

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
CANCELLATION DECISION
N° 3000256
of 25 April 2023

Claimant: **Van Haren Schoenen B.V.**
van Liemptstraat 10
5145 RB Waalwijk
Netherlands

Representative: **Taylor Wessing N.V.**
Kennedyplein 201
5611 ZT Eindhoven
Netherlands

against

Defendant: **Airwair International Limited**
Cobb's Lane, Wollaston, Wellingborough
NN29 7SW Northamptonshire
United Kingdom

Representative: **Merkenbureau Knijff & Partners B.V.**
Leeuwenveldseweg 12
1382 LX Weesp
The Netherlands

Contested trademark: Benelux registration 588724



I. FACTS AND PROCEEDINGS

A. Facts

1. On 6 October 2020, the claimant filed an application for cancellation with the Benelux Office for Intellectual Property (hereinafter: "the Office" or "BOIP") in accordance with Article 2.30bis(1)(a) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP"), invoking the following absolute grounds for invalidity:

- I. The contested sign cannot constitute a trademark (Article 2.2bis(1)(a) BCIP)
- II. The contested trademark is devoid of distinctive character (Article 2.2bis(1)(b) BCIP);
- III. The contested trademark has become a customary indication (Article 2.2bis(1)(d) BCIP);
- IV. The contested trademark consists exclusively of the shape, or another characteristic, which results from the nature of the goods, is necessary to obtain a technical result or gives substantial value to the goods (Article 2.2bis(1)(e) BCIP).

2. The application for cancellation is aimed at Benelux registration 588724, filed on 6 February 1996, of the following mark:



The contested trademark is registered as a shape mark, and the registration contains the following description:

*"The characteristic elements of this mark consist of the yellow stitching on the edge between the upper leather and the shoe sole of a shoe, in the manner as depicted on the graphic representation of the mark, the graphic representation of the shoe is not a part of the mark."*¹

3. The cancellation claim is directed against all goods of the contested trademark, namely:

*Class 25: Footwear, their parts and accessories, not included in other classes.*²

¹ The contested trademark is registered in Dutch. Original NL version: "De kenmerkende bestanddelen van dit merk bestaan uit het gele stiksel in de rand tussen bovenleer en schoenzool van een schoen, zoals aangegeven op de afbeelding van het merk, de afbeelding van de schoen maakt geen onderdeel uit van het merk."

² Original NL version: *Klasse 25: Schoeisel, hun onderdelen en toebehoren voor zover niet begrepen in andere klassen.*

4. The language of the proceedings is English.

B. Course of the proceedings

5. The application for cancellation is admissible and was notified by the Office to the parties on 29 October 2020. During the administrative phase of the proceedings both parties filed arguments and documents in support. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 1 July 2021.

II. ARGUMENTS

A. Claimant's arguments

6. The claimant starts by providing an explanation of the parties' activities. The defendant is a British shoe manufacturer, focusing on (leather) lace-up boots, who owns several trademarks registered in various countries. The claimant is a chain of retail shoe stores in the Netherlands. The claimant sold various versions of lace boots that were, in the defendant's opinion, infringing its rights. The defendant initiated several legal proceedings against the claimant, amongst others based on infringement of the contested trademark registration.

7. According to the claimant, the defendant tries to obtain a monopoly on (the shape of) yellow coloured stitching applied on footwear in general. Such monopoly cannot be based on the contested registration, because it is not capable of fulfilling the essential function of a trademark and should be declared invalid based on various legal grounds.

Ground I: Article 2.2bis(1)(a) BCIP

8. As a first ground, the claimant argues that the contested sign cannot constitute a trademark. According to the claimant, it is not sufficiently specific to qualify as a sign and has not been graphically represented in a clear and precise manner that enables users of the register to determine the precise subject matter of the mark. In this regard, the claimant notes that the contested registration simply refers to the colour "yellow", without any specification and/or (international) colour code, and that the lace boot itself is not disclaimed by dotted lines, whereas the description only includes that the image of the shoe forms no part of the contested registration. Further, the claimant submits that there are inconsistencies, since the contested registration is registered as a shape mark but is trying to seek protection for a specific colour and it is registered for shoes in general, so also the lace boot (which is not disclaimed by making use of dotted lines) should be disregarded. As a result, the trademark is not specific enough to qualify as a "sign" but is trying to seek protection for a general and abstract manner, which is not allowed to be registered as a trademark.

9. The claimant concludes that the representation of the contested trademark is not clear, precise, self-contained, easily accessible, intelligible, durable and objective. According to the claimant, a reasonably observant person / consumer with normal levels of perception and intelligence would, upon consulting the register, not be able to understand precisely what the trademark consists of or seeks to protect.

Ground II: Article 2.2bis(1)(b) BCIP

10. As a second ground, the claimant submits that the contested trademark is (inherently or *ab initio*) devoid of distinctive character. To be deemed inherently distinctive, the sign would have to be perceived by the Benelux average consumer, the relevant public, upon first impression – immediately – as an indicator of commercial origin for the registered goods. According to the claimant, this is not the case since average consumers are not in the habit of making assumptions about the origin of products based on the shape and the (unclear) colour of stitching in the absence of any graphic or word element. Rather, consumers perceive the outer appearance of a product as either decorative or functional features of the product as such.

11. The claimant refers to case law and argues that the exception to the rule, as formulated by the CJEU, that a shape is usually devoid of distinctive character unless it departs significantly from the norm or customs of the sector, does not apply here. In the shoe industry, there is a well-known diversity of different shapes, which are usually dictated by their function or merely seen as a decoration rather than as source identifiers. Coloured and clearly visible stitching were nothing new at the filing date of the contested registration, according to the claimant, who gives several examples and refers to a prior art search. The claimant adds that even if BOIP were to consider – incorrectly – that the shapes and/or characteristics of the contested registration did deviate from the (assumed) norms or customs of the shoe industry, these would still lack distinctiveness, since the stitching will be perceived by the average consumer as functional – to attach the shoe sole to the upper of the shoe – and not as a badge of origin.

12. The lack of distinctiveness is, according to the claimant, confirmed by a consumer survey (February 2021), that was carried out on his request by a Dutch market research agency (copies of both the report and the full answers were submitted).

13. Based on the foregoing, the claimant concludes that the contested registration is devoid of inherent distinctive character and it is also not capable of acquiring distinctiveness through use.

Ground III: Article 2.2bis(1)(d) BCIP

14. As a third ground, the claimant submits that the sign has become customary in the established practices of trade. He explains that this ground for invalidity applies to trademarks which were distinctive at an earlier stage, but which have become, in current language or in trade, a customary indication for the goods and services concerned at the moment of filing. If a sign is generic at its filing date, it must be declared invalid based on this ground.

15. The contested trademark became, according to the claimant, generic before its filing on 6 February 1996. In this respect, the claimant states that the evidence he submitted (see also above, paragraph 11) conclusively shows that (coloured) stitching on the welt of a lace boot is customary in the established practices of trade; this is not only done by one other undertaking in the last decennia but is applied on a large scale already since World Wars I and II. In respect of this second ground, claimant concludes that the applied stitching was customarily used for lace boots at the date of filing in a non-trademark context.

Ground IV: Article 2.2bis(1)(e) BCIP

16. The fourth and last ground invoked is that the contested trademark consists exclusively of the shape, or another characteristic, which (i) results from the nature of the goods, (ii) is necessary to obtain a technical result or (iii) gives substantial value to the goods. The claimant recalls that trademarks which fall within one of these grounds are absolutely excluded from trademark protection and possible acquired distinctiveness is therefore not relevant in this respect.

ii. Technical result

17. Regarding this ground, the claimant starts by arguing that (ii) the trademark is purely functional, since all its essential characteristics are necessary to obtain a technical result. He recalls that the objective pursued by this ground for exclusion is to prevent the exclusive and permanent rights that a trademark confers from serving to extend the life of technical IP rights indefinitely, such as patents, which the EU legislator has made subject to limited periods, and to prohibit any undertaking from indefinitely monopolising technical solutions which would enable them to prevent competitors from using such technical features for the improvement of their own product. He further recalls that, according to the case law, a mark consists "exclusively" of the shape of goods within the meaning of this Article when all its essential characteristics (i.e., its most important elements) perform a technical function, so that the presence of one or more minor arbitrary elements will not alter the conclusion.

18. The claimant states that the contested trademark can only claim protection for a single object and that the (only) essential characteristics are (1) the unclear depicted stitching (2) which comprises an unclear yellow colour and (3) is applied to a (non-coloured) welt and registered for all footwear c.q. types of shoes.

19. According to the claimant, the welt and stitching enable the upper of the footwear to be durably connected with the sole. The claimant explains that the use of a welt and stitching was invented by Charles Goodyear, who in 1869 invented the machinery for stitching that runs along the perimeter of shoe outsole. The claimant further refers to some UK patents that were applied for by (legal predecessors of) the defendant.

20. The claimant recalls that, according to the case law, the possibility of alternative "shapes" or technologies capable of achieving the same technical result does not preclude the applicability of this ground for exclusion. So, the fact that the contested registration contains *yellow* coloured stitching on a non-coloured welt, while also other alternative colours are available to colour the stitching, is, according to the claimant, insufficient to conclude that the contested registration not merely consists of functional elements.

iii. Essential value

21. The claimant further submits that the shape and other characteristics of the contested registration give substantial value to the goods in question. He explains that the reasoning behind this ground for refusal is the exclusion of shapes for trademark protection that could give an intrinsic (essential) value to the goods and could also have been protected by copyright or design law. Further, the concept of "value" should be interpreted not only in commercial (economic) terms, but also in terms of "attractiveness" which is to say, the likelihood that the goods will be purchased primarily because of their particular shape or of another particular characteristic. When other characteristics may give the product significant value in addition to

this aesthetic value, such as functional value (for instance safety, comfort and reliability), this absolute ground cannot be ruled out automatically.

22. According to the claimant, the appearance of a shoe will always play a decisive and important role in the purchase decision. Therefore, the aesthetic value for these kinds of products is decisive in the purchase decision of the relevant public. The claimant adds that the current trend also prescribes that the stitching of lace boots and footwear is made visible. The look of the Dr. Martens lace boot will be the primary consideration for buying the shoes, which includes the yellow stitching on the applied welt, and thus the appearance of the boots will give substantial value to the goods.

i. Nature of the goods

23. As a final ground, the claimant submits that the shapes and characteristics of the contested registration result from the nature of goods. He explains that this ground applies to all shapes or characteristics that are inherent to the generic function or functions of goods and which consumers may be looking for in the products of competitors. The claimant provides some examples as evidence that the use of (coloured) stitching on a welt, including yellow stitching, is a widely known, used and applied method with respect to lace boots. The stitching enables to connect the upper of the lace boots with its sole durably, efficiently and makes the goods water resistant, so according to the claimant, the essential characteristics and shape of the contested registration do not serve as indicators of origin but contain functional advantages that are inherent to the generic function of the goods in question.

Conclusion

24. Based on the foregoing grounds and arguments and the evidence submitted, the claimant requests BOIP to declare the contested registration invalid and to order the defendant to pay the costs of the proceedings.

B. Arguments of the defendant

25. The defendant explains that he is a global licensee of the Dr. Martens brand. The first model, the 1460 boot, was named after 1 April 1960 (1.4.60), the date on which the first sample was allegedly produced. This first model already combined several characteristics which are still present in today's models, including the object of the contested trademark, referred to by the defendant as: The yellow welt stitch (or "YWS"). According to the defendant, during the six decades following their introduction, these characteristics have made and still make the products recognizable as part of the "Dr. Martens family of footwear".

26. Initially, Dr. Martens footwear was designed for and worn by working people, as the air cushioned sole would be comfortable for people having to stand on their feet for long hours. Yet, the brand went through, in the words of the defendant, "a phenomenal lifecycle" to become "an icon of independence, androgyny and self-awareness". The defendant gives a very comprehensive - extensively documented, also by an expert statement from a professor in fashion theory at various universities - overview of his history, explaining that the brand has been embraced as a symbol of rebellion by various subcultures since the 1960s, and was - and still is - worn by many world-famous artists and celebrities. In the 1980s, the fame of Dr. Martens footwear also stretched out into the Benelux and since the 1990's, it had become as popular

there as anywhere else in the world and had reached the level of iconic, as illustrated by various press articles from that time, in which they are described in terms such as *"the DOC MARTENS – with the typical yellow stitching", "without doubt the most popular", "the model has been loved by people like Madonna, Naomi Campbell, Elton John and even the English princes William and Harry for years", "the Doc Martens belong to the line of classics of the twentieth century. Like the Ray Ban, Levi's (501) and the Volkswagen Beetle", "Doc Martens is one of the top thirty best-known brand names in the world. It is the most fashionable footwear around.."*. Today, Dr. Martens footwear has, according to the defendant, become omnipresent. In support of this, the defendant submitted, inter alia, PR reports, information on points of sale and turnover and sales figures in its own shops, online and through resellers.

27. The defendant states that the YWS is one of the distinctive features of the goods from the beginning in 1960 and it has been used on the vast majority (estimated at around 90%) of the footwear under the Dr. Martens brand. It has, according to the defendant, long become a famous sign, which is illustrated by many press articles describing it in terms like *"typical yellow stitching", "striking", "instantly recognizable"* etc (the defendant files a large number of exhibits dating between 1993 and today). Besides, retailers also often refer to the yellow stitch. The distinctiveness of the sign has been acknowledged by the Brussels Commercial Court in 1996 and 1997. In interlocutory proceedings between the same parties as in these cancellation proceedings, the District Court in the Hague considered that *"if the trademarks did not already have distinctive character at the time of registration, they have in any case acquired it through use"*.

28. Before addressing the grounds for invalidity invoked by the claimant, the defendant notes that the contested trademark registration was examined by the Office on absolute grounds. Therefore, in the defendant's view, there is a presumption of validity and the claimant has the burden of proof to demonstrate that the mark is not valid. In this respect, the defendant further refers to the aforementioned interlocutory proceedings before the District Court in the Hague, which considered *"there is, in the courts preliminary assessment, no question of a serious, non-negligible chance that the trademarks will not survive the invalidity proceedings brought before the BOIP. Therefore, the Court in preliminary relief proceedings is assuming the validity of the trademarks."*

Ground I: Article 2.2bis(1)(a) BCIP

29. The defendant contests the claimant's submissions that the trademark does not have a sufficiently clear and precise representation to qualify as a sign. According to the defendant, a colour code is only required for colour marks (relating to a colour as such, without a defined outline), whereas the YWS is obviously not a colour mark as it designates a specific position where the mark is to be applied on the goods. Further, the use of dotted lines, although (currently) common practice to depict parts that do not belong to the object of the trade mark, is by no means prescribed; according to the defendant, the description of the distinctive features, which states that the yellow welt stitch is the object of the mark and that the shoe does not form part of it, is perfectly understandable. The defendant further refutes the alleged inconsistencies. He recalls that until the most recent amendment of EU harmonized trademark law, there was no possibility to categorize a trademark as a "position mark" and therefore, colour-position marks, such as the YWS, were applied for in various ways. Finally, according to the defendant it is unclear what could be found to be ambiguous about the mark registered for the goods "footwear" relating to (as it is described) "the yellow stitching in the rim between the upper leather and the sole of a shoe".

30. The defendant concludes that it appears that the claimant first and foremost didn't want to understand the YWS, but there is no reason why it would have any lack of clarity or precision on the nature of the sign that is the object of the registration when it was filed. The defendant again refers to the

aforementioned interlocutory proceedings before the District Court in the Hague, which rejected this ground.

Ground II: Article 2.2bis(1)(b) BCIP

31. The defendant recalls that a minimum degree of distinctive character is sufficient. This applies to all categories of trademarks, including trademarks that are indissociable of the appearance of the product itself. In the latter case, however, contrary to more traditional trademarks like logos and word marks, average consumers are assumed not to be in the habit of making assumptions about the origin of products. In those circumstances, the CJEU has held that 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.

32. According to the defendant, the trademark is inherently distinctive and the claimant has the burden of proof that the YWS did not depart significantly from the norm or customs of the sector at the filing date (i.e., on 6 February 1996). The evidence provided by the claimant, showing other boots with visible stitching, is according to the defendant not convincing. The defendant claims that these are all more or less subtle copies of Dr. Martens footwear, which is in his view the ultimate proof that the sign has acquired a reputation worth copying. For assessing the norm and customs of the market, use that is intended to mimic the sign applied for must (unless the trademark proprietor has neglected the protection of its trademark, which is not the case) be disregarded.

33. Even if the YWS is considered not to depart significantly from the norm or customs of the sector at the filing date, the defendant claims that it still remains valid since it had acquired distinctiveness through use on either the filing date (i.e. on 6 February 1996) or on the date of the invalidity application (i.e. on 6 October 2020). The defendant recalls that acquired distinctiveness implies that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings. In support of this acquired distinctiveness claim, the defendant refers to his previously mentioned arguments and evidence relating to the history and popularity, which has seen a tremendous rise in the last years, of Dr. Martens and the contested trademark. Again, the defendant refers to the ruling of the District Court in The Hague, which stated that: "*Dr. Martens shoes are regularly mentioned in publications in the same breath as yellow stitching on the rim around the sole (the welt), which is also referred to as characteristic, famous, typical, striking, distinctive, recognizable, classic or iconic.*"

34. Relating to the market survey that was submitted by the claimant, the defendant claims that it is not reliable, since the claimant submitted another report based on the same survey but with a different outcome in the court proceedings between the parties. The results of this market survey where, according to the defendant, who submits an expert opinion criticizing the report, substantially misrepresented and thus unreliable. The defendant therefore requests the Office not to base any of its finding on the claimant's report. Besides, the defendant claims that the report is unsuitable, mainly because the questions raised are too "vague" to allow the respondents to give a relevant reply and the connection between the questions is not clear. In this respect, the defendant explains that already the first question ("*Upon seeing this image, what comes up, or do you have no idea?*") gives room for just any answer (the most common reply was "*a shoe*"), so it does not allow for the conclusion that the respondent did not (also) associate it with Dr.

Martens. And the responses to the second question (“*Why do you think that?*”) and following questions are incomprehensible without knowing the response to the first question. The defendant also submits a counter-survey, which he claims does not have the shortcomings of the survey submitted by the claimant. In this survey, the following question was raised: “*Below is a drawing of a lace-up boot. The whole drawing is drawn in dotted lines except for one aspect. From whom (which brand or shop) are the lace-boots with this aspect? If you have no idea, you may indicate so.*” According to the defendant, 478 of the 901 respondents (i.e., 53%) gave an answer that was categorized as “Dr. Martens”.

35. The defendant concludes that he considers it sufficiently plausible that at least a substantial part of the relevant public identifies footwear with a yellow welt stitch because of that characteristic as originating from Dr. Martens.

Ground III: Article 2.2bis(1)(d) BCIP

36. The defendant states that it is unclear to him what would be the added value of this ground in addition to the previous ground of invalidity (Art. 2.2bis(1)(b) BCIP, lack of distinctive character). To substantiate that the trademark did not - prior to the filing - date become customary in the bona fide and established practices of the trade, the defendant refers to his previously mentioned arguments.

Ground IV: Article 2.2bis(1)(e) BCIP

37. The defendant recalls that these grounds for invalidity were recently, with the implementation of the current Trademark Directive, extended from merely marks that consist exclusively of a certain “shape”, to marks that consist exclusively of a certain “shape, or another characteristic”. Since the contested trademark was registered more than two decades before this modification, these grounds do not apply to it, according to the defendant. The defendant adds that the claimant should be aware, like no other, that a trademark of which the object is a colour applied to a specific position does not consist exclusively of a “shape” in the sense of this ground, as this was the deciding factor in Van Haren’s high stakes litigation against Christian Louboutin (CJEU, case C-163/16).

38. In the defendant’s view, the grounds for exclusion of signs which consist exclusively of the shape, or another characteristic, which results from the nature of the goods themselves (Art. 2.2bis(1)(e)(i) BCIP) or which is necessary to obtain a technical result (Art. 2.2bis(1)(e)(ii) BCIP), do not apply, simply because one of the essential characteristics of the mark is the colour yellow. The defendant refers in this respect to the Lego Juris case (CJEU, C-48/09) and claims that a vital difference is that the colour was in that case considered to be a “*minor arbitrary element*” of the mark in question, whereas in this case, the colour yellow is an essential characteristic of the trademark. The colour yellow is not a feature that is inherent to the generic function of a lace boot or that has any other function, so it has nothing to do with the nature of the goods or any technical result.

39. Regarding the ground of exclusion of signs which consist exclusively of the shape, or another characteristic, which gives substantial value to the goods (Art. 2.2bis(1)(e)(iii) BCIP), the defendant recalls that only the *intrinsic* value of the trademark, not the attraction acquired through the use is relevant. The defendant believes it is unrealistic to assume that the feature of a yellow colour of the stitch on the welt is such a crucial factor for consumers when they make a purchase decision, that it can be considered to give

substantial value to the goods. The defendant further states that the ratio of the public interest underlying this ground for exclusion is to prevent the distortion of the conditions of competition on the market concerned. It can, in his view, not reasonably be argued that the YWS is such, that restricting this feature to a single undertaking would distort the conditions of competition on the market concerned – even more since the “meaning” that has been acquired for this feature must be disregarded.

40. Finally, the defendant refers once again to the interlocutory proceedings before the District Court in the Hague, which also rejected these grounds for invalidity.

Conclusion

41. The defendant concludes that the contested trademark cannot be invalidated on any of the grounds raised by the claimant. He requests that the invalidity application be dismissed in full and that the claimant be ordered to pay all costs.

III. GROUNDS FOR THE DECISION

A.1 Legal framework

42. Pursuant to Article 2.30bis(1)(a) BCIP an application for invalidity may be filed with the Office based on the absolute grounds set out in Article 2.2bis(1) BCIP.

43. It follows from the case-law that the relevant date for the purposes of examining, in the context of an application for a declaration of invalidity, the compliance of a trademark with Article 2.2bis(1) BCIP is that of the date of filing of the application for registration³.

44. Starting point in these proceedings is that the contested trademark enjoys a presumption of validity⁴. The principle of hearing both sides of the case applies (Article 2.30ter(1) BCIP) and the examination is limited to the arguments, facts and evidence submitted by the parties (Rule 1.37 in conjunction with Rule 1.21 IR).

A.2 Ground I: Article 2.2bis(1)(a) BCIP

45. The first ground for invalidity that has been invoked by the claimant is that the contested sign cannot constitute a trademark, since it is not sufficiently specific to qualify as a sign and has not been graphically represented in a clear and precise manner that enables users of the register to determine the precise subject matter of the mark.

46. In this respect, it should be noted that, as the defendant correctly states (paragraph 29 above), colour codes are only mandatory for colour marks⁵, dotted lines as disclaimers are (nowadays) common practice but not mandatory and the trademark type “position mark” has been introduced rather recently.

³ See by analogy CJEU, *Flugbörse*, 23 April 2010, C-332/09 P, ECLI:EU:C:2010:225.

⁴ EGC, *Castel*, T-320/10, 13 September 2013, ECLI:EU:T:2013:424

⁵ CJEU, *Libertel*, C-104/01, 6 May 2003, ECLI:EU:C:2003:244.

47. Even though the graphic representation could perhaps have been different or better with the current state of the art, the Office considers that the representation of the mark and the description of distinctive features (mentioned in paragraph 2 above) are sufficiently clear to understand what the subject matter of the trademark is, namely "yellow stitching on the edge between the upper leather and the shoe sole of a shoe, in the manner as depicted on the graphic representation of the mark". The addition that "the graphic representation of the shoe is not a part of the mark" is, in the Office's view, clear enough to indicate that the shoe is excluded and protection is sought for the stitching in the colour yellow used in this place of the shoe.

Conclusion

48. Based on the foregoing, the Office concludes that ground I cannot lead to invalidation.

A.3 Grounds II and III: Article 2.2bis(1)(b) and (d) BCIP

49. The second and third ground for invalidity that have been invoked by the claimant are that the contested trademark is devoid of distinctive character (Article 2.2bis(1)(b) BCIP) and has become a customary indication within the meaning of Article 2.2bis(1)(d) BCIP. For reasons of procedural efficiency, the Office will examine these two grounds together.

50. For the third ground, the Office agrees with the defendant that it sees no indications, and it seems far-fetched, that the trademark consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade. For the second ground, the Office agrees with the claimant that it is unlikely that the relevant public will perceive the sign (inherently or *ab initio*) as a trademark. In the shoe industry, there is a well-known diversity, and the Office does not believe that the relevant consumer is in the habit of making assumptions about the commercial origin of shoes based on a yellow (or whatever coloured) stitch on a welt, unless it has been "educated" to do so.

51. However, there is no need to extensively examine both these grounds, since they have in common that they are set aside if the trademark has acquired distinctiveness. In fact, Article 2.2bis(3) explicitly refers to paragraphs 1(b), (c) and (d), and states: "*A trademark shall not be declared invalid for the same reasons if, before the date of application for a declaration of invalidity, following the use which has been made of it, it has acquired a distinctive character*".

52. The Office considers that acquired distinctiveness before the date of the application for a declaration of invalidity has convincingly been proven by the defendant. The evidence provided shows Dr. Martens prominent presence on the Benelux market for decades. The evidence also shows the consistent use of the contested trademark. It is clearly shown that the yellow stitching is widely recognised as *the* identifying feature of the boots, as is illustrated by the overwhelming amount of press articles that were submitted by the defendant, in which it is referred to in terms such as "*characteristic*", "*famous*", "*typical*", "*striking*", "*distinctive*", "*recognizable*", "*classic*" or "*iconic*". The status attributed to the stitching in these publications illustrates its position in the market, demonstrating that it is being considered as a sign showing that the boots originate from a particular company. A simple and basically non-distinctive element such as a (coloured) stitching applied to shoes does not easily obtain such a status. This can only be the result of

very long and intensive use, extensive marketing and efforts to promote the trademark - in other words, the "ingredients" for acquired distinctiveness.

53. The different results of the market surveys submitted by the parties do not give the Office cause to question the acquired distinctiveness. The mere fact that the results differ so much is already an indication that not too much weight can be attached to them. It is also difficult to compare the surveys. The questions asked are completely different, so it is not surprising that the answers are too. In any event, the Office agrees with the defendant's criticism (paragraph 34 above) to the extent that the percentage that was mentioned by the claimant (25%) of the respondents who answered Dr. Martens to the first question, still appears quite high given the very open-ended nature of that question. The question posed in the survey submitted by the defendant seems more appropriate and the resulting percentage (53%) therefore also appears to represent the actual market situation better. The Office also notes that both surveys have the shortcoming that they only concern the Dutch market, whereas according to established case law, acquired distinctiveness should cover the entire Benelux territory⁶. However, since it is clear from the documents submitted that the long and intensive use made of the mark took place in a highly comparable way throughout the full Benelux territory, that omission does not give rise to doubts. Given the nature of the trademark, the Benelux consumer is highly comparable in all areas and the effect of the marketing efforts made is therefore comparable as well. This would be different if this case would for example involve a word mark in a language that is not spoken in the entire Benelux.

Conclusion

54. Based on the foregoing, the Office concludes that grounds II and III cannot lead to invalidation, since acquired distinctiveness has been convincingly proven.

A.4 Ground IV: Article 2.2bis(1)(e) BCIP

55. The fourth and last ground for invalidity that has been invoked by the claimant contains three different (sub)grounds. Article 2.2bis(1)(e) BCIP refers to trademarks that consists exclusively of the shape, or another characteristic, which (i) results from the nature of the goods, (ii) is necessary to obtain a technical result or (iii) gives substantial value to the goods. According to the claimant, these all apply to the contested trademark.

56. As a preliminary remark, it should be noted that, as the defendant correctly points out, the words "or another characteristic" were added recently, long after the contested trademark was registered. These words must therefore be disregarded, so that these grounds can only relate to the shape and not to other characteristics of the goods⁷. However, even assuming that the grounds would be applicable to the contested trademark, the Office finds that they must be rejected.

57. Regarding (sub)grounds (i) and (ii), the claimant's reasoning essentially amounts to arguing that the contested trademark is functional since the welt and stitching enables the upper of the lace boot to be durably connected with the sole. The Office agrees with the defendant's counter-argument that one of the

⁶ CJEU, EUROPOLIS, 7 September 2006, C-108/05, ECLI:EU:C:2006:530; BenCJ, Pet's Budget, 16 June 2020, C-2019/6/9; BenCJ, Sports direct, 16 June 2020, C-2019/5/6.

⁷ CJEU, Textilis, 14 March 2019, C-21/18, ECLI:EU:C:2019:199.

essential features of the trademark is the yellow colour of the stitch (for a description see paragraph 2 above) and that the contested mark is in this respect not comparable to the Lego case (paragraph 38 above). The claimant fails to substantiate – and it is also difficult to see – why the yellow stitching results from the nature of the goods or is necessary to obtain a technical result.

58. Regarding (sub)ground (iii), the claimant argues that the appearance of a shoe will play a decisive and important role in the purchase decision. According to the claimant, the current trend prescribes that the stitching of lace boots and footwear is made visible. The look of the Dr. Martens lace boot will be the primary consideration for buying the shoes, which includes the yellow stitching on the welt. Thus, the appearance of the shoes will give substantial value to the goods. The Office agrees that for the goods in question, their visual appearance will undoubtedly play a key role in the (potential) consumer's purchase decision. However, what is being claimed by the contested registration is not the visual appearance of the shoes, which has been "disclaimed" in the description (paragraph 2 above). The subject matter of the trademark concerns a well-defined element, namely "the yellow stitching on the edge between the upper leather and the shoe sole of a shoe, in the manner as depicted on the graphic representation of the mark". The claimant fails to substantiate – and it is, again, also difficult to see – why this specific element would intrinsically, so without taking into account the attraction acquired through the use of the trademark, be attractive to such an extent that it must be considered to give substantial value to the goods.

Conclusion

59. Based on the foregoing, the Office concludes that ground IV cannot lead to invalidation.

B. Other factors

60. Both parties request that the other party be ordered to pay the costs. It should, however, be recalled that, in the context of cancellation proceedings, there is no provision for an order to pay the costs incurred. There is only an allocation of the costs set at the fixed amount of the cancellation fee if the application is granted or rejected in full.

C. Conclusion

61. Based on the above factors, the Office finds that none of the invoked grounds can lead to invalidation.

IV. DECISION

62. The application for cancellation is not justified.

63. Benelux registration 588724 is upheld.

64. The claimant shall pay the defendant 1,420 euros in accordance with Article 2.30ter (5) BCIP in conjunction with rule 1.44 (2) IR, as the cancellation application is rejected in its entirety. This decision constitutes an enforceable order pursuant to Article 2.30ter (5) BCIP.

The Hague, 25 April 2023

BOIP



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