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**DISTINCTIVENESS AS A TRADE MARK ISSUE IN THE SHOE INDUSTRY,
COMPARISON BETWEEN US AND THE EU**

Bachelor's Thesis

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I hereby declare that I have compiled the thesis independently and all works, important standpoints and data by other authors have been properly referenced and the same paper has not been previously presented for grading.

The document length is 8491 words from the introduction to the end of conclusion.

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(Signature, date)

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ABSTRACT

The field of trademark law has grown and changed a lot in recent years, and we can expect to see it develop further in the coming years. The requirement for the distinctiveness of a trademark is an important subject and an interesting area of trademark law for various reasons, but especially due to the rise of non-traditional trademarks in the fashion industry. The aim of the thesis is to see if the criterion for distinctiveness differs between US and the EU and how the different legal systems examine the distinctiveness of trademarks, specifically through the presented case law. Another point of examination is how the differences in the criterion for distinctiveness relate to the protection granted for the trademarks. Moreover, the study briefly discusses the surrounding circumstances of non-traditional trademark protection, such as its potential limitations on competition and creativity.

The methodology of the thesis consisted of online-based legal journals, research papers and other academic sources as well as other sources for a versatile basis. As the thesis contains a comparative viewpoint, relevant legal frameworks are also used both from US and EU.

The results of the findings indicate that the differences in the approach to distinctiveness have implications towards the protection of non-traditional trademarks. The thesis also concludes that in the future, it will be important for policymakers to assess the effectiveness of the distinctiveness criteria in their respective jurisdictions. In conclusion, this thesis contributes to the understanding of the distinctiveness criteria for non-traditional trademarks in the shoe industry in the US and in the EU, their impact on protection levels, and the challenges facing their protection.

Keywords: Trademark, distinctiveness, intellectual property rights, comparison, non-traditional trademarks

INTRODUCTION

Trademarks surfaced centuries ago, to protect traders' marks to indicate the source of the goods. As trade mark law has grown into what it is today, it grew to make room and allow for the changes in commerce.¹ In today's highly competitive marketplace, trademarks have become an essential tool for businesses; trademarks serve to distinguish the goods and services from those of others alike. A trade mark can be for example a word, logo or even a sound. Trademarks are typically made to protect your brand as it prevents other businesses from using the trademarked sign, which prevents consumer confusion and gives them confidence about the quality of the product they are purchasing. This is particularly important in the fashion industry, where trademarks play a big role in creating brand identity and consumer appeal, and moreover, particularly important in the shoe industry; the long-lasting exclusivity of a trade mark is valuable for companies, as they can capitalize the long-term success.²

There have been various cases of trade mark disputes particularly in the shoe industry over the last few years. Businesses are trying to protect their trademarked signs, such as colors and shapes of their products, and it is not such an easy task. Whilst courts and trade mark offices are debating on what qualifies as a trade mark and how much protection should be granted, the topic of distinctiveness and trademarks remains a developing area of law.

This thesis focuses solely on trade mark law and explores cases concerning trademarks and their protection, and studies the legal challenges on establishing and maintaining trade mark distinctiveness. Copyright law nor design law is considered in this thesis. The author will start the thesis by providing an overview of some of the fundamental principles of trade mark law and criteria for trade mark distinctiveness, the difference in the approach to distinctiveness in the EU and in the US and further and will continue to examine the types of trademarks that are mostly used in the shoe industry. Further in the thesis, the author will present a few trade mark disputes with a high significance in the shoe industry and the compare and evaluate the disputes in the context of EU law and draw conclusions about the work.

The research problem of this thesis is the different approaches to assessing distinctiveness in the EU and in the US trade mark law in the shoe industry, as the impact of these different

¹ Dogan, Stacey L; Lemley, Mark A (2007) Grounding Trade mark Law through Trade mark Use, *Iowa Law Review* 92 (92 (5), p. 1670

² Hyman, J., Azema, C., & Morrow, L. (2018). If the ip fits, wear it: ip protection for footwear a u.s. perspective. *The Trade mark Reporter*, 108(3), 645-755.

approaches is unclear of the trade mark protection for shoes. The research purpose is to examine and compare the different approaches and standards used for the shoe industry, particularly when it comes to non-traditional trademarks such as colors and shapes and compare it between EU and the US. As research questions this thesis will present the following: what are the differences in the distinctiveness criteria between EU and the US trade mark laws and how do these differences affect the effectiveness of trade mark protection for the shoe industry in the two regions? How have the most significant cases of trade mark battles in the EU and in the US affected the criteria for distinctiveness? And lastly, how do the different approaches to distinctiveness affect the level of protection granted?

As for methodology, the author will focus on retrieving and collecting data from multiple academic sources, as well as other sources to get a multidisciplinary and a versatile basis for the thesis. The sources include online-based legal journals, research papers and cases as well as textbooks, and along with that, relevant legal framework. As the work includes a comparative viewpoint comparing EU and national law, the relevant legal framework will consist of EU as well as US laws.

This is as an issue very topical because of the competitiveness of the fashion industry nowadays; companies invest a lot of resources to distinctive branding elements. As there are differences between the criteria of distinction and extent of trade mark protection between jurisdictions, there are on-going debates and legal battles about the level of protection granted for brands and their certain types of branding elements, such as colors and shapes, as this thesis will show. With the rise of e-commerce, these elements have become even more important than before; in online marketplaces, it is particularly important to know the product and where it originates, as consumers are not able to see it physically before the decision to purchase.

1. FUNDAMENTAL PRINCIPLES OF TRADE MARK LAW

Typically trade mark consists of a sign or a logo, but it can be also for example a sound or even a smell. The fundamental principles of trade mark law vary little to almost nothing between United States and the European Union, but there are some minor differences. In the United States, the fundamental principles are based on the Lanham Act, which sets out the basic requirements for a trademark. A trade mark must meet two basic criteria in order to be eligible for protection in the United States, and these are the usage in commerce and distinctiveness.³ However, in the United States, protectability does not require registration; a mark can be protected in the United States without registration as well. In the EU, the basic requirements are set in the Trade Mark Regulation 2017/1001 and in the Trade Mark Directive 2015/2436, the Trade Mark Regulation being the latest version. In Article 4 of the Trade Mark Regulation the requirements for a trade mark are set, and these include the distinguishability from others and being represented on the Register of the European Union Trademarks.⁴

Categories of trademarks are referred to as the spectrum on which the trademarks are usually put⁵ in the meaning of evaluating distinctiveness. The spectrum usually varies from highly distinctive to not distinctive at all. The spectrum in the United States and in the European Union differs a bit; in the United States, the categories established are Generic, Descriptive, Suggestive, Arbitrary and Fanciful, fanciful acquiring the highest level of distinctiveness and generic having the least level of distinctiveness; generic words or signs are not likely to get their trademarks registered.⁶ In the European Union, the European Union Intellectual Property Office examines the distinctiveness, and it will ultimately assess the “greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings”.⁷

³ Legal Information Institute, Lanham Act, *Cornell Law School*, retrieved from https://www.law.cornell.edu/wex/lanham_act 26th April 2023

⁴ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (codification)(Text with EEA relevance.) *OJ L 154, 16.6.2017, p. 1–99*, retrieved from <https://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32017R1001&from=EN>

⁵ Judgement of the Court, C-342/97 (1999), *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, EU:C:1999:323, §22

⁶ Mazumdar, Purbita (2022) Different Spectrum of Trade mark Distinctiveness, *Jus Corpus Law Journal*, vol 2 issue 4, p. 1329-1332

⁷ What is distinctiveness? Trade mark Guidelines, *European Intellectual Property Office*, retrieved from <https://guidelines.euipo.europa.eu/1803468/1787358/trade-mark-guidelines/3-2-2-1-what-is-distinctiveness-> 26th April 2023

Likelihood of confusion is another important aspect of the fundamental principles of trade mark law; according to the United States Patent and Trade Mark Office, it is one of the most common reasons for the refusal of registration.⁸ a trade mark cannot be used or granted a trademark, if there is a possibility it could cause confusion among the consumers when it comes to the source of the goods or services. In the US, there are no strict tests for the likelihood of confusion; each case is decided on a case-basis.⁹

I.I. International legal framework

In an international level, a relevant legal framework relating to the protection of intellectual property are the Paris Convention and the agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).

Paris Convention is a treaty administered by World Intellectual Property Organization (WIPO) and it applies to industrial property in a broad scale; it covers patents, trademarks, industrial designs, utility models, service marks, trade names, geographical indications, and the repression of unfair competition.¹⁰ There are three main categories of provisions in the Paris Convention, which are national treatment, right of priority and some common rules.¹¹ The first one establishes that the same level of protection must be granted to all nationals of contracting states, and additionally non-nationals upon a condition of having an effective industrial or commercial establishment or a domicile in a contracting state.¹² The second category treats the right of priority, which means that if you file an application for a patent, mark, or an industrial sign in a contracting state, you have a period of time when you can apply for a protection in another contracting state with a right to priority to any applications that may come after the date of your first application in a contracting state.¹³ The third one establishes common rules for contracting states, including e.g., that patents are independent of each other in each contracting states, a

⁸ United States Patent and Trade mark Office, Likelihood of Confusion, retrieved from <https://www.uspto.gov/trademarks/search/likelihood-confusion#:~:text=Likelihood%20of%20confusion%20exists%20between,come%20from%20the%20same%20source>. 30 March 2023

⁹ *Ibid.*

¹⁰ WIPO, *Summary of the Paris Convention for the Protection of Industrial Property*, retrieved from https://www.wipo.int/treaties/en/ip/paris/summary_paris.html 15th March 2023

¹¹ *Ibid.*

¹² *Ibid.*

¹³ *Ibid.*

registered mark acclaimed in one country is independent of its viable registration in another country, and that collective marks must be granted protection.¹⁴

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) is an agreement establishing minimum standards for protection for the member states.¹⁵ Each member state may grant a more extensive protection, but not any lesser than in the agreement, and the methods for implementing the minimum standard provisions are left to consideration of the member state.¹⁶ The TRIPS agreement presented a very broad definition of trademarks, which led to the possibility to register and protect all kinds of marks; specifically, the non-traditional marks as well.¹⁷

¹⁴ WIPO, *Summary of the Paris Convention for the Protection of Industrial Property*, retrieved from https://www.wipo.int/treaties/en/ip/paris/summary_paris.html 15th March 2023

¹⁵ World Trade Organization, Overview: The Trips Agreement, retrieved from https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm 15th March 2023

¹⁶ *Ibid.*

¹⁷ Calboli, I. (2018). Chocolate, fashion, toys and cabs: The misunderstood distinctiveness of non-traditional trademarks. *IIC-International Review of Intellectual Property and Competition Law*, 49(1), 1-4.

2. DISTINCTIVENESS AS A TRADEMARK ISSUE

Distinctiveness is a foundational key concept in trade mark law, both in the US and the EU. It can be seen that it even has a doctrinal role, as it distinguishes the protectable trademarks from those not protectable.¹⁸ It also since it establishes the level of protection given to a specific mark; still, there are challenges to tackle with the concept. A major challenge is related to the difficulty of defining and assessing distinctiveness, as it is the level of distinctiveness which defines the category under which the trade mark falls and ultimately, the level of protection it will be granted. It can be challenging to draw the line between some marks, which may be instantly recognizable as belonging to a specific company, and others, which may be more ambiguous or suggestive. Different jurisdictions have different criteria for determining distinctiveness; this creates its own problems.

Another challenge which is involved in a lot of issues surrounding trademarks and distinctiveness is determining whether a mark has acquired distinctiveness through use. If the mark is not inherently distinctive but has come associated with a brand through the use in the market, it can be difficult to show that the mark as acquired secondary meaning.¹⁹

A key difference found in the trade mark law between United States and Europe lays in how the rights for a mark are obtained. In Europe, the rights are obtained through registering your mark, whereas in the United States the rights can be obtained through use, and additionally, you can register you mark, but it is not mandatory for protection. In both EU and the US, the trademarks will be examined for distinctiveness, in the EU by the European Intellectual Property Office, and in the US by the United States Patent and Trade Mark Office. Trademarks are subject to examination for distinctiveness based on the marks ability to distinguish itself from those of other undertakings and whether the mark functions as a source identifier.

2.1 Differences in the approach to distinctiveness in the EU and in the US

The concept of distinctiveness, although seen as a basic component of trade mark law, is approached quite differently in the two legal systems. As introduced, in the US the distinctiveness is based on the Lanham Act, which establishes categories based on the level of

¹⁸ McKenna, M. P. (2008). Teaching trade mark theory through the lens of distinctiveness. *St. Louis University Law Journal*, 52(3), 843-854.

¹⁹ Mazumdar, Purbita (2022) Different Spectrum of Trade mark Distinctiveness, *Jus Corpus Law Journal*, vol 2 issue 4, 2022, p. 1329

distinctiveness the trade mark carries. The so-called spectrum of distinctiveness, or the “Abercrombie classification”, was established in a case of *Abercrombie & Fitch Co. v. Hunting World*, and consequently, the trademarks are now categorized into different classes with different degrees of protection granted.

The European Union bases the idea of the distinction to the directive, which does not per se establish any categories, but is more flexible in a way that it only requires the goods or services to be distinguishable from those of other undertakings.²⁰ The directive further states that a trade mark must be able to be portrayed in a way that allows the public and the appropriate authorities to understand clearly and precisely what kind of protection its owner is receiving.²¹ As a result, this method can also be seen as less strict than the US method and considers each trade mark application's individual qualities. But there is another side to it: the US laws and precedent cases are always interpreted by the judges, so this leaves room for interpretation to the meaning of the “distinctive” character in trademarks.²²

In addition, the importance given to secondary meaning differs between the US and the EU. In the US, extensive use and consumer recognition over time can help a descriptive term that would not otherwise be distinctive become distinctive. However, a case of *W.N Sharpe Ltd. v. Solomon Bros Ltd.* established that words like “good” “best” and “superfine” cannot acquire secondary meaning, and therefore cannot be trademarked.²³ The EU, on the other hand, places more value on a mark's inherent distinctiveness, which requires that it be so at the time of registration.

In general, the differentiating approaches to distinctiveness may reflect divergent legal traditions and policy goals, as the US approach is more prescriptive and the EU approach allowing more case-by-case analysis.

²⁰ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (recast), *OJ L 336*, 23.12.2015, p. 1–26

²¹ *Ibid.* p. 1-26

²² Pozen, R. C., & Hirsch, J. (2008). US and EU Trade mark Protection. Retrieved from: https://edisciplinas.usp.br/pluginfile.php/4115991/mod_resource/content/1/US%20and%20EU%20trademark%20protection.pdf 9th of March 2023

²³ Mazumdar, Purbita (2022) Different Spectrum of Trade mark Distinctiveness, *Jus Corpus Law Journal*, vol 2 issue 4, p. 1329-1332

2.2 Trade mark Infringement

The scope of what can be protected as a trade mark has grown exponentially over the years, and this is, according to some scholars, due to the notion of distinctiveness.²⁴ As almost anything, from a smell to a shape of a product can be trademarked, a question arises: what is left that cannot be trademarked? In the European Union, the Trade mark Directive lays absolute grounds for refusal to grant a trademark. In addition to marks that lack the distinctive feature, these include for example marks that “trademarks which consist exclusively of signs or indications which have become customary in the current language”²⁵ or “signs which consist exclusively of the shape, or another characteristic, which results from the nature of the goods themselves”.²⁶ In the directive, relative grounds for refusal or invalidity are also listed in article 5, which include for example that “a mark shall not be registered, or registered invalid, where: a) it is identical with an earlier trademark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected.”²⁷

As distinctiveness is an important topic when talking about trademarks, so is trade mark infringement. Trade mark can be infringed, if another business uses a trademarked sign in their product for the purposes of distinguishing their goods or services. In the EU, in article 10 of the Trade mark Directive there are listed rights conferred by a trademark, and these include the right “to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where: a) the sign is identical with the trade mark and is used in relation to goods or services which are identical with those for which the trade mark is registered. (b) the sign is identical with, or similar to, the trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark; (c) the sign is identical with, or similar to, the trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to, or not similar to, those for which the trade mark is registered, where the latter has a reputation in the Member State and

²⁴ Calboli, Irene (2018) Chocolate, Fashion, Toys and Cabs: The Misunderstood Distinctiveness of Non-Traditional Trademarks, *International Review of Intellectual Property and Competition Law* 49, p. 1-4

²⁵ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (recast), *OJ L 336*, 23.12.2015, p. 1–26

²⁶ *Ibid.* p. 1-26

²⁷ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (recast), *OJ L 336*, 23.12.2015, p. 1–26

where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.”²⁸

When considering the markets of fashion and especially fashion footwear, the infringements are usually trade dress infringements, as trade dress refers to the look or the feel of the product or a service and the total picture what the consumers see.²⁹

Even though the European Union trade mark directive does not require any kind of intention to be considered when handling cases of infringement, it is something that the courts often consider.³⁰ Supposedly, the courts see that if an infringement is intentional, it is made in the belief that consumers will be confused, or at least there is a chance for it; the intent can be seen as evidence of the belief that consumers are drawn to confusion.³¹ This is an interesting aspect of trade mark infringement; the mens rea of a crime is fulfilled through the intent to deceive consumers.

2.3 Non-conventional marks

The registrability of the so-called non-conventional marks was on the debates before the 1994 Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) made it possible to protect all kinds of marks, even the so-called “non-conventional” marks, on a worldwide scale.³² The agreement sets out minimum standards for intellectual property protection, to which members of WTO must commit to when making their national laws.³³ The non-conventional marks can include for example shapes or sounds, almost anything, staying in the frameworks of being distinguishable. Many distinctive design signs, such as the Dr. Martens yellow stitches or Louboutin’s red soles, have taken advantage of this, and trademarked their products. These signs are maybe not traditionally something that would require a trade mark as creative works but require protection as a design or a copyright.³⁴ Nevertheless, they have acquired protection as

²⁸ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (recast), *OJ L 336*, 23.12.2015, p. 1–26

²⁹ Shpetner, M. A. (1998). Determining proper test for inherent distinctiveness in trade dress. *Fordham Intellectual Property, Media & Entertainment Law Journal*, 8(3), 947-1012.

³⁰ Yen, A. C. (2015). Intent and trade mark infringement. *Arizona Law Review*, 57(3), [i]-744.

³¹ *Ibid.* p. 716

³² Calboli, I. (2018). Chocolate, fashion, toys and cabs: The misunderstood distinctiveness of non-traditional trademarks. *IIC-International Review of Intellectual Property and Competition Law*, 49(1), 1-4.

³³ Dinwoodie, G. B., & Janis, M. D. (2022). *Trade dress and design law*. Aspen Publishing. p. 16–20

³⁴ *Ibid.* p. 16-20

trademarks nowadays, but as a result from designs being easy to copy, many of these marks have suffered from lengthy lawsuits regarding trade mark and trade dress infringements.

Position marks are a new phenomenon in the area of trade mark law. Position marks consist of a “specific way in which the mark is placed on or affixed to the product.”³⁵ Most of these marks concern fashion footwear.³⁶ These could include for example a specific color mark on a shoe, or any certain type of characteristic. The yellow stitching on the Dr. Martens is more specifically a position mark, such as is the red sole on the Louboutin shoes.³⁷ But a lot of marks have been denied position mark; the criteria is quite strict in the sense that the mark needs to indicate the origin in the consumers’ minds.³⁸ Many marks have been denied position marks, as the mark is too technical; for example, the red dot on the Tefal pans.³⁹

³⁵ European Union Intellectual Property Office, Position Mark, *Trade Mark Guidelines*

³⁶ Brancusi, Lavinia, The procustean fitting of trade marks under the requirements of clear and precise subject-matter in the EU trade mark law- A case of position marks, *The journal of world intellectual property*, volume 25, issue 1 p. 45-70, retrieved from: <https://onlinelibrary.wiley.com/doi/epdf/10.1111/jwip.12205> 10th March 2023

³⁷ Bos, Arnaud, The typical yellow stitching of Dr. Martens, *Merkenadviseurs Trade mark Attorneys*

³⁸ *Ibid.*

³⁹ *Ibid.*

3. DR. MARTENS, LEGAL DISPUTES

Since the 1940s, the well-known boot company Dr. Martens has been making sturdy, recognizable boots. The unmistakable yellow stitching on Dr. Martens boots, which has become to be the company's logo, is one of their most recognizable characteristics. Yet, over time, the use of this feature has also resulted in legal issues. This chapter will examine some of the most significant legal battles surrounding the yellow stitching and the Dr. Martens trademark.

Dr. Martens as a footwear brand, has suffered multiple lawsuits relating to their trademark, and the distinctive features of their designs. Many of these relate to trade dress infringements. Trade dress infringement takes place when a business employs the distinctive feature of one trademarked product or service to their own product or a service, making it possible to consumers confuse the products to another and trade dress can include almost anything from the visual appearance of the product, such as a color, shape, or a minor detail in the appearance.

Airwair, the company behind Dr. Martens, has trademarked the Dr. Martens. The brand is well known for its distinctive elements, including word marks, logos, and the iconic configuration of the footwear.⁴⁰ The most notable one is probably the yellow stitching on the soles of the boots; it has been an iconic feature on their shoes since the beginning of the production. This yellow stitching has become even more and more iconic during the years as the Dr. Martens has grown significance especially amongst the youth and it has been trademarked, first in the United Kingdom and later in other countries.

3.1 Airwair v. Van Haren

One of the most notable cases including Dr. Martens is from 2018, where Airwair, the parent company of Dr. Martens, claimed infringement on its design rights and a position mark by a Dutch fashion retailer, Van Haren.⁴¹ Airwair had claimed multiple infringements in 2021 and 2021, and the respondents included many notable companies, for example Primark.⁴²

⁴⁰ Dr. Martens: Giving infringers the boot (2016) *World Intellectual Property Review*. Retrieved from: <https://www.worldipreview.com/article/dr-martens-giving-infringers-the-boot>, 9th March 2023

⁴¹ Van Den Broek, Gie (2021) Dr. Martens vs. Van Haren. First phase of a long uphill march to plateau Kirchberg? [Post] LinkedIn, retrieved from https://www.linkedin.com/pulse/dr-martens-vs-van-haren-first-phase-long-uphill-march-van-den-broek/?trk=read_related_article-card_title 14th of March 2023

⁴² The Bird & Bird IP Team, Round-up of fashion-related IP decisions 2021, *Journal of Intellectual Property Law & Practice*, Volume 17, Issue 3, March 2022, Pages 260–296, retrieved from: <https://doi.org/10.1093/jiplp/jpac002>

Van Haren released a shoe line that included similar shoes to the Dr. Martens boots, which are known for the stitching on the welt; the Van Haren boots included the same kind of stitching in addition to the same overall look of the boot. The yellow stitching on the sole of the boot had been registered as a position mark in the Benelux Office for Intellectual Property only six months before the claimed infringement. ⁴³ The District Court of Hague took the view on the 19th of February of 2021 that the yellow stitching does not offer substantial value to the boots and therefore established the acquired distinctiveness at least through usage, and the position mark to be valid, but concerning the infringement of the design rights the Court did not see the chance for confusion and further decided that Van Haren did not infringe the design rights of Airwair. ⁴⁴

The company Van Haren did file a cancellation action against the trademarked Yellow Stich on Black Welt (the YSBW) in accordance with Article 2.30bis(1)(a) of the Benelux Convention on Intellectual Property. ⁴⁵ The company claimed in their cancellation application that there were several grounds for invalidity; that “the contested trade mark is devoid of distinctive character (Article 2.2bis(1)(b) Benelux Convention on Intellectual Property)”⁴⁶, “the contested trade mark has become a customary indication (Article 2.2bis(1)(d) Benelux Convention on Intellectual Property)”⁴⁷ and “the contested trade mark consist exclusively of the shape, or another characteristic, which results from the nature of the goods, is necessary to obtain a technical result or gives substantial value to the goods (Article 2.2bis (1)(e) Benelux Convention on Intellectual Property)”. ⁴⁸

However, on 8th December 2022 the Benelux Office for Intellectual Property decided that there were no grounds for invalidation of the trademarked Yellow Stitching on the Black Welt, as the acquired distinctiveness was compellingly proven, even though the claimant, Van Haren, conducted a survey through a Dutch market research agency, with an intent to prove that distinctiveness of the shoe does not actually exist. ⁴⁹

⁴³ Van Den Broek, Gie (2021) *supra nota*. 14th of March 2023

⁴⁴ The Bird & Bird IP Team (2022), *supra nota*. p. 260–296, retrieved from: <https://doi.org/10.1093/jiplp/jpac002>

⁴⁵ European Court of Justice, Cancellation Decision (8th April 2022) N° 3000257

⁴⁶ *Ibid.*, p.2

⁴⁷ *Ibid.*, p.2

⁴⁸ *Ibid.*, p.2

⁴⁹ *Ibid.*, p.4

3.2 AirWair Int'l Ltd. v. Pull & Bear Espana SA

This case took place in the United States as Airwair International Ltd, the owner of a United Kingdom company Dr. Martens Airwair Group Ltd. sued in California for an infringement of their trademark, as well as trade mark dilution and unfair competition claims under federal and California state law.⁵⁰ Airwair sued two companies: Pull & Bear, a Spanish company owned by an international fashion-retailer Inditex, and ITX USA (ITX), LLC, which was stated to be “a United States sister company, or other affiliate”⁵¹ of Pull & Bear, based in New York.⁵² According to Airwair’s claims, ITX was responsible for the e-commerce happening in the United States and the operating of the Pull & Bear’s U.S website with Pull & Bear’s direct oversight.⁵³ Airwair claimed that their trade dress was unique and Pull and Bear have damaged their business and reputation.⁵⁴ Pull and Bear did not see that the court in question had jurisdiction over the case and dismissed the action on the grounds that Pull and Bear does not distribute, market, or advertise the goods in California or in the US altogether.⁵⁵

The court finally decided the case in favor of the plaintiff Airwair Int’l Ltd. Regarding the first claim of Airwair, which was infringement of their trade mark under 15 U.S.C. §1114 (1)), the court established that the marks of “yellow stitching in the welt area, a two-tone grooved sole edge” (Registration No. 24377751), “a sole edge including longitudinal ribbing, and a dark color band over a light color” (Registration No. 5067689) and “longitudinal ribbing and a dark color band over a light color on the outer sole edge, welt stitching and a tab located at the top back heel of footwear” (Registration No. 5067692) are all valid trademarks and therefore infringed by the defendant.⁵⁶ The claims followed by that which were unfair competition under 15 U.S.C. §1125 and California common law, the court saw that the defendant did use similar trade dress as the plaintiffs, and without the plaintiff’s consent, which could cause confusion among the consumers and the general public.⁵⁷ The fourth and fifth claim presented, Trade mark Dilution under 15 U.S.C. §1125 (c), the court held that the defendant did take advantage of the similar

⁵⁰ AirWair Int'l Ltd. v. Pull & Bear Espana SA, (2020) Case No. 19-cv-07641-SI, (N.D. Cal.)

⁵¹ *Ibid.*

⁵² *Ibid.*

⁵³ *Ibid.*

⁵⁴ Lidgett, Adam (2021) Dr. Martens Maker Wins Injunction in California Trade Dress Case, *Law360*

⁵⁵ *Ibid.*

⁵⁶ Court Decision, 15.11.2021, United States District Court, Northern District of California, Airwair International LTD v. ITX USA LLC, Order Granting Plaintiffs Motion For Permanent Injunction, retrieved from <https://law.justia.com/cases/federal/district-courts/california/candce/3:2019cv07641/351812/201/> 24th April 2023

⁵⁷ *Ibid.*

trade dress in the boots without consent of the plaintiff and that it was likely to cause confusion amongst the public.

Ultimately, the Court grants permanent injunction for ITX and Pull and Bear, (the enjoined parties).⁵⁸ The parties are hereby restrained from “designing, manufacturing, importing, exporting, distributing, licensing, selling, marketing, advertising, promoting or offering for sale in the United States the ITX Accused Footwear or any footwear that uses any of the Dr. Martens Trade Dress.”⁵⁹

As the previous case, this case highlights again the strong trade mark of Dr. Martens, the yellow stitching on a black welt, but in the US territory. Even though there are different jurisdictional systems, the protection granted for the trademarks appears to be strong in both.

⁵⁸ Court Decision, 15.11.2021, United States District Court, Northern District of California, Airwair International LTD v. ITX USA LLC, Order Granting Plaintiffs Motion For Permanent Injunction, retrieved from <https://law.justia.com/cases/federal/district-courts/california/candce/3:2019cv07641/351812/201/> 24th April 2023

⁵⁹ *Ibid.*

4. LOUBOUTIN, LEGAL DISPUTES

Christian Louboutin S.A. is a high-end fashion designer from France, making ladies footwear and accessories.⁶⁰ The famous designer brand has used a bright red lacquer on the sole of the shoe for many decades; it has been a distinguishing feature of the shoes⁶¹, and in 2008, the red sole was granted protection as a trade mark under the Lanham Act in the United States.⁶² In 2010, the red sole was granted a trade mark from the Benelux Office for Intellectual Property, and in 2013 the mark was amended so that only high-heeled shoes would be covered. Louboutin has suffered multiple trade mark infringement proceedings as well, the most well-known cases relating to the use of the red sole in footwear, the defendants being for example Yves Saint Laurent and the Dutch shoe retailer, Van Haren. Both cases examine whether the red sole can be trademarked, as the defendants have challenged the function of the red sole as a trademark.⁶³ The outcomes of these cases have been various, with different questions considered and different outcomes.

4.1 Christian Louboutin SAS v. Van Haren Schoenen BV

A notable case concerning Louboutin was again with Van Haren, the Dutch shoe-retailer. In this lengthy case, Van Haren started to sell women's high heels with a red sole, and Louboutin initiated trade mark infringement proceedings; after a successful proceeding for Louboutin, Van Haren challenged the red sole as a trademark.⁶⁴ The parties had different opinions on whether the red sole could be seen as a mere color mark, which Van Haren claimed (in addition to challenging the distinctiveness altogether), or a figurative mark, as Louboutin claimed.⁶⁵ The Hague Court initially ruled that Van Haren would be liable for trade mark infringement, as far as the trade mark was valid⁶⁶, and the judge emphasized that the qualification of the mark did not

⁶⁰ Metzgar-Schall, N. (2015). Christian louboutin, s.a. v. yves saint laurent america, inc. and single-color trade mark protection through the doctrine of secondary-meaning. *Arizona State University Sports and Entertainment Law Journal*, 5(1), 154-162.

⁶¹ *Ibid.* p. 154-162.

⁶² Kuitse, R. L. (2013). Christian louboutin's red sole mark saved to remain louboutin's footmark in high fashion, for now. *Indiana Law Review*, 46(1), 241-242.

⁶³ Hocking, A. H., & Desmousseaux, A. (2015). Why louboutin matters: what red soles teach us about the strategy of trade dress protection. *Trade mark Reporter*, 105(6), 1339

⁶⁴ Beck, Benjamin & von Werder Konstantin (2018) Court of Justice of the EU: Louboutin's Red Sole Trade mark Is Valid, retrieved from <https://www.allaboutipblog.com/2018/06/court-of-justice-of-the-eu-louboutins-red-sole-trademark-is-valid/> 17th March 2023

⁶⁵ Gommers, Carina & De Pauw, Eva (2016) "Red Sole Diaries": a tale on the enforcement of Louboutin's position mark, *Journal of Intellectual Property Law & Practice*, Volume 11, Issue 4, p.258-269, retrieved from <https://doi.org/10.1093/jiplp/jpw008> 17th March 2023

⁶⁶ Gommers, Carina (2016) CJEU referral on Louboutin's red sole trademark, *Journal of Intellectual Property Law, & Practice*, Volume 11, Issue 7, p. 481-482, retrieved from <https://doi.org/10.1093/jiplp/jpw077> 17th March 2023

matter when assessing the distinctiveness of the mark.⁶⁷ Additionally, there were discussion whether the color red could be seen as a part of the “shape” giving substantial value to the goods according to the EU Trade mark Directive, which would exclude the mark from being valid according to the Article 4 (1)(e)(iii).

The question of if the “shape” was limited to only three-dimensional properties of the goods was referred to the CJEU.⁶⁸ In the additional opinion from the CJEU Advocate General Maciej Szpunar hold that he would classify the Louboutin’s trade mark as a sign consisting of the shape of the goods, because the “shape of the sole matches the spatial delimitation of the color red.”⁶⁹ The CJEU did not however agree with this opinion and upheld the validity of the Louboutin’s red sole trademark, as they concluded that the color of the trademark, which is the main feature of the sign with an internationally recognized identification code, cannot be seen only to be composed of shape of the product.⁷⁰ in their judgement, the validity is with a limitation that it is only valid when used with a contracting upper part, meaning that is the whole shoe is red, the trade mark would not be valid.

As this ruling concerned the Trade mark Directive 2008/95, which has been now replaced with the directive 2015/2436 with the changed wording from “the shape which gives substantial value to the goods...” to “signs shape or another characteristic...”, the meaning of this ruling seems unclear; under the new directive, the red sole could, according to a source, fall into the category of “another characteristic”.⁷¹

4.2 Christian Louboutin S.A. v. Yves Saint Laurent America, Inc.

Christian Louboutin S.A. v. Yves Saint Laurent America, Inc. is a significant trade mark infringement case concerning the trademarked red sole of Louboutin in the US. In this instance, Louboutin sued YSL for creating a line of footwear with red soles that were similar to his trade mark red-soled footwear. The use of a red sole on footwear, which Louboutin claimed it had been using since 1992, was claimed to be a distinctive brand, and YSL's use of a red sole on

⁶⁷ Gommers, Carina & De Pauw, Eva (2016) *supra Nota 4*, p. 258-269

⁶⁸ Gommers, Carina (2016), *supra nota 49*, p. 481-482

⁶⁹ Beck, Benjamin & von Werder Konstantin (2018) Court of Justice of the EU: Louboutin’s Red Sole Trade mark Is Valid, retrieved from <https://www.allaboutipblog.com/2018/06/court-of-justice-of-the-eu-louboutins-red-sole-trademark-is-valid/> 17 March 2023

⁷⁰ *Ibid.*

⁷¹ Teilmann-Lock, Stina & Petersen, Trine Brun (2018) Louboutin’s red sole mark and the logics of fashion, *Journal of Intellectual Property Law*, Volume 13, Issue 11, p.890-895. Retrieved from <https://doi.org/10.1093/jiplp/jpy136> 17 March 2023

some of its shoes was claimed to be trade mark infringement. YSL was granted a trade mark for the red soles in the United States in 2008.⁷²

The shoes YSL released that Louboutin claimed were infringing their trade mark were red in color, including the sole.⁷³ Due to the red sole, Louboutin asked YSL to remove the shoes from the market.⁷⁴ The line of shoes did include other monochromatic color shoes as well, such as purple, green, and yellow.⁷⁵ YSL also argued that they had been selling same kind of shoes since the 1970's, with red soles.⁷⁶ The two parties were keen to negotiate to avoid lengthy litigation, but the negotiations ended up being unsuccessful, and litigations started by Louboutin filing an action, claiming actions under the Lanham Act, 15 U.S.C § 1051 for trade mark infringement, counterfeiting and false designation of origin and trade mark dilution and claiming these same things under the state law with unlawful deceptive acts and practices.⁷⁷

The district court and the circuit court denied the denied the Louboutin's motion for preliminary injunction and stated that a "single color can never be protected by a trade mark in the fashion industry."⁷⁸ However, the case went further and was eventually decided by the Second Circuit Court of Appeals in 2012 after going through several rounds of appeals. The Second Circuit Court of Appeals decided against the decisions before, that Louboutin's crimson sole trade mark was legitimate when used in shoes as a contrasting color to the other color. Still, it remained as the judge determined that YSL's use of a red shoe with a single color was not a violation towards Louboutin's trademark.

This case was important because it established that color can be protected as a trade mark if it satisfies the distinctiveness requirements and clarified the extent of Louboutin's trade mark rights

⁷² Metzgar-Schall, N. (2015). Christian louboutin, s.a. v. yves saint laurent america, inc. and single-color trade mark protection through the doctrine of secondary-meaning. *Arizona State University Sports and Entertainment Law Journal*, 5(1), 154-162.

⁷³ *Ibid.* p.155

⁷⁴ *Ibid.* p.155

⁷⁵ Court Decision, 05.09.2012 United States Court of Appeals, (2012) Second Circuit, Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc. (n.d.). Docket No. 11-3303-cv. retrieved from <https://h2o.law.harvard.edu/cases/4776>, March 31, 2023

⁷⁶ *Ibid.*

⁷⁷ Metzgar-Schall, N. (2015). Christian louboutin, s.a. v. yves saint laurent america, inc. and single-color trade mark protection through the doctrine of secondary-meaning. *Arizona State University Sports and Entertainment Law Journal*, 5(1), 154-162.

⁷⁸ Metzgar-Schall, N. (2015). Christian louboutin, s.a. v. yves saint laurent america, inc. and single-color trade mark protection through the doctrine of secondary-meaning. *Arizona State University Sports and Entertainment Law Journal*, 5(1), 154-162.

in the US. Additionally, it demonstrated that even if a trade mark has been registered with the government, the judges can still review and determine whether it is distinctive.

5. COMPARISON OF THE DISPUTES IN THE CONTEXT OF EU LAW

The disputes presented are fairly recent regarding trademarks and have had a significant impact on the ideas of legal criteria and the idea of distinctiveness relating to trademarks. The cases raise questions about non-traditional trademarks, i.e., colors and shapes, regarding the scope of protection granted to them and to what extent they are able to protect their trade mark by preventing other businesses to use features alike in their own products. Distinctiveness plays a big part in all of the cases, but it is looked at in different way. The cases relating to Airwair and Dr. Martens center around the distinctiveness of the yellow stitching in the shoes, whether it brings value to the shoe and whether trade mark is valid, as the stitching has been merely functional in nature in the past. In the cases relating to Louboutin, the red sole of the shoe has been the issue in the center, that as well being a distinctive feature of the Louboutin shoes. The questions arisen from these cases have been merely about can a color be trademarked and whether a color qualifies as a distinctive feature- in the EU the red color trade mark has even been challenged by a competitor.

As both of the companies relating to the cases examined in this thesis, Dr. Martens, and Louboutin, have trademarks in the EU, it is important to look these cases in the context of EU law. When assessing distinctiveness, there is certain criteria to be fulfilled. In the European Union, the European Union Intellectual Property office (EUIPO) determines the criteria distinctiveness of a trademark. It will take into account number of elements when determining a signs distinctiveness, such as the signs inherent characteristics, market context, and the perception of a consumer, along with evidence of acquired distinctiveness. The degree of acquired distinctiveness or secondary significance is another factor used by EUIPO. By being used in the marketplace, a trade mark that has gained distinctiveness, like a well-known brand name, has become recognisable. The EUIPO looks at the trademark's degree of recognition in the relevant market and whether it has come to be associated with a specific good or service.

When discussing word marks, the traditional frameworks seem to be a good way to assess distinctiveness, as words usually have well-known meanings which are easy to assess.⁷⁹ But as talking about marks which are non-traditional, such as colors, shapes or sounds, the traditional framework might not be the ideal way to assess distinctiveness.⁸⁰ The assessment of non-

⁷⁹ McKenna, M. P. (2008). Teaching trade mark theory through the lens of distinctiveness. *St. Louis University Law Journal*, 52(3), 843-854.

⁸⁰ *Ibid.* p. 843-854.

traditional marks is complex, and requires case-by-case analysis, taking into consideration multiple different factors, such as the level of recognition, the degree of uniqueness and the use over time.

5.1 The acquired meaning

A key concept here is the secondary meaning, or the acquired distinctiveness through use, which is what the EUIPO will examine if a mark does not comply with the Article 7 (1) (b) (c) or (d) of the European Union Trade Mark Regulation, as long as the intended trade mark has become distinctive through the usage of it.⁸¹ In this way, the Article 7 requirement of the distinctiveness can be overlooked, and it can be registered as a trademark, such as has been made with the red sole of the Louboutin shoes and the yellow stitching of Dr. Martens boots for example. In the guidelines of assessing distinctiveness, it is also pointed out that the distinctiveness must be acquired before the filing of the trade mark application, and it has to be relevant in the field of the goods and services; the applicant must provide evidence that the goods or services are coming from the trade mark owner because of that trademark.⁸² In the US, the secondary meaning is also understood in a broader sense, whereas in the EU, it must be in the relevant context where the goods or services are sold.

In all the cases presented where Dr. Martens was the plaintiff, the ruling has been done in favor of Dr. Martens. As both the EU and US cases have been surrounding the same distinctive features of the Dr. Martens shoes design, particularly the yellow stitching, the trade mark appears to remain secure and strong, throughout the EU and the US.

In the Louboutin cases, the case involving Van Haren, was decided in favor of Louboutin, but the case involving Yves Saint Laurent, was more complicated. The trade mark of Louboutin was enforced in the EU, but the US was hesitant to grant a trade mark to the red sole at first. As it was granted eventually, the trade mark is valid, but the hesitation in the beginning can make one question the strongness of the trademark.

⁸¹ Guidelines for examination of European Union Trademarks, European Union Intellectual Property Office, retrieved from [https://euiipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/trade_marks/draft-guidelines-2017-wp-lr2/27_part_b_examination_section_4_AG_chap_14_article_7\(3\)_tc_lr2_en.pdf](https://euiipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/trade_marks/draft-guidelines-2017-wp-lr2/27_part_b_examination_section_4_AG_chap_14_article_7(3)_tc_lr2_en.pdf) 26th April 2023

⁸² *Ibid.*

5.2 Recent development of trademarks

The protection of non-traditional trademarks such as the ones Dr. Martens and Louboutin have, has grown significance in the past years. Irene Calboli claims in her article that this is unnecessary, is based on an incorrect interpretation of the notion of distinctiveness and can lead to the limiting of the competition in the markets for aesthetic aspects and product design, e.g., colors, patterns, and shapes.⁸³ It is also claimed that they act as barriers to creativity and design.⁸⁴ The failure to interpret distinctiveness is based on the vague interpretation of the notion of distinctiveness⁸⁵, and today, anything that is vaguely distinctive in its representation, can claim the status of a trademark, according to Calboli.⁸⁶ Will the protection of non-traditional trademarks go beyond reason? The risk of the scope of protection becoming too wide is real. With limiting the markets, the overprotection can also potentially limit the availability of certain products as well, which in the end does not serve consumers nor businesses. However, it can be also argued that the protection of non-traditional trademarks is important in the competitive markets of today and that it enhances creativity and design, rather than blocking them.

The future of trademark protection is something that is important to discuss as well. In recent years, the changes in trademark law have been significant for various reasons; the technological advancement and the growth of the online shopping platforms, to name a few. 3D printing is an interesting issue regarding the technological advancements; it has the potential to disrupt the fashion industry in many ways. This will bring new challenges to the trademark protection, for example with the rising of the 3D technology, it may become difficult to distinguish between physical and digital goods, and to determine what types of trademarks are appropriate for these new types of expression. Some authors even claim that 3D printing will diminish the need for trademarks altogether.⁸⁷ It will remain to be seen, whether there will be a need for new legal frameworks regarding it.

However, all the above highlight the importance of distinctiveness in trade mark law. In the cases, the distinctiveness was inspected through the lens of secondary meaning, when

⁸³ Calboli, I. (2022). "Chapter 1: Non-traditional trademarks as barriers to competition, innovation, and creativity: what if their protection could be effectively limited in practice?". In *Reforming Intellectual Property*. Cheltenham, UK: Edward Elgar Publishing. p. 1-7. Retrieved May 5, 2023, from <https://doi.org/10.4337/9781803922256.00006>

⁸⁴ *Ibid.* p. 1-7.

⁸⁵ *Ibid.* p. 1-7.

⁸⁶ *Ibid.* p.1-7.

⁸⁷ Grace, J. (2014). The end of post-sale confusion: how consumer 3d printing will diminish the function of trademarks. *Harvard Journal of Law & Technology*, 28(1), 263-288.

determining the validity of the trademarks. Additionally, the cases highlight the importance of jurisdiction; in cases involving trademarks, the specific jurisdiction can have a major impact on the outcome. Jurisdiction was a critical factor for example in the *Airwair v. Van Haren*, where the court did uphold the validity of the trademark, but only in the Netherlands.

6. CONCLUSION

To summarize, after a brief introduction to the international legal framework for trade mark law, this thesis consisted of an overview of distinctiveness as a trade mark issue and presenting four trade mark dispute cases: two from US and two from inside the EU. The cases from concerning these trade mark disputes were various, but they certainly have strengthened the trade marks in question, both in the US and in the EU, as well as set precedent for the protection of non-traditional trademarks. As research questions, the thesis provided the following: what are the differences in the distinctiveness criteria between EU and the US trade mark laws and how do these differences affect the effectiveness of trademark protection for the shoe industry in the two regions? How have the most significant cases of trade mark battles in the EU and in the US affected the criteria for distinctiveness? And lastly, how do the different approaches to distinctiveness affect the level of protection granted?

As for the first question, the findings on the difference of the distinctiveness criteria in the US and the EU were not very significant. But while the EU seems to focus on the acquired distinctiveness when examining the distinctiveness of a trademark, the US seems to focus on other things, in the *Louboutin* case, to the functionality of the red sole, and in the *Dr. Martens* case, to the distinctiveness of the stitching design. These differences can have effect on the protection of a non-traditional mark in the US and in the EU; the focus on one thing is always away from something else.

The US system of the “spectrum of distinctiveness” can leave room for different kinds of marks to be registered, and it can be easier to get protection for a trademark; however, the burden of proofing the acquired distinctiveness lies with the applicant. In the EU, the focus on inherent distinctiveness can mean that stronger trademarks are protected; the somewhat more flexible approach of the US can lead to less protection and therefore, weaker against potential infringers. The differences in the approach to distinctiveness criteria have implications for the level of protection granted to non-traditional marks, which in turn can possibly affect the ability of companies to establish and maintain their brands. While a stricter approach to distinctiveness may keep corporations from monopolizing conventional designs, it may also result in weaker protection of important trademarks. A more flexible approach, on the other hand, may allow for the protection of a greater range of trademarks, but it may also result in the overprotection of non-distinctive or descriptive marks. In this regard, both EU and the US can have things to learn from each other; who is to say, is either one better than the other. Ultimately both EU and the US

need to balance between preserving valuable trademarks and avoiding overprotection of non-distinctive marks, encouraging innovation and creativity, and preventing anti-competitive practices.

The cases of these trademark battles have taught a lot about the distinctiveness in the two regions. Both regions have emphasized the visual distinctiveness of non-traditional marks, and particularly in the EU, the battles have highlighted the importance of acquired distinctiveness. The non-traditional marks that have acquired distinctiveness through use can also have a narrower scope of protection in contrast with the inherently distinctive marks. In conclusion, the significant battles of for trademark protection have shown that the importance of understanding the criteria of distinctiveness in different regions for effective trademark protection.

Overall, the different approaches to distinctiveness in the US and in the EU can reflect legal traditions and tell us about the jurisdictional systems. While both systems have their advantages regarding the protection of non-traditional trademarks, the applicants for trademarks need to be aware of these differences to protect their trademark as effective as possible.

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