

## Benelux Court of Justice invalidates Dr Martens position mark

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### INTERNATIONAL

Legal updates: case law analysis and intelligence

- Van Haren sought the invalidation of Airwair's position mark, which consisted of yellow stitching on black welt
- The BOIP found that Airwair had successfully proved that the mark had acquired distinctiveness through use
- The BCJ disagreed, holding that the intensive and lengthy use of the mark for dark boots did not lead to acquired distinctiveness for boots in other colours

In [Van Haren Schoenen BV v Airwair International Limited](#) (Case C 2022/15), the Benelux Court of Justice (BCJ) has held that the Benelux Office for Intellectual Property (BOIP) was wrong to reject an invalidity request filed by Van Haren Schoenen against a position mark consisting of a yellow stitch on black welt (a leather rim sewn round the edge of a shoe upper to which the sole is attached). The mark belonged to Airwair International, the company behind the iconic Dr Martens shoes.



The BCJ held that the mark, which was registered as a position mark for any colour of boots, did not have any inherent distinctiveness, and that Airwair had managed to prove acquired distinctiveness only in relation to *black* and *dark-coloured* Dr Martens boots. According to the BCJ, when the mark is applied to boots of another colour, it does not leave the same visual impression and is thus not capable of identifying the origin of the boots.

## Background

In June 2020 Airwair sought protection in the Benelux in respect of the mark depicted above in relation to “lace boots” in Class 25. In October 2020 Van Haren, a large Dutch shoe retail chain, requested the invalidation of the mark. Van Haren put forward that the mark:

1. lacked distinctive character;
2. consisted exclusively of a sign which had become customary in the *bona fide* and established practices of the trade; and
3. consisted exclusively of the shape of goods which was necessary to obtain a technical result and/or which gave substantial value to the goods.

The BCJ judgment only dealt with the lack of distinctive character of the mark. In this regard, the BOIP had held that it was unlikely that the relevant public would consider the position mark *ab initio* as a trademark. In other words, the mark lacked inherent distinctiveness. However, the BOIP had found that Airwair had succeeded in proving that the mark had acquired distinctiveness due to its consistent use over the course of decades, and due to the fact that experts referred to the yellow stitches as, among other things, “characterising”, “famous”, “typical” and “iconic”. Van Haren did not agree that Airwair had sufficiently proven acquired distinctiveness in relation to all colours of boots, and lodged an appeal with the BCJ.

## Benelux Court of Justice decision

The BCJ agreed with Van Haren’s argumentation and invalidated the mark. According to the BCJ, the evidence of acquired distinctiveness of the mark consisted almost exclusively of Dr Martens boots in black and dark colours. While the evidence did present Dr Martens boots bearing the mark in other (lighter) colours, the BCJ found that the visual impression created by the mark on such products was considerably different compared to that created by the mark on *dark* boots. The BCJ held that, due to this considerably different visual impression, the relevant public would not perceive the mark as an indication of origin. Thus, the intensive and lengthy use of the mark for dark boots did not lead to acquired distinctiveness for boots in *other colours*.

As regards the evidence of acquired distinctiveness based on the endorsements by experts (referring to the yellow stitches as “characterising”, “famous”, “typical” and “iconic”), the BCJ held that none of these sources mentioned the black welt. This led the BCJ to believe that the experts were all referring to the use of the mark on dark shoes, as the black welt could not easily be spotted on these boots. The endorsements of these experts thus only related to acquired distinctiveness of the mark as to dark boots.

As the mark had been registered for all colours of boots and Airwair managed to prove acquired distinctiveness only for black and dark boots, the mark was invalidated in its entirety.

## Comment

Whether this will be the end of Airwair’s monopoly in relation to the yellow stitching and black welt remains to be seen, as the BCJ made it clear that acquired distinctiveness *had* been shown for dark boots. Is a new, more specific, registration to come?

A French version of the decision may be found [here](#).

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