated 2 March 2001 and 19 June 2013 show that repair services are available and that replacement soles can be purchased for the applicant's shoes. A page dated 10 April 2007 shows a home page for the applicant's website. The web button which enables customers to access the current sale is the word 'SALE' stamped in red on what looks to be a sole shape, though the detail is indistinct due to the quality of the print.

39. Pages 149 - 150 of the exhibit are an article from The Independent dated 30 May 2003. The title is '50 Best Beach Accessories'. The applicant's two strap shoe is shown from above and from the bottom, showing the sole of the shoe.

40. AW6 – is made up of 56 press articles from 2014. Some are taken from newspapers, such as that shown at pages 214-216 from The Daily Telegraph dated in March and titled, 'Telegraph Fashion Special'. Others are from magazines, such as page 177 which is taken from the August issue of FHM and page 190 from the August issue of Marie Claire. Within the articles models and celebrities are shown wearing a wide range of the applicant's goods. The shoes are also reviewed and shown in a number of product shots. None of the images shows the sole of a shoe or the sole pattern which is the subject of this registration.

41. Mr Wichmann states at paragraph 38 of his witness statement:

"[The proprietor's] distributor Central Trade Ltd. currently supplies more than 800 retail outlets within the whole UK. This figure includes only the classic shoe stores, sporting shoe chains and so on but not online retailers

such as ASOS or Amazon UK. [The applicant's] Trade Mark is displayed prominently to advertise the products at the various retail outlets."

42. AW7 – Is made up of prints from the websites of two shoe retailers which sell the proprietor's products, namely, The Office and Schuh. The prints provide details of those businesses but do not show any of the relevant goods or the trade mark.

43. At paragraph 41 of his statement Mr Wichmann states that the proprietor's products bearing the trade mark have also been sold through a number of 'other sources'.

44. Exhibit AW8 comprises examples taken from waybackmachine dated between August 2004 and April 2015. The prints are taken from 'Deluxe Shoe Boutique' and rawshoe.co.uk. The prints show a range of the proprietor's goods for sale on both websites. In most cases multiple views of the shoes are shown, which include pictures of the soles of the shoes, but do not show those goods being sold with reference to the trade mark.

45. AW9 – is made up of prints from a number of blogs which discuss counterfeit versions of the proprietor's goods.

46. AW10 – is described by Mr Wichmann as witness statements which have been presented to City of London Police along with a report of third party domain names which the applicant has had taken down since November 2015. A large number of the domain names include 'birkenstock' with the remainder referring to shop retailers generally.

Evidence in reply

47. This consists of a second witness statement from Francisco Mora Marti, dated 17 May 2016. There are no exhibits to the witness statement, which is made up of submissions. The key points are:

- With regard to the comments from the proprietor that much of Mr Marti's evidence relates to trade in Spain, he states that the products may originate there but are available worldwide, including the UK. He concludes that one would not expect major differences in the consumer behaviour within the shoe and footwear market within the EU or worldwide.
- With regard to the proprietor's evidence, Mr Marti concludes that much of it does not show the soles of the shoes, where it does, it is not clear if the featured design is the subject of the contested trade mark. It simply supports sales of Birkenstock products in general. He maintains the applicant's view that the average consumer does not perceive the sole of footwear as an indication of origin.

48. That concludes my summary of the evidence to the extent that it is necessary.

The decision

49. I will deal first with the grounds under sections 47(1) and 3(1) of the Act, the relevant legislation for which is as follows:

47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

And:

“3. - (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, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

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.”

The relevant public

50. The distinctive character of the trade mark applied for must be assessed, first, by reference to the goods the subject of the opposition and, secondly, by reference to the perception of those goods by the relevant public.

51. The relevant public is defined in *Matratzen Concord AG v Hukla Germany SA* – C-421/04 (CJEU):

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and

reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

52. The relevant public for the opposed goods in class 25 is the general public. The goods in class 10 may also include, in addition to the general public, members of the medical profession such as podiatrists and physiotherapists.

The objection under section 3(1)(b)

53. The date at which the distinctiveness of the proprietor’s trade mark must be assessed is the date of the application for registration, namely, 1 September 2014. I must make an assessment on the basis of the trade mark’s inherent characteristics, and, if I find the trade mark is open to objection on that basis, I must then determine whether the trade mark has, in fact, before the date of the application for registration, acquired a distinctive character as a result of the use made of it and, in accordance with the proviso to s.47(1) detailed above, assess whether the mark had acquired a distinctive character by the date of the application for invalidation

54. It is well established that the absolute grounds for refusing registration must be examined separately, although there is a degree of overlap between sections 3(1)(b), (c) and (d) of the Act: see *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] E.T.M.R. 57, the Court of Justice of the European Union (“CJEU”), paragraphs 67 to 70.

55. In *Starbucks (HK) Limited, PCCW Media Limited, UK Broadband Limited v British Sky Broadcasting Group plc, British Sky Broadcasting Limited, Sky IP International Limited*¹, Arnold J referred to summaries of the law in two decisions from the CJEU in

¹ [2012] EWHC 3074 (Ch):

relation to Articles 7(1)(b) and (c) of the Community Trade Mark Regulation, which correspond to sections 3(1)(b) and (c) of the Act:

“90. The principles to be applied under Article 7(1)(b) of the CTM Regulation were conveniently summarised by the Court of Justice of the European Union in Case C-265/09 P *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* [2010] ECR I-8265 as follows:

‘29. ... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v. OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, 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 (*Henkel v. OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v. OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v. OHIM* [2010] ECR I-0000, paragraph 33).

32. 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 (*Storck v. OHIM*, paragraph 25; *Henkel v. OHIM*, paragraph 35; and *Eurohypo v. OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that 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 (see, to that effect, respectively, Case C-447/02 P *KWS*

Saat v. OHIM [2004] ECR I-10107, paragraph 78; *Storck v. OHIM*, paragraph 26; and *Audi v. OHIM*, paragraphs 35 and 36).

33. 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. It could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P and C-474/01 P *Procter & Gamble v. OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v. Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v. OHIM*, paragraphs 36 and 38; and *Audi v. OHIM*, paragraph 37).

34. In that regard, the Court has already stated that difficulties in establishing distinctiveness which may be associated with certain categories of marks because of their very nature – difficulties which it is legitimate to take into account – do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law (see *OHIM v. Erpo Möbelwerk*, paragraph 36, and *Audi v. OHIM*, paragraph 38).

...

37. ... it should be pointed out that, even though it is apparent from the case-law cited that the Court has recognised that there are certain categories of signs which are less likely *prima facie* to have distinctive character initially, the Court, nevertheless, has not exempted the trade mark authorities from having to carry out an examination of their distinctive character based on the facts.

...

45. As is clear from the case-law of the Court, the examination of trade mark applications must not be minimal, but must be stringent and full, in order to prevent trade marks from being improperly registered and, for reasons of legal certainty and good administration, to ensure that trade marks whose use could be successfully challenged before the courts are

not registered (see, to that effect, *Libertel*, paragraph 59, and *OHIM v. Erpo Möbelwerk*, paragraph 45).”

56. In making a finding regarding this mark, I also bear in mind the comments of the CJEU in *Henkel KGaA v OHIM*² in which it stated:

“36. According to equally consistent case-law, the criteria for assessing the distinctive character of three-dimensional trade marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade mark. However, when those criteria are applied, account must be taken of the fact that the perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (Case C-136/02 P *Mag Instrument v OHIM* [2004] ECR I-9165, paragraph 30, and *Storck v OHIM*, paragraphs 26 and 27).

37. In those circumstances, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94 (Case C-173/04 P *Deutsche SiSi-Werke v OHIM* [2006] ECR I-551, paragraph 31, and *Storck v OHIM*, paragraph 28).

38. That case-law, which was developed in relation to three-dimensional trade marks consisting of the appearance of the product itself, also applies where, as in the present case, the trade mark applied for is a figurative mark

² C-144/06P

consisting of the two-dimensional representation of that product. In such a case, the mark likewise does not consist of a sign unrelated to the appearance of the products it covers (*Storck v OHIM*, paragraph 29).”

57. The applicant’s pleading under 3(1)(b) is that the proprietor’s mark is clearly the textured sole of an item of footwear which has been registered for items of footwear or parts of footwear. It concludes, “*the Registration therefore essentially covers a mark that is the sole of footwear for footwear...The Mark will not be seen as a trade mark; it is devoid of any distinctive character and is simply a common place adornment to the sole of footwear.*”

58. In its skeleton argument, the proprietor states that the ‘sole device’ is capable of acting as a badge of origin:

“12...The Sole Device, whether it is viewed as a 2D device or as a 3D shape is clearly a distinctive pattern. The Register is full of simple shape marks which can act as a badge of origin. The Sole Device is no different save that it is not even a simple shape – as in reality the repeating pattern increases the complexity.

13. The Sole Device is meant to be located on the sole of the shoe, but as nearly every shoe purchase will involve holding the shoes in the average consumer’s hands it is hard to see how the distinctive sole would not be noticed...”

59. At exhibits AW2 and AW3 of its evidence the proprietor provides details of a number of trade marks which currently have effect in the UK. The majority are EU trade marks which relate, in some way, to soles of shoes for footwear. The proprietor concludes from this that:

“...consumers are accustomed to regarding patterns as applied to footwear as distinctive guarantors of trade origin.”

60. It has long been established that 'state of the register' evidence of this type is unlikely to assist the proprietor's case.³ There is no indication of how many of these marks are actually in use, nor how they are being used, or are being perceived by the average consumer. I will say no more about these exhibits.

61. The proprietor's own evidence indicates that the mark which is the subject of this registration is not a 2D printed pattern applied to the sole of a shoe, but is the textured pattern of the sole of a shoe, which has grooves or indentations in the surface. In other words, the registered mark is a figurative mark which consists of a two dimensional representation of a three dimensional mark.

62. It is clear from decisions such as that in *Henkel*, which I have recorded above, that a mark of this type which is essentially part of the goods, with no additional graphic or word element, should depart significantly from the norms and customs of the trade in order to fulfil its essential function of indicating origin. This is particularly so as there is no evidence to show that the relevant public, whether a member of the general public or a medical professional (which may be the case with regard to the goods in class 10), selects shoes from a particular trade source on the basis of the pattern on the sole or even that, in this context, they would pay any attention to the sole. They would be unlikely to notice or give any origin significance to this mark which would simply be seen as a textured sole used on an item of footwear.

63. It is clear from the totality of evidence filed by both sides and my own experience, that it is common to find a wide range of geometric and linear patterns on the soles of shoes. In my view, the 'sole device' at issue here does not depart significantly from other patterns, shapes and linear designs which are routinely used for these goods. The mark is therefore indistinguishable from the goods themselves and in the absence of any additional graphic or word element, there is no part of this mark which provides the consumer with an origin message. I find that the mark is not distinctive.

³ See, for example, *Henkel KGaA v Deutsches Patent- und Markenamt, Case C-218/01 and Zero Industry Srl v OHIM, Case T-400/06*.

Acquired distinctiveness

64. The proprietor stated throughout its evidence and at the hearing that the 'sole device' had acquired the distinctiveness necessary to satisfy the Registry that at the date of application and it was capable of functioning as a trade mark.

65. The evidence shows that sales of shoes in the UK between 2003 and 2014 were €86,667,997 which amounted to 6,165,887 pairs of shoes for the same period. The proprietor states that 90% of these shoes *'incorporate the present trade mark.'*

66. The evidence also includes large numbers of press articles from a wide range of sources including newspapers and magazines, inter alia, The Guardian and Vogue.

67. What the evidence does show is a high volume of sales and considerable awareness in the press and media of the Birkenstock brand. It also shows a number of product photographs from a range of traders which include a photograph showing the sole of the proprietor's shoes. What it does not show is a single example of the proprietor's goods being sold by reference to the sole mark which is the subject of these proceedings. The only evidence which shows an image of a sole which is similar to that which is at issue here (and is used in promotional material) is shown on page 2 of a 1997 Birkenstock catalogue⁴ and that appears to be nothing more than a decorative background.

68. The only specific reference to the nature of the soles of shoes being advertised as a desirable feature is made in respect of a 'super grip' sole, which is not the sole which is the subject of these proceedings.

69. The fact that online shoe traders show several views of a product, sometimes including a picture of the sole, does not mean, without evidence to the contrary, that the sole is being used in a trade mark sense. In my experience, it is simply the case that when buying such goods at a distance, without actually being able to hold them, it is fairly common practice to show as many views of the product as possible, to enable

⁴ See exhibit AW5

the consumer to have as much information about those goods as possible before making the purchase.

70. The evidence filed by the proprietor does nothing to advance its case that the 'sole device' had acquired the necessary distinctiveness to overcome its inherent position of lacking the necessary distinctiveness to function as a trade mark and the position is no different if considered at the date of application for invalidation.

71. The invalidation under section 3(1)(b) succeeds.

72. I will consider the remaining grounds in brief.

The invalidation under section 3(1)(c)

73. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was also summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*⁵:

"91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

'33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and*

⁵ *Above at 1*

Designs) (*OHIM*) *v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

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 (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

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 (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

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 (Joined

Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). 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 (*Koninklijke KPN Nederland*, paragraph 57).'

“And

‘46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a ‘characteristic’ of the goods or services referred to in the application. By using, in Article 7(1)(c) of

Regulation No 40/94 , the terms ‘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’, the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

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).⁶

“92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

74. With regard to its application in respect of figurative marks I bear in mind Mr Richard Arnold Q.C.’s decision in *Johnson & Johnson’s Application*⁶, in which he upheld the registrar’s decision to refuse to register a device of flowers for toiletries and

⁶ *BL O/105/06*

medicated products for topical application on the grounds that the device was descriptive of a characteristic of such products, namely those with a floral fragrance. He said:

“12...In my view the mark is a realistic representation of flowers rather than an abstract device. In any event, however, I consider that the hearing officer was entitled to come to the conclusion that the message that the mark would convey to the average consumer of the goods in question was that they incorporated a floral fragrance”.

75. The applicant states:

“8. The mark is descriptive as it is used to indicate both the quality and intended purpose of the footwear, namely demonstrating that it provides grip to the wearer and allows the footwear to be worn on a variety of surfaces. Furthermore, such adornment on the sole of a shoe is common in the trade and expected by consumers.”

76. The proprietor states that this ground is misconstrued and has not been made out by the applicant.

77. The applicant’s pleadings are twofold. The first is that the mark at issue indicates that the goods provide grip and can be worn on a number of surfaces. This is clearly not the case, since the mark is simply a textured pattern on the sole of a shoe. The mark does not give any indication of materials from which it might be made, its purpose, quality or any other characteristic of the goods. As to the suggestion that the mark describes the goods as being able to be worn on a number of surfaces, I would suspect that this is the case for the vast majority of footwear.

78. The second part of the applicant’s pleading is that ‘such adornment is common in trade’. It is true that the soles of shoes can include a number of types of patterns, lines and geometric shapes, as I have found previously in this decision. However, this mark does not describe any characteristic of the goods.

79. Consequently, the opposition under 3(1)(c) of the Act fails.

The opposition under section 3(1)(d)

80. The general principles with regard to this section of the Act are provided in *Telefon & Buch Verlagsgesellschaft mbH v OHIM*:⁷

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (BSS, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (BSS, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and BSS, paragraph 39).

⁷ T-322/03 (GC)

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and BSS, paragraph 40).”

81. In respect of its pleadings under this section the applicant submits:

“10. Such adornment on the sole of a shoe, identical or highly similar to the Mark, is customary in the bona fide and established practices of the trade as it has been used extensively by third parties for at least 30 years.”

82. The proprietor submits that there is no evidence that the Sole Device has become customary in the trade in this jurisdiction.

83. Registration should only be refused under this section of the Act where the figurative mark has become customary in the current language or in the bona fide and established practices of the trade to designate the goods (or services) for which registration is sought (the proprietor’s goods in classes 10 and 25).

84. Evidence in support of the applicant’s case is contained in exhibits FMM08-18. It comprises internet prints and catalogues from shoe component suppliers, manufacturers and retailers of shoes. The evidence does show examples of the pattern which is the subject of the proceedings, both as a sheet material and in the form of pre-cut soles bearing the pattern. However, all of the exhibits relate to the trade in, for the most part, Spain, but also Portugal, Italy, Germany and Turkey. In its evidence in reply the applicant states that the situation shown in its initial evidence is analogous to the situation in the UK, since the same goods are available here. That may well be the case but it was for the applicant to show, in evidence, that the proprietor’s mark is customary in the trade in the UK and it has not done so.

85. Consequently, the invalidation under section 3(1)(d) fails.

The invalidation under section 3(2)

86. The relevant section of the Act states:

3. – (2) A sign shall not be registered as a trade mark if it consists exclusively of -

(a) the shape which results from the nature of the goods themselves,

(b) the shape of goods which is necessary to obtain a technical result, or

(c) ...

87. Aldous L.J. stated in *Philips v Remington 1*⁸ that this exclusion covers any goods covered by the proposed trade mark registration. In this case the goods are footwear, orthopaedic footwear and parts of such footwear.

The 3(2)(b) ground

88. The judgment in *Philips v Remington 1*, the subsequent CJEU judgment⁹ and the decision in *Lego Juris A.s. v OHIM*¹⁰ mean that the exclusion under 3(2)(b) applies where the essential features of the shape are attributable only to a technical result. Other minor features which make no material impact on the consumer do not prevent the exclusion from applying providing the essential features are caught by the exclusion. Further clarification was provided in *Société des Produits Nestlé SA v Cadbury UK Ltd*¹¹ (the *KIT KAT* case) in which the CJEU concluded that the second indent to article 3(1)(e) of Directive 104/89, which is identical to, and the basis for, s.3(2)(b) of the Act, means that:

⁸ [1999] RPC 809

⁹ C-299/99, reported at [2003] RPC 2

¹⁰ C-48/09, paragraphs 51 and 52

¹¹ C-215/14

“...registration may be refused of signs consisting exclusively of the shape of the goods which is necessary to obtain a technical result, must be interpreted as referring only to the manner in which the goods at issue function and it does not apply to the manner in which the goods are manufactured.”

89. In my view, the essential features of the shape at issue are:

- The outline shape of the sole of a shoe.
- The pattern applied to the sole shape.

90. The applicant claims that:

“...13. ..., the Mark is essentially formed of a number of dissecting wavy lines that provide grip to the sole of the footwear. As such, the Mark does not consist of a trade mark but instead merely consists of a shape that is necessary to obtain a technical result, namely the wearer of the footwear is unlikely to slip when walking or moving in the footwear in question. There are no elements present in the Mark that are not functional.”

91. The proprietor submits, in its skeleton argument:

“21. As to the claim that there is some technical function, this requires evidence and there is none. The only evidence they could adduce is that the rubber in the Birkenstock shoes has good grip. The problem here is that the Applicant is confusing the actual products of Birkenstock with the trade mark image contained in the Sole Device. The Sole Device has nothing to do with rubber.”

92. I agree that the mark is formed ‘of a number of dissecting wavy lines’, however, there is no evidence to indicate that this particular pattern has any technical function. The only evidence provided which describes the proprietor’s footwear as having a ‘SUPERGRIP’ sole, relates to a different sole pattern than the one which is the subject

of these proceedings¹² and appears to relate to the material from which the sole is made, rather than any pattern which is presented on that sole. Even if it did refer to the correct pattern, I would still not be able to conclude that the pattern itself provided grip and was therefore attributable only to a technical result. In accordance with my findings earlier in this decision, the pattern is one of many which could have been selected and is, in my view, more akin to a decorative, rather than functional, feature. I find support for this view in the *Lego*¹³ decision in which the CJEU stated:

“...In addition, since that interpretation implies that the ground for refusal under Article 7(1)(e)(ii) of Regulation No 40/94 is applicable only where all the essential characteristics of the sign are functional, it ensures that such a sign cannot be refused registration as a trade mark under that provision if the shape of the goods at issue incorporates a major non-functional element, such as a decorative or imaginative element which plays an important role in the shape.”

93. In conclusion, the essential features of the contested mark are not attributable only to a technical result and this ground fails.

94. With regard to the application for invalidation under 3(2)(a), the applicant relies on the outline shape of the mark. It states:

“12. The Mark is clearly the shape of the sole of footwear. Footwear is normally a standard shape to fit human feet and therefore the Mark is essentially the shape which results from the nature of the goods themselves.”

95. The proprietor states:

“20. ...The outside of the sole of a shoe is, quite obviously, going to be similar. That is not however what the trade mark is aimed at. The Sole Device pattern has to be bounded. Therefore the boundary is, invariably,

¹² See, for example, Exhibit FMM19

¹³ Above at 6, paragraph 52

the shape of the sole of a shoe. The distinctive part of the Sole Device is the pattern contained within that boundary.”

96. Clearly the mark includes a pattern element in addition to the outline of the mark and must be considered in its totality.

97. Until recently there was very little case law in respect of this particular subsection. However, in *Hauck v Stokke*¹⁴ the CJEU held:

“The first indent of Article 3(1)(e) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that the ground for refusal of registration set out in that provision may apply to a sign which consists exclusively of the shape of a product with one or more essential characteristics which are inherent to the generic function or functions of that product and which consumers may be looking for in the products of competitors.”

98. Given my findings above, it is clear that none of the grounds for refusal set out in this provision is applicable to the shape (mark) at issue in this case. The pattern in question is not ‘inherent to the generic function or functions of that product’ and is not one which consumers may be looking for in the products of competitors. Consequently, the application for invalidity under this ground fails.

Conclusion

99. The invalidation succeeds under section 3(1)(b) and fails in respect of the other grounds pleaded.

¹⁴ *Case C-205/13*

COSTS

100. The applicant has succeeded in invalidating the proprietor's mark and is entitled to an award of costs in its favour. I note that the proprietor stated the following in its skeleton argument:

“Not one piece of evidence produced by the Applicant is relevant, yet every piece had to be considered in case something is hidden within an exhibit which is relevant.”

101. The vast majority of the applicant's evidence was from outside the relevant jurisdiction and it was of limited value in assisting me in reaching a decision in this matter. I will bear this in mind as well as taking account of the fact that the applicant did not attend the hearing nor did it file written submissions in lieu. The award is in accordance with the scale provided in Annex A of Tribunal Practice Notice 4 of 2007 and is as follows:

Official fee:	£200
Preparing a statement and considering the other side's statement:	£200
Filing and considering evidence:	£200
Total	£600

102. I order Birkenstock Sales GmbH to pay Eurogloria S.L. the sum of £600. This sum is to be paid within seven days of the expiry of the appeal period or within seven days if unsuccessful.

Dated this 31st day of October 2016

Ms Al Skilton
For the Registrar,
the Comptroller-General