

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

Alicante, 09/02/2026

K&L Gates LLP
OpernTurm
Bockenheimer Landstrasse 2-4
D-60306 Frankfurt am Main
ALEMANIA

Application No:

019169533

Your reference:

6014847.05209

Trade mark:



Mark type:

Position mark

Applicant:

**NIKE Innovate C.V.
One Bowerman Drive
Beaverton Oregon 97005-6453
ESTADOS UNIDOS (DE AMÉRICA)**

ON INHERENT DISTINCTIVENESS**I. Summary of the facts**

On 15/04/2025 the Office issued a Notice of grounds for refusal pursuant to Article 7(1)(b) EUTMR because it found that the trade mark applied for is devoid of any distinctive character.

The goods for which the grounds for refusal were raised were:

Class 25 *Footwear.*

The grounds for refusal were based on the following main findings:

Under Article 7(1)(b) EUTMR, trade marks which are devoid of any distinctive character are not to be registered. It precludes the registration of trade marks which are devoid of distinctive character, which renders them incapable of fulfilling their essential function (16/09/2004, C-329/02 P, SAT.2, EU:C:2004:532, § 23).

The signs referred to in Article 7(l)(b) EUTMR are, therefore, in particular, those which do not enable the relevant public to repeat the experience of a purchase if it proves to be positive, or to avoid it if it proves to be negative, on the occasion of a subsequent acquisition of the goods or services concerned (05/12/2002, T 130/01, Real People, Real Solutions, EU:T:2002:301, § 18; 29/09/2009, T 139/08, Smiley, EU:T:2009:364, § 14 and the case-law cited therein).

A trade mark must also enable the relevant public to distinguish the goods and services of one undertaking from those of other undertakings without conducting an analytical or comparative examination and without paying particular attention (12/02/2004, C-218/01, Perwoll, EU:C:2004:88, § 53; 12/01/2006, C-173/04 P, Standbeutel, EU:C:2006:20, § 29).

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.

Position marks are similar to figurative and three-dimensional marks, as they relate to the application of elements to the surface of a product (15/06/2010, T-547/08, Strumpf, EU:T:2010:235, § 20), and that when assessing the distinctiveness of a mark, the classification of a 'position mark' as a specific category of marks is irrelevant for the purpose of assessing its distinctive character (06/06/2019, C-223/18 P, DEVICE OF A CROSS ON A SPORT SHOE SIDE (fig.), EU:C:2019:471, § 42; 15/06/2010, T-547/08, Strumpf, EU:T:2010:235, § 20, 21 26; 21/10/2004, C-447/02 P, shade of orange, EU:C:2004:649, § 78).

In the present case, the goods are aimed mainly at the general consumers displaying an average level of attention. As the mark applied for bears no verbal element, the relevant public consists at least the general consumers throughout the European Union.

The trade mark applied for cannot be separated from the shape of the *Footwear* and the relevant public does not necessarily perceive a shape mark consisting of the appearance of the product itself in the same way as it perceives a word mark, a figurative mark or a shape mark that does not have such an appearance. While the public is used to recognising the latter marks instantly as signs identifying a product, it will not necessarily do so where the sign is indistinguishable from the appearance of the product itself.

The appearance of the mark for which protection is sought does not depart significantly from the norm or customs of the relevant sector. End users will usually pay more attention to the label or name of the product than to its shape.

The sign consists merely of a combination of presentational features, an area in the midsole designed for specific functions such as shock absorption or arch support, that would be seen by the relevant consumer as typical of the shapes of the goods for which an objection has been raised. This shape is not markedly different from various basic shapes commonly used in the trade for the goods; it is merely a variation of them.

This fact was supported by the following internet searches. Information extracted on 15/04/2025 at:

- <https://www.myfootdr.com.au/2020/08/top-five-signs-your-running-shoes-are-worn-out/>
- [Hitmars Chaussures de Course Homme Femme Running Sport Fitness Respirantes Legere Gym Athlétique AIR Sneaker Noir Vert Blanc Rose Jaune EU36-EU47 : Amazon.fr: Mode](https://www.hitmars.com/produit/chaussures-de-course-homme-femme-running-sport-fitness-respirantes-legere-gym-athletique-air-sneaker-noir-vert-blanc-rose-jaune-eu36-eu47/)
- https://www.skechers.es/en/technologies/comfort-technologies/skech-air/uno---stand-on-air/403674L_WHT.html

The relevant content of the above links was reproduced in the objection letter.

Therefore, the sign is devoid of any distinctive character within the meaning of Article 7(1)(b) EUTMR.

On 11/06/2025, the applicant requested a 2-month extension to submit its observations, which was granted on 11/06/2025.

II. Summary of the applicant's arguments

The applicant submitted its observations on 15/08/2025 which may be summarised as follows.

1. The sign, colloquially referred to as the "Cassette", consists of an irregular and distinctive shape featuring an elongated inner section, positioned on the midsole of Nike's AM90 shoe. This configuration is unusual within the footwear sector and constitutes a visually striking element that departs significantly from the norms and customary designs of the relevant market.
2. The examiner considers that the shape of the mark is dictated by the arch of the shoe, which is said to be a functional and common feature. However, the shape of the mark is an arbitrary design comprising an abstract, fin-like form with an elongated inner section. Its characteristics are aesthetic, non-functional and unusual, and the design is intended to convey an impression of speed or forward motion even when the wearer is stationary.
3. A position mark is defined by the manner in which the sign is applied to a specific location on the relevant goods. In this case, the sign consists of a unique and eye-catching shape that frames and accentuates the visible Air unit of the AM90 shoe.

The examiner's assertion that the sign cannot be separated from the shape of the footwear is unfounded, as the sign is a clearly identifiable and distinct branding element applied to the side of the shoe.

The mark is non-functional and serves as an indicator of commercial origin when placed on the rear midsole of Nike's AM90 footwear; it is not merely an area of the midsole.

4. The assessment of distinctive character must be carried out with reference to the goods for which registration is sought, taking into account the perception of the relevant public. In this respect, the Cassette shape is unique and not a common feature of footwear. When viewed in its specific position on the shoe, it constitutes a striking focal element that attracts attention and enables consumers to identify the product as originating from Nike.

5. Several trade marks for Class 25 goods have been registered in the European Union despite consisting of relatively simple shapes, on the basis that they possess sufficient inherent distinctiveness.

Representation	EU Trade Mark Registration No.	Filing Date	Status
	018957248	29 November 2023	Registered
	018788380	31 October 2022	Registered
	018326910	26 October 2020	Registered
	018135227	11 October 2019	Registered
	019120100	16 December 2024	Registered

	019044140	20 June 2024	Registered
	018755531	02 September 2022	Registered
	018759833	12 September 2022	Registered

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.

After giving due consideration to the applicant's arguments, the Office has decided to maintain the grounds for refusal.

Article 7(1)(b) EUTMR

Pursuant to Article 7(1)(b) EUTMR, trade marks which are devoid of any distinctive character shall not be registered.

It is settled case-law that a mark is distinctive in the sense of Article 7(1)(b) EUTMR if this mark serves to identify the product or service in respect of which protection is sought as originating from a particular undertaking, and thus to distinguish that product or service from those of other undertakings (29/04/2004, C-473/01 P & C-474/01 P, Tabs (3D), EU:C:2004:260, § 32; 21/10/ 2004, C-64/02 P, Das Prinzip der Bequemlichkeit, EU:C:2004:645, § 42).

As also correctly pointed out by the applicant, a minimum degree of distinctive character is sufficient to preclude the application of the absolute ground for refusal set out in Article 7(1)(b) EUTMR (24/01/2017, T-96/16, STRONG BONDS. TRUSTED SOLUTIONS, EU:T:2017:23, § 14). The registration of a sign as a trade mark is not subject to or dependent on a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings (16/09/2004, C-329/02 P, SAT/2, EU:C:2004:532, § 41).

In order to assess whether a trade mark has any distinctive character, the overall impression it conveys must be considered. The public perceives a trade mark as a whole and does not proceed to analyse its various details (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 25).

The Office stresses that a trade mark must enable purchasers of the goods or services in question to distinguish them from the goods or services of other undertakings without conducting an analytical or comparative examination and without paying particular attention (12/02/2004, C-218/01, Perwoll, EU:C:2004:88, § 53; 12/01/2006, C-173/04 P, Standbeutel, EU:C:2006:20, § 29).

The Office must, in order to determine whether the sign in respect of which protection is sought under trade mark law has distinctive character, carry out an examination by reference to the actual situation, taking account of all the circumstances of the case and in particular any use which has been made of the sign (see, by analogy, 27/03/2019, C-578/17, Hartwall, EU:C:2019:261, § 26 and the case-law cited).

The examination of the distinctive character of a mark cannot therefore be carried out in the abstract (see, by analogy, 27/03/2019, C-578/17, Hartwall, EU:C:2019:261, § 27 and the case-law cited).

Moreover, the distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception which the relevant public has of those goods or services (13/09/2018, C-26/17 P, DEVICE OF A PATTERN (fig.), EU:C:2018:714, § 31 and the case-law cited).

Relevant public

In the present case, given the nature of the products in question, the level of attention of the relevant public will be that of an average consumer, normally informed and reasonably attentive and aware.

Since the sign does not include any verbal elements, the relevant public to be considered is that of the entire European Union.

The sign



The sign applied for consists of the mark

The contested mark is not a mere figurative mark, but a position mark and has to be assessed as such. A trade mark may be devoid of distinctive character as a figurative mark but when applied for on a specific position or positions it may obtain a distinctive character. Thus, the position of the trade mark is relevant for the overall assessment. However, it is to be stressed that the mark as such is also relevant for the overall comparison.

The representation of the contested mark shows the position of an elongated, curved and irregular figurative element applied to the rear side of the midsole of a shoe, extending along the arch of the foot to the heel.

The applicant submits, point 1, that the sign, referred to as the "Cassette", is unusual and visually striking within the footwear sector and therefore departs significantly from market norms. This argument cannot be upheld.

In the footwear sector, consumers are accustomed to a wide variety of midsole designs, contours and surface elements, particularly in sports and lifestyle footwear. Variations in shape, thickness, cut-outs or elongated sections in the midsole are commonplace and form part of the normal design freedom available to manufacturers. The mere fact that a shape is irregular or eye-catching does not, in itself, confer distinctive character.

According to settled case-law, only a mark which departs significantly from the norms or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR (20/10/2011, C 344/10 P & C 345/10 P, Botella esmerilada II, EU:C:2011:680, § 47).

The shape at issue does not depart significantly from these norms. It appears as yet another ordinary midsole panel, consistent with the wide variety of shapes used for cushioning, stability, or purely decorative purposes. The fact that the applicant considers the shape "irregular" does not mean that consumers will perceive it as a trade mark.

The applicant argues, point 2, that the shape is purely aesthetic, non-functional and arbitrary, and therefore distinctive. However, the absence of a technical function is not sufficient to establish distinctive character.

Even assuming that the sign is not technically dictated by function, this does not automatically mean that consumers will perceive it as a trade mark. In sectors such as footwear, consumers primarily perceive shapes, lines and contours applied to the midsole as decorative or structural design elements, regardless of whether they serve a technical purpose.

Moreover, the elongated and contoured form of the sign follows the natural architecture of the shoe and integrates seamlessly into the midsole structure. As such, it will be perceived as part of the product's overall design rather than as an autonomous sign. The alleged impression of "speed" or "forward motion" is a subjective aesthetic effect and does not amount to an indication of commercial origin.

The applicant claims, point 3, that the sign is clearly separable from the footwear and functions as a branding element framing the visible Air unit. This argument is not persuasive.

The Office recalls that position marks are assessed in the same way as figurative or three-dimensional marks, as they relate to the application of elements to the surface of a product (15/06/2010, T-547/08, Strumpf, EU:T:2010:235, § 20), and that when assessing the distinctiveness of a mark, the classification of a 'position mark' as a specific category of marks is irrelevant for the purpose of assessing its distinctive character (06/06/2019, C-223/18 P, DEVICE OF A CROSS ON A SPORT SHOE SIDE (fig.), EU:C:2019:471, § 42; 15/06/2010, T-547/08, Strumpf, EU:T:2010:235, § 20, 21 26; 21/10/2004, C-447/02 P, shade of orange, EU:C:2004:649, § 78).

What matters is whether the sign, as applied to the goods, will be perceived by the relevant public as indicating commercial origin.

It is acknowledged that certain designs or logos may become associated with particular brands through consistent use and recognition. However, this does not mean that every design or shape placed on the heel area will automatically be perceived as a mark of origin. In this case, the mark applied for lacks inherently distinctive elements that would be immediately recognised as an indication of origin.

The sign is integrated into the midsole area, an area of footwear where consumers expect to find design, cushioning, reinforcement and aesthetic features. The applied-for sign does not stand out as an independent badge of origin but is perceived as a design element highlighting or surrounding a functional or decorative component of the shoe.

The fact that the sign is placed in a specific location does not, in itself, render it distinctive. Consumers do not habitually infer trade mark significance from midsole shapes or contours unless they are markedly different from sector norms, which is not the case here.

Finally, the applicant asserts, point 4, that due to its uniqueness and visual impact, the sign enables consumers to identify the goods as originating from Nike. This claim cannot be accepted.

Distinctive character must be assessed independently of any association with a specific undertaking and cannot be based on the applicant's reputation or internal branding strategy. The relevant question is whether average consumers, without prior knowledge or training, would perceive the sign as a trade mark.

In the footwear sector, consumers rely primarily on word marks, logos or well-known figurative elements to identify origin. They do not generally perceive midsole design features

as trade marks unless those features are exceptionally striking and immediately recognisable as badges of origin. The sign at issue does not meet this threshold.

Consequently, the relevant public will perceive the applied-for sign merely as a decorative or structural element of the footwear design and not as an indication of commercial origin.

Prior registrations by the EUIPO

Finally, the accepted registrations, cited by the applicant, point 5, cannot lead to a different result.

Indeed, earlier registrations may be taken into consideration, but they are not decisive and do not oblige the Office to register the same sign or a similar one (14/06/2007, T207/06, EUROPIG, EU:T:2007:179, § 40), and the applicant cannot rely, in support of that argument, on a decision that was supposedly more lenient in earlier cases (27/02/02, T-106/00, STREAMSERVE, EU:T:2002:43, § 66 and 67).

If the Office concludes that the mark should not be registered under the terms of Article 7(1)(b) EUTMR, it cannot change this decision simply because a similar or equally non-distinctive mark was registered in the past.

In fact, the Courts have consistently held that decisions concerning the registration of a sign as a European Union trade mark that the Office, including the Boards of Appeal, are called on to take under the EUTMR are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, and notwithstanding the importance of the principles of equal treatment and the principles of sound administration, the legality of those decisions must be assessed solely on the basis of that Regulation and not on the basis of the Office's previous decision-making practice (10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 73-75; 16/07/2009, C-202/08 P & C-208/08 P, RW feuille d'érable, EU:C:2009:477, § 57).

Therefore, even if the Office has accepted similar trade marks, this does not alter the outcome of the present case. In any case, the Office must examine every case on its own merits and cannot be bound by previous or erroneous decisions (08/07/2004, T 289/02, Telepharmacy Solutions, EU:T:2004:227, § 59).

The applicant has not demonstrated how the combination of elements in the applied mark differs significantly from customary designs, nor how it would be perceived as inherently distinctive by the relevant public. Therefore, the applied mark does not demonstrate the requisite departure from the norm or custom within the footwear sector to justify its registration as a distinctive mark.

It follows from all the above that the sign applied for lacks distinctive character pursuant to Article 7(1)(b) EUTMR.

ON ACQUIRED DISTINCTIVENESS

In addition to the abovementioned arguments, in the reply to the Office's objection letter of 15/04/2025, the applicant included a claim that the sign applied for had acquired distinctive character through use within the meaning of Article 7(3) EUTMR. The applicant

also confirmed, in a communication received on 18/09/2025, that this claim was meant as a principal claim.

In support of the claim, the applicant submitted evidence of use on 15/08/2025, and the Office accepted new observations on an exceptional basis on 18/12/2025.

The evidence to be taken into account is the following:

- Annex 1 Submissions dated 14 August 2025
- Annex 2 Witness Statement of Jennifer M. Reynolds dated 7 August 2025
- Annex 3 Exhibit A – Representative samples of annual brand rankings featuring Nike
- Annex 4 Exhibit B – National registration certificates for the Cassette Mark
- Annex 5 Exhibit C – Facebook Post on Nike's Marketing of the AM90 shoe
- Annex 6 Exhibit D – Representations of Air Max 90 shoes available on Nike's country-specific local stores hosted on Nike's main website Nike.com
- Annex 7 Exhibit E – Representative websites of Nike's third-party retail partners
- Annex 8 Exhibit F – Representative selection of invoices exhibiting Nike's wholesales of AM90 shoes
- Annex 9 Exhibit G – Representative selection of images of window and in-store displays offering AM90 shoes for sale at AW Lab store locations in Rome and Barcelona, in 2020
- Annex 10 Exhibit H – Representative selection of posts captured in the EU from Nike's Social Media channels
- Annex 11 Exhibit I – Excerpts of pages of the "Nike Field Guide to Air Max" promotional brochure
- Annex 12 Exhibit J – Screenshots from promotional videos for new AM90 shoes produced and disseminated by Nike and Foot Locker
- Annex 13 Exhibit K – Representative press releases and articles discussing the history of Air Max Day and past Air Max Day events hosted and publicised in the EU
- Annex 14 Exhibit L – Representative selection of videos and social media posts from Nike's "Kiss My Airs" advertisement campaign in Spain
- Annex 15 Exhibit M – Representative selection of screenshots from "The Story of Air Max: 90 to 2090" Documentary
- Annex 16 Exhibit N – Representative selection of articles, advertisements and social media posts on the "Future is in the Air" campaign and promotional events

Annex 17 Exhibit O – Representative selection of French magazine articles published from 2014 to present promoting and discussing the AM90 shoe

Annex 18 Exhibit P – Representative selection of third-party press articles on the history of the AM90 shoe

Annex 19 Exhibit Q – Representative selection of third-party press articles discussing the prominence and culture of the AM90 and its development to a must-have fashion item and including various examples of limited edition AM90 shoes

Annex 20 Exhibit R – Representative selection of social media posts from global celebrities and influencers promoting or wearing the AM90 shoe

Annex 21 Exhibit S – Representative selection of books featuring the AM90 shoe published in the EU

Annex 22 Exhibit T – Representative selection of museum exhibitions and artworks featuring the AM90 created and published in the EU

Annex 23 Exhibit U – Representative selection of magazine articles featuring the AM90 and the Cassette Mark published in the EU

Annex 24 Exhibit V – English translations of reports summarizing results of consumer surveys conducted in France, the Netherlands and Spain dated March 2023, May 2024 and November 2022 respectively

Annex 25 Exhibit W – Representative selection of examples of infringing AM90-like shoes that Nike enforced against in the EU

Annex 26 Decision of the Spanish Patent and Trademark Office of November 6, 2025

Annex 27 English excerpt taken from the Spanish trademark register

Assessment of the evidence

Under Article 7(3) EUTMR, the absolute grounds for refusal laid down in Article 7(1)(b) to (d) EUTMR do not preclude registration of a mark if, in relation to the goods or services for which registration is requested, it has become distinctive as a consequence of the use made of it. In the circumstances referred to in Article 7(3) EUTMR, the fact that the sign which constitutes the mark in question is actually perceived by the relevant section of the public as an indication of the commercial origin of a product or service is the result of the economic effort made by the trade mark applicant. That fact justifies putting aside the public-interest considerations underlying Article 7(1)(b) to (d) EUTMR, which require that the marks referred to in those provisions may be freely used by all to avoid conceding an unjustified competitive advantage to a single trader.

First, it is clear from the case-law that the acquisition of distinctiveness through use of a mark requires that at least a significant proportion of the relevant section of the public identifies the products or services as originating from a particular undertaking because of the mark. However, the circumstances in which the conditions for the acquisition of distinctiveness through use may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as specific percentages.

Second, to have the registration of a trade mark accepted under Article 7(3) EUTMR, the distinctive character acquired through the use of that trade mark must be demonstrated in the part of the EU where it was devoid of any such character under Article 7(1)(b) to (d) EUTMR.

Third, in assessing, in a particular case, whether a mark has become distinctive through use, account must be taken of factors such as, *inter alia*: the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been, the amount invested by the undertaking in promoting the mark, the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking and statements from chambers of commerce and industry or other trade and professional associations. If, on the basis of those factors, the relevant class of persons, or at least a significant proportion thereof, identify the goods as originating from a particular undertaking because of the trade mark, it must be concluded that the requirement for registering the mark laid down in Article 7(3) EUTMR is satisfied.

Fourth, according to the case-law, the distinctiveness of a mark, including that which is acquired through use, must also be assessed in relation to the goods or services for which registration is applied, in light of the presumed perception of an average consumer of the category of goods or services in question, who is reasonably well-informed, observant and circumspect.

(10/11/2004, T-396/02, Karamelbonbon, EU:T:2004:329, § 55-59; 04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 52; 22/06/2006, C-25/05 P, Bonbonverpackung, EU:C:2006:422, § 75; 18/06/2002, C-299/99, Remington, EU:C:2002:377, § 63).

Moreover, the Office recalls that, according to the General Court, a distinction must be made between '**direct proof**' of acquisition of distinctive character (surveys, evidence of the market shares held by the mark, statements from chambers of commerce and industry or other trade and professional associations) and '**secondary evidence**' (sales volumes, invoices, advertising material and duration of use) that are merely indicative of the mark's recognition on the market (12/09/2007, T-141/06, Texture of glass surface, EU:T:2007:273, § 40). Although secondary evidence may serve to corroborate direct proof, it cannot be a substitute for it.

As regards the territorial aspect, pursuant to Article 1 EUTMR, an EUTM has a unitary character and has equal effect throughout the EU. A mark must be refused registration even if it is devoid of distinctive character only in part of the EU. That part of the EU may be comprised of a single Member State (22/06/2006, C-25/05 P, Bonbonverpackung, EU:C:2006:422, § 81-83; 29/09/2010, T-378/07, *Représentation d'un tracteur en rouge, noir et gris*, EU:T:2010:413 § 45 and the case-law cited). As a logical consequence, acquired distinctiveness must be established throughout the territory in which the trade mark did not *ab initio* have distinctive character (22/06/2006, C-25/05 P, Bonbonverpackung, EU:C:2006:422, § 83, 86; 29/09/2010, T-378/07, *Représentation d'un tracteur en rouge, noir et gris*, EU:T:2010:413, § 30).

Since, in this case, the mark consists of a position mark without word elements, the applicant should demonstrate that the mark has acquired distinctive character across the EU.

The burden of proof lies with the applicant, who claims that the sign applied for has acquired distinctiveness prior to the filing date of the application, being 08/04/2025 (judgments of 11/06/2009, C-542/07 P, Pure Digital, EU:C:2009:362, § 49, 51; and 07/09/2006, C- 108/05, Europolis, EU:C:2006:530, § 22).

After having carefully checked the evidence submitted by the applicant, the Office considers that this evidence does not demonstrate the objected mark has acquired distinctive character through its use across the EU.

The sign is a position mark, named "The Cassette" by the applicant, and comprising the irregular shape located on the midsole section of the AM90 shoe that includes an elongated interior shape (as shown in the visual comparison between the AM90 shoe and the mark for which protection is sought).



First, with regard to the **duration of use**, the Office acknowledges that the applicant has shown that the sign has been used within the European Union since 1990.

The evidence includes annual EU sales figures for the AM90 shoe covering fiscal years 2016 to 2025, as well as country-specific sales data for several EU Member States for the period 2021 to 2024.

Country ⁴	Sales in Excess of (EUR)
Austria	€ 3,200,000.00
Belgium	€ 7,100,000.00
Croatia	€ 1,400,000.00
Czech Republic	€ 3,000,000.00
Germany	€ 170,200,000.00
Denmark	€ 2,700,000.00
France	€ 66,000,000.00
Greece	€ 4,500,000.00
Hungary	€ 1,300,000.00
Ireland	€ 5,400,000.00
Italy	€ 25,900,000.00
Netherlands	€ 135,600,000.00
Poland	€ 21,800,000.00
Portugal	€ 1,900,000.00
Slovenia	€ 3,000,000.00
Spain	€ 16,200,000.00
Sweden	€ 5,100,000.00
TOTAL	€ 1,284,400,000.00

(p18 of the annex 2).

The applicant has submitted evidence of advertising expenditure amounting to EUR 8.5 million for the promotion and marketing of AM90 footwear in the European Union between 2017 and 2022 (Annex 2, p. 20), together with a selection of invoices relating to wholesale sales of AM90 shoes (Annex 8). The file also contains promotional brochures (Annex 11), promotional videos (Annex 12), and various depictions of AM90 footwear taken from Nike's own website (Annex 6), from third-party retailers (Annex 7), and from window displays and in-store merchandising (Annex 9).

This material is supplemented by evidence of social-media activity (Annexes 5, 10 and 14), including posts by global celebrities and influencers wearing or promoting AM90 shoes (Annex 20). The applicant has further provided references to press and magazine articles (Annexes 13, 17, 18, 19 and 23), a documentary (Annex 15), and several books featuring

the AM90 model (Annex 21). All of this evidence predates the filing date of the contested application.

Taken together, the evidence demonstrates that the applicant has made substantial commercial and promotional efforts in relation to the AM90 shoe model over a significant period of time.

However, Article 7(3) EUTMR requires proof that the relevant public has come to perceive the *sign applied for*, not the product as a whole, nor the AM90 model name, as an indicator of commercial origin. The evidence submitted does not establish that the specific position mark at issue has acquired distinctiveness through use. The materials overwhelmingly promote the AM90 shoe generally, or the Nike brand more broadly, but they do not show that consumers identify the particular midsole element constituting the contested sign as a trade mark in its own right.

In other words, while the applicant has demonstrated considerable investment in marketing the AM90 footwear line, there is no measurable indication that such expenditure has resulted in the relevant public recognising the contested sign as a badge of origin. The evidence does not show that consumers rely on the midsole element, independently of the overall appearance of the shoe and the Nike brand, to distinguish the applicant's goods from those of other undertakings.

Secondly, as regards the **manner of use** and the goods in connection with which the sign has been used, the evidence confirms that the mark has been applied exclusively to footwear.





However, the AM90 model has undergone numerous design iterations over the years, and several of the images submitted depict versions of the midsole element that differ from the precise configuration of the sign for which protection is sought. These variations, whether in contour, proportion, or overall presentation, mean that a part of the evidence does not show use of the exact sign applied for, but rather of modified or evolved design features. Such discrepancies limit the evidential value of the material, as acquired distinctiveness must be demonstrated in relation to the specific sign as filed, not to a family of similar or related shapes.





(annex 19)

Thirdly, regarding the **territorial aspect** the Office reiterates that pursuant to Article 1 EUTMR, an EUTM has a unitary character and has equal effect throughout the EU. Accordingly, a mark must be refused registration even if it is devoid of distinctive character only in part of the EU. That part of the EU may be comprised of a single Member State (22/06/2006, C-25/05 P, Bonbonverpackung, EU:C:2006:422, § 81-83; 29/09/2010, T-378/07, Représentation d'un tracteur en rouge, noir et gris, EU:T:2010:413 § 45 and the case-law cited). As a logical consequence, acquired distinctiveness must be established throughout the territory in which the trade mark did not ab initio have distinctive character (22/06/2006, C-25/05 P, Bonbonverpackung, EU:C:2006:422, § 83, 86; 29/09/2010, T-378/07, Représentation d'un tracteur en rouge, noir et gris, EU:T:2010:413, § 30).

Since, in this particular case, the mark consists of a position mark without word elements, the applicant should demonstrate that the mark has acquired distinctive character across the EU.

In this regard, the Office considers that all the evidence referred to above constitutes secondary evidence, which, in the present case, must be corroborated by direct proof of consumer perception. When examining the material submitted, the Office notes the presence of English translations of consumer-survey reports conducted in France, the Netherlands and Spain, dated March 2023, May 2024 and November 2022 respectively (Annex 24).

However, these surveys are insufficient to demonstrate acquired distinctiveness. The French survey was carried out on fewer than 1,000 respondents, and the Dutch and Spanish surveys on samples of only 500 respondents each. Such limited samples cannot be regarded as representative of a significant proportion of the relevant public in the European Union. This is particularly evident given that the EU comprises 27 Member States with a combined population exceeding 450 million people. The surveys therefore lack the breadth and statistical weight required to establish that the sign is recognised as an indicator of commercial origin across the Union.

Moreover, even assuming that the evidence were sufficient to establish acquired distinctiveness in Spain, France and the Netherlands, this would still not be sufficient for an EU trade mark. Acquired distinctiveness must, in principle, be demonstrated throughout the European Union. Where evidence is submitted only for certain Member States, the applicant

must explain and substantiate, by reference to objective factors, why recognition of the sign in those territories can be extrapolated to other parts of the Union.

In the present case, no such justification has been provided. As a result, the evidence submitted does not demonstrate that the sign has acquired distinctive character throughout the European Union.

Furthermore, the applicant has not provided any additional direct evidence, such as broader market surveys, independent opinion polls, or statements from neutral third parties, capable of demonstrating that the relevant public perceives the sign as filed, and not the AM90 shoe or the Nike brand more generally, as a trade mark.

As a result, the evidence on file provide little to no substantiation of the level of consumer recognition of the contested sign within the relevant market. In the Office's view, there is therefore no need to examine the applicant's submissions on acquired distinctiveness in further detail.

Article 7(3) EUTMR is an exception to the general rules set up by Article 7(1)(b) and (c) EUTMR and as such must be applied narrowly. The evidence must be clear and convincing to allow a safe conclusion that the mark has been used as a badge of origin. The Office considers that the evidence submitted by the applicant does not allow a safe conclusion that



the sign  would be identified, by a significant proportion of the relevant public, as an indicator of commercial origin used by the applicant.

Conclusion

For the abovementioned reasons, the claim that the trade mark applied for has acquired distinctive character through use pursuant to Article 7(3) EUTMR is rejected.

IV. Conclusion

For the abovementioned reasons, and pursuant to Article 7(1)(b) EUTMR, the application for European Union trade mark No 019169533 is hereby rejected.

According to Article 67 EUTMR, you have a right to appeal against this decision. According to 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 of 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.



Carine FORZY