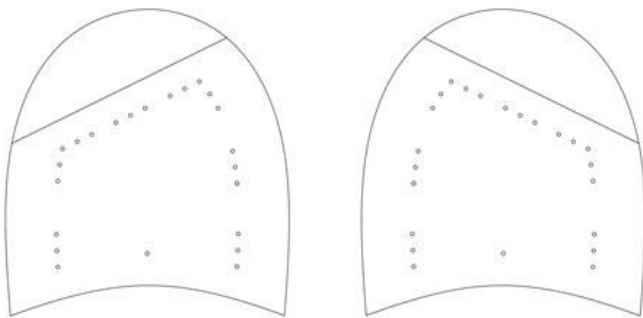
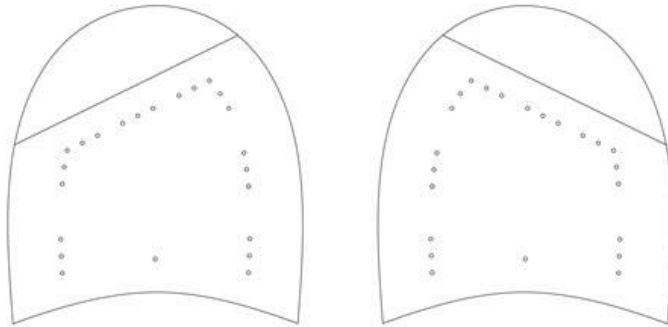


O-563-18

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 3207630
BY EDWARD GREEN AND COMPANY LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 25:**



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Mark Description: The mark consists of the arrangement of nail heads in groups on the underside of a left shoe heel and the underside of a right shoe heel around a part of the perimeter thereof, as shown in the representations.

Background

1. On 19 January 2017, Edward Green and Company Limited ('the applicant') applied to register the above trade mark for the following goods in class 25:

Footwear; shoes; boots; men's shoes; women's shoes; children's shoes; high quality gentleman's shoes and boots, at least partially made by hand; high quality shoes and boots at least partially made by hand; accessories for footwear in this class.

2. On the 27 January 2017 the UK Intellectual Property Office ('IPO') issued an examination report in response to the application. In the report, an objection was raised against class 25 under section 3(1)(a) of the Trade Marks Act 1994 ('the Act') and the examiner stated that:

Section 3(1)(a)

The application is not acceptable in Class 25 as there is an objection under Section 3(1)(a) of the Act. This is because the mark description is not a clear explanation for the mark applied for and is therefore not graphically represented. I note the description claims the mark 'consists of the arrangement of nail heads in groups of three' it is unclear from the representation what these groups of three are as the nails appear in a random sequence of groups of one, three, and five.

Additionally use of the term 'exemplified on the representations suggests infinite positions of the nail heads and the depiction is a only typical graphical representation.

3. On the 27 March 2017, in response to the 3(1)(a) objection the mark description text was amended as follows:

"The mark consists of the arrangement of nail heads in groups on the underside of a left shoe heel and the underside of a right shoe heel around a part of the perimeter thereof, as shown in the representations"

4. On the 11 April 2017 the IPO issued a further examination report in response to the application. In the report, an objection was raised against class 25 under Section 3(1)(b) of the Act. The examiner stated that:

Section 3(1)(b)

The application is not acceptable in Classes 25. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the mark representation consists of the non-distinctive arrangement of nails presented on the underside of a heel.

The average customer would fail to note any single origin of trade when presented with such a representation on the goods claimed. The mark is therefore objected to under section 3(1)(b).

5. On the 9 June 2017 Amy Reynolds of Fieldfisher LLP ('the agent'), requested a hearing which was duly scheduled for 4 September 2017.

6. Prior to the hearing, skeleton arguments and evidence of acquired distinctiveness, accompanied by exhibits were submitted for my consideration at the hearing.

7. At the hearing, Ms Reynolds made reference to the skeleton arguments and in support of prima facie acceptance, submitted:

- The footwear in question is what is known as 'Goodyear Welted', which means it is largely handmade and this is reflected in the price of the shoe. The average consumer therefore, is not the general public at large, but a specialised consumer of Goodyear Welted shoes.
- The sign is not devoid of distinctive character and is capable of identifying the origin of the goods.

8. However, Ms Reynolds also reserved the right for the case to be considered on the grounds that the sign had acquired distinctiveness through the use made of it. She submitted that the exhibits filed in support of the application demonstrate:

- That a significant proportion of the relevant class of consumers (identified as specialised consumers of hand-made shoes) recognise the sign as being from Edward Green.
- Consumers of high quality shoes, pay particular attention to small details on shoes, such as grade of leather, stitching and Nail Heel Patterns.
- Consumers recognise that different shoe manufacturers adopt different Nail Heel Patterns on the heel of their shoes as a badge of origin;

- Consumers understand that shoe manufacturers often make shoes for other businesses and that it is possible to identify which manufacturer made the shoes, by reference to the Nail Heel Pattern, even if there is no other labelling on the shoe.
- Consumers recognise the Applicant's 'Nail Heel Pattern' as a badge of origin of the applicant, even when no other branding is present.
- The Nail Heel Pattern is recognised as emanating from Edward Green by other shoe manufacturers in the industry.

9. I reserved my decision at the hearing but subsequently gave it in writing on 7 September 2017, whereby I maintained the objection under the principal ground of section 3(1)(b) of the Act in the prima facie. I also refused the claim that the mark had acquired distinctiveness. This did not constitute a formal refusal and a period of two months was granted to allow time for the applicant to consider filing additional evidence to support the plea of acquired distinctiveness, or to appeal the hearing decision.

10. On 7 November 2017, Ms Reynolds filed additional evidence and further submissions, contending that the average consumer of the specific goods claimed, namely *“high quality gentleman’s shoes and boots, at least partially made by hand; high quality shoes and boots at least partially made by hand”*, is not the public at large, but a specialised consumer of Goodyear Welted shoes. The additional evidence included further information about the manufacturing process of Goodyear Welted shoes and the price point which positioned them at the top end of the shoe market. Ms Reynolds submitted that in my hearing report, I had erred in my assessment of the average consumer, by failing to take in to account the commercial reality of the Goodyear Welted shoe market.

11. On 4 December 2017, I responded to Ms Reynolds maintaining the objection and also my assessment of the average consumer and how they would perceive the sign. I explained that whilst the shoes may be at the higher end (price wise) of the shoe market, it does not necessarily follow that the consumers of these shoes would be more predisposed to view the Nail Heel Pattern on a heel *in a trade mark light*, than they otherwise would be. I stated that even if the applicant were to limit the specification to ‘Goodyear Welted shoes’ (assuming that such a limitation was Postkantoor compliant) this would not alter the perception of how the average consumer would perceive the mark. I also maintained my position on the question of acquired distinctiveness, in that the exhibits had not demonstrated that the consumer places reliance solely on the mark in question.

12. I considered there would be little benefit in extending proceedings and the application was formally refused in my letter of 4 December 2017.

13. By way of a form TM5 which was submitted on 4 January 2018, I have been asked to provide a full statement of grounds of my reasons for refusal which I now give.

Decision

14. The relevant section of the Act reads as follows:

“3.-(1) The following shall not be registered –
 (a) ...

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

(c) ...

(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.”

Legal principles: section 3(1)(b)

15. The relevant authorities at European and UK level have established certain key legal principles to be applied in relation to section 3(1)(b) of the Act. These can be summarised as follows:

- The Court has held that “...the public interest... is, manifestly, indissociable from the essential function of a trade mark” (Case C-329/02P, *SAT.1 Satelliten Fernsehen GmbH v OHIM*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. It is also well established that the words ‘devoid of distinctive character’ are interpreted as meaning ‘unpossessed’ of distinctive character based on the perceptions of the average consumer and in relation to the goods and services applied for.
- Section 3(1)(b) must include within its scope those marks which, whilst not designating a characteristic of the relevant goods and services (i.e. not being necessarily descriptive), will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin. In terms of assessing distinctiveness under section 3(1)(b), the CJEU provided guidance in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (Postkantoor) C-363/99* where, at paragraph 34, it stated:

"A trade mark's distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to 55/01 Linde and Others [2003] ECR I-3161, paragraph 41, and C-104/01 Libertel [2003] ECR I-3793, paragraphs 46 and 75)."

16. The question of a mark being devoid of any distinctive character is answered by reference to the goods and services applied for, and the perception of the average consumer in relation to those goods or services.

17. In making a finding regarding this sign, which does not contain any graphic or word elements, I also bear in mind the comments of the CJEU in *Henkel KGaA v OHIM2* in which it stated:

“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).

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).

Application of the legal principles: assessment in the prima facie case

18. On the basis of the above guidance, it is clear that any assessment of a sign’s distinctive character must be assessed, first, by reference to the goods which are the subject of the application and, secondly, by reference to the perception of the relevant consumer using those goods. In the case of footwear *per se*, the relevant consumer of the goods is the general public, who are likely to be reasonably observant and circumspect. The level of attention is likely to be moderate to high given that some consumers will pay a high degree of attention in making their selection, however the goods concerned are not highly specialised items. Although the goods are largely made by hand and command a high price, it does not necessarily follow that in all cases the consumer will be highly specialised or have a specialist knowledge. As stated in my hearing report, in the case of *Dualit EWHC - 19990705 (paras 36 & 37)*, the Court held that it is inappropriate to discount potential members of the public based on the commercial intent of the applicant. Therefore, the relevant consumer of these products is the general public and the signs distinctiveness should be assessed in respect of their perception, rather than a specialist consumer, with specialist knowledge.

19. In the event that the specification were limited to e.g. ‘*Goodyear Welted shoes*’, assuming that such a limitation to be *Postkantoor* compliant, my assessment of the average consumer would not change, by virtue only of the price bracket of the shoes sold. Even if ‘*Goodyear welted*’ shoes attract a higher price, this does not alter the fact average consumer of such shoes is the general public and my conclusion in regard to the average consumer would remain the same.

20. In terms of the inherent characteristics of the sign applied for, I regard it to be an arrangement of nails forming a pattern on the underside of a shoe. During the hearing, the applicant, Ms Freeman, informed me that the heel of the shoe is attached by the dovetail

and that the nails do not form a function in the construction of the heel itself and are only present for brand recognition and decorative purposes.

21. In my view, the sign in question, does not possess any particular feature which would distinguish it from simply a series of nails used to fix the heel to the upper part of the shoe sole. Ms Reynolds' arguments about the sign's non-commonplace configuration are not persuasive unless, in my opinion, such features or characteristics are going to have the effect on the average consumer of rendering the sign as an indication or badge of origin.

22. The mark at issue consists of a simplistic arrangement of nails on the heel, of the sole of a shoe and whilst Ms Freeman has confirmed that nails do not form a function in the construction of the heel itself, I consider that consumers would regard this arrangement as mere decoration, or a method of attaching the sole to the shoe as stated in the decision R437/2007-4 Fourth Board of Appeal, *Edward Green & Company Limited v OHIM* where the Board stated:

9. The purpose of a trade mark is to indicate to consumers that a particular product or service emanates from one particular source. In order to perform this function it must be distinctive, since it is its distinctiveness that enables it to be recognised amongst all the other names, labels, logos, symbols, phrases, shapes, colours and nail patterns which are employed in the field of commerce to which the product or service belongs. The realistic graphical representation of the lower part of the sole of a shoe in the present case possesses no such quality that the Board can discern. The two standard ways of attaching the sole of a shoe to the main part of the shoe are with the use of glue or by nailing them together. When employing the nail method it is usual to place the nails around the rim of the sole. A representation consisting of the heel of a shoe with nails placed around the rim of the heel, albeit in sets of three, is unremarkable, nondistinctive and therefore will not distinguish the commercial origin of the shoes. It is difficult to entertain the notion that consumers would attach trade mark significance to an ordinary shaped heel with nails running around the edge in what appears to be a conventional and typical manner, familiar to all (with or without access to the Internet). As the examiner stated, it is merely a variation on a common theme. It is not inherently distinctive and it is therefore not a trade mark unless there is convincing evidence of acquired distinctiveness.

Given that it is not uncommon to have nails in various arrangements on the heels of shoes, it is my view that the average consumer of the goods in question would not attach any trade mark significance to a simplistic nail pattern, without first being educated that it was there to serve such a purpose. The mark is therefore not capable of distinguishing the goods of the applicant, from those of other traders.

The evidence filed to demonstrate Acquired Distinctiveness

23. Evidence of acquired distinctiveness was filed on the 31 August 2017, before the hearing. Additional evidence was also submitted on 7 November 2017. The supplementary evidence subsumed the initial evidence and provided more in-depth detail, such as the Good Year Welting process and company turnover figures. The evidence included Witness Statements from Hillary Freeman (Managing Director of the applicant). The statements detailed that the relevant consumers consist of those who purchase Goodyear Welted and also footwear retailers, for whom shoes are made. It was submitted that consumers

recognise the Nail Heel Pattern as emanating from the applicant. The more detailed submissions contained within both rounds of evidence can be summarised as follows:

- Ms Freeman states that the average consumer consists of informed consumers of Goodyear Welted quality shoes, which are mostly manufactured by hand. A typical purchaser of Goodyear Welted shoes would be particularly discerning and interested in the quality and details such as the materials, stitching and design. The shoes are considered to be investment pieces and the customer will therefore spend more time considering such a purchase and the various aspects of the shoe.
- The exhibits demonstrate that the Goodyear welted shoe market is specialised, with only a small number of artisan workshops in the UK, of which the applicant is one. Due to the handmade nature of these exceptional shoes they are positioned at the highest end of the shoe market and the exhibits from the applicant's website demonstrate that their price point is over £900 per pair.
- The applicant has used a Nail Heel Pattern featuring nails in clusters of three since the early 1980's. The precise Nail Heel Pattern (as filed) has been used since 2004 and this is the pattern used on all the applicant's shoes, even when they are re-heeled. The applicant is not the only shoe manufacturer to adopt a Nail Heel Pattern on the heel of its shoes and Exhibit HF16 demonstrates the use of Nail Heel Patterns by other manufacturers such as Barbera, Crockett and Jones and Alfred Sargent. The exhibits also confirm that the Edward Green Nail Heel Pattern differs to those of other shoe manufacturers.
- The applicant is very discreet and does not promote or market its goods extensively via the traditional methods of print, radio or television advertisements. Instead, it places an emphasis on word of mouth reputation and allows the quality of its shoes to speak for itself. The applicant has a long and established list of clients who are particularly discerning, loyal and include Academy Award winning actors, British politicians, European monarchs and other members of nobility and aristocracy. The applicant's social media accounts also attract a strong following.
- In store, the shoes are displayed in different orientations so that customers visiting the store can see and inspect the Nail Heel Pattern while browsing. Further, it is customary for a purchaser to pick up a shoe, turn it over and inspect the craftsmanship, sole and heel of a shoe. The sole of the shoe is often where the price tag for the shoe resides.
- The applicant claims that consumers know and recognise the Nail Heel Pattern used by Edward Green. Exhibited in HF20 are extracts from a discussion thread www.styleforum.net, dated from 2006. It contains a discussion over 220 pages long by users regarding particular markings, that luxury shoe manufacturers use on their products. The discussion mentions the Nail Heel Patterns of several manufacturers and contains comments such as: "*the single Nail Heel Pattern...looks like Alfred Sargent*", "*only Cheaney's and C&J have the 3-Nail Heel Pattern near the heel pads. However, C&J always has an additional nail at the centre front of the heel*". Exhibits HF21 & 22 are from a popular men's fashion website

www.askandyaboutclothes.com, where the proprietor, Andy Gilchrist confirms numerous discussions from visitors to the site, on the subject of identifying a shoe manufacturer by Nail Heel Patterns on the heel of shoes. Similar comments from customers visiting the website include: “...if the heels are original, the Nail Heel Pattern argues against EG. As far as I know, even way back, they used groups of three”, and “I was at the Ralph Lauren store in Chevy Chase the other day, and they had four new shoes on display, all allegedly made by Edward. The Nail Heel Pattern, soles, size/ID code on the interior, all seemed to confirm the claim”.

- The applicant makes approximately 350 pairs of shoes per week, which equates to 15,400 pairs per year. Sales from the Applicant’s London retail store account for approximately 43% of the total annual sales. The Applicant’s turnover figures for the last 5 years are provided below:

<i>Year</i>	<i>Turnover</i>	<i>Shoes/Boots</i>	<i>Slippers</i>	<i>Total</i>
	<i>GBP</i>	<i>Pairs</i>	<i>Pairs</i>	<i>Pairs</i>
2016	£6,584,013	14711	290	15001
2015	£5,895,618	14309	457	14766
2014	£5,554,914	13498	288	13786
2013	£5,504,930	13079	347	13426
2012	£5,244,276	13428	126	13554

- The applicant manufactures shoes for the well-known fashion designer, Ralph Lauren. Contained in the exhibits at HF24 is a letter from the Senior Vice President of footwear design, John Ascher, who explains that the Nail Heel Pattern is a distinctive marking, or ‘signature’ of the applicant which allows their customers to identify that the shoes were manufactured by Edward Green. No other Edward Green branding is present on these shoes, so the pattern is the only way of identifying that the goods are made by the applicant.

Acquired distinctiveness – The legal principles

24. These are well known and the established principles can be expressed as follows:

- Mere evidence of use, even if substantial, does not make the case for acquired distinctiveness.
- If, to a real or hypothetical individual, a word or mark is ambiguous in the sense that it may be distinctive or descriptive then it cannot comply with the requirements of the Act

for it will not provide the necessary distinction or guarantee. It is in that sense that common or descriptive meaning must be displaced¹.

- It follows that, with regard to the acquisition of distinctive character through use, the identification by the relevant class of persons of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark. The expression ‘use of the mark as a trade mark’ in section 3 refers solely to use of the mark for the purposes of the identification, by the relevant class of person, of the product as originating from a given undertaking²;
- The mark must have acquired distinctiveness through use throughout the territory of the UK.
- In assessing whether a trade mark has acquired a distinctive character the competent authority must make an overall assessment of the relevant evidence, which in addition to the nature of the mark may include (i) the market share held by goods bearing the mark, (ii) how intensive, geographically widespread and long-standing the use of the mark has been, (iii) the amount invested by the proprietor in promoting the mark, (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor, (v) evidence from trade and professional associations and (vi) (where the competent authority has particular difficulty in assessing the distinctive character) an opinion poll. If the relevant class of persons, or at least a significant proportion of them, identifies goods or services as originating from a particular undertaking because of the trade mark, it has acquired a distinctive character;³
- The position must be assessed at the date of application, being 19 January 2017.

25. The guidance on the test to be applied, provided by the ECJ in *Philips Electronics NV v Remington Consumer Products Ltd* (C-299/99) which, although in the context of a mark that was a particular shape of the goods, from only one known supplier, it was nevertheless found that the proviso could only be relied upon where reliable evidence shows that recognition of the mark as indicating the goods/services of one undertaking is as a result of **its use as a trade mark** [my emphasis]. The ECJ, in *Societe des produits Nestle SA v Mars UK Ltd*, at paragraph 29, indicated that this latter point means “use of the mark for the purposes of the identification, by the relevant class of persons, of the product or services as originating from a given undertaking”.

¹ The first and third principles are stated in *Bach and Bach flower Remedies Trade Marks* [2000] RPC 513, paras 49 and 45 respectively

² See, e.g. *Societe des produits Nestlé SA v Mars UK Ltd*, (C-353/03 (‘Nestlé’)); *Philips Electronics NV v Remington Consumer Products Ltd* (C-299/99); *Henkel KGaA v Deutsches Patent – und Markenamt* (C-218/01)

³ *Windsurfing*, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-1318 at [23], *Philips v Remington* at [60]-[62], *Libertel v Benelux-Merkenbureau* at [67], *Nestlé v Mars* at [31] and C-25/05P *August Storck KG v Office for Harmonisation in the Internal Market (Storck II)* [2006] ECR I-5719 at [75].

26. Reliance is an essential factor when it comes to non-conventional marks. *Vibe Technologies Application ('Vibe' Vibe Technologies Ltd's Trade Mark – BL – O/166/08)*, questioned whether 'association' of the sign with a particular manufacturer or supplier is enough to demonstrate or infer acquired distinctiveness or whether 'something else' is required. At paras 71- 88 of the *Vibe* case the Appointed Person reviews the relevant case law at the time, both at EU and UK level, for the purpose of shedding light on this question originally posed in *Kerly's Law of Trade Marks (14th Edn)* paras 8-023 – 8-025. The Appointed Person notes that at para 8-025 the editors of *Kerly's* propose the following propositions: (1) mere association with a particular manufacturer is not enough; (2) the use of the sign must establish, in the perception of the average consumer, that the product originates from a particular undertaking; and (3) that perception must result from the use of the sign as a trade mark – in other words, the proprietor must have done something in his use to identify the sign as a trade mark, and mere extensive use during a period of monopoly, without more, is most unlikely to have achieved this.

27. As confirmed by *KIT KAT([2017] EWCA Civ 358)*, any evidence of acquired distinctiveness must prove that the sign itself is recognised as denoting trade origin, not by borrowing the reputation of a trade mark it is associated with. At paragraph 78, the Court explained the distinction:

*"We are concerned here with a mark, the three-dimensional shape of a chocolate product that has no inherent distinctiveness. A shape of this kind is not inherently [distinctive] such that members of the public are likely to take it as a badge of origin in the way they would a newly coined word or a fancy name. Now assume that products in that shape have been sold on a very large scale under and by reference to a brand name which is inherently highly distinctive. Assume too that the shape has in that way become very well-known. That does not necessarily mean that the public have come to perceive the shape as a badge of origin such that they would rely upon it alone to identify the product as coming from a particular source. They might simply regard the shape as a characteristic of products of that kind or they might find it brings to mind the product and brand name with which they have become familiar. **These kinds of recognition and association do not amount to distinctiveness for trade mark purposes, as the CJEU has now confirmed in its decision in this case"***

Application of the legal principles: assessment of the evidence

28. It is clear from decisions such as that in *VIBE* and *KIT KAT* which I have referred to, that a mark of this type requires the evidence of acquired distinctiveness to demonstrate that the sign itself is recognised as denoting trade origin, not by borrowing the reputation of a trade mark it is associated with, namely Edward Green, but by being independently relied upon as the identifier of commercial origin by the relevant consumer.

29. From reviewing the evidence, I am left with no doubt that the applicant does indeed make shoes of the very highest quality, which are positioned at the highest point of the shoe market and are in excess of £900 per pair. It cannot be assumed however, that consumers are more alert to details in the shoe such as a pattern of nails on the heel due to the high price of the product. I am also unconvinced by the evidence, that consumers of 'high end'

shoes are more predisposed to regard details such as Nail Heel Patterns, in a trade mark light than they otherwise would be.

30. The evidence heavily relies upon consumer fashion forums (Exhibit HF20- HF22) to demonstrate consumer recognition of the sign. However, upon closer inspection of the comments from the consumers, this evidence is not clearly indicative of consumers relying solely on the Nail Heel Pattern as the brand identifier. The comments also refer to the heel shape, serial numbers and stitching, alongside the Nail Heel Pattern as a means of identifying that the shoe is likely to have been produced by Edward Green. The exhibits referred to above are therefore unpersuasive in demonstrating the consumer places a reliance on the sign as presented.

31. In respect of the use of the sign by the applicant, whilst some of the exhibits show the Nail Heel Pattern, there is no reference or inference that the heel pattern is used as a trade mark. On the basis of the case law mentioned above, the identification by the relevant class of persons of the product, or service, as originating from a given undertaking, must be as a result of the use of the mark as a *trade mark*. As stated in my hearing report, the fact that online shoe traders sometimes show several perspective views of a shoe which may include the heel, does not demonstrate that the sole is being used as a trade mark by the proprietor, it is simply a consequence of the consumer requiring as much information about the footwear as possible.

32. The evidence fails to demonstrate that the applicant has made any attempt to highlight to consumers that the Nail Heel Pattern is indeed an indication of trade origin. In a recent decision, *Birkenstock Sales GmbH v Eurogloria s.l. O-072-18*, Mr James Mellor, QC, sitting as the Appointed Person, gave some indication of the type of evidence needed to demonstrate acquired distinctiveness in regard to non-conventional marks, observing at paragraphs 35 and 44:

“What was striking to me was the effective absence of evidence showing marketing designed to educate the public that the sole pattern was a badge of origin or as demonstrating that the Proprietor trusted the sole pattern to convey such a message”.

“There are various ways to persuade a tribunal that the relevant public have been educated to perceive even an unconventional sign as a badge of origin, without going to the expense of a qualitative survey (with all the attendant difficulties of (a) constructing a survey that will produce worthwhile results and (b) interpreting the results). As I have indicated above, one can start with evidence to show that the proprietor of the mark has itself conducted such a program of education in its marketing for a suitable length of time. In many ways, such evidence can be much more convincing than a survey, but it requires investment in the right sort of marketing over a suitable length of time.”

33. Several of the exhibits refer to statements from experts in the trade who are also manufacturers of high quality shoes. Whilst I note the statements are made by very knowledgeable traders in this field, the test for distinctiveness involves the perceptions of the relevant consumer, being the general public, rather than relying solely on expert opinion, as

such specialists are not the end consumer of the product. The views held by such experts are unlikely to be representative of the level of knowledge of the consumer and therefore carry less weight in determining consumer perception of the sign.

34. I must be satisfied, from the evidence as a whole, that a significant proportion of relevant consumers regard the sign (in and of itself) as a trade mark or 'guarantee' of origin. However, the evidence filed by the proprietor, does not allow me to make the necessary inferences to draw the conclusion that a significant proportion of the relevant class of persons, identify the goods as originating from a particular undertaking.

35. In this decision I have considered all the papers on file and the submissions made. Having done so and for the reasons provided above, the application is refused under section 3(1)(b) of the Act for all the goods claimed.

Dated this 11th Day of September 2018

Sarah Grant

For the registrar

The Comptroller General