

O-203-14

**\ TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATIONS
Nos. 2625133 & 2625150
BY GO OUTDOORS LIMITED
TO REGISTER THE TRADE MARKS
GO WALKING
&
GO RUNNING**

IN CLASSES 18 & 35

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER Nos. 104511 & 104512 BY**

SKECHERS USA INC II

BACKGROUND

1) On 19 June 2012 Go Outdoors Limited (hereinafter the applicant), applied to register the following trade marks:

Number	Mark	Class	Goods
2625133	<p>GO WALKING</p> <p>GO Walking</p> <p>A series of two marks</p>	18	Rucksacks and bags; covers for rucksacks and bags; rucksack frames; rucksacks, slings and pouches for carrying babies and infants; rucksacks, day sacks, backpacks and bags for use in sporting and outdoor pursuits; bags for climbers; panniers for use with bicycles; bags for use in hunting; walking poles; walking sticks; umbrellas.
		35	Retail services connected with the sale of cosmetics, perfumes, soaps, essential oils, sun block, suntan lotion, lip balm, hair lotions, body lotions, dentifrices, deodorants for personal use, shower gel, shampoos, fuels, fuel for use in barbeques, materials (including liquids) for lighting barbeques, first aid kits, plasters, materials for dressings, plaster kits, disinfectants, preparations for destroying vermin, bandages, dressings, insecticides, hand steriliser kits, metal climbing equipment, crampons, hooks, ice nails, metal pegs, pitons of metal, rope thimbles of metal, keys and key rings, metal ropes, tent pegs, hand tools, saws, saw blades, scissors, knife sharpeners, machetes, shovels, axes, mallets, tent stake pullers, hand tools for use in hunting including knives, cutlery, can openers, hand implements (electric) for use in barbeque cooking, eyewear, sunglasses, goggles for sports, spectacles, spectacle frames, cases for spectacles and sunglasses, sports optics, protective bags and cases for eyewear, protective clothing for use in sporting and outdoor pursuits activities, protective helmets for use in sporting and outdoor pursuits activities, protective headgear for use in sporting and outdoor pursuits activities, insulated/protective gloves, flashlight batteries, batteries, thermometers, whistles, compasses, reflectors, personal flotation devices, eyeglass repair kits, personal security alarms, rechargeable battery packs, battery chargers, AC/DC power supplies, satellite navigation systems, location finders, range finders, sonar fish finders, binoculars, cameras, camera lenses, camera flashguns, camera casings, disposable cameras, camera bags, lighting equipment, heating equipment, cooking equipment, lanterns, nightlights, key chain lights, mantles, torches and flashlights, heaters, stoves, griddles and grills, barbecues, barbecue apparatus, barbecue cooking apparatus, water purifiers, bicycles, including mountain bikes, apparatus parts and fittings for use with bicycles, boats including inflatable boats, leisure boats, rowing boats, rubber boats, sailing boats and fishing boats, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, horological and chronometric instruments, rucksacks, bags, rucksack frames, rucksacks for carrying babies and infants, slings for carrying babies and infants, pouches for carrying babies and infants, day sacks, backpacks, bags, bags for climbers, bags for use in hunting, whips, harnesses, saddlery, blankets for horses, blinkers for horses, horse bridles, horse covers, horse rugs, horse shoes, reins, leads, stirrups, straps, halters, walking poles, walking sticks, umbrellas, sleeping bags, ground mats, tent pegs, map cases, mattresses for camping, camping furniture, garden furniture, mirrors, insulated bait boxes, insulated tackle boxes, stove carrying cases, cooking utensils for use with barbeques, hand implements (non-electric) for use in barbeque cooking, insulated food and drink containers, water carriers, bottles, cups, cooking

		<p>utensils, coffee pots, mugs, cups, plates, pots, pans, bowls, flasks, buckets, canteens, glasses, corkscrews, washbags, toothbrushes, tents, awnings, tarpaulins, ropes, string, ground sheets, hammocks, fishing nets, textiles, textile piece goods, covers for use with garden furniture, mosquito nets, towels, clothing, footwear, headgear, thermal clothing, jackets, trousers, over trousers, breeches, sweatshirts, knit wear, shirts, hats, balaclavas, mitts, gloves, thermal underwear, socks, gaiters, boots, apparatus for use in outdoor pursuits, apparatus for use in sporting activities, paragliders, hang gliders, gliders [playthings], kites, toy bicycles, sporting articles for wear adapted for use in a specific sport of outdoor pursuits (other than helmets), apparatus for use in fishing, apparatus for use in water sports and other sports utilising water, pads and protectors for use in sporting activities, skis, snowboards, surf boards, bindings for skis, snowboards and surfboards, ski poles, covers for skis, ski bindings, snowboards and surfboards, bags adapted for skis, ski bindings, snowboards and surfboards, wedges for ski boots or ski bindings, slalom posts and gates, ski wax, skateboards, protective padding for sportswear, namely elbow guards, knee guards, wrist guards; electronic shopping retail services connected with the sale of cosmetics, perfumes, soaps, essential oils, sun block, suntan lotion, lip balm, hair lotions, body lotions, dentifrices, deodorants for personal use, shower gel, shampoos, fuels, fuel for use in barbeques, materials (including liquids) for lighting barbeques, first aid kits, plasters, materials for dressings, plaster kits, disinfectants, preparations for destroying vermin, bandages, dressings, insecticides, hand steriliser kits, metal climbing equipment, crampons, hooks, ice nails, metal pegs, pitons of metal, rope thimbles of metal, keys and key rings, metal ropes, tent pegs, hand tools, saws, saw blades, scissors, knife sharpeners, machetes, shovels, axes, mallets, tent stake pullers, hand tools for use in hunting including knives, cutlery, can openers, hand implements (electric) for use in barbeque cooking, eyewear, sunglasses, goggles for sports, spectacles, spectacle frames, cases for spectacles and sunglasses, sports optics, protective bags and cases for eyewear, protective clothing for use in sporting and outdoor pursuits activities, protective helmets for use in sporting and outdoor pursuits activities, protective headgear for use in sporting and outdoor pursuits activities, insulated/protective gloves, flashlight batteries, batteries, thermometers, whistles, compasses, reflectors, personal flotation devices, eyeglass repair kits, personal security alarms, rechargeable battery packs, battery chargers, AC/DC power supplies, satellite navigation systems, location finders, range finders, sonar fish finders, binoculars, cameras, camera lenses, camera flashguns, camera casings, disposable cameras, camera bags, lighting equipment, heating equipment, cooking equipment, lanterns, nightlights, key chain lights, mantles, torches and flashlights, heaters, stoves, griddles and grills, barbecues, barbecue apparatus, barbecue cooking apparatus, water purifiers, bicycles, including mountain bikes, apparatus parts and fittings for use with bicycles, boats including inflatable boats, leisure boats, rowing boats, rubber boats, sailing boats and fishing boats, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, horological and chronometric instruments, rucksacks, bags, rucksack frames, rucksacks for carrying babies and infants, slings for carrying babies and infants, pouches for carrying babies and infants, day sacks, backpacks, bags, bags for climbers, bags for use in hunting, whips, harnesses, saddlery, blankets for horses, blinkers for horses, horse bridles, horse covers, horse rugs, horse shoes,</p>
--	--	---

			<p>reins, leads, stirrups, straps, halters, walking poles, walking sticks, umbrellas, sleeping bags, ground mats, tent pegs, map cases, mattresses for camping, camping furniture, garden furniture, mirrors, insulated bait boxes, insulated tackle boxes, stove carrying cases, cooking utensils for use with barbeques, hand implements (non-electric) for use in barbeque cooking, insulated food and drink containers, water carriers, bottles, cups, cooking utensils, coffee pots, mugs, cups, plates, pots, pans, bowls, flasks, buckets, canteens, glasses, corkscrews, washbags, toothbrushes, tents, awnings, tarpaulins, ropes, string, ground sheets, hammocks, fishing nets, textiles, textile piece goods, covers for use with garden furniture, mosquito nets, towels, clothing, footwear, headgear, thermal clothing, jackets, trousers, over trousers, breeches, sweatshirts, knit wear, shirts, hats, balaclavas, mitts, gloves, thermal underwear, socks, gaiters, boots, apparatus for use in outdoor pursuits, apparatus for use in sporting activities, paragliders, hang gliders, gliders [playthings], kites, toy bicycles, sporting articles for wear adapted for use in a specific sport of outdoor pursuits (other than helmets), apparatus for use in fishing, apparatus for use in water sports and other sports utilising water, pads and protectors for use in sporting activities, skis, snowboards, surf boards, bindings for skis, snowboards and surfboards, ski poles, covers for skis, ski bindings, snowboards and surfboards, bags adapted for skis, ski bindings, snowboards and surfboards, wedges for ski boots or ski bindings, slalom posts and gates, ski wax, skateboards, protective padding for sportswear, namely elbow guards, knee guards, wrist guards.</p>
2625150	<p>GO RUNNING</p> <p>GO Running</p> <p>A series of two marks</p>	35	<p>Retail services connected with the sale of cosmetics, perfumes, soaps, essential oils, sun block, suntan lotion, lip balm, hair lotions, body lotions, dentifrices, deodorants for personal use, shower gel, shampoos, fuels, fuel for use in barbeques, materials (including liquids) for lighting barbeques, first aid kits, plasters, materials for dressings, plaster kits, disinfectants, preparations for destroying vermin, bandages, dressings, insecticides, hand steriliser kits, metal climbing equipment, crampons, hooks, ice nails, metal pegs, pitons of metal, rope thimbles of metal, keys and key rings, metal ropes, tent pegs, hand tools, saws, saw blades, scissors, knife sharpeners, machetes, shovels, axes, mallets, tent stake pullers, hand tools for use in hunting including knives, cutlery, can openers, hand implements (electric) for use in barbeque cooking, eyewear, sunglasses, goggles for sports, spectacles, spectacle frames, cases for spectacles and sunglasses, sports optics, protective bags and cases for eyewear, protective clothing for use in sporting and outdoor pursuits activities, protective helmets for use in sporting and outdoor pursuits activities, protective headgear for use in sporting and outdoor pursuits activities, insulated/protective gloves, flashlight batteries, batteries, thermometers, whistles, compasses, reflectors, personal flotation devices, eyeglass repair kits, personal security alarms, rechargeable battery packs, battery chargers, AC/DC power supplies, satellite navigation systems, location finders, range finders, sonar fish finders, binoculars, cameras, camera lenses, camera flashguns, camera casings, disposable cameras, camera bags, lighting equipment, heating equipment, cooking equipment, lanterns, nightlights, key chain lights, mantles, torches and flashlights, heaters, stoves, griddles and grills, barbecues, barbecue apparatus, barbecue cooking apparatus, water purifiers, bicycles, including mountain bikes, apparatus parts and fittings for use with bicycles, boats including inflatable boats, leisure boats, rowing boats, rubber boats, sailing boats and fishing boats, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, horological</p>

		<p>and chronometric instruments, rucksacks, bags, rucksack frames, rucksacks for carrying babies and infants, slings for carrying babies and infants, pouches for carrying babies and infants, day sacks, backpacks, bags, bags for climbers, bags for use in hunting, whips, harnesses, saddlery, blankets for horses, blinkers for horses, horse bridles, horse covers, horse rugs, horse shoes, reins, leads, stirrups, straps, halters, walking poles, walking sticks, umbrellas, sleeping bags, ground mats, tent pegs, map cases, mattresses for camping, camping furniture, garden furniture, mirrors, insulated bait boxes, insulated tackle boxes, stove carrying cases, cooking utensils for use with barbeques, hand implements (non-electric) for use in barbeque cooking, insulated food and drink containers, water carriers, bottles, cups, cooking utensils, coffee pots, mugs, cups, plates, pots, pans, bowls, flasks, buckets, canteens, glasses, corkscrews, washbags, toothbrushes, tents, awnings, tarpaulins, ropes, string, ground sheets, hammocks, fishing nets, textiles, textile piece goods, covers for use with garden furniture, mosquito nets, towels, clothing, footwear, headgear, thermal clothing, jackets, trousers, over trousers, breeches, sweatshirts, knit wear, shirts, hats, balaclavas, mitts, gloves, thermal underwear, socks, gaiters, boots, apparatus for use in outdoor pursuits, apparatus for use in sporting activities, paragliders, hang gliders, gliders [playthings], kites, toy bicycles, sporting articles for wear adapted for use in a specific sport of outdoor pursuits (other than helmets), apparatus for use in fishing, apparatus for use in water sports and other sports utilising water, pads and protectors for use in sporting activities, skis, snowboards, surf boards, bindings for skis, snowboards and surfboards, ski poles, covers for skis, ski bindings, snowboards and surfboards, bags adapted for skis, ski bindings, snowboards and surfboards, wedges for ski boots or ski bindings, slalom posts and gates, ski wax, skateboards, protective padding for sportswear, namely elbow guards, knee guards, wrist guards; electronic shopping retail services connected with the sale of cosmetics, perfumes, soaps, essential oils, sun block, suntan lotion, lip balm, hair lotions, body lotions, dentifrices, deodorants for personal use, shower gel, shampoos, fuels, fuel for use in barbeques, materials (including liquids) for lighting barbeques, first aid kits, plasters, materials for dressings, plaster kits, disinfectants, preparations for destroying vermin, bandages, dressings, insecticides, hand steriliser kits, metal climbing equipment, crampons, hooks, ice nails, metal pegs, pitons of metal, rope thimbles of metal, keys and key rings, metal ropes, tent pegs, hand tools, saws, saw blades, scissors, knife sharpeners, machetes, shovels, axes, mallets, tent stake pullers, hand tools for use in hunting including knives, cutlery, can openers, hand implements (electric) for use in barbeque cooking, eyewear, sunglasses, goggles for sports, spectacles, spectacle frames, cases for spectacles and sunglasses, sports optics, protective bags and cases for eyewear, protective clothing for use in sporting and outdoor pursuits activities, protective helmets for use in sporting and outdoor pursuits activities, protective headgear for use in sporting and outdoor pursuits activities, insulated/protective gloves, flashlight batteries, batteries, thermometers, whistles, compasses, reflectors, personal flotation devices, eyeglass repair kits, personal security alarms, rechargeable battery packs, battery chargers, AC/DC power supplies, satellite navigation systems, location finders, range finders, sonar fish finders, binoculars, cameras, camera lenses, camera flashguns, camera casings, disposable cameras, camera bags, lighting equipment, heating equipment, cooking equipment, lanterns, nightlights, key chain lights, mantles, torches and</p>
--	--	--

		<p>flashlights, heaters, stoves, griddles and grills, barbecues, barbecue apparatus, barbecue cooking apparatus, water purifiers, bicycles, including mountain bikes, apparatus parts and fittings for use with bicycles, boats including inflatable boats, leisure boats, rowing boats, rubber boats, sailing boats and fishing boats, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, horological and chronometric instruments, rucksacks, bags, rucksack frames, rucksacks for carrying babies and infants, slings for carrying babies and infants, pouches for carrying babies and infants, day sacks, backpacks, bags, bags for climbers, bags for use in hunting, whips, harnesses, saddlery, blankets for horses, blinkers for horses, horse bridles, horse covers, horse rugs, horse shoes, reins, leads, stirrups, straps, halters, walking poles, walking sticks, umbrellas, sleeping bags, ground mats, tent pegs, map cases, mattresses for camping, camping furniture, garden furniture, mirrors, insulated bait boxes, insulated tackle boxes, stove carrying cases, cooking utensils for use with barbecues, hand implements (non-electric) for use in barbecue cooking, insulated food and drink containers, water carriers, bottles, cups, cooking utensils, coffee pots, mugs, cups, plates, pots, pans, bowls, flasks, buckets, canteens, glasses, corkscrews, washbags, toothbrushes, tents, awnings, tarpaulins, ropes, string, ground sheets, hammocks, fishing nets, textiles, textile piece goods, covers for use with garden furniture, mosquito nets, towels, clothing, footwear, headgear, thermal clothing, jackets, trousers, over trousers, breeches, sweatshirts, knit wear, shirts, hats, balaclavas, mitts, gloves, thermal underwear, socks, gaiters, boots, apparatus for use in outdoor pursuits, apparatus for use in sporting activities, paragliders, hang gliders, gliders [playthings], kites, toy bicycles, sporting articles for wear adapted for use in a specific sport of outdoor pursuits (other than helmets), apparatus for use in fishing, apparatus for use in water sports and other sports utilising water, pads and protectors for use in sporting activities, skis, snowboards, surf boards, bindings for skis, snowboards and surfboards, ski poles, covers for skis, ski bindings, snowboards and surfboards, bags adapted for skis, ski bindings, snowboards and surfboards, wedges for ski boots or ski bindings, slalom posts and gates, ski wax, skateboards, protective padding for sportswear, namely elbow guards, knee guards, wrist guards.</p>
--	--	---

2) The applications were examined and accepted, and subsequently published for opposition purposes on 16 November 2012 in Trade Marks Journal No.6966.

3) On 18 February 2012 Skechers U.S.A. Inc. II (hereinafter the opponent) filed notices of opposition, subsequently consolidated. The grounds of opposition are in summary:

- a) The opposition is limited to “retail services connected with the sale of clothing and footwear. The opponent states that the clothing and footwear will be used to go walking and the marks are descriptive everyday words which describe the activity for which the clothing and footwear is designed. They state that there is no perceptible difference between the sign and the mere sum of its parts. They claim there is an immediately apparent, direct and specific relationship between the sign and the services. They point out that the goods in Class 25 themselves were deemed to offend against section 3(1)(b) & (c) of the Act and that the retail services should also suffer the same fate.

4) On 22 April 2012 the applicant filed counterstatements which basically denied that the marks offend against section 3(1)(b) or (c) of the Act.

5) Both sides filed evidence. Both seek an award of costs in their favour. The matter came to be heard on 5 February 2014 when the applicant was represented by Mr Malynicz of Counsel instructed by Messrs Wilson Gunn and the opponent by Mr Reed of Counsel instructed by Messrs D Young & Co. LLP.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 24 June 2013, by Garry Batchelor the Customer Services Manager (UK and Ireland) of Skechers USA Ltd a company related to the opponent as they are both in the same group of companies. He states that Skechers is a world leading footwear company selling a variety of different designs in substantial quantities in the UK and worldwide. He states that he has worked for the company for twelve years and as such is fully conversant with the UK footwear industry. He states:

“5. The words GO WALKING describe the activity of moving or travelling by putting one foot in front of the other, allowing each foot to touch the ground before lifting the next. Similarly, the words GO RUNNING describe the activity of moving or travelling somewhere quickly on foot, as a sport or for fun.

6. The fitness industry and health professionals frequently exhort and encourage people to “go running”, “get running”, “start running”, “go walking”, “get walking” and “start walking” in order to improve an individual’s level of fitness and overall health. I have included at exhibit GB2 of this witness statement some examples of organisations (including the Ramblers’ website at www.getwalking.org and www.ramblers.org.uk/go-walking.aspx) promotions and literature (including a magazine entitled “GO WALKING”) which suggest to people that they should “go walking”, “get walking”, “start walking”, “go for a walk”, “keep walking”, “go running”, “get running” and “start running”.

7. The activities of walking and running require appropriate footwear and clothing and the majority of retailers of clothing and footwear (for example, Decathlon, Snow + Rock, Blacks, Mountain Warehouse and Nike) include specific sections on their websites and within their retail stores which are entitled “running” and “walking” or “run” and “walk”. Consumers will identify these sections of the retailers’ website, or areas of the retail shop, as being the appropriate place to find and select clothing and footwear which is particularly suitable and appropriate for running or walking (for example, clothing for running might have a slick, fast drying exterior and footwear for running might include additional shock absorbers and/or extra stability). Some examples of this use of the words “running” and “walking” by retailers of clothing and footwear are included at exhibit GB3 to this witness statement.

8. Similarly, the marks which the applicant has applied for (GO RUNNING and GO WALKING) are currently frequently used by retailers of footwear and clothing to identify particular footwear and clothing which is especially suitable or relevant for the purposes of going running or going walking. Some examples are enclosed at exhibit GB4 of this witness statement.

9. Retailers of clothing and footwear must be able to use the descriptive marks GO RUNNING and GO WALKING to identify appropriate clothing and footwear offered for sale which consumers may wish to purchase if they want to go running or go walking. The applicant should not be granted a monopoly in the marks GO RUNNING and GO WALKING for clothing and footwear.”

7) Mr Batchelor provided the following exhibits:

- GB2: This consists of pages from various websites: a page which encourages people to “go walking” in order to avoid disease (dated 2011); a page relating to a free magazine given away with Caravan and Camping magazine which provides information and advice for individuals wanting to go walking (dated 2012); a page advertising a “GO Walking” pedometer (dated 2010); a magazine entitled “Country Walking” (dated July 2013); a page which encourages people to “save money –start walking” in relation to getting to work (undated); a site supported by Oldham Council encouraging people to lead a healthier lifestyle by walking which has the headline “Oldham- Let’s go for a walk” (undated); a National Trust website encouraging people to “go walking” as it’s the best way to experience nature (undated); a page entitled “Let’s Go Bedfordshire’s promoted routes and sites” then states “Lets go walking” and shows details of walks in Bedfordshire (undated); pages from the NHS which states “Where to go walking this summer” (undated) and HSC Public Health Agency which encourages people to “Go walking. Go biking.” (dated April 2009); pages from a ramblers group which has a slogan “get walking keep walking” as well as providing information on finding a walk and stating “Get walking and get healthy”(undated); various pages encouraging people to “start running”; three pages headed “so let’s go RUNNING” (dated March 2013); a page entitled “Up & Running” which begins its narrative “Let’s Go!” (undated).
- GB3: Pages from shopping websites which offer goods split into sections for various sports such as football, basketball, running, walking, fishing, training, camping, cycling, hiking, climb, ski, travel, walking and hiking, trail running, gym wear, base layers, mountaineering, trekking, bowls, cricket, darts, golf etc. These sites were from, inter alia, Nike, Mountain Warehouse, Decathlon, Snow + Rock, Blacks, Trespass, North Face, Sports Direct and John Lewis. None had dates upon them.
- GB4: This exhibit has pages from websites offering specific goods for sale such as “New Balance Go Running Tights”; Stow and Go Running Gloves”; and an

Adidas Running T-shirt with the slogan “Go Run” printed upon it. None of these pages are dated.

APPLICANT’S EVIDENCE

8) The applicant filed a witness statement, dated 23 August 2013, by John Llewelyn Graham the founder of GO Outdoors Ltd and the CEO from 1998 to 2013. He states that his company is a leading retailer of clothing, apparatus and equipment for outdoor pursuits, activities and sports and has 44 retail outlets in the UK (42 as at the date of application). He states that the stores sell a huge range of products from general clothing items to specialist mountaineering equipment. They stock over 35,000 different products, mostly from third parties but including some own branded products. He states that the marks “GO WALKING” and “GO RUNNING” have appeared in all the company’s stores since 2006. He states that his company operates a discount card which shoppers purchase for a low fee and obtain discounts throughout the year. In 2006 there were 260,000 registered clients and by 2012 over 2.5 million people had purchased the cards. In addition to the retail stores the company has sold on-line since 2004. The company has used a number of GO brands, in 2004 it introduced GO Camping; GO Walking; GO Travelling; Go Caravanning; GO Climbing; GO Cycling and GO Skiing. Then in 2007 it added GO Running; GO Fishing and GO Riding. He states that the signage in each store reflected these brands. He states that there are a number of established players in the outdoor market (e.g. Milletts), which is worth approximately £1.4 billion and of which the applicant has an approximate 10-12% share. Mr Graham explains that his company does not keep individual sales figures for each of its sub-brands. He provides figures for the total GO Outdoors business and then provides estimates for the sales of walking and running products under both GO Walking and GO Running. He also provides estimates of promotional expenditure on radio, television, magazines, mailshots, billboards etc on both marks.

YEAR	Running Products £	Advertisements for running products	Walking products	Advertisements for walking products
2007	170,000	13,000	10,000,000	770,000
2008	360,000	20,000	15,000,000	850,000
2009	950,000	60,000	28,000,000	1,700,000
2010	1,500,000	102,000	42,000,000	3,000,000
2011	2,600,000	180,000	51,000,000	3,400,000

9) Mr Graham states that his company’s stores currently get 11.5 million customers a year through the doors (2011-9.8 million). He states that from his experience approximately half are keen on outdoor activities whereas the other half are buying general clothing such as a coat to go to work in or take their children to school. He states his belief that the marks are inherently distinctive and/or they have acquired distinctiveness as a result of the use made of them. He also provides the following exhibits:

- JLG6: A range of photographs of the outside and inside of stores showing how the marks in suit are widely used. These are all dated prior to the relevant date of June 2012.
- JLG7: This shows a range of banners and posters used both inside and outside the stores. These are undated.
- JLG8-13: These exhibits comprise copies of billboard advertisements, mailshots, magazine publications, newspaper advertisements, scripts for radio and TV commercials, all dated between 2006 and May 2012. These show extensive use of the marks in suit as well as the family of GO marks. It would appear that only the GO Outdoors mark uses the device element of a range of mountains in a circle.

OPPONENT'S EVIDENCE IN REPLY

10) The opponent filed a second witness statement by Mr Batchelor, dated 18 November 2013. He points out that the footfall figures are likely to represent a number of repeat customers so the figures do not represent unique customers which will be substantially fewer. He points out that Mr Graham claims that both marks have featured on the website since 2004 yet elsewhere in his statement Mr Graham states that the mark GO RUNNING was introduced in 2007. He states that the applicant's exhibit JLG6 shows the marks in suit being used to designate areas of the store where either "running" or "walking" products are available. He states that the photographs show that these are mostly third party brands and so the marks in suit are not being used as trade marks upon the goods in question. He also criticises the estimates provided by Mr Graham as it was stated that no figures were collated for these sales or promotions and it is not clear how Mr Graham has provided the figures. He states that if the marks had been used as retail brands then sales figures would have been available. He also provides the following exhibit:

- GB1: Copies of the applicant's website produced by the "waybackmachine" website. These are dated between October 2005 and October 2012 and these show no use of either of the marks in suit on the applicant's website.

11) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

12) Prior to the hearing the opponent clarified which of the services they were objecting to. These were stated to be the following in Class 35:

- 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),

13) The opposition is under Sections 3(1)(b) and (c) which read:

“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.”

14) I first turn to the ground of opposition under Section 3(1)(c). The principles to be applied under Article 7(1)(c) of the Community Trade Mark Regulation were conveniently summarised as follows by the CJEU in the following paragraphs from the court’s judgment in Case C-51/10P *Agencja Wydawnicza Technopol sp. z o.o. v OHIM* (with references to previous case law omitted):

“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.

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.

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.

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.”

15) In addition, I note that a sign is caught by the exclusion from registration in Article 7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned (Case C-191/01 P *OHIM v Wm Wrigley Jr Co.*)

16) Although the case law cited above relates to the application of the Community Trade Mark Regulation, the provisions in question are identical to corresponding provisions in the Trade Marks Directive, which find expression in the UK in s.3(1) of the Act. The judgments of the CJEU therefore provide authoritative guidance as to the correct application of s.3(1)(c) of the Act.

17) It is clear that the matter must be assessed from the perspective of “the relevant class of persons”, which in this case is composed primarily of consumers and end users of the services listed in paragraph 12 above, i.e. the general public.

18) The opponent contends:

“a) The expressions "Go Walking" and "Go Running" are already used by health

organisations, by ramblers, and as the title or partial title of magazines - see examples in Exhibit GB-2 (Tab 5). Whilst these are not uses by vendors of such products, it demonstrates that these terms are linguistically normal terms (whether on their own or as part of a sentence) as opposed to being fanciful or grammatically incorrect expressions. This increases the chances of a trader wishing to use an ordinary English expression.

b) Retailers of running footwear/clothing and walking footwear/clothing tend to organise their online stores into 'running' and 'walking' sections, just as is done by the Applicant - see examples in Exhibit GB-3 (Tab 6). The words 'running' and 'walking' are entirely descriptive of the goods that are being sold.

c) Some vendors are already using the expression "Go Running" or "Go Run" on or in connection with such goods - see examples in Exhibit GB-4 (Tab 7). In particular:

- i) Field & Trek are selling running tights using the description "New Balance Go Running Tights Ladies";
- ii) Amazon is selling a Nike t-shirt printed with "JOGGING SUCKS! Nike GO RUNNING";
- iii) Amazon is selling some gloves using the description "Stow and GO Running Gloves";
- iv) "Very" is selling an Adidas running t-shirt printed with "Go Run" using the description "Adidas Go Run Response Running T-shirt".

11. It is entirely plausible that a vendor of running shoes may wish to say: "*Go Running in our shoes*" to demonstrate the intended purpose of their shoes. Likewise, it is entirely plausible that a vendor of walking boots may wish to say: "*Go walking in our boots*" to demonstrate their intended purpose.

12. It is submitted that such potential uses are not contrived or unlikely – they are

natural expressions that might well be used to indicate the intended purpose of the goods.

13. The Applicant seeks to distinguish between a retailer of such goods and a manufacturer of such goods. The Opponent submits that such a distinction is illusory in respect of these goods. The expressions set out above are apt to describe a range of running shoes or walking boots being sold by a particular retailer stocking a range of branded shoes/boots from different manufacturers. The term is equally descriptive of the retailing of the goods as it is of the goods themselves.

14. It is submitted that the terms "Go Walking" and "Go Running" are more than merely suggestive or evocative of the intended purpose of walking clothing or running clothing - they are entirely descriptive of the intended purpose i.e. that the goods are to be used to go running or to go walking."

19) I disagree with the fundamental position taken by the opponent that the terms "GO Walking/GO Running" describe the basic activity of walking/running. The words "walking/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. Whilst the average consumer will of course recognise that the marks are encouraging them to participate in the activity it does not follow that they will recognise the marks as designating a characteristic of the retail services. Many trade marks allude to characteristics of the goods or services for which they are used, but nevertheless make good trade marks. The CJEU's reference to the signs which are "easily recognisable by the relevant class of persons" is not to be taken as meaning that marks that are recognisable as having been derived from two or more descriptive indications must themselves be excluded from registration. In fact the CJEU has found that even a combination of complete descriptive elements:

".... may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements."

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.”

21) The opponent clearly carried out extensive internet searches yet could find only one instance of use of the term “Go running” in relation to a pair of tights. There is no evidence of when this use began or its extent. The two examples of T-shirts are clearly not trade mark use (or even if they were are use of the whole slogan not just a convenient part) and the instance of the gloves shows the problems of internet searches in that the mark being used is clearly “Stow and Go” which is totally different to the instant marks. Consequently, there is no need to exclude the marks from registration in order to give effect to the policy underlying s.3(1)(c), which is to prevent the registration of “descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought [so that they] may be freely used by all traders offering such goods or services.” **I therefore reject the section 3(1)(c) ground of opposition.**

22) I now turn to the ground of opposition under Section 3(1)(b). The principles to be applied were conveniently summarised as follows by the CJEU in Case C-265/09 P *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (again with references to previous case law omitted):

“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.

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.

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.”

23) I must also be aware that the test is one of immediacy or first impression, as confirmed by the European Court of First Instance (now the General Court) which, in its decision on *Sykes Enterprises v OHIM*, T-130/01(Real People Real Solutions), stated the following:

“...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 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."

24) The applicant also referred me to Case O-079-10 *No Half Measures* at paragraphs 17-25 where Professor Annand summarised the CJEU *Audi* decision thus:

“Section 3(1)(b) (art. 3(1)(b) Directive 2008/95/EC, art. 7(1)(b) Regulation (EC) 2007/2009)

17. In *Audi*, the ECJ clarified and explained its previous case law on marks consisting of advertising slogans or promotional statements. The context was an application for registration as a Community trade mark by Audi of the word mark *Vorsprung durch Technik* in respect of a large number of goods and services in various Classes.

18. It is clear from *Audi* that there has been some misunderstanding or over-enthusiastic application of *OHIM v. Erpo Mibelwerk*, in particular, paragraphs 34 and 35 of that case where the ECJ stated (emphasis mine):

“34. The Court of Justice has also held that, although the criteria for assessing distinctiveness are the same for the various categories of marks, it may become apparent, in applying those criteria, that the relevant public’s perception is not necessarily the same for each of those categories and that, therefore, it may prove more difficult to establish distinctiveness for some categories of mark than for others (see Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraph 38; Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble v OHIM* [2004] ECR I-0000, paragraph 36; and Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* [2004] I-0000, paragraph 36).

35. The possibility cannot be excluded that the case-law mentioned in the foregoing paragraph of this judgment is also relevant to word marks consisting of advertising slogans such as the one at issue in this case. *That could be the case in particular if it were established, when assessing the distinctiveness of the trade mark in question, that it served a promotional function consisting, for example, of commending the quality of the product in question and that the importance of that function was not manifestly secondary to its purported function as a trade mark, namely that of guaranteeing the origin of the product.* Indeed, in such a case, the authorities may take account of the fact that average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans (see, to that effect, *Procter & Gamble*, paragraph 36)”.

19. That had created a circular situation or “Catch 22” for applicants of marks consisting of advertising slogans or promotional statements to the extent that

it had become very difficult in practice to obtain registration of such marks in the absence of evidence of acquired distinctiveness through use. In Case C-517/99, *Merz v. Krell* [2001] ECR I- 6959 at paragraph 40, the ECJ recognised that a sign can perform the dual functions of being an advertising slogan or promotional statement and an indication of origin (Case C-487/07, *L'Oréal SA v. Bellure NV*, 18 June 2009, para. 58). However, the highlighted passage in *OHIM v. Erpo Mibelwerk* (para. 35) was taken to impose (Or confirm – see *REAL PEOPLE, REAL SOLUTIONS*, para. 20, *Mehr für Ihr Geld*, para. 25.) a requirement that the relevant public must immediately perceive the sign as an indication of origin so that even if a mark was not descriptive of the goods or services it covered, it would be regarded as non-distinctive if it conveyed an objective message.

20. On the other hand, in *OHIM v. Erpo Mibelwerk* at paragraph 35, it seems to me that the ECJ was dealing with the U.K. Government's contention that a mark must unambiguously identify the origin of the goods or services concerned. An advertising slogan or promotional statement would ultimately only do that if it created a striking impression when used in relation to the goods or services in question. Following paragraph 35, the ECJ stated in *OHIM v. Erpo Mibelwerk*:

“36. However, difficulties in establishing distinctiveness which may be associated with certain categories of trade marks because of their very nature, such as those consisting of advertising slogans – difficulties which it is legitimate to take into account – do not justify laying down specific criteria supplementing or derogating from the criterion of distinctiveness as interpreted in the case-law referred to in paragraphs 32 to 34 of this judgment ...”.

21 In other words, the Court was saying that notwithstanding the objective message conveyed by a mark comprising an advertising slogan or promotional statement it was impermissible to demand added value as a condition for registrability. The ECJ accordingly confirmed the GC's annulment of the OHIM decision to refuse registration of DAS PRINZIP DER BEQUEMLICHKEIT for land vehicles and household furniture on the ground of the mark's non-distinctiveness.

The Audi judgment

22 In *Audi* the ECJ unravels the conundrum. It starts by setting out the familiar principles of distinctive character:

“32. Under Article 7(1)(b) of Regulation No 40/94 [section 3(1)(b) of the Act], trade marks which are devoid of any distinctive character are not to be registered.

33. It is clear from settled case-law that, for a trade mark to possess

distinctive character for the purposes of that provision, it must serve to identify the goods in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish those goods from those of other undertakings (*Procter & Gamble v OHIM*, paragraph 32; *OHIM v Erpo Möbelwerk*, paragraph 42; Case C-144/06 P *Henkel v OHIM* [2007] ECR I-8109, paragraph 34; and Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66).

34. According to equally settled case-law, 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 relevant public's perception of the mark (*Procter & Gamble v OHIM*, paragraph 33; Case C-25/05 P *Storck v OHIM* [2006] ECR I-5719, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67)."

23. Next, the ECJ turns to the registrability of advertising slogans or promotional statements again in familiar terms:

"36. 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 (*OHIM v Erpo Möbelwerk*, paragraphs 32 and 44).

37. However, it is apparent from the case-law that, 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 marks of certain categories as compared with marks of other categories (see *Procter & Gamble v OHIM*, paragraph 36; *OHIM v Erpo Möbelwerk*, paragraph 34; and *Henkel v OHIM*, paragraphs 36 and 38).

38. While the Court has not excluded the possibility that that case-law may, in certain circumstances, be relevant to word marks consisting of advertising slogans, it has however stated that difficulties in establishing distinctiveness which may be associated with word marks consisting of advertising slogans 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 the criterion of distinctiveness as interpreted in the case-law referred to in paragraphs 33 to 34 of the present judgment (see *OHIM v Erpo Möbelwerk*, paragraphs 35 and 36).

39. The Court has therefore held, in particular, that 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) of Regulation No 40/94 [section 3(1)(b) of the Act] (*OHIM v Erpo Möbelwerk*, paragraphs 31 and 32; see also Case C-392/02 P *SAT.1 v OHIM* [2004] ECR I- 8317, paragraph 41).”

24. However, the ECJ explains that the GC’s appraisal of the distinctive character of *Vorsprung durch Technik* (or lack of it), proceeded on a misunderstanding of those principles:

“40. In the present case, the reasoning followed by the General Court derives from an erroneous interpretation of the principles set out in paragraphs 36 to 39 of the present judgment.

41. It must be held that, even though the General Court stated in paragraph 36 of the judgment under appeal that it is clear from the case-law that registration of a mark cannot be excluded because of that mark’s laudatory or advertising use, it went on to explain that the reason for its finding that the mark applied for lacks distinctive character was, in essence, the fact that that mark is perceived as a promotional formula: that is to say, its finding was made precisely on the basis of the mark’s laudatory or advertising use.

42. Thus, in paragraphs 41 and 42 of the judgment under appeal, the General Court held that, although the mark *Vorsprung durch Technik* can have a number of meanings, or constitute a play on words, or be perceived as imaginative, surprising and unexpected and, in that way, be easily remembered, this nevertheless does not make it distinctive. It held that those various elements make the mark distinctive only if it is perceived immediately by the relevant public as an indication of the commercial origin of the goods and services covered by that mark. It held that, in the case before it, the relevant public perceives the mark, first and foremost, as a promotional formula.

43. The General Court based that finding on its analysis in paragraphs 43 to 45 of the judgment under appeal. It considered, first, that because of the broad range of meanings attributable to the notion of ‘Technik’, the reference to that notion is not, for all the goods and services covered, such as to confer distinctive character on the mark applied for. Secondly, the word ‘Vorsprung’ (meaning, inter alia, ‘advance’ or ‘advantage’) linked with the preposition ‘durch’ (meaning, inter alia, ‘through’) is, for the public relevant to the trade mark application and, in particular, for the German-speaking public, primarily laudatory in nature. Thirdly, although it is necessary, for the purposes of assessing whether a compound mark is distinctive, to consider that mark as a whole, it is also necessary to note that the mark is addressed to a wide public and that the majority of undertakings wishing to provide goods and services to that wide public might well, in view of the laudatory character of

that expression, use it themselves, regardless of how it ought to be interpreted.

44. However, while it is true – as was pointed out in paragraph 33 of the present judgment – that a mark possesses distinctive character only in so far as it serves to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, it must be held that 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.

45. On that point, it should be noted that the laudatory connotation of a word mark does not mean that it cannot be appropriate for the purposes of guaranteeing to consumers the origin of the goods or services which it covers. Thus, such a mark can be perceived by the relevant public both as a promotional formula and as an indication of the commercial origin of goods or services. It follows that, in so far as the public perceives the mark as an indication of that origin, the fact that the mark is at the same time understood – perhaps even primarily understood – as a promotional formula has no bearing on its distinctive character.

46. However, by the line of reasoning set out in paragraphs 42 and 43 of the present judgment, the General Court did not substantiate its finding to the effect that the mark applied for will not be perceived by the relevant public as an indication of the commercial origin of the goods and services in question; in essence, rather, it merely highlighted the fact that that mark consists of, and is understood as, a promotional formula.

47. As regards the General Court's finding in paragraph 41 of the judgment under appeal that the mark *Vorsprung durch Technik* can have a number of meanings, or constitute a play on words or be perceived as imaginative, surprising and unexpected and, in that way, be easily remembered, it should be noted that, although the existence of such characteristics is not a necessary condition for establishing that an advertising slogan has distinctive character, as is apparent from paragraph 39 of the present judgment, the fact remains that, as a rule, the presence of those characteristics is likely to endow that mark with distinctive character.

48. As for the conclusion of the General Court in paragraph 46 of the judgment under appeal that 'the mark *Vorsprung durch Technik* does not therefore contain elements which, beyond the obvious promotional message of the mark, could enable the relevant public to commit the expression to memory easily and immediately as a distinctive mark for the goods and services covered', suffice it to state that not only is that finding wholly unsupported by the reasoning which precedes it but, moreover, it is

contradicted to a certain extent by the finding made in paragraph 41 of that judgment, as set out in paragraph 47 of the present judgment.

49. It follows that Audi is right to claim that the assessment carried out by the General Court under Article 7(1)(b) of Regulation No 40/94 [section 3(10)(b) of the Act] is vitiated by an error in law ...”.

25. Finally, the Court substitutes its own determination of the distinctiveness of *Vorsprung durch Technik*:

“53. As the Board of Appeal stated in the contested decision, the expression ‘*Vorsprung durch Technik*’ is a widely known slogan which Audi has been using for years to promote the sale of its motor vehicles. It was registered in 2001 as a Community trade mark for goods in Class 12 on the basis of proof that that slogan was widely known in German-speaking regions.

54. As regards the goods and services in question, other than those in Class 12, the Board of Appeal based its refusal of registration on the fact 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. 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 cannot therefore be registered unless it is shown that the public has come to perceive it as a trade mark.

55. That analysis shows that Article 7(1)(b) of Regulation No 40/94 [section 3(1)(b) of the Act] was misapplied.

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 [section 3(1)(c) of the Act], 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.

60. It follows from the foregoing considerations that the contested decision must be annulled in so far as, on the basis of Article 7(1)(b) of Regulation No 40/94 [section 3(1)(b) of the Act], the Second Board of Appeal refused in part the application for registration of the mark Vorsprung durch Technik."

25) The applicant contended:

"11. Prof Annand analysed *Audi* in considerable detail, referring to the important point that "in so far as the public perceives the mark as an indication of that origin, the fact that the mark is at the same time understood-perhaps even primarily understood-as a promotional formula has no bearing on its distinctive character". (see 45 of *Audi*). As such, it is now clear that the fact that a mark is exhortational/promotional/laudatory, even primarily so, is not a basis for a finding under section 3(1)(b). There has to be an assessment of the distinctiveness of the mark nonetheless."

26) The opponent contended that the marks are, by themselves, simply non-distinctive exhortations to the reader to "Go Walking/Go Running". When used in relation to walking/running goods they will not be perceived as being distinctive of an entity that is manufacturing or selling those goods. They further contend that use of the words "walking/running" in relation to walking/running goods would plainly be lacking in distinctive character. It is claimed that addition of the word "go" does not make it distinctive, as it is simply a combination of two ordinary words in a natural sequence to

form an expression with a meaning. Therefore, the marks as wholes would not enable the average consumer to distinguish walking boots or running shoes being retailed by one undertaking from those of another undertaking.

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.**

28) I will go on to consider the position under acquired distinctiveness. The applicant has stated that it uses the marks in suit, along with a family of similar marks, Go Climbing, Go Fishing etc within the different sections of its stores. At annex 1 I have included a representative selection of photographs of stores, both outside and inside and advertising brochures. 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. Mr Graham, the founder of the applicant company has provided estimates of sales under each of the instant marks, which have been challenged in the evidence in reply. The opponent has criticised the figures as it was not clear how they had been collated, other than by the overall knowledge of the founder of the company who would have access to all purchase and sales figures and breakdowns. To my mind in such circumstances I am willing to accept the applicant's figures. 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.

CONCLUSION

29) The ground of opposition under Section 3(1)(c) failed, but the ground of opposition under 3(1)(b) succeeded.

COSTS

30) As both sides have achieved a measure of success I do not propose to favour either side with an award of costs.

Dated this 7th day of May 2014

**George W Salthouse
For the Registrar,
the Comptroller-General**

ANNEX 1.





4/4

Garageholer 5.1 2009





September 2007

GO Walking *In any weather with our massive range of waterproofs!*

Men's Waterproofs *Massive autumn savings on a huge range of outdoor clothing!*

 Regatta Packaway II CARD PRICE £15 £25 £10	 Resolute Jacket CARD PRICE £63 £70 £7	 RGT Jacket CARD PRICE £63 £70 £7	 Hydrolite CARD PRICE £72 £80 £8
 Regatta Ultra II 3 in 1 CARD PRICE £45 £65 £20	 Regatta Bolson Jacket CARD PRICE £50 £75 £25	 CRAGHOPPERS Ridge II Overtrousers CARD PRICE £39 £60 £21	
 Woolhill III CARD PRICE £40 £65 £25	 Resolute Jacket CARD PRICE £81 £90 £9	 RFS Trak CARD PRICE £77 £90 £13	 Discovery IA CARD PRICE £162 £180 £18

Women's Waterproofs *Use your Discount Card to save £££ this autumn!*

 Woolhill III CARD PRICE £15 £29 £10	 Regatta Packaway II CARD PRICE £28 £40 £12	 Resolute Jacket CARD PRICE £50 £60 £10	 Callisto CARD PRICE £63 £70 £7	 Hydrolite CARD PRICE £72 £80 £8
 Discovery IA CARD PRICE £162 £180 £18	 Regatta Ultra II 3 in 1 CARD PRICE £45 £65 £20	 Sprayway Siren Airforce CARD PRICE £99 £100 £1	 CRAGHOPPERS Peak III Overtrouser CARD PRICE £39 £60 £21	

Kid's Waterproofs *Top brand outdoor clothing for autumn adventures!*

 Regatta Packaway II CARD PRICE £10 £18 £8	 Regatta Helaine CARD PRICE £25 £35 £10	 Monsieur CARD PRICE £36 £40 £4	 Resolute Jacket CARD PRICE £45 £50 £5
---	--	--	---

Shop online all the time at **GOoutdoors.co.uk** order hotline 08450 020 888 mon - sat 9am-6pm

206



