

Bata Toughees' sole reason for suing rival

By [Waldo Steyn](#)

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It's been reported that Bata Toughees manufacturer, Futura Footwear, is suing a rival called Novita in South Africa for selling shoes which bear a similar wavy sole pattern.



Futura claims that there's been trademark infringement and passing off. Futura maintains that the wavy sole serves to distinguish the Bata Toughees brand from other brands. A representative of the company is quoted as saying: "The sole serves to assist customers who are illiterate, to identify the Toughees shoes by visual symbols of the sole design more readily."

Novita, on the other hand, maintains that the sole plays no role in the shoe-purchasing decision, pointing out that the sole's not even visible when the product is on display.

The case is interesting for various reasons. For starters, some people may be surprised to hear that the design of the sole of a shoe can be registered as a trademark. In fact, it's possible to register as a trademark almost any feature that serves to indicate the origin of the product and distinguish it from the competition. That's because the Trademarks Act has a very wide definition of the term "mark", and this includes words, colours, numbers, patterns, ornamentation and shape. A sole design would probably fall under what's loosely termed a 3D mark.

A 3D mark is no different from a conventional word or logo mark, in that it can be registered only if it is distinctive. The mark can either be inherently distinctive, for example if it's striking or unusual, or it can acquire distinctiveness through extensive use. Yet it does seem that the trademark authorities need more persuading when it comes to 3D marks than with word or logo marks. That's because they're not always convinced that a 3D mark is regarded *as a trademark* by the public. So you'll find that 3D marks are rarely accepted on the basis of inherent distinctiveness.

Further, even if you can show that a 3D mark has become associated with your product through considerable use (in other words, that it actually acquired distinctiveness), you may still need to persuade the authorities that the public actually sees that feature as serving a trademark (origin-identifying) function. In a recent case Europe's highest court refused to register the shape and appearance of the Lindt gold bunny for chocolate. The court said that a 3D mark can only be registered if it "departs significantly from the norm or customs of the industry and thereby fulfils its essential function of indicating origin."

SA no stranger to interesting shoe trademark cases

There have been some interesting shoe trademark cases in South Africa. In an old case involving Puma, the court took the view that stripes (or stripe motifs) applied to sports shoes were not trademarks but simply a form of adornment. But the South African courts now recognise that this isn't the case at all. In the recent case of *Adidas v Pepkor*, the Supreme Court of Appeal accepted that Pepkor had infringed various three-stripe trademark registrations belonging to Adidas by selling a shoe bearing a four-stripe motif. In the process, the court rejected the argument raised by Pepkor that stripes on shoes are simply decorative and do not perform a trademark role. The judge said this:

"It seems to me that it will be very difficult to persuade a court that any mark applied to goods for 'embellishment' or 'decoration'... is not applied for the purposes of distinguishing the goods...If the use creates an impression of a material link between the product and the owner of the mark there is infringement, otherwise not."

So what about sole designs?

They are slightly different in that they're less visible than stripes or other motifs applied to the sides of shoes. Novita might therefore respond to a claim of trademark infringement by applying to cancel the Futura registration. It might argue that, even if registration was granted on the basis of acquired distinctiveness, that acceptance was wrong because a sole design is not seen as a trademark (an origin-indicating feature) by the public. If this happens the court might then need to consider evidence as to how people actually go about buying shoes. A factor that might come into play is that in a society with low literacy levels, features like sole designs might play a significant role. Language and literacy issues certainly can come into trademark cases. For example, there was a case in the Western Cape where the court held that the trademarks Albex and All Blax (both for bleaches) would be confused. The court reasoned that, although educated and first-language English speakers probably wouldn't confuse the marks, there are many people in the Western Cape who don't fall into these categories.

Another argument that Novita might possibly put forward in an application to cancel the Futura trademark is that the sole design consists *exclusively* of a pattern that is necessary to obtain a specific technical result - in this case providing the shoe with adequate grip. This argument might even be extended to include that the registration of Futura's sole design as a trademark is likely to limit the development of shoe sole "grip" patterns in South Africa. Importantly, if Futura's sole design is found to consist exclusively of a pattern for providing shoes with adequate grip, then the fact that another pattern could achieve the same technical result should not save the Futura's sole design trademark.

Novita's defence might be...

Even if Novita doesn't attack the trademark registration, it might simply argue that it isn't guilty of infringement because it isn't making what's called "trademark use" of the sole design. In 2007, in a case involving BMW and Verimark, the Supreme Court of Appeal made it clear that a trademark registration is only infringed if a third party uses it as a trademark. The facts there were that Verimark had used a BMW vehicle in a TV ad for a car polish, and the BMW badge was clearly visible in the ad. BMW claimed that Verimark had infringed a trademark registration for the BMW badge. The court disagreed, saying that the use of the badge did not show any commercial connection between the car polish and BMW. A similar type of argument might be raised here - the shoe is sold under a particular brand name, and the wavy pattern that appears on the sole doesn't play any trademark (origin-indicating) role whatsoever.

Futura is also alleging passing off. Passing off is a common-law action that doesn't depend on a trademark registration, but rather on the existence of a reputation and a likelihood of confusion. A major difference between a trademark infringement

claim and a passing-off claim is that, whereas with trademark infringement it's simply a case of comparing mark for mark, with passing off surrounding factors are taken in account. So, for example, the brand names will be considered. Which means that if the Novita shoes are sold under a brand name that's far removed from Bata Toughees, the likelihood of confusion goes down. On the other hand, if it can be shown that a significant number of consumers in fact rely on the wavy sole pattern when making their purchases (perhaps because they can't read the brand names), then there might indeed be a passing off.

So an interesting case on a number of levels. And a reminder that you can and should register all the important distinguishing or origin-indicating features of your product as trademarks. Not just the brand name and logo.

ABOUT THE AUTHOR

Waldo Steyn is Senior Associate in Intellectual Property at ENS (Edward Nathan Sonnenbergs).

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