

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2102708  
BY INLIMA S.L.  
TO REGISTER A THREE DIMENSIONAL TRADE MARK  
IN CLASSES 32 & 33

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 46387  
by ADIDAS AG.

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2102708  
BY INLIMA S.L.  
TO REGISTER A TRADE MARK IN CLASSES 32 & 33

5

AND IN THE MATTER OF OPPOSITION THERETO  
By ADIDAS AG

### BACKGROUND

10

On 14 June 1996, Inlima S.L. of 16 Julio, 54 (Polg.Son Castello), 07009 Palma De Mallorca, Spain applied under the Trade Marks Act 1994 for registration of a three-dimensional trade mark (reproduced below) in respect of the following goods:

15

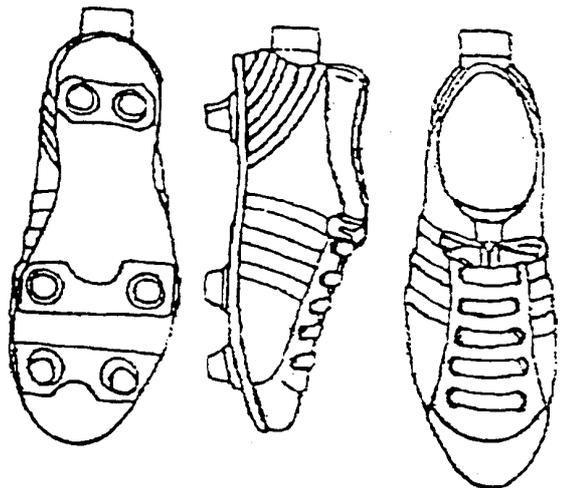
Class 32: "Beer, mineral and aerated water and other non-alcoholic drinks; syrups and other preparations for making beverages."

Class 33: "Wines and liqueurs."

20

25

30



35

The mark consists of a 3 dimensional shape.

On the 6 February 1997 Adidas AG filed notice of opposition to the application. The grounds of opposition are:

40

1) The opponents are the owners of a Three Stripes Device trade mark which consists of three equally spaced stripes, each of the same colour and width, which appear on the outside of the uppers of footwear. The opponents have been using the Three Stripes Device trade mark in the United Kingdom in respect of footwear for very many years and the mark has acquired a substantial reputation in the UK and throughout the world and is well known as denoting the products of the opponents. Indeed it is a "famous mark".

45

2) The opponents' mark is entitled to protection under the Paris convention as a well-known trade mark in accordance with the provisions of Section 6(1)(c) of the Trade Marks Act 1994.

5 3) The applicants' Device trade mark which is the subject of application No 2102708 is similar to the opponents' Three Stripes Device mark in so far as it includes a 3 stripes device on footwear which is substantially identical to the opponents' mark and the use and registration of the applicants' mark is calculated to injure, and is likely to cause damage to, the business and goodwill of the opponents.

10 4) The application is open to objection under Section 5(3) of the Trade Marks Act 1994 on the ground that it is similar to the following existing registrations belonging to the opponents:

15 No 2027687 advertised in Trade Mark Journal No 6141  
No 2027689 advertised in Trade Mark Journal No 6134

Use of the applicants' mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the opponents' earlier trade mark.

20 5) The application is open to objection under Section 5(4) of the Trade Marks Act 1994, in that use of the mark applied for is liable to be prevented by virtue of the law of passing-off.

25 6) The application is open to objection under Section 3(3)(b) of the Trade Marks Act 1994 on the ground that the mark is of such a nature as to deceive the public as to the origin of the goods.

30 The applicants subsequently filed a counterstatement denying all of the grounds of opposition. Both sides ask for an award of costs.

Both sides filed evidence in these proceedings and the matter came to be heard on 15 April 1999 when the applicants were represented by Mr Gordon of R J Gordon & Co., their trade mark agent, and the opponents by their trade mark agent, Mr Ellis-Jones of J A Kemp & Co.

#### 35 OPPONENTS' EVIDENCE

40 This consists of a statutory declaration by Mr Robert Balfour McCulloch, dated 23 July 1997, the Managing Director of Adidas (UK) Ltd, a position he has held for four years. Adidas (UK) Ltd is a wholly owned subsidiary of Adidas AG.

45 Mr McCulloch states that the opposition is based upon two registrations 2027687 & 2027689 registered on 20 July 1995. Basically, these both consist of three contrasting stripes and are registered for "Footwear; sports shoes; shoes for casual wear" (copies at annex A). They were both registered on the basis of substantial evidence of distinctiveness. At exhibit RBM/2 is a copy of Mr McCulloch's earlier statutory declaration in connection with the trade mark application No 2027689. The large numbers of exhibits which formed part of this declaration

are retained in the public file for application number 2027689.

In this earlier statutory declaration Mr McCulloch provides a potted history of the company. He states that the “three stripe mark” (TSM) was first used in 1949. The company adopted the slogan “the mark with the three stripes”, and emphasised this aspect in it’s advertising and promotional literature.

A list of top-level sports competitions, eg the Olympics and World Cup, covering a forty-two-year period where it is claimed that the majority of participants wore the TSM is provided. Mr McCulloch states that in the UK the TSM has been used on footwear continuously since 1955. Sales figures are provided for the period 1961 - 1995. I have chosen to show only the last ten years as this period is most relevant. I have also shown an amalgam of advertising and sponsorship expenditure for the last six years ( no figures being available for the period 1986 - 1989).

Year	Sales £	Advertising £
1986	30,998,000	
1987	41,080,000	
1988	33,200,000	
1989	35,000,000	
1990	43,000,000	2,577,000
1991	50,500,000	2,746,000
1992	38,322,075	4,445,000
1993	33,094,750	4,181,000
1994	34,704,000	3,661,000
1995	40,114,200	6,941,000

All of the sales figures relate solely to TSM products, but the advertising figures include other brands although the TSM would be substantially represented.

It is claimed that the TSM products are extensively available via sports shops, mail order from catalogues such as GUS, Littlewoods, Grattans, Freemans, & Empire Stores, as well as from specialist sports mail order catalogues. The advertising has been via national and local press, magazines (particularly sporting magazines), posters, leaflets and sponsorship of athletes.

Mr McCulloch states that the opponents’ TSM products are worn by a number of leading sportsmen and sportswomen and are seen each year by millions of fans at the sporting events, watching on television and also from pictures in the press. He also claims that the TSM has achieved a cult following and is worn by a number of celebrities unconnected with sports ie actors. Mr McCulloch also refers to a survey conducted by NOP in June 1995. Respondents

were shown a trainer bearing only the TSM and asked whom they thought the manufacturer was. The result was that 89% of respondents shown the trainer correctly identified the manufacturer, as Adidas. Of these, 75% gave the TSM as the reason for their identification. The same respondents were then shown a Reebok trainer identified only by the crossed line device, and 71% identified the manufacturer correctly as a result of its device mark. Mr McCulloch states that this survey demonstrates the strong distinctive character of the TSM for footwear, and indeed device marks on sports footwear.

It is claimed that since 1967 the opponents have also sold clothing under the TSM brand. Mr McCulloch says "...Adidas sports clothing bearing this mark has been sold in very substantial quantities in the UK and has been extensively advertised and promoted. This mark is registered in the name of Adidas AG in the UK under number 1240808. This trade mark, and the reputation associated with it, underlies and strengthens the distinctiveness of the TSM for footwear."

Further, he points out that the Adidas group has registrations for the TSM for footwear in France, Germany, Spain, Italy, Benelux, Austria, Denmark, USA & Canada. He claims that the sports footwear industry is now dominated by a few manufacturers who are internationally known due to high profile advertising and promotion.

Finally, Mr McCulloch states that the TSM in relation to footwear has been used by his company for "some 40 years and is now very widely recognised and exclusively associated in the UK with Adidas footwear." He also claims that the applicants' mark "consists of a three-dimensional shape of a football boot with three equally spaced stripes appearing on the outside of the uppers of the boot. As such, I believe that the mark is similar to the trade mark belonging to Adidas AG and which is the subject of the registrations No 2027687 & No 2021689."

#### APPLICANTS' EVIDENCE

This consists of a statutory declaration, dated 17 October 1997, by Jose Manuel Munoz Monroy the general manager of Inlima S.L.

Regarding the opponents' claim to be the proprietors of a '3 stripe trade mark' Mr Monroy comments that "According to my understanding, a 'stripe' is a band of uniform breadth on a surface from which it differs in colour or texture. If there is any doubt about this, the disclaimer entered on the Registration Certificates of the two trade mark registrations No 2027687 and 2027689 (exhibit RBM/1) clearly specifies that each of the two marks is restricted to the colour contrast between the stripes and the surface on which they are carried." He then describes the coloured illustration of his company's trade mark at exhibit ES1. He states that:

"It is clear, from the illustration that the Inlima mark is a three-dimensional shape. It is a glass bottle in the form of a football boot, the neck of the bottle extending rearwardly of the heel. It is apparent that the three-dimensional shape is of a single colour (black) including all of the embellishments.

5 The purpose of the mark is to provide a bottle having a shape which would be of interest to followers of the game of football and also to provide surfaces, eg the flat upper surface and the opposite sides between embellishments at the heel and embellishments on either side of the instep, for carrying stickers depicting illustrations of famous footballers and their club colours and regalia. The embellishments and the stickers follow the line of the spaced parallel embellishments at the heel.

10 Clearly, it would not be advisable to provide the bottle, including the embellishments, in anything other than a single dark colour since, otherwise, it would detract from the detail of the stickers.

15 The embellishments are not 'stripes' because they are not of a colour contrasting with the surrounding surfaces. The embellishments are indicated in the line drawings which comprise representations of the Inlima mark as published on page 13780 of Trade Marks Journal No 6150; they are not of a colour contrasting with a background."

Therefore, Mr Monroy claims, the application is not for a football boot with three equally spaced stripes on the outside of the uppers as claimed by the opponents.

20 Further Mr Monroy points out the difference between the goods of the opponents and the goods covered by his company's application, and comments that trade marks must always be considered in relation to the goods for which they are registered. Whilst accepting that the opponents have used the TSM for some time on items of footwear, he disputes that the TSM is either "well-known" or "famous". He reiterates that confusion is not possible as his  
25 company's mark does not comprise of three stripes and is not proposed to be used in respect of footwear, and the mark is clearly not an item of footwear. He also points out that the trade channels for his company's products are very different to those of the opponents.

30 Mr Monroy claims that the same three trade marks that feature in this dispute have been registered in Spain and have coexisted for seventeen years without any complaint from the opponents. Copies of the applicants' and opponents' Spanish Trade Mark Registrations are provided (although these are all in Spanish with no translation provided).

35 That concludes my review of the evidence. I now turn to the decision.

## **DECISION**

The first ground of opposition is under Section 3(3)(b) which states:

- 40 (3) *A trade mark shall not be registered if it is -*
- (a) *.....*
  - (b) *of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).*

45 The opponents' evidence does not contain any arguments that the public would be deceived as to the nature, quality or geographical origin of the products if the mark were applied to any of

the applicants' goods. Any deception arising from the applicants' use of their mark falls to be considered under Section 5. The ground of opposition under Section 3(3)(b) therefore fails.

Next, I turn to the grounds of opposition under Section 5(3) which states:

5                   5 (3) *A trade mark which -*

                  (a) *is identical with or similar to an earlier trade mark, and*

10                  (b) *is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,*

15                   *shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.*

20 An earlier right is defined in Section 6, the relevant parts of which state

                  6.- (1) *In this Act an 'earlier trade mark' means -*

25                   (a) *a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,*

                  (b)...

30                   (c) *a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark."*

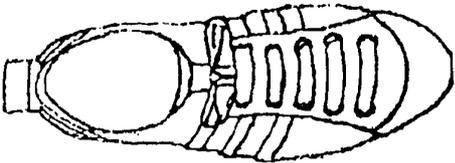
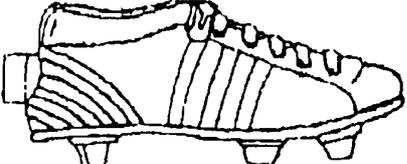
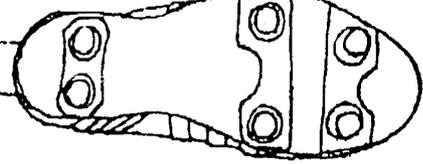
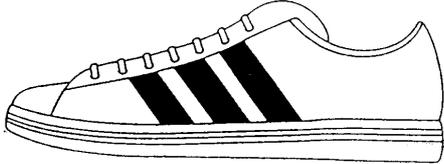
35 The opponents are the registered proprietors of two trade marks (numbers 2027687 and 2027689) registered in the UK on 20 July 1995, prior to 14 June 1996, the relevant date. The opponents have offered considerable evidence regarding their TSM. In the past ten years annual sales have averaged over £38million per annum. No figures are given for the total sports / leisure footwear market or the opponents market penetration. The opponents also refer to a survey undertaken when seeking to register their marks in which a substantial majority of respondents recognised the articles of sports footwear by their device markings and specifically recognised the TSM as used on the opponents' goods. They have also provided evidence of their extensive advertising and sponsorship, which has resulted in their products being seen in the context of successful sportsmen and women.

45 The applicants whilst accepting that the opponents have prior registrations, dispute that the opponents' mark is well known or famous. At the hearing Mr Gordon stated that the TSM was "of interest only to people who are involved in sport, but it is not widely known". He also stated "You could have three stripes in toothpaste, three stripes running down the side of a

car, but it would not mean Adidas”.

I do not accept the view that the sports shoes, as produced by the opponents, are of interest only to those involved in sport. They are, and have been for many years, a standard item of leisure wear, worn by all age groups. The leisurewear industry covers a very large percentage of the population. The opponents have provided figures which show that they enjoy substantial sales and that they actively promote the TSM device. They are therefore known by to a significant part of the general public, not just those involved in sporting activities. I therefore consider the opponents to have established that they enjoy a considerable reputation in the TSM.

I must now consider whether the marks are similar. For ease of reference the marks are reproduced below:

15 APPLICANTS' MARK	OPPONENTS' MARKS
<div data-bbox="180 824 635 987">  </div> <div data-bbox="180 1025 587 1189">  </div> <div data-bbox="180 1227 603 1391">  </div> <p data-bbox="180 1624 603 1653">The mark consists of a 3 dimensional shape.</p>	<p data-bbox="715 795 810 824">2027687</p> <p data-bbox="715 824 1517 965">The mark consists of three equally spaced stripes, each of the same colour and width, on the outside of the uppers of the footwear, the stripes contrasting in colour with that part of the upper on which they appear and extending forwardly away from the sole, on the area between the sole and the laces or other fastening of the footwear as illustrated below:</p> <div data-bbox="850 1014 1294 1178">  </div> <p data-bbox="715 1256 810 1285">2027689</p> <p data-bbox="715 1285 1517 1451">The mark consists of three equally spaced stripes, each of the same colour and width, on the outside of the uppers of the footwear, the stripes contrasting in colour or material with that part of the upper on which they appear and extending forwardly away from the sole, on the area between the sole and the laces or other fastenings on the footwear as represented below:</p> <div data-bbox="850 1552 1294 1727">  </div>

50 The applicants deny that the marks are similar claiming that their mark is a three dimensional (3D) shape whilst the opponents' mark is a device. They also claim that as their mark is

produced in a single dark colour the marks on the side of the boot are embellishments rather than stripes as they are not of a contrasting colour. Further, they state that their product is clearly a bottle as it has a neck protruding from the heel, therefore it is not a football boot it merely represents one. Finally, at the hearing Mr Gordon invited me to view the embellishments as rows of stitching which on a real football boot would be holding padding to the inside of the boot.

The fact that the applicants' mark is a three-dimensional shape whereas the opponents' mark is a device does not debar the opposition. The claim by the applicants that the marks on the side of the boot shown in their mark are embellishments rather than stripes rests, in the main, on their contention that the boot is produced in a single colour and the embellishments are not in a contrasting colour. I do not accept this argument. Their application does not restrict the mark to a single colour, they would therefore be entitled to use stripes of a contrasting colour if they desired. However, a single colour restriction would not assist as it is clear from the applicants' own evidence that the lines on the side of the boot are clearly recognisable as three stripes even when the boot is produced in a single dark colour. As to the argument that the marks on the side of the boot represent the stitching to hold internal padding in place, if this were the case then all football boots would have the same external markings, which they obviously have not.

The marks are clearly not identical. However, despite the fact that the applicants' mark has stripes around the heel which are not present in the opponents' mark, it is my opinion that the marks are similar in that the applicants' mark contains within it a sign which captures the distinctive character of the opponents' mark as applied to a bottle in the shape of the very goods for which the opponents' mark is registered.

Having decided that the marks are similar, that the goods are dissimilar and that the opponents have a reputation in the footwear market I have to consider whether the use by the applicants of the three-dimensional shape for goods in classes 32 and 33 would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or repute of the opponents' three stripe mark.

In *RBS Advanta v Barclays Bank Plc* 1996 RPC p307, Laddie J. considered the meaning of the proviso to Section 10(6) of the Act which deals with comparative advertising. The second half of the proviso contains wording identical with the wording in Section 5(3) of the Act. Laddie J. expressed the following view on the meaning of the above words in that context:

“At the most these words emphasise that the use of the mark must take advantage of it or be detrimental to it. In other words the use must either give some advantage to the defendant or inflict some harm on the character or repute of the registered mark which is above the level of *de minimis*”.

The opponents contend that most people seeing the applicants' mark will think of them. For the applicants it was argued that three stripes on a car or in toothpaste would not be seen as linked to the opponents. They also pointed out that the products are very different. Whilst I accept these views, the applicants have, by creating a bottle shaped like a football boot, used the mark on an article which visually replicates the goods of the opponents. The combination of a bottle shaped to resemble a football boot and the use of three stripes on the side of the boot in the same manner as the TSM of the opponents brings about the correlation.

There is no evidence that the opponents have licenced their mark for use on dissimilar goods. The goods of the two parties would not normally be offered for sale through the same outlets, although this may not apply to isotonic drinks, which are covered by the applicants' specification of goods. The specific "sporting" connection with such drinks coupled with the closer channels of trade and the opponents' reputation makes it likely that the average consumer of such products would be likely to believe that there was some connection in trade between the parties. That would clearly amount to the applicants' mark taking unfair advantage of the reputation of the opponents' mark, without due cause.

In the absence of evidence of licencing of the opponents' mark it would not be safe to assume that the use of the applicants' mark on the other goods covered by the specification would lead the average consumer to believe that there was an actual connection with the opponents. This is not necessary for the opposition to succeed, as was found in the EVEREADY case [1998 RPC 631] and in the CORGI case [Declaration of Invalidity No 9236, dated 30 September 1998] before the Appointed person, Mr Geoffrey Hobbs QC.

The opposition under Section 5(3) failed in both these cases because the owner of the earlier mark was unable to identify a relevant unfair advantage or detriment.

This case is easily distinguished from these earlier cases. In this case the applicants' mark includes not only a similar mark, but one that is represented upon a fancy bottle which reflects the goods for which the earlier mark is registered. This appears calculated to bring the opponents' mark to mind (which is not fatal in itself) in order that the applicants' mark will benefit from the reputation of the earlier trade mark. In my judgement it is precisely the sort of parasitic use that Section 5(3) was intended to provide a protection against.

The applicants have alcohol included in their specification. Given the similarity of the applicants' mark to the goods of the opponents the use of the applicants mark on alcohol would, in my view, be detrimental to the opponents.

I therefore find that the opposition succeeds on the ground under Section 5(3).

In case I am found to be wrong, I will consider the other ground of opposition under Section 5(4) which states:

*(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -*

*(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or*

*(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.*

*A person thus entitled to prevent the use of a trade mark is referred to in this Act as*

*the proprietor of an “earlier right” in relation to the trade mark.*

5 (5) *Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.*

10 In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

15 *“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.*

20 *A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is ( with footnotes omitted) as follows:*

25 *‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:*

30 *(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;*

*(2) that there is a misrepresentation by the defendant ( whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and*

35 *(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.*

40 *The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of “passing off”, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.’*

45 *“ Further guidance is given in paragraphs 184 to 188 of the same volume with regard*

*top establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:*

5 *To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:*

10 *(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and*

*(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.*

15 *While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.*

20 *In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:*

*(a) the nature and extent of the reputation relied upon;*

25 *(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;*

*(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;*

*(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and*

30 *(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.*

35 *In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."*

With these considerations in mind I turn to assess the evidence filed on the behalf of the parties in the present proceedings as set out earlier in this decision.

40 The opponents claim to have a reputation in the market such that anyone who saw the TSM on footwear would assume that it came from the opponents. To back up this assertion they have filed considerable evidence of reputation and goodwill. The opponents have shown that sales of their footwear with the TSM have averaged over £38million per annum over the last ten years. They have also filed evidence of their promotional activities over the past forty years. There is also the evidence of the survey which showed that the opponents' mark was  
45 recognised by a significant proportion of respondents. The survey results or methodologies were not contested by the applicants either in their evidence or at the hearing. There is also evidence that the opponents have used their TSM on clothing which would have further

enhanced their reputation. Therefore, I am persuaded that at the relevant date, 14 June 1996, the opponents had significant goodwill in their TSM for sports shoes; shoes for casual wear and sports clothing.

5 I have already compared the two marks and found them to be similar, although there are obvious differences in the fields of activity. However, the parties do not need to be in the same field of activity for there to be passing off. In *Lego System Aktielskab and Another v Lego M Lemelstrich Ltd* [1983] F.S.R. 155 the manufacturers of the famous building bricks succeeded in a passing off action against an old established Israeli company which manufactured irrigation equipment. However, the further apart the fields of activity the greater the onus on the opponents to show that there is a likelihood of confusion. The opponents have not established likelihood of confusion in anything other than goods which are loosely in the “sporting section” of the leisure industry. The only such products that the applicants’ specification which could be said to be fall into this category are “isotonic drinks” in Class 32.

15 I am persuaded that members of the public would believe the isotonic drink products of the applicants were connected in trade with the opponents. The opposition under Section 5(4) in respect of “isotonic drinks” in Class 32 therefore succeeds.

20 The opponents also claim that their mark is entitled to protection under the Paris Convention as a well-known trade mark. Section 55 of the Trade Marks Act 1994 states:

*The Paris Convention: supplementary provisions*

55.-(1) *In this Act-*

25 (a) *“the Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20<sup>th</sup> 1883, as revised or amended from time to time, and*

(b) *a “Convention country” means a country, other than the United Kingdom, which is a party to that Convention.*

30 In view of my findings under 5(3) and 5(4) above I do not need to consider this aspect.

The opposition having succeeded the opponents are entitled to a contribution towards their costs. I order the applicants to pay them the sum of £535

35 Dated this 7 day of July 1999

40 George W Salthouse  
For the Registrar  
The Comptroller General

# ANNEX A

TRADE MARKS  
REGISTRY



REGISTRATION  
CERTIFICATE

Trade Marks Act 1994 of Great

Britain and Northern Ireland

The mark shown below has been registered under No. 2027687 as of the date 20 July 1995.

The mark consists of three equally spaced stripes, each of the same colour and width, on the outside of the uppers of the footwear, the stripes contrasting in colour with that part of the upper on which they appear and extending forwardly away from the sole, on the area between the sole and the laces or other fastening of the footwear as illustrated below.



( T The mark has been registered in respect of:  
Class 25:  
Footwear; sports shoes; shoes for casual wear.  
In the name of Adidas AG  
Incorporated in Germany

Sealed this day at my direction

P. R. S. HARTNACK, REGISTRAR  
DATE 20 December 1996

TRADE MARKS  
REGISTRY



REGISTRATION  
CERTIFICATE

Trade Marks Act 1994 of Great

Britain and Northern Ireland

The mark shown below has been registered under No. 2027687 as of the date 20 July 1995.

The mark consists of three equally spaced stripes, each of the same colour and width, on the outside of the uppers of the footwear, the stripes contrasting in colour with that part of the upper on which they appear and extending forwardly away from the sole, on the area between the sole and the laces or other fastening of the footwear as illustrated below.



The mark has been registered in respect of:  
Class 25:  
Footwear; sports shoes; shoes for casual wear.  
In the name of Adidas AG  
Incorporated in Germany

Sealed this day at my direction

P. R. S. HARTNACK, REGISTRAR  
DATE 20 December 1996