

O-005-08

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION No. 2360896
STANDING IN THE NAME OF PAUL LYNAM**

AND

**IN THE MATTER OF A REQUEST FOR A DECLARATION
OF INVALIDITY THERETO UNDER NO. 82933
BY COURTESY SHOES LIMITED**

BACKGROUND

1) On 15 April 2004, Paul Lynam applied to register a series of two trade marks one of which was TREADSAFE. The trade marks were applied for in respect of the following goods:

Class 9: Safety footwear **Class 25:** Clothing, footwear, headgear.

2) The application was examined, subsequently amended and then accepted, and the TREADSAFE trade mark published for opposition purposes. No opposition was filed, and the registration procedure was completed on 8 October 2004.

3) On 11 July 2007, Courtesy Shoes Limited applied for a declaration of invalidity under sections 3(1)(b) and (c) of the Trade Marks Act 1994 (the Act).

4) The Applicant frames their attack in the following terms:

“1.....on the grounds that it consists of the common descriptive words “tread” and “safe” the whole being a phrase which indicates the nature and intended purpose of the goods concerned, e.g. boots and shoes that allow the wearer to tread safely or boots and shoes that have a tread that helps make the wearer safe.

2. The above statement was true as at the date of filing of the application for registration...and is true now.

3. The registration is invalid in respect of “safety footwear” in class 9 and “footwear” in class 25...”

5) On 12 September 2007 the Registered Proprietor filed a counter-statement which consists, in essence, of a denial of the grounds on which the request for invalidation is based. I note that in paragraph 5 of their counterstatement, the Registered Proprietor says:

“Additionally or alternatively, even should the registration be deemed to have been in breach of sections 3(1)(b) or (c) as of the date of filing of the application, the Registered Proprietor maintains that the trade mark TREADSAFE had acquired sufficient distinctiveness, as of the date of filing of the Application for Declaration of Invalidity, for section 47(1), second sentence,....to apply.”

6) Both parties filed evidence in these proceedings and both ask for an award of costs. The matter came to be heard on 14 August 2008 when the applicant was represented by Mr Silcock of Counsel instructed by ip21 Ltd and the registered proprietor was represented by Dr Banford of Messrs T.M Gregory & Co.

Applicant’s evidence-in-chief

7) This consists of a witness statement, dated 30 October 2007, from Tom Farrand who is a trade mark attorney in the employ of ip21 Ltd, the Applicant’s professional representatives in these

proceedings. Mr Farrand states that in his view the word TREADSAFE (presented as one word) or TREAD SAFE (presented as two words) are to all intents and purposes the same. He adds that he would expect the average consumer to readily recognise the two common words irrespective of whether there is a space between them.

8) He then provides a number of exhibits and draws a number of conclusions. These are as follows:

- Exhibit TF1 consists of a copy of the relevant pages from the sixth edition of the Concise Oxford English Dictionary which he notes indicates that the word TREAD can function as a verb and a noun. He notes that as a verb, TREAD is defined, *inter alia*, as: “Set down one’s foot, walk , step...”; this is, in his view, the most widely known meaning of the word. When used as a noun, he notes the word TREAD means, *inter alia*, the part of the sole of a shoe that makes contact with the ground. Although less well know, in his view, this meaning would still be widely recognised by the average consumer.
- Exhibit TF2 consists of pages taken from the same dictionary mentioned above for the word SAFE which, Mr Farrand notes, is defined as an adjective. He notes a number of definitions including: “uninjured”, “secure, out of or not exposed to danger” and “affording security or not involving danger”.
- Exhibit TF3 consists of a page taken from the same dictionary in which the abbreviation *pred.* is defined as: “predicate; predicative(ly)” which he notes is used in relation to the first meaning of SAFE mentioned above. He states that the first meaning given to SAFE is that of a predicative adjective i.e. that the normal and correct use is after a verb. In Mr Farrand’s view the phrase TREAD SAFE carries the dictionary meanings: “to put down one’s foot uninjured”, “to walk uninjured” or “to step out of danger” Where TREAD is used as a noun, the phrase TREAD SAFE would, he says, mean “sole of a shoe that affords security”. He concludes that the combination of the words TREAD and SAFE is in line with correct and common usage of both words adding that the phrase does not diverge from English grammar rules, but complies with them. Mr Farrand adds that when used in relation to footwear the phrase TREAD SAFE would inform the public about the characteristics of the footwear i.e. boots or shoes that facilitate the wearer to tread safe in, for example, slippery conditions.
- Exhibit TF4 consists of the results of a search of the Internet using the Google search engine, in which Mr Farrand says he found instances of other traders in footwear using the phrase TREAD SAFE to describe the characteristics of the footwear they are selling. I note that these are not dated, but as the search was carried out for this case it is reasonable to assume that it was after the relevant date. The extracts are taken from the Clifford James, My Simon and Shoes for Crews websites; the final two of which appear, given the references to prices in \$, to be American websites. I note the Clifford James website includes the following references:

“Stylishly crafted Super-soft leather upper has a distinctive toe panel feature. 4 eyelet lace-up opening for an extra generous fit. Internal comfort is guaranteed by a leather insole, suede leather heel grip, cushioned arch support and softly padded lining. A patterned **tread safe** grip-sole gives a longwearing life.” (my emphasis)

And:

“Enjoy the all day comfort.....Finished with a patterned **tread safe**-grip sole” (my emphasis)

9) On my reading of the pages provided from the My Simon and Shoes for Crews websites, the only references to TREAD SAFE are, it would appear, in the search terms that were used to interrogate the websites. In addition, I note there is no mention in Mr Farrand’s witness statement of the Shoes for Crews website.

10) Mr Farrand concludes his witness statement in the following terms:

“I conclude from the above.....that the phrase “tread safe” is used in the context where it describes and informs potential customers of the characteristics of the footwear that is being offered for sale. I further conclude that the phrase “tread safe” is one that traders in footwear may legitimately wish to use in relation to their products.”

Registered Proprietor’s evidence-in-chief

11) This consists of two witness statements. The first, dated 11 December 2007, is from Jonathan Banford. Mr Banford is a trade mark attorney in the employ of T M Gregory & Co, the Registered Proprietor’s professional representatives in these proceedings. The majority of Mr Banford’s witness statement responds to Mr Farrand’s grammatical analysis of the words TREAD SAFE summarised above. The main points emerging from Mr Banford’s witness statement in this regard are as follows:

- Exhibit JB1 consists of pages from the Concise Oxford English Dictionary (eleventh edition, revised 2006) for the words TREAD and SAFE. Mr Banford notes that the definitions of the words are, for the most part, in line with the definitions provided by Mr Farrand, but that the abbreviation *pred.* no longer appears in the definition of the word SAFE. This suggests, in his view, that the formal grammatical construction to which Mr Farrand refers is now considered old fashioned or unimportant.
- Exhibit JB2 consists of pages from the dictionary mentioned above for the words Predicative and Copula, with Mr Banford noting that the only verb mentioned as being a copula and as taking predicative adjectives is the verb “to be”.
- Insofar as exhibit TF4 is concerned and the extracts from the Clifford James website, he notes that the words TREAD SAFE are used as part of the phrase “A patterned tread safe grip-sole”. In his view the adjective “patterned” qualifies the noun TREAD and the adjective SAFE qualifies the word grip. This, in his view, describes a sole with a patterned tread which provides a safe grip; any attempt to isolate and ascribe a particular meaning to TREAD SAFE is, he says, artificial.
- Insofar as the remaining pages of exhibit TF4 are concerned, he makes the same points I have recorded above regarding the origin of the pages concerned and their relevance to these proceedings.

12) Mr Banford also provides the following views:

- The use of the word SAFE after a verb is at odds with customary and grammatically correct usage;
- Predicative adjectives follow specific verbs such as “is” and “feel” in, for example, “this path is safe” and “I feel safe” and are known as copula or linking verbs;
- When one requires a term to qualify a verb, it is grammatically correct to use the adverbial form “safely”
- The usage of TREAD SAFE suggested by Mr Farrand is artificial and misleading. The average consumer would expect to read TREAD SAFELY and would realise that TREAD SAFE was not merely descriptive;
- In the context of the use of the word TREAD as a noun, the overwhelming majority of English adjectives precede the noun that they qualify;
- The correct usage would be SAFE TREAD; and that in his view the words TREAD SAFE are neither in line with correct or common usage and diverge from standard English;
- There is a small but recognisable difference visually between TREADSAFE and TREAD SAFE, adding that when a portmanteau word such as TRADESAFE is created there will be a tendency to accent one syllable over another, altering the pronunciation relative to that of the separate words.

13) The second and final witness statement, dated 18 January 2008, is from John Hickling who is the Sales Manager of Tutte & Thomas Limited who he explains have traded in footwear for many years. He has, he explains, worked for this company since 1979 in both purchasing and sales, and has in that time built up a thorough knowledge of the footwear market in the UK. Mr Hickling says:

“3. I know Paul Lynam and his company PFL Import/Export Ltd, who are competitors of Tutte & Thomas Limited. I am well aware of Mr Lynam’s TREADSAFE brand. I always associate the TREADSAFE brand with Mr Lynam and his company, and I am sure that Mr Lynam’s customers have the same confidence in, and recognition of, his TREADSAFE brand as Tutte & Thomas Limited’s customers have in our GRAPHITE brand.”

14) That concludes my review of the evidence filed in these proceedings insofar as I consider it necessary.

DECISION

15) Section 47 of the Act reads as follows:

“47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2)

(3)

(4)

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

16) Insofar as it is relevant, sections 3(1) 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) 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.”

17) It is clear from the views expressed by the European Court of Justice in *Companyline* [2003] E.T.M.R. 20, *Linde AG (and others) v Deutsches Patent-und Markenamt*, Journal Cases C-53/01 to C-55/01, and the High Court in *Have a Break* [2002] EWHC 2533 (Ch) that Section 3(1)(b) has separate and independent scope from Section 3(1)(c). Therefore, I have to consider each section separately.

18) There are a number of European Court of Justice judgments which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the

Community Trade Mark Regulation), whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – (*Wm Wrigley Jr & Company v OHIM* – Case 191/01P (Doublemint) paragraph 30;
- thus Article 7(1)(c) (Section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM*, paragraph 31;
- it is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes – *Wm Wrigley Jr v OHIM*, paragraph 32;
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, Case C-363/99 (Postkantoor), paragraph 57;
- if a mark which consists of a word produced by a combination of elements is to be regarded as descriptive for the purposes of Article 3(1)(c) it is not sufficient that each of its components may be found to be descriptive, the word itself must be found to be so – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, paragraph 96;
- merely bringing together descriptive elements without any unusual variations as to, for instance, syntax or meaning, cannot result in a mark consisting exclusively of such elements escaping objection – *Koninklijke Nederland v Benelux Merkenbureau*, paragraph 98;
- however such a combination may not be descriptive if it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements – *Koninklijke Nederland NV v Benelux Markenbureau*, paragraph 99.

19) The applicant referred me to Kerly’s Law of Trade Marks and Trade Names (14th Edition) at paragraphs 8-048 – 8-053 which read as follows:

“8-048. The wording used in Sections/Arts 3(1)(b), (c) & (d) appears, at first sight, to set an absolute and very low requirement for distinctive character: “*devoid of any distinctive character*” and “*trade marks which consist exclusively*” of, essentially non-distinctive signs or indications. Faced with this language, applicants have argued repeatedly that they need only show a scintilla of distinctive character in order to overcome these hurdles and/or that the hurdle is very low.

8-049. Underlying many of the arguments out forward by applicants seeking to overcome Art.7(1)(b)/3(1)(b) grounds is the beguiling notion that there is a sliding scale of distinctiveness from, say, 0 to 100, where 100 is wholly distinctive and 0 is wholly devoid of distinctive character/wholly descriptive/completely generic. The notion of a scale of distinctiveness can be useful to explain how a mark may be distinctive yet also convey a message which is descriptive of the goods or services in question, and also how the message conveyed by a mark may change over time. This notion can be mis-used. Applicants like the concept of a sliding scale because they can argue that a low score of 1, 2, 3, x etc must be sufficient to overcome these absolute grounds. If the tribunal or Court then says, well, a minimum degree of distinctive character is more than x, then the applicant argues his mark is just over that minimum level. This type of argument is essentially bogus and there are two ways to explain why.

8-050. First, this “sliding scale” argument ignores the fact that marks below the borderline set by these absolute grounds suffer from a disability or inertia. In truth, the only way to overcome such a disability or inertia is through the correct type of use on a substantial scale so that the public are educated to understand the mark conveys an origin message. The “sliding scale” argument allows the disability or inertia to be ignored and this is illegitimate.

Second if the “sliding scale” notion is adopted, it should be recognised that it works down to a notional point, but then there is a cliff or step. Marks with sufficient inherent distinctive character are able to step up out of the morass of non-distinctive matter.

8-051. The further point is that the assessment of distinctive character has to be undertaken through the eyes of the average consumer of the goods or services in question. The average consumer test itself contains a threshold, in this sense; an applicant may be able to show that a small proportion of people do understand his mark to convey an origin message, but that is not sufficient to show that the average consumer would so understand the mark.

8-052. These considerations in fact provide the answer as to why the absolute grounds are expressed as they are. They do not need to be expressed or interpreted in terms of minimum level of distinctive character because of the nature of distinctive character. It carries with it its own threshold.

8-053. Many of the problems caused by setting too low a standard for distinctive character could be overcome if the ECJ were to state clearly that the basic requirement for registration of any mark is that it must possess a distinctive character, whether inherent or acquired.”

20) The applicant also referred to *Wm Wrigley Jr Company v OHIM (DOUBLEMINT)* [2004] All ER (EC) 1040 at paragraphs 31-35 which read:

“31. By prohibiting the registration as Community trade marks of such signs and indications, art 7(1)(c) of Regulation 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods and services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks(see; inter alia, in relation to the identical provisions of art. 3(1) (c) of

First Council Directive (EEC) 89/104 (to approximate the laws of the member states relating to trade marks) (OJ 1989 L40 p 1), the *Windsurfing Chiemsee* case (para 25) and *Linde Ag v Deutsches Patent-und Markenamt* Joined cases C-53-55/01 [2004] IP& T 172, [2003] ECR I-3161 (para 73)).

32. In order for OHIM to refuse to register a trade mark under art 7(1)(c) of Regulation 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.

33. In the present case, the reason given by the Court of First Instance, at para 20 of the contested judgment, for holding that the word at issue could not be refused registration under art 7(1)(c) was that signs or indications whose meaning goes beyond the merely descriptive are capable of being registered as Community trade marks and, at para 31 of the contested judgment, that the term cannot be characterised as exclusively descriptive. It thus took the view that art 7(1)(c) of Regulation 40/94 had to be interpreted as precluding the registration of trade marks which are exclusively descriptive of the goods or services in respect of which registration is sought, or of their characteristics.

34. In so doing, the Court of First Instance applied a test based on whether the mark is exclusively descriptive, which is not the test laid down by art 7(1)(c) of Regulation 40/94.

35. It thereby failed to ascertain whether the word at issue was capable of being used by other economic operators to designate a characteristic of their goods and services.”

21) I also rely upon the following from *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (POSTKANTOOR)*[2004] ETMR 57:

“[T]he purpose of the prohibition of registration of purely descriptive signs ... as trade marks was to prevent registration ... of signs or indications which, because they were no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that marketed them and were thus devoid of the distinctive character needed for that function.

The signs or indications ... were only those which might serve in normal usage from the consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration was sought. A mark composed of signs or indications satisfying that definition should not be refused registration unless it comprised no other signs or indications and, in addition, the purely descriptive signs or indications of which it was composed were not presented or configured in a manner that distinguished the resultant whole from the usual way of designating the goods or services concerned on their essential characteristics.

With regard to word trade marks, descriptiveness had to be determined not only in relation to each word taken separately but also in relation to the whole which they formed. Any perceptible difference between the combination of words submitted for registration and the terms used in common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics was apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.

[A] mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics ..., unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the second case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purpose of the same provision.

It is ... irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording [of the section] does not draw any distinction by reference to the characteristics which may be designated by the signs or indications of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially.”

22) The average consumer for the goods would be the average adult citizen in the UK, I must also take into account the traders who sell such products. Footwear is not an item which is purchased without thought. Shoes and boots are considered purchases not least because size, material (natural or man-made) and cost need to be taken into account, more so if they also have a safety function to perform.

23) I accept that the mark could be seen as the two words “tread” and “safe”. Given the appalling standards of literacy in use by advertisers and the media in general, particularly television programmes, the grammatical incorrectness will probably be unnoticed by the average consumer. Thus, the average consumer could view the mark in suit as informing them that the footwear concerned will allow them to tread or step safely. However, this, on its own, does not provide anywhere near enough information of itself to be useful or to be viewed as an attempt to describe a characteristic of the footwear. Footwear is purchased for a number of reasons, such as fashion, comfort, safety or just practicality. If the mark in suit is seen as a descriptor then it is a very poor one as it provides no real information about the product. It is not clear if they are non-slip, impervious to chemicals, reinforced with materials such as steel to prevent crushing, cushioned to prevent injury from a repetitive action or specifically designed to ensure correct posture. I accept that there is evidence of use of the words by another supplier of footwear. However, this is isolated to a single

company and is used in relation to the grip of the sole of the shoe, indeed it is hyphenated in one instance “tread safe-grip sole” and qualified in the other “a patterned tread safe grip-sole”. But the words “tread safe” or “tread safely” alone impart no information to the average consumer, as all footwear offers a degree of protection from the elements and detritus. Therefore, to my mind, the mark in suit would not be viewed by the average consumer as descriptive for the goods for which it is registered, but would be seen as a trade mark. The application under Section 3(1)(c) therefore fails.

24) I now turn to the objection based on Section 3(1)(b) of the Act. In considering this ground I take account of the following principles derived from the ECJ cases referred to below:

a) for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);

b) a mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Koninklijke KPN Nederland v Benelux Merkenbureau*, paragraph 86);

c) a trade mark’s distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public’s perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);

d) the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

25) The applicant referred me to Kerly’s at paragraph 8-086 which states:

“The appeals in BABY-DRY proceeded only on the Art.7 (1)(c) ground [equivalent here to the s. 3(1) (c) ground] and Art.7(1)(b) [equivalent to s. 3(1)(b)] was not in issue. It is possible that if the Art. 7(1)(b) ground had remained in issue, so that the Court had been forced to focus more clearly on “distinctive character”, such an objection would have been upheld.”

26) The applicant also contended that the average consumer would not regard the mark in suit as an indication of origin but as “a laudatory epithet or general descriptive phrase”. Whilst I have accepted that the average consumer could view this as the two words “tread” and “safe” and might be blissfully unaware of the grammatical error they would not acquire any information regarding the product. The phrase “tread safe” does not describe footwear, or any characteristic of footwear as all would be deemed to assist you walking. I doubt that anyone would advertise footwear as “unsafe”, so I do not believe that it can be seen as laudatory. The term “Treadsafe” does not describe the footwear, it does not inform the average consumer beyond that which they would have assumed in the first instance. Only when other matter is added does it provide the average consumer with the necessary information for the term to be considered descriptive. To my mind, whilst by no means the strongest of trade

marks, it has enough for it to be considered distinctive. The application under Section 3(1)(b) therefore fails.

27) I order the applicant, Courtesy Shoes Limited, to pay to the registered proprietor, Paul Lynam, the sum of £1000. 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 8 day of January 2009

**G W Salthouse
For the Registrar
the Comptroller-General**