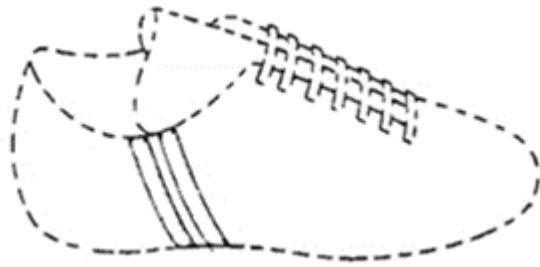


# Kluwer Trademark Blog

## On branding practices and lack of distinctiveness in position marks – two parallel stripes on the side of a shoe are not distinctive per se

Katharina Schmid (schmid-ip) · Wednesday, December 11th, 2024

The General Court (GC) has recently confirmed that the figurative European Union trademark no. 002810299 consisting of two parallel stripes on the side of a shoe lacked **distinctiveness** (T-307/23 of 23.10.2024 – Jima Projects vs. EUIPO).



The decision is noteworthy, as it confirms previous case law that a “branding practice” does not automatically render a simple sign distinctive (nor an allegedly more lenient Office practice at the filing date), and clarifies the threshold of evidence that a cancellation applicant has to submit.

The mark, filed in 2002 as a figurative mark, covers “*footwear, including sports footwear*”, and was registered only in 2020, following lengthy opposition proceedings (see inter alia T-479/08). It consists of two transversal lines, intended to be positioned on the side of a shoe, and not the shape of the shoe itself. Nowadays, it would be considered a “**position mark**” (Art 3(3)(d) EUTMIR), although the GC stressed that the qualification as a position mark or not had no impact on the assessment of distinctiveness).

The GC’s ruling can be summarized as follows :

- ‘Footwear’ in Class 25, including sports shoes, are everyday consumer goods aimed at the **general public**, which has an **average level of attention**.

- The GC recognized a *practice* that many manufacturers of sports shoes or casual shoes use **relatively simple motifs** affixed to the side of shoes, *intended* to indicate their commercial origin. However, that alone is not sufficient to render the sign distinctive. If a (simple) sign was viewed as an indication of origin, this would be less so because of its positioning but because of the intensive use which has been made of it.
- Otherwise, signs which are indistinguishable from the appearance of the goods, are inherently distinctive only if they depart significantly from the norms or customs of the sector.
- Excessively simple signs, e.g. a sign consisting of a basic geometric figure (circle, line, rectangle, conventional pentagon), will not usually work as source identifier unless they have acquired distinctive character. The sign at issue was considered a simple decorative element and not inherently distinctive.

The applicant also complained that the Board of Appeal (“BoA”) should have applied a more “lenient” case-law and decision-making practice of EUIPO, which allegedly existed at the filing date of the application in 2002. It further claimed that the cancellation applicant had not submitted any evidence that the relevant public would perceive the mark as a simple decorative element, and not as an indication of source. The GC dismissed these arguments:

- A more lenient examination practice of the EUIPO in 2002 (at the time of filing) was not proven, but would be irrelevant for the assessment in a cancellation action. What matters is compliance with the law, which has not changed over the entire period of time. Accordingly, also later case law has to be taken into account.
- The applicant complied with its **duty to provide evidence** and the BoA’s with its duty to **provide reasons** in that it submitted / fully took into account the evidence provided by the applicant, which related to GC’s case law and EUIPO’s decision-making practice and to the particularities of the footwear market (p. 58-60, 91).

The trademark owner also alleged a breach of its right to property (Art 17, 41 (2)(c) of the EU [Charter on Fundamental Rights](#) and the protection of legitimate expectations and of legal certainty) – however, to no avail. A trademark runs the inherent risk that it may later be declared invalid, and EU trademark law does not have an incontestability rule.

On balance, the present ruling adds to a solid line of case law of the GC in relation to the lack of inherent distinctiveness of excessively simple signs in relation class 25 goods (see also T-53-13, wavy line, T-3/15, 5 parallel stripes, T-63-15, two parallel stripes on shirt sleeves, et al.), unless

when acquired distinctiveness is proven. Whether these are position or figurative marks has no impact on distinctiveness.

(The author acted for the intervener, the cancellation applicant before the EUIPO.)

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A graphic for a survey report. It features a dark background with a circular inset showing a gavel on a glowing digital circuit board. The text is white and blue. A blue button with a white arrow points to the right.

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