

BL O/0648/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 4026119

BY Crocs, Inc.

TO REGISTER THE FOLLOWING MARK IN IN CLASSES 10 AND 25



Background

1. On 14th March 2024, Crocs, Inc. (the applicant) applied to register the 3D shape of a shoe as shown above for the following goods:

Class 10: Orthopaedic shoes

Class 25: Footwear; shoes; clogs; boat shoes; beach shoes

2. On 20th March 2024, the Intellectual Property Office (IPO) issued an examination report in response to the application. The examination report raised an objection under section 3(1)(b) of the Trade Marks Act 1994 (the Act), as follows:

The application is not acceptable for the goods claimed in Classes 10 and 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 applied for consists of a 3D representation of the type of goods. Whilst aesthetically pleasing, without any distinctive elements the average consumer would not attribute any trade mark significance to the sign.

As such this mark could equally apply to any undertaking within the relevant field and thus is not capable of indicating brand origin. In order to function as a trade mark a sign must be capable of distinguishing your goods from those of another undertaking, however, marks devoid of distinctive character are incapable of performing this essential function.

3. Subsequently, a number of requests for extensions of time to respond to the examination report were submitted. The applicant explained that they were in the process of compiling evidence of acquired distinctiveness. By way of letter dated 13th September 2024, the examiner granted one final extension of time.
4. On 13th November 2024, Bird & Bird LLP (the applicant's attorney), responded by filing evidence of acquired distinctiveness. The examiner responded by way of letter on 23rd January 2025 outlining that they had assessed the

evidence provided but were not persuaded that the average consumer had become educated to the sign applied for as guaranteeing the origin of the goods.

5. On 20th March 2025, Bird & Bird requested a hearing to discuss the case. A hearing was appointed and held on 17th April 2025 with a senior ex-parte hearing officer of the IPO.
6. A hearing report was issued on 2nd May 2025 in which the hearing officer concluded that he considered the mark to be devoid of distinctive character in the prima facie, however, he had been persuaded that the mark had acquired a distinctive character based on the evidence provided. The application was subsequently forwarded to publication for opposition purposes.
7. On 9th July 2025, the IPO received third party observations under section 38(3) of the Act. Further information was provided to support the observations. The observer claimed that the application should not have been accepted as, in their view, the applicant had not demonstrated that the relevant public perceive the 3D mark as originating solely from the applicant. In their opinion, the evidence of acquired distinctiveness filed by the applicant only demonstrates an association with the sign applied for when used in conjunction with the applicant's other trade marks, for example the word 'Crocs' and the crocodile shaped logo applied to the rivet on the shoe strap. The observer also complained that the evidence filed does not take into account the significant third party use of the 3D mark (or similar) in relation to other branded products. The observer argued that the sign ought to have been refused under section 3(1)(b) as it lacked distinctive character and that an objection under section 3(2)(c) should have been raised as the sign consisted of a shape that added substantial value to the goods.
8. On 31st July 2025, the IPO wrote to the applicant to inform it that a late objection was being raised under section 3(1)(b), in line with section 40(1) of the Act. This was because it was considered that at hearing, no specific finding was made in relation to the norms and customs in trade. This consideration would naturally have followed into the assessment of the evidence of acquired distinctiveness. It was considered that the information provided by the observer demonstrated that there was widescale use of the shape of the shoe, or a similar shaped shoe, in trade by other providers. The IPO confirmed however that no objection was being raised under section 3(2)(c).
9. The applicant again requested a number of extensions of time to provide a response to the late objection which were granted. A comprehensive response was submitted on 21st October 2025, challenging the late objection. A further survey (which I shall call the Appinio survey) was provided to complement the evidence of acquired distinctiveness previously filed,

including an earlier survey which I shall call the 'Shopping Centre' survey). A hearing was requested should the examiner not be persuaded that the application should, once again, be allowed to proceed to publication.

10. On 12th November 2025, the examiner responded by maintaining the late objection against the application. As a result, the application was forwarded for a second ex-parte hearing to be held.

11. A video hearing was held on 15th December 2025. Mr Mark Holah of Bird and Bird represented the applicant. At the outset of the hearing I posed a number of questions which I wished to receive submissions on. These were as follows:

- 1) *Did the applicant concede the prima facie case, or did they wish to provide submissions in this regard?*
- 2) *I asked for submissions on norms and customs in trade as this would help me determine the baseline against which I would assess the evidence of acquired distinctiveness filed.*
- 3) *Could the applicant provide any examples of case law involving the acceptance, by the UK courts, of a mark consisting of the shape of a product?*
- 4) *Does the applicant have any other IP protection, e.g. registered design?*
- 5) *Can the applicant point out, in the evidence, where reliance is demonstrated and could they explain their understanding of 'reliance'.*
- 6) *Does the applicant advertise the shape alone without any other signs?*
- 7) *On the second survey (Appinio), who had access to this and how did they access it?*

Mr Holah provided answers to these questions at hearing however, as he had not had the benefit of being sighted on them prior, we agreed that he would be allowed further time to consider and make written submissions on each of my questions.

12. On 16th February 2026, the applicant responded to the interim hearing report, answering the questions posed and providing further examples of the applicant's advertising on social media and globally, including a video clip. A copy of Appinio's Panel Book which summarises the findings of their survey was also submitted.

13. I shall briefly summarise the answers to the questions asked at hearing, and subsequently answered in writing as follows:

Did the applicant concede the prima facie case, or did they wish to provide submissions in this regard?

- No, the applicant did not concede the prima facie case but did not wish to make further submissions in this regard.

Norms and customs in trade

- The applicant submitted that whilst the test for inherent distinctiveness of a shape requires an assessment of the norms and customs in trade, and that it would be easier to prove acquired distinctiveness for a shape that departs from those norms and customs, the key question when assessing acquired distinctiveness is whether the consumer identifies the goods as originating from the applicant. Information was provided to demonstrate that the shape of the product was outside of the ordinary. It was argued that this was the case at the relevant date (filing date of the application) but also in 2002 when the shape was first introduced.

Examples of case law involving the acceptance, by the UK courts, of a mark consisting of the shape of a product

- The applicant was unable to provide details of any cases in which a UK court had accepted, as a trade mark, the shape of a product. Reference however was made to the Louboutin red sole (registration number 2472368). The applicant argued that whilst that mark could more accurately be described as a position mark, the principles in relation to the assessment of such a mark and a shape mark were not dissimilar.

Other IP protection

- The applicant confirmed that the specific shape is not registered as a design in the UK.

The applicant's understanding of the term 'reliance' and where this is demonstrated in the evidence

- The applicant cited the case of *Société des Produits Nestlé v Cadbury UK Ltd [2017] EWCA Civ 358*, pointing out that whilst reliance can be used to demonstrate acquired distinctiveness, it is not essential to show this. The applicant contends that where a shape is used in conjunction with other marks, there are two possibilities:
 - o The shape is always ancillary, such that any recognition of the shape is effectively based on other branding and consumers have not been educated to perceive the shape alone as a trade mark.
 - o The shape mark, through consistent use as a trade mark, has assumed a primary role in product choice, so that consumers would perceive the shape alone (without any other branding) as designating the origin of the goods.

The applicant contends that their mark falls into the second category.

Examples of the applicant advertising the shape alone

- Further examples were included showing posts on social media that include the shape of the shoe with no reference to other trade marks used by the applicant.

Who had access to the Appinio survey and how they accessed it

- The applicant confirmed that Appinio collected responses from a representative sample (1,000 people) from its panel of nearly 2 million members. The sample was representative of a distribution of people in the UK based on age, gender etc. Participants accessed the survey via a multi-factor authentication link. The IP addresses of participants were checked to ensure respondents were based in the UK.

14. On 23rd March 2026, I responded, having considered the further submissions of 16th February 2026 alongside all of the documentation attached to the file thus far, confirming that I had not been persuaded that the objection against the sign should be waived. As the applicant did not concede the prima facie case, I made an assessment of the sign in the first instance determining that it merely consisted of the shape of a shoe and that consumers are not in the habit of identifying origin by reference to the shape of a product alone. Equally, having considered the case for acquired distinctiveness, my conclusion was that the evidence provided demonstrated an association between the consumer and the sign only and did not show that the shape was relied upon to identify the origin of the goods. I therefore refused the application.

15. A Form TM5 (Request for a statement of reasons for registrar's decision) was received on 2nd April 2026. Having received the request, I am now obliged to set out the reasons for my decision.

The Law

16. The relevant parts of section 3 of the Act read 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.

The Relevant Legal Principles – Section 3(1)(b)

17. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to some decisions of the EU courts which predate the UK's withdrawal from the EU.
18. The mark consists of the three dimensional shape of an article of footwear, as worn on the right foot. The images of the footwear are presented as a line drawing and do not contain any text or logo elements within. The goods in respect of which the mark is to be used are 'orthopaedic shoes' in Class 10 and 'footwear, shoes, clogs, boat shoes, beach shoes' in Class 25. When considering the goods upon which the mark is to be used, and having also considered the applicant's use of the mark, it is clear that the sign is a 3D representation of the goods themselves as can be seen throughout the evidence of acquired distinctiveness provided by the applicant.
19. As the mark relates to footwear, I consider the relevant consumer of these goods to be the general public at large. I would regard footwear as being an everyday item, used by all. An individual will purchase such items fairly frequently, taking a number of factors into consideration, such as appearance, fit, cost etc. I therefore believe the relevant consumer would apply at least a moderate level of attention and circumspection when considering whether or not to purchase.
20. Given my own personal knowledge of footwear, and considering the information provided in the third party observations, I would regard the shape of the footwear in the sign to be similar to other clog-type products on the market. I note that the applicant denies this to be the case and has argued strongly that the shape is iconic, in particular at the time the product was first launched. I must however consider the shape as at the time of the filing of the application, and not the date on which the applicant first marketed their product (2002).
21. It is my view that the mark consists of a non-distinctive representation of the goods themselves, being shoes, and would merely serve to inform the consumer of the shape of those goods. The mark, as filed, would not indicate to the consumer the origin of the goods in question. Whilst the third party observations, and information provided therein, is not necessarily

determinative, they reinforce my opinion that the shape of the footwear depicted within the mark, was not outside of the norms and customs in trade at the time of filing of the application. Absent education, the consumer would fail to recognise the sign as a distinctive trade mark.

22. The Court of Justice of the European Union ('CJEU') has emphasised the need to interpret the grounds of refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (Bio ID v OHIM, C-37/03P paragraph 59 and the case law cited there and, more recently, Celltech R&D Ltd v OHIM, C-273/05P).
23. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provision referred to above) the Court has held that "...the public interest... is, manifestly, indissociable from the essential function of a trade mark", SAT.1 SatellitenFernsehen GmbH v OHIM, C-329/02P. 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. Marks which are devoid of distinctive character are incapable of fulfilling that essential function.
24. 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 ECJ 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)

25. The mark that is the subject of this application is a 3D sign which I have concluded above is a representation of the goods, namely a shoe.

26. It is important to recognise that the position in the UK as regards marks which constitute the appearance of a product or its packaging is uncertain. For the reasons set out in BL O/555/22 (Device of a lawnmower) at paras 31-48, the UK courts do not regard the jurisprudence of the CJEU as being 'acte clair'. That is to say whether the test of 'departing significantly from the norms and customs of the trade' is both a necessary and sufficient test for Trade Mark distinctiveness and registration. I refer also to Henkel KGaA v OHIM (Case C-144/06 P) which refers to the criteria for assessing the distinctive character of three-dimensional trade marks as being no different to other category of marks, and consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or their packaging:

36 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)

37 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).

27. This was further reiterated in joined cases C-344/10 P and C-345/10 P Freixenet SA:

45. It is also settled case-law that, 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 (see, in particular, Mag Instrument v OHIM, paragraph 30; Case C-173/04 P Deutsche SiSi-Werke v OHIM

[2006] ECR I-551, paragraph 27; Storck v OHIM, paragraph 26, and Case C-144/06 P Henkel v OHIM [2007] ECR I-8109, paragraph 36).

46. 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 designates. 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 distinctive character in relation to such a three-dimensional mark than in relation to a word or figurative mark (see, in particular, Mag Instrument v OHIM, paragraph 30; Deutsche SiSi-Werke v OHIM, paragraph 28, and Storck v OHIM, paragraph 27).

47. 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 (see, in particular, Mag Instrument v OHIM, para 31; Deutsche SiSi-Werke v OHIM, para 31, and Storck v OHIM, para 28).

28. When considering whether a mark departs significantly from the norms and customs of the trade, I refer to the three steps identified by Lord Justice Kitchen in [2017] EWCA Civ 1729, London Taxi and paragraph 45:

45. The first step in the exercise is to determine what the sector is. Then it is necessary to identify common norms and customs, if any, of that sector. Thirdly it is necessary to decide whether the mark departs significantly from those norms and customs.

29. It would appear that when determining if a shape mark is inherently distinctive the CJEU may be (but as I have said, it is not *acte clair*), saying that the only necessary and sufficient test is whether the shape departs significantly from the norms and customs of the sector. However, whilst the UK Courts seem to acknowledge that the question of 'departing significantly from the norms and customs' may be a necessary test, they do not appear to agree that it is also a 'sufficient' test. In other words, it is only the statutory test of being 'devoid of distinctive character' (from a trade mark perspective) that matters rather than any Court substituted test of 'differing significantly'. The UK Courts' perspective also appears to differentiate between the concept of distinctiveness *per se* (i.e. the ability to stand out in a general sense), and distinctiveness in the trade mark sense (i.e. denoting trade origin). In this

regard, it is worth noting the following comments from Kerly's, 16th Edition, Chapter 10:

10-35 The essential function of a trade mark is to distinguish the goods and/or services of one undertaking from those of other undertakings and the term "distinguish" must be understood in that way. The attribute of a trade mark which gives it the necessary ability to "distinguish" is its distinctive character, but the assessment of distinctive character is really an assessment of whether the sign/trade mark can distinguish in the sense just mentioned.

10-36 Problems arise if the term "distinguish" is used or understood more loosely. The examples given below demonstrate that "distinguish" can and has been used to mean different things. First, there is the correct meaning: see the citations from the Court of Justice judgments set out above.

10-37 Secondly, the term "distinguish" can be used in the sense of "different". In the past, this meaning tended to be used (especially in CFI judgments) in cases involving the shapes of goods or their packaging, where the applicant frequently argues to this effect: "my mark has (the minimum degree of) distinctive character because it can clearly be distinguished from others in the market." This type of argument is utterly bogus. It amounts to nothing more than saying that "my mark is different". Deployment of this type of argument is a clear sign that the mark does not have distinctive character.

10-38 Thirdly, "distinguish" or "distinctive" is used in the sense of "standing out", likely to attract the attention of the consumer. This is a slight variation on "different", in that the mark is now adjudged to be sufficiently different such that it attracts the attention of the consumer. However, there are many things which will attract the attention of the consumer (bright or garish colours, snazzy graphics, bold claims) which have nothing to do with distinctive character. The usefulness of this concept depends entirely on whether the consumer's attention is attracted in the right "trade-origin message" manner.

10-39 Fourthly, the term "distinguish" is used in the "recognition" sense. Again, this may be only a slight variant on the above, but it has a greater aura of respectability because it involves the average consumer. Thus, the applicant argues to this effect: "my mark has distinctive character because the average consumer would recognise it, thereby enabling him or her to repeat the purchasing experience if positive or avoid it if negative." The CFI has correctly rejected recognition as being sufficient in some cases, e.g.: 49 The fact that consumers may get into the habit of recognising such a product from

its get up is not enough to preclude the ground for refusal based on Article 7(1)(b) of the Regulation – Unilever v OHIM (T-194/01).

30. It is therefore clear from these comments that from the UK's perspective, simply being different or standing out is not sufficient for establishing distinctiveness in a trade mark sense.

Application of Legal Principles

31. When considering how the relevant consumer will perceive the mark I have taken into consideration the fact that consumer perception 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, and furthermore, 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 (Henkel, Freixenet SA). The sign applied for consists of the shape of an item of footwear, being the shape of the goods themselves.
32. The specification covers orthopaedic footwear in Class 10 and general footwear, including clogs, in Class 25. The sector in which these goods would be offered is clearly the footwear sector. Such goods are offered to the general public at large, including those goods which are adapted for orthopaedic purposes. Beyond the fact that shoes must be shaped to fit to and stay on the foot, there are a huge array of options in relation to how these goods might be shaped, adorned etc.
33. The sign applied for consists of the shape of an article of footwear to be worn on the right foot. The shoe has a clog-like appearance which is open at the heel, has a strap and has a series of holes on top where the toes would fit reaching up towards the ankle. The footwear has been left plain in that there are no words, logos, or other forms of adornment placed on it.
34. From my personal knowledge, I am aware that there are other undertakings offering clog styled shoes which may not necessarily be identical to (for example in relation to the number of holes on top) but are similar to the shape as applied for. I believe it is acceptable to use my own experience of the marketplace, paragraph 20 of BL O/0568/26 refers:

I do not agree. The distinctive character of a mark, or the lack of it, is something a Hearing Officer must evaluate, for better or worse, on the basis of the materials before them. The Hearing Officer "is in the position of a notional juror, using his or her own common sense and experience of the world": GE Trade Mark [1973] R.P.C. 297 , 321. The tribunal is an expert tribunal and the starting point is one of respect for its assessment. Further, As Mr. De Froment himself cited to me (albeit

in support of his own argument) in Major League Baseball Properties Inc. v Vinelight Holdings LLC BL O/0662/25, Phillip Johnson AP stated:

21. In the absence of evidence, Hearing Officers have to make factual findings based on their own experience of the marketplace. The parties have an opportunity to file evidence and make submissions, but in most cases there will be things the Hearing Officer has to decide for which there is no evidence neither was the issue substantively addressed in submissions. In such cases, Hearing Officers simply have to do the best they can. A decision cannot be overturned merely because (in the absence of evidence) an appellate tribunal might have made a different factual finding from that of the Hearing Officer: O2 Holdings Ltd's Trade Mark Application [2011] RPC 22 at [60]. In any event, I am not sure I would make a different finding if it had been open to me to do so."

35. Whilst the above case relates to an assessment of distinctiveness it is clear that such an assessment in this case engages the question of norms and customs in the trade; namely that I am required to make such an assessment. Further, that regardless of my personal view, relevant information has been provided in the third party observations. I note that the applicant, in their letter dated 21st October 2025, challenged this information. In particular, the applicant has drawn attention to the differences in shape between the various clog-styled shoes provided in the observations, though there is some admission that some of the shoes shown are more similar in shape such that the applicant is seeking to take action against lookalike products.

36. In relation to the challenge around the similarity between the products I am mindful that whilst the consumer is well informed and reasonably circumspect, they would not conduct an analytical examination of the goods in order to identify features which differ between the products of different undertakings. This is confirmed in C-136/02 Mag Instrument v OHIM, paragraph 32:

It must always be determined whether such a mark permits the average consumer of that product, who is reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention.

37. In my view, the examples of clog shoes shown in the third party observations demonstrate that products with a similar shape are available in the marketplace and were likely to have been available at the time of filing.

38. For all of the reasons outlined above, that being from my own knowledge of the marketplace, and from the information provided in the third party observations, the sign does not, in my opinion depart from the norms and

customs in trade at the time of filing of the application. Therefore, it would only be seen as designating the shape of the goods. The sign lacks inherent distinctiveness and is unacceptable in the prima facie.

39. However, the position surrounding the norms and customs test is not *acte clair*, as mentioned previously in this decision and is confirmed in decision BL O/555/22 (the Device of a Lawnmower case), paragraphs 63 and 64:

As for the precise nature of the test, and whether it is necessary or necessary and sufficient, it is not necessary for me to decide that based on my findings above. Therefore, I will make only the following necessarily tentative observations.

First, the ultimate test is the one set out in the statute – the norm and customs test is merely a means to answering the statutory question in shape mark cases, and should be treated accordingly.....

40. If I am therefore wrong in relation to my finding on the norms and customs in trade at the time of filing, a contingent finding is necessary in line with the statutory test, i.e. does the mark have a distinctive character that would allow consumers to identify the brand origin of the goods? In this regard, my view remains that the sign lacks distinctive character in the prima facie as it would not, without education, indicate origin to consumers.
41. I am mindful also that whilst the applicant did not concede that the mark lacks distinctive character in the prima facie, they chose not to make submissions on this. I believe this supports my view that the sign does not have a distinctive character as it would merely be seen as a representation of the goods.

Acquired distinctiveness and the relevant legal principles

42. Section 3 of the Act states that a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) of the Trade Marks Act 1994 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.
43. The guiding principles when assessing evidence to demonstrate acquired distinctiveness are set out in *Windsurfing Chiemsee* (Joined cases C-108/97 and C 109/97):

51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and longstanding use of the mark has been; the amount invested by the undertaking in promoting the mark; the

proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from Chambers of Commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgments (see, to that effect, Case C-210/96 Gut Springenheide and Tusky [1998] ECR I-4657, paragraph 37).

44. The way in which an inherently non-distinctive mark may acquire a distinctive character was elaborated upon by the CJEU in Case C-299/99 Koninklijke Philips Electronics NV v Remington Consumer Products Ltd [2002] ECR I-5475 at paragraph 64:

...the identification, by the relevant class of persons, of the product as originating from a given undertaking must be as a result of the use of the mark as a trade mark and thus as a result of the nature and effect of it, which make it capable of distinguishing the product concerned from those of other undertakings.

45. In other words, an inherently non-distinctive mark can only acquire a distinctive character if the maker or supplier of the goods and services concerned uses the mark in such a way that it comes to guarantee to consumers that the product originates from a particular undertaking. I must therefore assess the evidence and determine whether a significant proportion of relevant consumers have come to perceive the mark as designating the goods of a single undertaking and that it serves to distinguish those goods from those of other undertakings as a result of the use made of it. In that respect, such use must be use as a trade mark, in other words, it must be used in a manner that enables the relevant consumer to perceive the goods designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular undertaking.

46. In Case C-353/03 Société des Produits Nestlé SA v Mars UK Ltd [2005] ECR I 6135 the CJEU has also held that a non-distinctive mark may have acquired

distinctive character if it has been used as part of or in conjunction with a registered trade mark.

26. In regard to 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 (judgment in Philips, paragraph 64).

27. In order for the latter condition, which is at issue in the dispute in the main proceedings, to be satisfied, the mark in respect of which registration is sought need not necessarily have been used independently.

28. In fact Article 3(3) of the directive contains no restriction in that regard, referring solely to the ‘use which has been made’ of the mark.

29. The expression ‘use of the mark as a trade mark’ must therefore be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking.

30. Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.

47. I refer also to the comment in *Bach and Bach Flower Remedies Trade Marks* [2000] RPC 513 at paragraph [49] (per Morritt LJ with whom Thorpe and Chadwick L.JJ agreed):

... use of a mark does not prove that the mark is distinctive. Increased use does not do so either. The use and increased use must be in a distinctive sense to have any materiality.

Application of the case law

48. The evidence of acquired distinctiveness filed on 13th November 2024 had been considered previously by another hearing officer. In handling the application following the late objection, and throughout the hearing process, I have considered matters afresh for myself (but inevitably including all materials supporting the case for acquired distinctiveness) and arrived at my own independent view. It may at first sight appear odd that in considering, in part at least, the same materials, two hearing officers may arrive at different conclusions. That said, the original hearing officer did not have the benefit of the observations in his deliberation and the applicant raised no challenge to

the registrar's right to resile from the original conclusion based on the fact that no obvious finding had been made in relation the norms and customs of the trade.

49. The evidence provided on 13th November 2024 included:

- A witness statement from Trevin David, Vice President Regional General Counsel at Crocs plus exhibits.
- A witness statement from Lauren Ensign, Trade Mark Attorney at Bird & Bird LLP, plus exhibits.
- A witness statement from Alex Kessler, Fashion News Editor at British Vogue.
- A witness statement from Navi Ahluwalia, UK Editor at Hypebae.
- A witness statement from Mark Wilcock, Footwear Product Director at Footasylum Ltd.
- A witness statement from Anne S. Gallagher, Executive Director at Luxury Law Alliance.
- A witness statement from Ciara Hughes, Associate at Bird & Bird LLP, plus exhibit.

50. Further evidence was filed on 21st October 2025 alongside the applicant's response to the third party observations and late objection. This took the form of a second consumer survey, undertaken by Appinio.

51. In the covering letter with the evidence filed on 13th November 2024, the applicant describes the sign as a 'Classic Clog' and outlines that it was designed in 2002 and has been continuously on sale since that time. They describe the shape as having been an 'intrinsic feature of the Crocs brand from the outset'. Crocs sold around 120 million pairs of shoes in over 80 countries in 2023 alone. The company has an annual revenue of \$4 billion worldwide and claims to be one of the world's largest casual footwear brands. The shape which is the subject of the application is claimed to be Crocs' 'most important and successful product'.

52. Insofar as the UK market is concerned, Trevin David (Vice President Regional General Counsel at Crocs) sets out in his witness statement that:

- a. Originally Crocs had a single global website but a specific UK site has since been developed.
- b. In the UK, Crocs has had a turnover in relation to the Classic Clog of 4.3 million Euros in 2015, rising to over 69 million Euros in 2023. The total units sold was 330,000 in 2015, rising to 3,360,000 in 2023. (Exhibit TD5 refers).
- c. That there are sales throughout the UK, in particular, it is noted that national stores such as Footasylum Ltd and JD Sports Fashion PLC appear among the invoices provided in Exhibit TD6.

- d. Expenditure on marketing in the UK in 2015 was 70,000 Euros and rose to 455,000 Euros by 2022. Expenditure in 2023 on marketing was in the minuses in the UK, I can only assume that this is due to the way marketing costs are covered by subsidiary companies, as outlined in Exhibit TD7.
- e. Marketing is carried out on numerous social media platforms such as Facebook®, Instagram® and TikTok®. All of the sites attracting millions of followers. (Exhibits TD8, TD9 and TD10 refer).
- f. Crocs has won numerous awards over the years, including 'UK Footwear Brand of the Year' in 2007 amongst others.

53. The witness statement of Lauren Ensign (Trade Mark Attorney at Bird & Bird LLP) sets out the process by which she undertook the Shopping Centre survey. That is that she was instructed to obtain 100 valid responses at Westfield London, a shopping centre in West London. Colleagues at Bird & Bird LLP had devised the survey and the marketing team helped to format it for display on an iPad. Participants were shown four shoes: a Birkenstock sandal; a generic clog; a Crocs classic clog; and a Dr. Martens boot.

54. Participants were members of the public approached by Ms Ensign. She ensured that she included a range of ages and genders and estimates that the age range was from 18 years old to around 70 years old.

55. Point 8 of the witness statement of Lauren Ensign explains that participants were asked to 'type the name of the brand they **associated** with each shoe design' (*my emphasis*). If they were unsure, they were asked to answer 'I don't know'. Participants were not informed of the real reason behind the survey, other than it was for market research purposes for a client. The client was not identified.

56. The results of the survey were that 65% recognised the Birkenstock shoe, no brand was associated with the generic clog, 93% recognised the Crocs shoe and 63% recognised the Dr. Martens boot.

57. The witness statement of Alex Kessler, a previous Fashion News Editor of British Vogue, confirms that he believes that the sign applied for should be considered a product 'originating from Crocs' based on the shape alone. It is his opinion that consumers when encountering the shape would presume it was from Crocs.

58. The witness statement of Navi Ahluwalia, UK Editor at Hypebae, states that they have worked with and written about footwear brands over a number of years and insists that the Crocs Classic Clog is one of the most instantly recognisable shoes. The shape has become synonymous with the brand.

59. The witness statement of Mark Wilcock, Footwear Product Director at Footasylum Ltd, states that the classic clog is instantly recognisable as a Crocs product, has become iconic and is 'only' associated with Crocs.
60. The witness statement of Anne S. Gallagher, Executive Director of Luxury Law Alliance states that the shape is 'unique and instantly recognisable' as a Crocs product.
61. The witness statement of Ciara Hughes, an Associate at Bird & Bird LLP, presents an extract (Exhibit CH1), from the V&A website which shows a pair of shoes made by the applicant featuring the shape of the Classic Clog from the Young V&A Collection. A description and summary accompanies the image of the shoes. It is stated that *'Crocs, perhaps because of their unusual appearance have become a hugely popular international brand and have been replicated by many other manufacturers globally'*.
62. There were many exhibits provided both with the original evidence filed on 13th November 2024 and with the additional evidence of 21st October 2025, including a video clip of an advert depicting the shoes. I note that the shoes shown within do not have the word 'Crocs' on them, however they have the Crocs logo on the button on the strap.
63. It is clear from all of the above that the shape has been used for a significant amount of time, it has generated an impressive turnover and is no doubt widely **recognised** by a significant percentage of the average consumer. However, as I have pointed out in my hearing report, this is not necessarily sufficient when considering marks which consist of the shape of a product. The courts have been quite clear that it is not sufficient that consumers associate a shape with a brand (paragraphs 77 and 78 of *Société des Produits Nestlé and Cadbury UK Ltd, [2017] EWHC Civ 358* refer), it must be demonstrated that they rely on the shape alone to identify the origin of the goods. As I pointed out in my hearing report dated 23rd March 2026, this is a high bar and there are numerous other decisions which support this view, as 23rd March 2026¹.
64. During the hearing, I asked the applicant if they were aware of any decisions from the Appointed Persons or courts in which the shape of a product was deemed to be capable of functioning as a trade mark. The answer was negative. Whilst this in and of itself is of course not determinative and it cannot be said that there is an outright bar to the registration of marks that consist of the shape of a product, equally, it could not be said that in the UK at least, there is a predisposition towards the registration of such marks based

¹ Kit Kat (*Societe des Produits Nestle SA v Cadbury UK Ltd [2017] EWHC Civ 358*), the London Taxi (*The London Taxi Corporation v Frazer-Nash Research Ltd [2017] EWCA Civ 1729*), the Husqvarna lawnmower (BL O/555/22) and the Diabetic Patch (*Abbott Diabetes Care Inc vs Sinocare Inc & Ors [2025] EWHC 206 (Ch)*).

on acquired distinctiveness or at least, there is ample guidance on when such a sign might be considered to meet with the requirements for registration.

65. I now consider specifically the two surveys and their impact of the evidence taken as a whole.

Surveys

66. Surveys must be conducted in line with the Whitford guidelines, in *Imperial v Philip Morris* [1984] R.P.C 293 and set out in Kerly's Law of Trade Marks and Trade Names 17th Ed (see paragraph 23-031):

- (1) All surveys conducted, their methodology and results must be disclosed.*
- (2) The totality of all answers must be disclosed.*
- (3) The questions asked must not be leading.*
- (4) The questions asked must not lead the interviewee into a field of speculation upon which they would not otherwise have embarked.*
- (5) Exact answers and not abbreviations must be provided.*
- (6) Coding must be accurately carried out, and the coding methods disclosed.*
- (7) The instructions given to the interviewers must be disclosed.*

67. I am also mindful of the guidance in the recent case of *Abbott v Sinocare* and others [2025] EWHC 206 (Ch), para 128, refers:

Again, there did not appear to be a real difference between the parties as to the applicable legal principles concerning the use of surveys in a trade mark context, as to which, the following were indicated by the authorities cited to me:-

- (a) A survey as to confusion is unlikely to be of real value where the goods or services in question are ordinary consumer goods or services and the Court feels that there will be no real difficulty in determining the issue of confusion without one;*
- (b) A survey as to acquired distinctiveness may have more utility since the Court may feel that it is not able to determine such a dispute based on its own experience and/ or the Court may feel the need to guard against an idiosyncratic decision;*
- (c) Cases likely to be of real difficulty include those where the mark in question is not a traditional one or where a traditional mark has been used in conjunction with another trade mark and the survey is designed to assist with the question whether the former, by itself, has acquired distinctiveness;*
- (d) Reliance on evidence of use alone to show distinctiveness for a non-traditional mark without survey evidence is extremely difficult;*

(e) Likewise, a survey alone may be insufficient to show acquired distinctiveness but it may provide valuable confirmatory support where the relevant mark has been used extensively;

(f) The Court will be circumspect when considering whether a survey is able to show distinctiveness of a trade mark as a badge of origin as opposed to its recognition and association with the products of the holder of the mark; and

(g) Likewise, the Court will be concerned to ensure that the survey tests whether the mark holder is indicated exclusively as opposed to merely the first one that comes to mind; it may find useful further information ruling out third party association.

68. This is taken to be fair summation of the treatment of surveys in relation to matters of acquired distinctiveness. In particular, the need for circumspection is noted (point (f) above) as well as the requirement to show exclusivity (point (g) above). The Judge also reminds us of the Whitford methodological guidelines in relation to such surveys presented in Court matters. Despite the fact this is an ex parte matter it seems reasonable to adopt the above guidance.

69. In the Shopping Centre survey, participants were provided images of different shoes: a Birkenstock sandal; a generic clog; a Crocs Classic and a Dr Martens boot. The results provided show that 93% of respondents recognised the Croc, with 65% of recognising the Birkenstock and 63% recognising the Dr Marten. I note these are very different types of shoes and I wonder if the results would be quite as stark had participants been provided with images of different clogs.

70. It is noted that a second survey was commissioned by the applicant, following the late objection being raised and prior to the ex partes hearing with myself. The survey was conducted by Appinio, an independent survey company with a panel of 1,802,499 participants, as at January 2025, according to the applicant. The survey was undertaken using 1,000 participants in the UK aged between 18 - 65 years old. Though the applicant, in their letter of 16th February 2026, describes the participant base as selected as 'a nationally representative distribution based on age and gender', it is not entirely clear what other criteria was used to select the participants, i.e. was this just a random selection from the overall panel base or were other criteria used in the selection.

71. The first question in the Appinio survey was open ended. Participants being asked what comes to mind when presented with the sign as applied for. 52.7% of participants responded 'Crocs'.

72. When asked in question 3 'if you saw this product in a store (or in an ad), what would you think it was?' 46.6% of people also answered 'Crocs'.
73. Question 5 asked 'which brand or company name did you identify', the result being that 97.6% responded 'Crocs'. This question only being posed to the 620 people who indicated that they identified a brand in question 4.
74. 76% of people indicated that they would be surprised to learn that the product shown was not Crocs and when asked why they answered in the way they had, most responses indicated that participants felt that the product looked like 'Crocs'. It could be argued that this question is leading which would conflict with the Whitford criteria. It asks participants to speculate. I think that if this question was designed to show that the shape was exclusively regarded by consumers as a trade mark of a single undertaking, this could have been achieved more persuasively had the interviewees been presented with a blind test. Namely, that of a series of similar looking shoes, consumers were asked to identify Crocs and were, in statistically significant proportion, able to do that.
75. In sum, overall, both surveys suggest a high level of recognition for the shape of the shoe, however, I am mindful of the comments in paragraph 89 of the Kit Kat case:

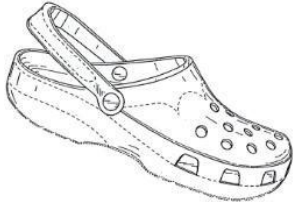
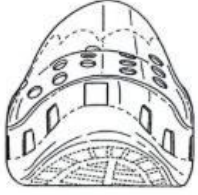
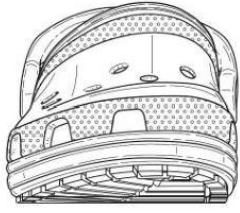
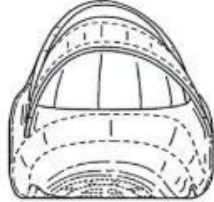
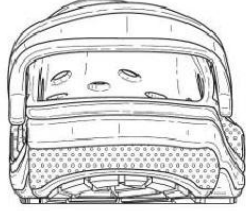
*The hearing officer therefore rightly paid particular attention to the second survey. He considered for himself the responses to it and, in light of the other evidence before him, came to a reasoned conclusion as to what it established. The high point for Nestlé is his finding that at least half the people surveyed thought that the picture shown to them was a Kit Kat. **But in giving their responses they might have had in mind a product coming from the same source as Kit Kat or a product of the Kit Kat type or a product which looked like a Kit Kat.** The hearing officer was therefore entitled and indeed bound to consider the results in light of all of the other evidence before him. I am also satisfied he was entitled to conclude as he did that Nestlé had shown recognition and association of the shape with Kit Kat but had failed to prove that the shape (and hence the Trade Mark) had acquired a distinctive character in light of the use which had been made of it.*

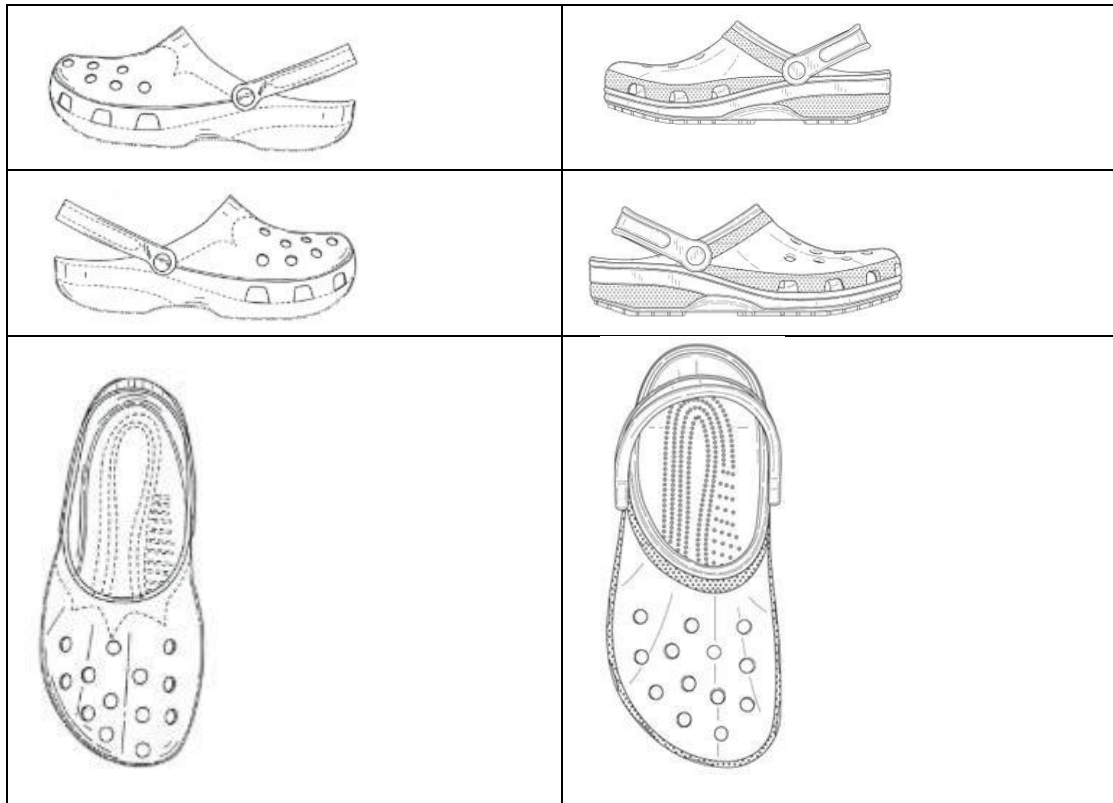
76. Despite the surveys demonstrating a strong recognition for the shape of the shoe, and an association with Crocs, I am not convinced that they, taken along with the body of evidence overall, demonstrate that consumers would rely on the shape alone, and nothing further, to indicate the origin of the goods.
77. **In summary I have conclude that, taking the evidence as a whole and the case law which guides me, the case for acquired distinctiveness has not**

been made out. Before I draw matters to a final conclusion there is the question of motivation in filing the application which has been raised by the observer.

Motivation of the Applicant

78. The third party observations raise concerns over the motivation of the applicant in applying to register the sign as a trade mark. It is alleged that the applicant holds a number of design registrations for the shape of the shoe (some of which will soon expire), and that by applying to register it as a trade mark, they are attempting to obtain a monopoly over the design. At hearing I asked if the sign was in fact registered. Such a factor may have been relevant to my considerations around the norms and customs in trade to some extent. I was informed, both verbally at hearing, and in the applicant's written submissions of 16th February 2026, that the specific shape was not the subject of a design registration.
79. The applicant holds Community registration 257001-001 (and comparable UK design 90002570010001). The images are shown in the table below alongside the representations which accompany the current trade mark application.

RCS 257001-0001	TM 4026119
Application Date: 22nd November 2004	Application Date: 14th March 2024
	
	
	



80. There are some visible differences between the two shapes but I feel I need not comment any further on this, nor on the motivation of the applicant in applying to register the sign. Whilst the third party observations suggest that an objection ought to have been raised under section 3(2)(c) of the Act, no such objection has been raised. I would also note that any consideration around the motivation of the applicant may stray into an allegation of bad faith. Again, such an objection has not been raised and I am mindful that an allegation of bad faith is a serious one and the bar for such a finding is a high one and requires an assessment of the objective intentions of the applicant of which I am not aware.

81. My considerations have concentrated purely on whether I believe that the sign is relied upon by consumers to identify the origin on the shoes. That is, I have considered whether the sign is able to fulfil the basic requirement of a trade mark in that it would allow a consumer to differentiate the applicant's goods from those of another undertaking.

Conclusion

82. In this decision, I have considered all documents filed by the applicant, and all arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused because it fails to qualify under section 3(1)(b) of the Act.

Dated this 23rd day of July 2026

**Morwenna Bell
For the Registrar
Comptroller-General**

