

## Position marks: geometric sign located on side of shoe can be inherently distinctive

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- Due to the combination of geometrical elements in the sign and its specific positioning on the goods, the mark was sufficiently striking and memorable to be distinctive
- Footwear consumers are likely to consider that signs located on the side of shoes indicate the commercial origin of the goods, thereby reducing the complexity threshold required for such position marks
- The position mark applied for was considered to be inherently distinctive, *per se* and without additional elements

In its decision of 9 October 2023 in Case [R 1291/2023-2](#), the Second Board of Appeal of the EUIPO annulled the examiner's refusal to register a position mark for footwear. Taking into account the complexity of the sign and its specific positioning with respect to the norms and customs in the footwear sector, the contested mark was considered to be inherently distinctive.

## Background

On 12 April 2022 Paredes Holding Center SL filed an application for the EU position mark [No 018686228](#) for footwear (Classes 9 and 25), which consisted of the following sign:



On 25 April 2023 the examiner rejected the application due to a lack of inherent distinctiveness (Article 7(1)(b) of [Regulation 2017/1001](#)), considering, in short, that the sign applied for was a simple geometric figure that did not differ significantly from the norms or customs of the relevant sector. Since the sign was not characteristic, striking or unusual, the average consumer would see it as a mere decorative element, and not as a trademark.

The examiner also highlighted that the Court of Justice of the European Union had established that, although it is common practice for decorative elements to be placed on footwear and for many variations of geometric shapes to appear on the side of shoes, consumers did not regard these elements as an indication of the origin of the goods, unless they had memorised them because of their widespread use as identifiers of commercial origin.

Paredes appealed.

## Board of Appeal decision

The Board of Appeal annulled the examiner's decision and ruled that the position mark applied for was inherently distinctive.

In short, the board's reasoning was as follows:

- In order to assess the distinctiveness of the position mark applied for, it was necessary to weigh up the degree of complexity of the sign and the consumer's perception of signs located in the place where the mark was displayed.
- The sign applied for was not a basic figure but, rather, a combination of geometric elements that was sufficiently complex.
- It is common for footwear manufacturers to always display the same design, such as lines or geometrical forms, on the outside of their products. Further, it is a well-known fact that the use of simple devices has been increasingly common for many years on clothing and, in particular, on footwear.
- It is not necessary for a trademark to convey precise information as to the identity of the manufacturer of the goods or the provider of the services; nor does it need to be original or fanciful.
- In view of the case law and the customs of the sector, it is plausible that the relevant consumers are accustomed to identifying certain signs on the side of the goods as indicative of their commercial origin, although it is not possible to accept that any sign placed in that position will automatically be perceived as a trademark.
- The fact that the consumer identifies that particular area of the product as the place where manufacturers usually affix their distinctive signs enables the reduction, to a certain extent, of the threshold of complexity required for such sign to perform its main function of identifying commercial origin, in comparison with other types of trademarks whose range of action is much wider, such as word or figurative marks.

In conclusion, the combination of geometric elements in the contested mark and its specific location on the goods in question enabled the sign, taken as a whole, to be sufficiently memorable and striking. The consumer was not likely to perceive it merely as decorative, ornamental or functional in the context of footwear. The sign applied for, *per se* and without additional elements, was thus inherently distinctive and fulfilled its function as an indication of origin.

## Comment

In a context where position trademarks for footwear are often challenged, this decision provides a useful precedent for EU trademark owners seeking to demonstrate the current practices in the sector and the inherent distinctiveness of their signs, independently of the claim of acquired distinctiveness.

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