

**Refusal of application for a European Union trade mark
(Article 7 and Article 42(2) EUTMR)**

Alicante, 31/08/2023

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Application No: **018731419**

Your reference:

Trade mark:



Mark type:

Position

Applicant:

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Puerto Rico**

I. Statement of the facts

With the notification dated 27/03/2023 the applicant was informed, that the sign applied for cannot be registered under Article 7(1)(b) EUTMR.

The objection was/is raised for the goods claimed, which are: *“Metallic gold outer soles sold as an integral component of men’s and women’s shoes”* in Class 25.

The mark description reads: the mark consists of a product configuration consisting of a metallic gold sole on footwear. The dotted lines demonstrate placement of the mark and are not claimed as a feature of the mark.

The objection was based on the following points:

- The distinctive character of a trade mark is assessed with reference to the goods or services for which protection is sought and the perception of the relevant public.
- The goods are addressed to the general public. The relevant territory is the

whole European Union.

- The perception of the relevant public is influenced by the type of sign applied for. Signs that are indistinguishable from the appearance of the product itself will not normally be seen by consumers as an indication of the commercial origin of these goods. They are only distinctive for the purposes of Article 7(1)(b) EUTMR if they depart significantly from the norm or customs of the sector (11/07/2013, T-208/12, 'Rote Schnürsenkelenden', EU:T:2013:376, § 33).
- It also speaks against distinctiveness if the goods in issue are available to the consumer in a wide variety of designs (07/02/2002, T-88/00, 'Maglite', EU:T:2002:28, § 37), as it will then be more difficult to show that the claimed mark deviates significantly from that wide variety.
- In the case at hand the sign is not distinguishable from the appearance of the goods it designates, namely "*metallic gold outer soles sold as an integral component of men's and women's shoes*"; it would only be distinctive for the purposes of Article 7(1)(b) EUTMR if the consumer was able to recognize the sign applied for as originating from a particular undertaking and thus to distinguish the shoes of the applicant from those of other undertakings (21/04/2010, T-7/09, 'Spannfutter', EU:T:2010:153, § 26) and, also, if it departs significantly from the norm or customs of the sector. The benchmark also applies to signs which are only applicable to a component or an element of the appearance of the product, in the case at hand "*Metallic gold outer soles*" (10/10/2008, T-387/06 to T-390/06, 'Pallet', EU:T:2008:427, § 36; 13/04/2011, T-202/09, 'Footwear', EU:T:2011:168, § 40; 19/09/2012, T-50/11, 'Stoffmuster', EU:T:2012:436, § 43).
- The sign consists of a metallic gold sole on footwear. It is clear from these objective characteristics that the sign applied for aims to protect a coloured surface in a particular position of the shoe. The sign merges in the eyes of the relevant public with the claimed goods itself, i.e. shoes, since in the words of the applicant the metallic gold outer soles are sold as an integral component of men's and women's shoes.
- As to the gold colour of the sole, the public will not instantly perceive a single colour, or a coloured element which forms part of the external appearance of the goods as a reference to the commercial origin of the goods (21/10/2004, C-447/02, 'Orange', EU:C:2004:649, § 78). Thus, while colours are capable of conveying certain associations of ideas, and of arousing feelings, they possess little inherent capacity for communicating specific information, especially since they are commonly and widely used, because of their appeal, in order to advertise and market goods or services, without any specific message (06/05/2003, C-104/01, 'Libertel', EU:C:2003:244, § 40; 24/06/2004, C-49/02, 'Blau/Gelb', EU:C:2004:384, § 38; 12/11/2008, T-400/07, 'Farben in Quadraten', EU:T:2008:492, § 35).
- Furthermore, the use of the gold colour to highlight the quality of a given product is a common place associated with high quality and excellence and, therefore, does not confer distinctive character on the product.
- The combination of the colour gold and its position on the goods do not add anything which could render the sign distinctive. The relevant public would perceive the sign as a non-distinctive design that merely serves as decorative

chic. The sign applied for is not immediately capable of imprinting itself on the consumer's mind to allow them repeating or avoiding the shopping experience. Colours are commonly used in the field of footwear and also in the position at issue. See thereto some examples from a Google™-search retrieved today:



<https://footwearnews.com/2019/business/retail/green-shoe-sole-trademark-christian-louboutin-1202746636/>



<https://www.pinterest.com/pin/497929302523434264/>



<https://www.internationaldanceshoes.com/glitter-soles/>



<https://www.pinterest.com/pin/326088829260108834/>



<https://www.etsy.com/es/listing/182668965/azure-blue-shoe-sole-kit-slip-resistant>



https://www.etsy.com/listing/169748925/colored-shoe-sole-kit-diy-red-bottom?click_key=0e2df54f5aabe926a7d3e5d5f29dd3a06a64d111%3A169748925&click_sum=094f4083&ref=sold_out-23



<https://www.pinterest.com/pin/50032245831057050/>



<https://www.soulfulheels.com/products/orange-sole>

- Regardless of the specific colour (in this case gold) these designs embellish footwear so frequently, that the relevant public will see nothing but a non-distinctive sign.
- Therefore, the sign's overall impact remains that of a non-distinctive feature, which is prima facie incapable of transmitting a trade mark message.
- Therefore, the sign is devoid of any distinctive character within the meaning of Article 7(1)(b) EUTMR.

II. Summary of the applicant's arguments

The Office has not received any observations within the specified time limit.

III. Reasons

Pursuant to Article 94 EUTMR, it is up to the Office to take a decision based on reasons or evidence on which the applicant has had an opportunity to present its comments.

Since the applicant did not respond to the notice of refusal, the objection to the sign is upheld and further argumentation is superfluous.

IV. Conclusion

For the reasons set out in the above referred to notification dated 27/03/2023, the sign



does not possess at first sight any distinctive character in relation to the goods pursuant to Article 7(1)(b) EUTMR and is therefore unable to function as a trade mark in the market place, i.e. it fails to distinguish these goods from those of other undertakings.

Under Article 67 EUTMR, you have a right to appeal against this decision. In accordance with Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid



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Examiner