

O-362-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2557203
BY JUSTIN DEAKIN AND SOPHIE DEAKIN TO REGISTER THE TRADE
MARK**

Shoe Lace



IN CLASS 25

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 101202
BY JD SPORTS FASHION PLC**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No. 2557203
by Justin Deakin & Sophie Deakin to register the trade mark**

Shoe Lace



in Classes 25

and

**IN THE MATTER OF Opposition thereto under No. 101202
by JD Sports Fashion Plc**

BACKGROUND

1) On 24 September 2010, Mr Justin Deakin and Mrs Sophie Deakin (“the applicants”) applied under the Trade Marks Act 1994 for registration of the above shown mark in respect of *Footwear, Clothing, Headgear* in Class 25.

2) The application was advertised in the Trade Marks Journal on 24 September 2010 and on 16 November 2011, JD Sports Fashion Plc (“the opponent”) filed notice of opposition to the application. The grounds of opposition are based upon Sections 3(1)(b), 3(1)(c) and 3(3)(b) of the Act. It claims that the applicants’ mark is devoid of any distinctive character and that it consists exclusively of indications which may serve in trade to designate an item to fasten footwear and that shoe laces are also commonly used in relation to clothing and headgear.

3) The opponent also contends that the words SHOE LACE indicate the nature of the goods, namely that the goods are shoe laces or goods that consist of shoe laces. As such, the mark incorrectly describes the goods of the application that could include goods that consist of, or feature a SHOE LACE. This would amount to a misrepresentation as to the nature of the goods.

4) The applicants subsequently filed a counterstatement denying the opponent’s claims.

5) Only the opponent filed evidence in these proceedings. Both sides ask for an award of costs. Both parties filed submissions, but no hearing was held.

Opponent's Evidence

6) This takes the form of a witness statement, dated 7 March 2011, by Alan Fiddes, Trade Mark Attorney and partner at Urquhart-Dykes & Lord LLP, the opponent's representative in these proceedings. In support of the claim that the applicants' mark is not distinctive he provides, at Exhibit AMF1", Internet extracts, all dated 9 February 2011, illustrating that the words SHOE LACE and the device of a shoe lace is a common feature used, or applied to, all forms of clothing and headgear.

7) The first of these extracts, from www.cafepress.co.uk, shows twenty one t-shirts, six of which feature stylised images of laces appearing on the front either incorporated into a shoe or pair of shoes, or shown in a criss-cross pattern as if fitted to footwear. Four appear with phrases such as "Look I can tie my own shoes". A further two feature the phrase "Shoelaces untie!" on the front of the T-shirt.

8) The second extract, from www.gearbuyer.com, illustrates what is described as a "Nike Shoelace Hoodie" priced at \$45. There are numerous extracts from www.zazzle.co.uk variously showing T-shirts with the word SHOELACE appearing on the front (and one where the word appears on the back), an apron described as "Shoe lacing aprons" and features a representation of four pairs of shoes as viewed from above, "trucker hats" featuring the word "shoelace" appearing on the front of the hat and neck ties featuring the word "shoelace".

9) Next is an extract from www.shoelacebelts.com that appears to promote the use of shoe laces as belts citing that they are lighter and more comfortable and popular with skateboarders. The second page also carries an advert for "Panasaya Shoelace Belts". Extracts from www.panasayaclothing.com are provided in the next extract and features the same shoelace belt priced at \$12.99.

10) A further extract from www.eponaclothing.com features "Women's Kylie Shorts" featuring "shoelace style draw cords". This website lists a UK based contact telephone number. An extract from www.prontokids.com illustrates a "kids shoelace cluster headband" for sale at \$25.00. Finally, an extract from www.katies.com.au features a "shoelace tie front tee" women's top priced both in pounds sterling and Australian dollars.

DECISION

Section 3(1)(b)

11) I find it convenient to begin by considering the grounds based upon Section 3(1)(b) of the Act. This part of the Act reads:

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

(a) [...]

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

(c) [...]

(d) [...]

12) Anna Carboni, sitting as the Appointed Person in O-363-09 *COMBI STEAM Trade Mark*, conveniently summarised the leading case law in respect of this part of the Act:

7. It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs “a residual or sweeping-up function”, backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: *Procter & Gamble Ltd’s Trade Mark Application* [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): Case C-363/99 *Koninklijke KPN Nederland BV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] ETMR 57 (ECJ) at [86]. However, the converse is not true: a mark which is not descriptive may nevertheless be devoid of distinctive character for other reasons (*ibid.*).

8. When a trade marks examiner assesses the distinctiveness of a trade mark within the meaning of section 3(1)(b), s/he must do so firstly by reference to the goods or services listed in the specification, and secondly by reference to the perception of the mark in relation to such goods or services by the relevant public, which consists of average consumers of the goods or services in question, who are deemed to be reasonably well informed, observant and circumspect: Joined Cases C-53/01 to C- 55/01 *Linde AG, Winward Industries Inc and Radio Uhren AG* [2003] ETMR 78 at [41].

9. It is not necessary to show that a mark has a particular level of creativity or originality in order to establish distinctive character: Case C-329/02P *SAT. 1 Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 (ECJ) at [41]. While the Court of First Instance (“CFI”) has repeatedly referred to “a minimum degree of distinctive character” as being sufficient to avoid article 7(1)(b) of the CTMR/article 3(1)(b) of the Directive (for example, Case T-34/00 *Eurocool Logistik GmbH & Co. KG v OHIM (“EUROCOOL”)* [2003] ETMR 4 at [39]; Case T-128/01 *Daimler Chrysler Corp v OHIM*

[2003] ETMR 87 at [33]; Case T-320/03 *Citicorp v OHIM* (“LIVE RICHL Y”) at [68]), the ECJ has not adopted this wording and has deemed it unnecessary to give any more precise definition to the possible dividing line between lack of distinctiveness and the minimum distinctiveness to which the CFI refers: *Deutsche Krankenversicherung AG v OHIM* (“COMPANYLINE”) [2002] ECR I-7561 at [20].

10. The ECJ approaches the issue of distinctiveness by reference to the underlying purpose of article 3(1)(b) of the Directive / 7(1)(b) CTMR, which in the Court’s view is to preclude registration of trade marks that are incapable of performing the essential function of guaranteeing the identity of the origin of the marked product 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: *SAT. 1 v OHIM* at [23]; Case C-37/03 P *BioID AG v OHIM* [2005] ECR I-7975 (ECJ) at [27].

13) I must, therefore, put myself in the place of someone who encounters the applicant’s mark, used in relation to footwear, clothing and headgear and determine how they would react. SHOE LACE is, of course, a combination of ordinary words of the English language that conveys an obvious message, namely, an item used to fasten shoes to the feet of the wearer.

14) The opponent contends that because the mark consists of the words SHOE LACE and a device of a shoe lace then the device element does no more than reinforce the word element of the mark. Consequently, the mark indicates the nature of the goods, namely, shoe laces or goods that consist of shoe laces. Further, the opponent also submits that the word element speaks louder as it is this that the consumer will refer to in speech. This is nothing contentious in this last point but, nonetheless, just because the word element speaks loudest does not mean that distinctive character resides solely in the word element. The opponent attempts to address this by claiming that the device element merely reinforces the word element and consequently is also devoid of distinctive character.

15) The device forms two incomplete circles, one above the other that could be described as being reminiscent of the number “8” or, more likely, a letter “s”. The opponent submits that arranging the product in a particular way does not avoid the mark offending against the various provisions of the Act. However, I must consider the impression created by the mark and in this context, the presentation of the device is such as to strike the consumer as being unusual and not the normal way of representing a shoe lace. In fact, the average consumer is unlikely to even perceive the device element as being a shoe lace at all. Upon close inspection, the narrowing of the line at each end of the device element is reminiscent of a shoe lace, but the average consumer would not analyse the mark in this way and such small detail is likely to go unnoticed. Taking account of

all these points, the presentation of the device will immediately alert the consumer to an additional message other than a possible non-distinctive one that, for example, a device of a shoe lace in ordinary use might convey.

16) The evidence submitted by the opponent illustrates a number of logos featuring laces, as they appear on items of clothing. This evidence consists of Internet hits all dated 9 February 2011, about five months after the relevant date being the filing date of the contested application. However, I accept that, whilst they reflect the position as at that date, the position is unlikely to have been significantly different than at September 2010. In all of these examples the laces are either shown integral with a pair of shoes, or, when they are shown alone, in a criss-cross pattern as if fitted to a shoe. Such evidence fails to support the submission that the device element in the mark is devoid of any distinctive character.

17) Extracts from two different websites illustrate that shoe laces are sometimes marketed as belts and referred to as “shoe lace belts”. Others show the words SHOE LACE appearing on the front of T-shirts. However, none of these are persuasive in illustrating that the current mark lacks any distinctive character. This is because it is unclear whether some of the exhibits shown illustrate trade mark use or mere decorative use, for example, where the words SHOE LACE appear on the front of a T-shirt. Consequently, these exhibits do not illustrate that the applicant’s mark will be perceived by the consumer as a non-distinctive decoration. It has its own particular get-up. It is clear that, when the size of the device element is taken into account, being significantly larger than the word elements, together with the shape created by the shoe lace then, the mark as a whole, must be found to possess distinctive character.

18) I should also mention that the opponent’s submission that the mark is devoid of distinctive character in respect of shoe laces has no relevance to these proceedings because the applicants’ goods do not include shoe laces.

19) To summarise, it is my conclusion that the average consumer “who does not know there is a question” would not consider the applicants’ mark to be devoid of any distinctive character in respect of the goods claimed. Rather, it will function as an indication of origin. Therefore, the grounds based upon Section 3(1)(b) objection fails.

Section 3(1)(c)

20) This part of the Act reads:

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

(a) [...]

(b) [...]

(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) [...]

21) As Ms Carboni referred to in *COMBI STEAM*, if a mark is entirely descriptive of characteristics of goods it will also be devoid of any distinctive character. It follows that where a mark has been found to have distinctive character, then it will not consist exclusively of a sign which may serve, in trade, to designate a characteristic of the goods in question. Consequently, in light of my finding in respect of the grounds based upon Section 3(1)(b) of the Act, the grounds based upon Section 3(1)(c) must also fail.

Section 3(3)(b)

22) This part of the Act reads as follows:

(3) A trade mark shall not be registered if it is-

(a) [...]

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

23) In *Elizabeth Emanuel v Continental Shelf 128 Ltd*, Case C-259/04, the CJEU stated in paragraph 47 of its judgment that the application of this provision "presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived". An objection under section 3(3)(b) should therefore only be raised if there is a real (as opposed to a purely theoretical) potential for deception of the public.

24) The opponent submits that the average consumer would only assume that the applicants' mark would only be used in relation to a "shoe lace". As the applicant's goods may not necessarily consist of a "shoe lace" or feature a "shoe lace", in these circumstances, use of the mark would be a misrepresentation as to the nature of the goods. It concludes that the average consumer, when purchasing the goods, would be deceived into thinking that the goods are a "shoe lace" or feature a "shoe lace". The applicants claim that it is standard practice for the purchaser of clothing, headgear and footwear to try on the item or to inspect it for size, style and suitability to personal taste. As a result of this purchasing process, nobody would be deceived in to believing the goods were shoe laces.

25) There is no evidence of any actual deception, however, the claim must nevertheless be upheld if there is a sufficiently serious risk of deception. Clearly, the mark contains the words SHOE LACE, but it also contains a visually significant device element, being a line forming two joined, incomplete circles, one above the other being reminiscent of a letter "s". It is not the normal way of representing a shoe lace. In my view, the device bestows upon the mark, when viewed as a whole, a character that goes beyond merely designating the goods or a characteristic of those goods, as contended by the opponent. As such, contrary to the position of the opponent, I consider that the nature of the contested mark, together with the nature of the purchasing process, will make deception unlikely in relation to the goods claimed. It is my view that if the average consumer saw the mark in respect of footwear, clothing or headgear there would be no presumption that they incorporated shoe laces.

26) In summary, taking into account the impression created by the mark, when viewed as a whole, would not result in a sufficiently serious risk that the consumer will be deceived if these goods incorporate shoe laces.

COSTS

27) The opposition having failed, the applicants are entitled to a contribution towards their costs. I take account of the fact that no hearing has taken place but that the opponent filed evidence and the applicants filed written submissions in reply. I award costs on the following basis:

Considering Notice of Opposition and preparing statement in reply	£500
Considering evidence and filing written submissions	£400
TOTAL	£900

28) I order JD Sports Fashion Plc to pay Justin Deakin and Sophie Deakin the sum of £900. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of October 2011

**Mark Bryant
For the Registrar,
the Comptroller-General**