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The Case Of Non-traditional Trade Marks – Can The Soles Of Shoes Be Protected As Trade Marks?

7 August 2019 *5 min read*

By Janine Hollesen, Head of Intellectual Property Practice

The answer to this question is yes according to the KwaZulu-Natal High Court in a recent case, where Bata Brands SARL ("Bata") sued Novita Shoes CC ("Novita").

Novita, a family-run shoe manufacturing company was sued by Bata for trade mark infringement of its registrations for non-traditional trade marks, which were registered for the ornamentation of soles of shoes.

Bata relied on two trade mark registrations, copied below, both of which carried the endorsement that "the mark consists of the features of the pattern and/or configuration of a sole for footwear, substantially as shown below":

Bata trade mark sole registration

The marks were used by Bata for shoes known in the South African market as Bata Toughees, which have been used for many years for school shoes.

Novita had manufactured a shoe (shown below), presumably for Jet stores, the nationwide clothing and footwear chain:

Jet shoe sole

("Jet Shoes")

The High Court had to decide whether the ornamentation on the sole of the Jet Shoes infringed the Bata trade mark registrations in terms of the Trade Marks Act. It was held that the soles of the Jet Shoes are likely to be confused with the Bata registered marks by a significant number of people viewing them in commercial outlets and found that they infringed the Bata registrations.

In a previous case which dealt with soles of shoes[1] ("Millennium Case"), the issue had to be decided by the Supreme Court of Appeal ("SCA"). The respondent in that case counter-claimed for the removal of the registered shoe sole marks, which were relied upon in the infringement case.

When faced with an infringement action, it is possible to bring a counter-claim for the removal of the mark relied upon, on a number of basis which, if successful, will do away with the infringement action. In that case the SCA found that the registrations were to be removed also on the basis that the marks did not have any distinctive value.

For a trade mark to be registerable, it must be capable of distinguishing the goods or services of a person from the goods or services of another – in other words the mark must serve as a badge of origin.

In the Millennium shoe case, the court held that:

- the mere fact that the soles may be distinctive does not mean that they are distinctive in the trade mark sense, which is to indicate source of origin;
- typically the pattern or shape of a shoe sole would be regarded by the purchaser as either ornamental or as part of the design of the shoe tread and it is seldom that it will be considered to be a source identifier.

The Bata case may have had a different result had Novita applied for the removal of the registrations on the basis that the pattern of the shoe sole was ornamental or was part of the design of the shoe.

With regard to soles of shoes, reference can also be made to the long-running trade mark dispute in the European Union, which was concerned with the red sole of the Christian Louboutin shoes. Louboutin has claimed for some time that it had rights in the red sole of its high-heel shoes. According to internet reports, the shoes sprung to life in 1992 when Louboutin used an assistant's red nail polish to paint the sole of the shoe.

The trade mark registration was limited "high-heeled shoes (other than orthopaedic shoes)." The mark was described as consisting "of the colour red (Pantone 18-1663TP) applied to the sole of a shoe as shown (the contour of the shoe is not part of the trade mark, but is intended to show the positioning of the mark)." The mark is shown below:

Louboutin red sole trade mark

The case was mainly concerned with European trade mark law, which does not allow for the registration of shapes, where they add substantial value to goods. The European Court of Justice was of the view that Louboutin was not aiming to protect the shape of a shoe, but the application of a colour red to a specific part of it and as a result could be protected as a trade mark.

Coming back to South Africa, our Trade Marks Act defines a mark as "any sign capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour or container for goods or any combination of the aforementioned". As a result, any of these items (or combination thereof), generally termed non-traditional trade marks, can be registered as a trade mark.

However, it does not end there as the Act provides that a non-traditional trade mark can be removed from the register, where its registration will limit the development of any art or industry.

It is therefore important when filing applications for non-traditional trade marks that they are filed correctly to ensure that they are graphically represented, which would include the appropriately worded endorsements to ensure that the mark can upheld judicial scrutiny if attacked.

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[1] Lubbe NO and others v Millennium Style Proprietary Limited [2007] SCA 10 (RSA).



Janine Hollesen

Head of Intellectual Property

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