

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2038186
IN THE NAME OF BUFFALO BOOTS LTD
TO REGISTER A TRADE MARK IN CLASS 25**

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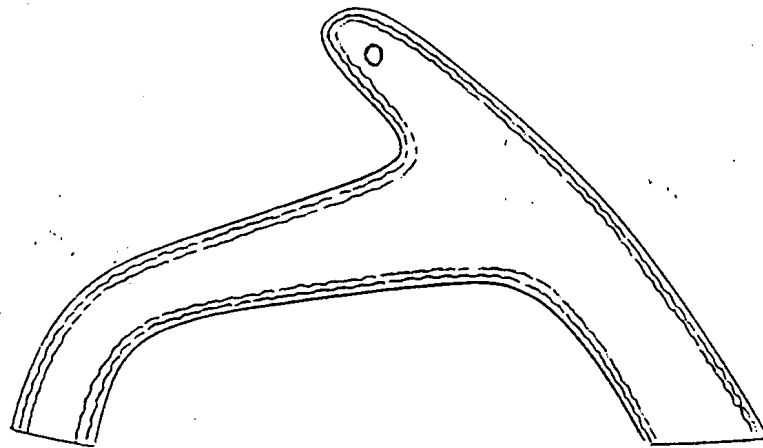
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DECISION

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On 25 September 1995 Buffalo Boots Ltd., c/o George Hay & Company of Cambridge Street, Pimlico, London, SW1 V4PS applied to register the following sign as a trade mark in Class 25:

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Objection was taken to the application under Sections 3(1)(a) and (b) of the Act because the mark is a device of a reinforcing section of material such as is commonly seen stitched onto footwear.

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Messrs Edward Evans & Co, representing the applicants, argued in correspondence that the mark did not consist of such a device. The agents contended that it was a very distinctive shape somewhat reminiscent of a boomerang, that although there may or may not be stitching within the

shape of the device this was not the only feature of which the mark consisted, and that the shape of the device was distinctive as a trade mark because although it was a shape which was applied to articles of footwear, the shape was fanciful and performed no functional purpose. They also drew to the Registrar's attention the fact that the identical mark had been registered in Germany and Spain.

The objections were maintained and on 16 September 1996 the matter came to be heard before Mr Michael Needleman. At the hearing, Ms Helen Fisher of Edward Evans & Co argued that it was common to apply distinctive shapes to footwear to distinguish them from those of other traders. Mr Needleman decided that, prima facie, the device applied for was not capable of distinguishing one trader's footwear from those of other traders. In his opinion most marks of this type only become distinctive through use. However, Mr Needleman agreed to suspend the application for three months for Ms Fisher to file details of the German and Spanish registrations.

On 16 December 1996 a statutory declaration by Herr Ulrich Bruckmann, the German attorney of Buffalo Boots Ltd, was filed. This declaration testified that the identical device to the present application had been registered in Germany and in Spain without it having been necessary in either case for the applicants to have proved distinctiveness of the mark by virtue of any use.

By this time the Hearing Officer, Mr Needleman, had left the Registry, and the matter came to be considered by Miss Virginia Douglas. The applicant was informed that Miss Douglas was of the opinion that registration of the mark in Germany and Spain did not assist in overcoming the prima facie objections raised against the application in the United Kingdom, and that in the absence of any evidence of distinctiveness in this country the application would be refused. There was a

further exchange of correspondence, and samples of footwear, showing the way the mark was used, were submitted to Miss Douglas for inspection. After inspecting these exhibits Miss Douglas wrote to Messrs Edward Evans & Co on 10 July 1997 informing them that the application was not considered to be acceptable prima facie. The application was suspended for
5 3 months, until 10 October 1997, for any further submissions the applicant wished to make.

On 11 August 1997 a Form TM33 was filed appointing Messrs Marks & Clerk as agents for the applicant.

10 By 7 November 1997 no further submissions had been received and the application was therefore refused in accordance with Section 37(4) of the Act.

Following refusal of the application I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of decision and the materials used
15 in arriving at it.

As the person who heard the applicant's case (Mr Needleman) has since left the Registry, the applicant was offered the chance of a further hearing, but the applicant declined to accept the offer. Miss Douglas has also now left the Registry. It falls to me therefore to write this decision
20 based on the papers on the file.

No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

Section 3(1)(a) & (b) of the Act are set out below:-

3-(1) The following shall not be registered:

5 (a) signs which do not satisfy the requirements of Section 1(1)

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

Section 1(1) of the Act reads as follows:-

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1-(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing the goods or services of one undertaking from those of other undertakings.

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A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

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In the light of Mr Needleman’s comments above, I do not think that the ground of objection under Sections 1(1) and 3(1)(a) can be sustained. The Registrar is not, therefore, taking the position that the mark could never become a distinctive mark. The Hearing Officer’s decision was that the mark is, prima facie, devoid of any distinctive character.

The samples showing the applicant’s mark in use which were sent to the Registry for inspection were actual pieces of footwear, therefore it has been impossible to attach them to this decision.

The samples consist of three different styles of 'trainer' type shoe. On examination of these samples it is apparent that the mark applied for is a representation of the reinforcing section applied to the sides of each shoe. The markings on the representation are the stitching by which the section is attached to the shoe, and the circle at the top is the eyelet hole. The Hearing Officers
5 were aware from their own knowledge that most training shoes feature some reinforcing sections of material between the stronger material which contains the laceholes and that which is usually found at the toe and heel of the shoe and/or the sole. In use the two lower protrusions depicted in the mark appear to be attached to the welt. The shape represented by the mark therefore appears to be an effective way of linking the stronger areas of the shoe together so as to increase
10 its strength and durability. At least that is the way it is likely to be perceived, prima facie, by the public. I conclude that the shape appears to be primarily functional, being the kind of reinforcement applied to most footwear of the same type.

Although there are other shapes that could be used to achieve the same result, that does not mean
15 that this shape is distinctive. Mr Hugh Laddie in the PROFITMAKER case (1994) RPC 613 at page 616 lines 38-44 said:

“The fact that honest traders have a number of alternative ways of describing a product is no answer to the criticism of the mark. If it were, then all those other ways could, on the same argument, also be the subject of registered trade marks. The honest trader should
20 not need to consult the register to ensure that common descriptive or laudatory words, or not unusual combinations of them, have been monopolised by others”.

In my view Mr Laddie's remarks apply equally to the alternative shapes available for use as reinforcing sections of footwear. This type of reinforcing being commonly used on training shoes, it is difficult to see how the public would recognise the sign as a trade mark at all, without, in the

words of Mr Justice Jacob in the “Treat” decision (1996 RPC 306) “first educating the public that it is a trade mark”.

5 The applicant has registered the identical mark in Germany and in Spain. However, registration of the mark other than in the United Kingdom is not decisive. I have no idea of the circumstances surrounding those registrations or of whether the Offices were aware what the device represented.

10 In the case of Phillips Electronics NV v Remington Consumer Products (1998) RPC 283 Mr Justice Jacob took the view that under a law which allows for the registration of shapes, a two dimensional representation of a shape is subject to the same objections to registration as would apply to the mark in three-dimensional form. I therefore take the view that the case for registration for this mark is no different than would have been the case had the applicant explicitly applied for the registration of a mark consisting of the shape of a reinforcing section applied to footwear.

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Ms Fisher, for the applicant, also submitted examples of other ‘shape’ marks that had been accepted by the Registrar, prima facie, for footwear, but I do not consider those precedents to be binding and in any case they can be distinguished from this application.

20 In conclusion, I find that the mark is devoid of distinctive character and is debarred from registration under Section 3(1)(b) of the Act.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the

terms of Section 37(4) of the Act because it fails to qualify under Section 3(1)(b) of the Act.

Dated this 22 day of July 1998.

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ANNE PRITCHARD
For the Registrar
The Comptroller General