

**EIP**

# Nike Just Do It Again in “FOOTWARE” Trade Mark Dispute Against Puma

The UK High Court dismissed Puma SE’s (“Puma”) appeal against UK IPO decision O-415-20 (the “Decision”) relating to the registration of the word mark “FOOTWARE” by Nike Innovate C.V (“Nike”).

## **Background**

The Hearing Officer rejected Puma’s opposition to the registration of the word mark “FOOTWARE” by Nike in respect of goods and services in classes 9, 38 and 42 (encompassing software and hardware). The application which led to Nike’s registration was dated 14 March 2019.

Puma’s opposition was based on sections 3(1)(b), (c) and (d) of the Trade Marks Act 1994.

The Hearing Officer concluded that the mark was not descriptive and therefore did not fall foul of s.3(1)(c) (with the same conclusion applying to s.3(1)(b)). In relation to s.3(1)(d) and on the evidence relied upon by Puma, the Hearing Officer concluded that the use of “FOOTWARE” had not become customary in the trade for any of the contested goods or services at the relevant date.

## **Puma’s Grounds of Appeal**

Puma sought to argue against the Hearing Officer’s decision on all fronts.

In relation to s.3(1)(b) and (c), Puma argued that (i) the Hearing Officer erred in failing to consider the notional and fair use of the trade mark across the full range of its very broad specification of goods and services; and (ii) if the Hearing Officer had considered notional and fair use in relation to the area of specifications where Puma contended that the mark

was descriptive, the only reasonable conclusion to be drawn was that the mark was descriptive.

On s.3(1)(d), Puma submitted that the Hearing Officer again erred because she failed to consider notional and fair use of the mark, which included use in relation to footwear products.

### **Standard of Review in the High Court**

The Judge was clear on the standard of review to be applied to an appeal from an IPO decision referencing *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) [2017] R.P.C. 17, in which Daniel Alexander QC sitting as the Appointed Person summarised the role at paragraph 52. Additionally, counsel noted that the summary should be read together with the authorities cited earlier in that decision.

### **Section 3(1)(c) Outcome**

Puma's case under s. 3(1)(b) was not advanced on a different basis from that under s.3(1)(c). And therefore, the parties focused on the objection under s. 3(1)(c).

The Judge got into the detail of the Decision and found it clear therein that the Hearing Officer did consider the full range of possible goods and services for which registration was sought, and therefore rejected Puma's first contention. With that, the Judge took the view that Puma's second contention did not arise and described it as "in reality a complaint as to the application of the (correct) legal principle to the facts." And thus, Puma's submissions were rejected.

### **Section 3(1)(d) Outcome**

The Hearing Officer noted much of the evidence presented in relation to s.3(1)(d) was not from the UK and thus irrelevant to the argument under s.3(1)(d). Puma did not contend that the Hearing Officer's conclusion (that the evidence was insufficient to establish the that use of "FOOTWARE" had become customary in the trade for any of the contested goods or services) was based on an error of principle. Therefore, there was no reason to interfere with the Hearing Officer's primary conclusion.

### **Take Away Points**

The Judgment made clear that if a party is unable to show an error in principle, for example that the Hearing Officer misunderstood the evidence and in doing so, reached the wrong conclusion, then an appeal to the High Court is unlikely to be successful.

For an opponent to succeed in relation to arguments being made under 3(1)(d) that a sign

has become customary in the trade, a party needs to ensure sufficient evidence is provided in relation to trade in the UK concerning the particular goods or services to satisfy the first instance tribunal.

The judgment is available [here](#).