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Issue

Reference number
2025/6557
Date of ruling
30 September 2025
Case number
2023/AR/266

Uitgereikt aan

Uitgereikt aan

Uitgereikt aan

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Registerable

Not registrable

Interim judgment Sine Die

Airwair
International
v.
Retail Distributions Concept

EU trade mark
Benelux trade mark
Application for an
injunction

Court of Appeal
Brussel

Judgment

8th Chamber,
civil matters

Submitted on
Not to be registered

In the case of

AIRWAIR INTERNATIONAL LIMITED, a company incorporated under the laws of the United Kingdom, with company number 03009359, having its registered office at WOLLASTON, Wellingborough NN29 7SW, Northamptonshire, Cobb's Lane (United Kingdom),

appellant,

lawyers: Dieter DELARUE and Alexander HEIRWEGH, lawyers with offices at 2000 ANTWERP, Wapenstraat 14,

present at the hearing: Dieter DELARUE and Alexander HEIRWEGH, lawyers;

against

RETAIL DISTRIBUTION CONCEPTS BV, ON 0411.551.895, with registered office at 1190 VORST, Marguerite Bervoetsstraat 94,

respondent,

lawyers: Isabelle SCHMITZ and Alain BERENBOOM, lawyers with offices at 1000 BRUSSELS, Florencestraat 13, and Emmanuel VERRAES, lawyer with offices at 1040 BRUSSELS, Victor Jacobsaan 78.

Present at the hearing: Emmanuel VERRAES, lawyer.

The appeal is directed against a judgment handed down by the President of the Dutch-speaking Commercial Court of Brussels, sitting in injunction proceedings, on 22 December 2022.

No writ of service of this judgment has been submitted.

The appeal was lodged with the registry in time, on 28 February 2023. The document is in the correct form.

I. FACTUAL BACKGROUND

1. Airwair International Limited (hereinafter 'Airwair') is the manufacturer of Dr. Martens footwear. This footwear, and in particular the '1460' model, which was first commercialised in 1960, has become world-famous, among other things as a symbol of youth cultures and emancipation movements.



According to Airwair, the success and popularity of the Dr. Martens footwear translates into annual sales of approximately 14 million pairs worldwide, of which almost 500,000 in the Benelux (paragraphs 4.4 and 4.2 Airwair), through a network of physical shops, official distributors in the Benelux and its own online shop.

Airwair uses various trademarks for Dr. Martens footwear.

In the current proceedings, it invokes the following four trademarks:

- Benelux trademark 0588724, applied for on 6 February 1996 and registered on 1 December 1996, in class 25 '*Footwear, their parts and accessories not included in other classes*', with the following graphic representation and description:



Colour: 'Yellow'

Description of the distinctive elements: *"The distinctive elements of this mark consist of the yellow stitching in the edge between the upper leather and the sole of a shoe, as shown in the image of the mark; the image of the shoe is not part of the mark."*

Type: "shape mark"

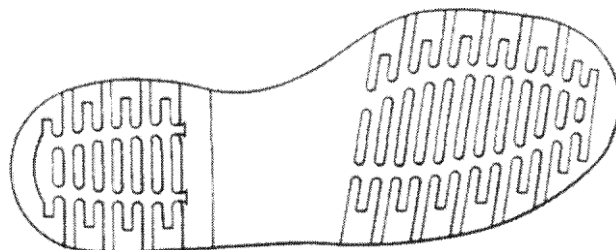
- Benelux trademark 1417807, also referred to by Airwair as the '*yellow stitching on a black welt*' mark, where the term 'welt' refers to the edge between the upper leather and the sole of the shoe, applied for on 27 May 2020 and registered on 28 May 2020 for '*lace-up boots*' in class 25, with the following graphic representation and description:



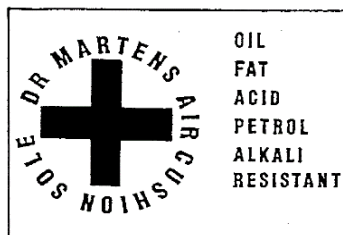
Description of the distinctive elements (free translation): *"The trade mark consists of the combination of a black welt (Pantone 19-3909 TCX) that runs along the perimeter of a boot's outsole and a yellow stitch (Pantone 3965 XGC) applied to the welt in the manner as shown. The matter shown in dotted lines, being the outline of the boot's upper and outsole, are not part of the trade mark but serve to show the positioning of the trade mark."*

Type: position mark

- Benelux trademark 0588726, also referred to by Airwair as the 'DMS sole pattern' mark, applied for on 6 February 1996 and registered on 1 December 1996 in class 25 '*footwear, their parts and accessories, insofar as not included in other classes*', without description, with the following image and the indication '*shape mark*'.



- EU trade mark 000059089 (hereinafter referred to as EU trade mark 59089), applied for on 1 April 1996 and registered on 21 April 1998, in classes 16, 18 and 25, inter alia for '*footwear and parts thereof*' and '*soles*', with the following image, with the indication: '*figurative mark*'. Airwair also refers to the this mark as the 'resistance rectangle' mark.



2. Retail Distributions Concepts BV (hereinafter 'Redisco') operates in Belgium as the operator of the Mano and Pronti footwear chains, with more than 70 shops.

In early 2020, Redisco purchased the boot models shown below from two suppliers, Apex Footwear Ltd and Rolling Business.

Airwair argues that by offering the boots shown below in its Belgian shops, Redisco is infringing the first three marks mentioned above for the shoes from Apex, and all four marks for the shoes from Rolling Business.

3. Redisco purchased the boots shown below (according to Airwair, *'the first contested shoe'*) in black and green from Apex Footwear, a supplier from Bangladesh. These boots are known under the item numbers 431XM5P7 (black) and 437XM5P7 (green):

Black (item number 431XM5P7):



Green (item number 437XM5P7):



The sole of these shoes looks like this:

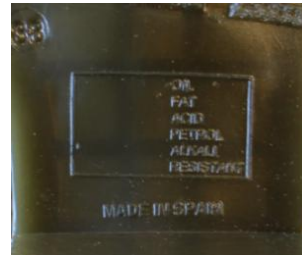


4. Redisco purchased two models of boots from the Spanish supplier Rolling Business:

Model 441XM2J6 0 (the *'second contested shoe'* according to Airwair).



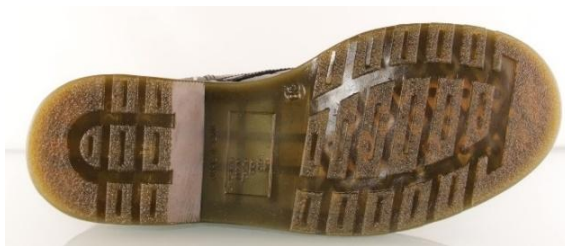
The sole of this shoe looks like this:



- Model 431 XM 6A5 0 (*the third contested shoe*):



The sole of this shoe looks like this:



5. In a cease and desist letter dated 9 November 2020, Airwair's then legal counsel requested Redisco to cease the sale of the above footwear. Airwair accused Redisco of, among other things, infringing the Benelux trademarks 588726 (DMS sole pattern), 1417807 (yellow stitching on black welt) and the EU trademark 59089 (resistance rectangle), as well as copyrights on the 1460 shoe.

In a letter dated 27 November 2020, Redisco's lawyers contested Airwair's claims. Redisco argues that, despite this dispute, it took precautionary measures, without any adverse acknowledgement. The unsold footwear from supplier Apex (83 pairs, whereas 811 pairs of shoes had already been sold) were stored in Redisco's warehouses. Unsold footwear from supplier Rolling Business were returned to this supplier.

However, Airwair claims that certain footwear was still being sold until at least 15 October 2022.

On 8 November 2021, Airwair summoned Redisco before the president of the Dutch-speaking Commercial Court of Brussels, sitting in injunction proceedings.

Redisco claims to have taken additional precautionary measures and to have sent another letter by email on 8 November 2021 to the points of sale that had not responded to the first product recall. Redisco then returned additional footwear to Rolling Business, a total of 229 pairs. The remaining footwear (201 pairs out of 430 pairs) are said to have been sold.

6. During the proceedings before the President of the Dutch-speaking Commercial Court of Brussels, Airwair extended its claim. It claimed to have noticed that Redisco had also infringed its trademark rights by marketing the shoes 431XS7B2 and 436XM7C7 shown below (*the 'fourth contested shoe'* according to Airwair), in a version in matt and shiny leather.

Item number 431XS7B2:



Item number 439XM7C7:



Redisco states that it also withdrew these models from sale as soon as Airwair requested it to do so in January 2022. At Airwair's request, it provided the identity and address details of its Turkish supplier of these shoes.

II. PROCEDURAL HISTORY AND SUBJECT OF THE APPEAL

7. Airwair requested the court of first instance to:

"declare Airwair's claims admissible and well-founded, and consequently."

- *prohibit Redisco from using the contested signs (more specifically, the contested stitching signs, the contested sole pattern signs and the contested resistance sign) in the Benelux (with regard to the Benelux marks invoked) and in the European Union (with regard to the EU mark invoked) for footwear, subject to the following penalty payments:*

- o a penalty of €25,000 for each day that Redisco uses one of the contested signs in violation of this prohibition;*
- o a penalty of €1,000 per product bearing at least one of the contested signs that Redisco continues to market or offer in violation of this prohibition;*

to order Redisco to submit, no later than 14 calendar days after the date of the interim judgment, a report from an independent auditor confirming the following information: (i) the names and addresses of the manufacturers and suppliers of all shoes bearing at least one of the contested signs; and (ii) the quantities received and sold, as well as the price obtained for the shoes in question, on pain of a penalty payment of €50,000 per day of delay;

dismiss Redisco's counterclaim for annulment of the Benelux trade marks Nos. 588724, 588726 and 1417807 as unfounded;

In any event, order Redisco to pay all costs of the proceedings, including the legal costs, estimated at 1,560 euros (base amount).

8. Redisco requested the court of first instance:

'With regard to the claimant's claim.

To declare that the defendant does not infringe the claimant's trademark rights (Benelux trademarks nos. 0588724, 0588726, 1417807, and EU trademark no. 000059089) by marketing products with item numbers 431XM5P7, 437XM5P7, 441XM2J6, 431XM6A5, 431XS7B2 and 439XM 7C7;

Consequently, to declare the claimant's claims unfounded,'

To declare the counterclaim well-founded and, consequently, to declare Benelux trademarks 1417807, 0588724 and 0588726 invalid;

Order the claimant to pay the costs of the proceedings, including the legal costs of €1,440, the basic amount for claims that cannot be assessed in monetary terms;

Declare the judgment enforceable notwithstanding any appeal and to the exclusion of security and/or deposit.

Order the claimant to pay the court fees (Art. 269 of the Registration Code), estimated at €165 in this case.*

9. In a judgment dated 22 December 2022, the president of the Dutch-speaking Commercial Court of Brussels, sitting in injunction proceedings, ruled as follows:

"Declares the claims on the principal claim admissible but unfounded.

Declares the claims on the counterclaim admissible and well-founded as

follows:

Declares the Benelux trademark with number 0588726 is invalid due to lack of distinctive character.

Rejects the additional claims as unfounded.

Pursuant to Article 1017 of the Judicial Code, the court costs shall be apportioned and both parties shall be ordered to pay half of the court costs as the unsuccessful party.

The court fees of EUR 165 shall be borne in equal shares by both parties to the proceedings, who shall pay this amount to the Federal Public Service Finance upon request by that service.

10. Airwair lodged an appeal with this court on 22 February 2023.

In its final submission of 20 October 2023, it formulated its claim on appeal as follows:

“To declare Airwair’s appeal admissible and well-founded;

To reverse the contested judgment insofar as it declares Airwair’s Benelux trademark No. 588726 invalid, rejects Airwair’s claims as unfounded and orders Airwair to pay (part of) the costs of the proceedings;

Ruling again,

To declare that Redisco has infringed Airwair’s invoked trademarks and to prohibit Redisco from using the contested signs (more specifically, the contested stitching marks, the contested sole pattern marks and the contested resistance mark) in the Benelux (with regard to the Benelux trademarks invoked) and in the European Union (with regard to the EU trademark invoked) for shoes, on pain of the following penalties:

- o a penalty of 25,000 euros for each day that Redisco uses one of the contested signs in violation of this prohibition,*
- o a penalty of €1,000 per product bearing at least one of the contested signs that Redisco would continue to market or offer in violation of this prohibition;*

order Redisco to submit, no later than 14 calendar days after the date of the interim judgment, a report from an independent auditor confirming the following information: (i) the names and addresses of the manufacturers and suppliers of all shoes bearing at least one of the contested marks; and (ii) the quantities received and sold, as well as the price obtained for the shoes in question, on pain of a penalty of 50,000 euros per day of delay or part thereof;

order Redisco to pay all costs of the proceedings, including the costs of the summons and the legal fees in both the first instance and on appeal (basic amount in each case).

11. Redisco, in turn, requests the court to:

“Dismiss AIRWAIR’s appeal as unfounded,

Consequently, to declare AIRWAIP's Benelux trademarks 1417807, 0588724 and 0588726 invalid, and to declare REDISCO's incidental appeal against the judgment a quo admissible and well-founded insofar as it had declared the claim for invalidation of Benelux trademarks 1417807 and 0588724 unfounded,

and to uphold the judgment a quo by declaring that there is no infringement of EU trade mark No 000059089, as a result of which the products with item numbers 431XM5 P7, 437XM5P7, 441XM2J6, 431XM6A5, 431XS7B2 and 439XM7C7 are therefore not infringing;

At least — in the alternative — declare that REDISCO does not infringe Benelux trade marks Nos 0588724, 0588726 and 1417807, nor EU trademark no. 000059089 of AIRWAIR by marketing the products with item numbers 431XM5P7, 437XM5P7, 441XM2J6, 431XM6A5, 431XS7B2 and 439XM 7C7;

With regard to costs:

Primarily: to order AIRWAIR, pursuant to Article 14 of Directive 2004/48/EC, to pay the legal costs and lawyers' fees incurred by REDISCO;

in the alternative: order AIRWAIR to pay the costs of the proceedings, including the maximum legal aid fee of EUR 14,000 and the court fees for both instances.

12. In its judgment of 6 February 2024, the Second Chamber of the Benelux Court of Justice declared Benelux trade mark No 1417807 ('yellow stitching on black welt') invalid.

Airwair challenged the judgment of the Second Chamber of the Benelux Court of Justice before the First Chamber of the Benelux Court of Justice, pursuant to Article 9b of the Treaty establishing the Benelux Court of Justice and determining its Statute (hereinafter: the Treaty).

This gave rise to the filing of a petition by Airwair in accordance with Article 748 §2 Judicial Code, after which the court granted new deadlines for exchanging written submissions by order of 15 April 2024.

Airwair's amended claim in its additional submission is as follows:

"In main order,

- (i) to declare Airwair's claims as formulated in its final submission of 20 October 2023 well-founded, except for the claim based on Benelux No. 1417807 and*
- (ii) to stay further consideration of the claim based on Benelux trademark No. 1417807 until the First Chamber of the Benelux Court of Justice has ruled in the appeal proceedings against the judgment of 6 February 2024 of the Second Chamber.*

In the alternative, before giving judgment, to refer the following questions to the Court of Justice of the European Union for a preliminary ruling.

- o Does Article 4(1)(b) of Directive 2015/2436 preclude the invalidation of a position mark for yellow stitching registered for lace-up boots on the basis of the general assumption that consumers do not make assumptions about the origin of a shoe solely on the basis of the position, the shape or the colour of a stitching, without a concrete assessment having been made of the standard or of what was customary in the sector concerned at the time of the application for this mark?*
- o Does Article 4(4) of Directive 2015/2436 preclude the invalidation of a mark registered for lace-up boots on the grounds that the distinctive character acquired was only proven for dark-coloured lace-up boots, but not for light-coloured lace-up boots?*

In an additional submission, Redisco maintains its previous claim, but adds the following in a highly subordinate order with regard to Benelux trademark no. 1417807:

"if and to the extent that the Court finds that the existence of an infringement of this Benelux trademark is based solely on the validity or invalidity of the trademark in question." it would be wise to await the decision of the First Chamber of the Benelux Court of Justice in this regard or to refer the preliminary questions to the European Court of Justice, which the Court deems appropriate for these proceedings."

III. ASSESSMENT

A. Counterclaims for the annulment of Benelux trademarks 1417807, 0588724 and 0588726

A.1. Benelux trademark 1417807 ('yellow stitching on a black welt')

13. Airwair accuses Redisco of infringing Benelux trademark 1417807. In the current proceedings, Redisco has filed a counterclaim for the annulment of Benelux trade mark 1417807, based on Article 2.2bis, paragraph 1, sub b (Benelux Convention on Intellectual Property (Trade Marks and Designs), hereinafter referred to as BCIP). It argues that the trade mark in question lacks any distinctive character.

In its judgment of 6 February 2024, the Second Chamber of the Benelux Court of Justice declared this Benelux trademark invalid on the basis of Article 2.2bis, paragraph 1, sub b BCIP due to the lack of intrinsic distinctive character and lack of proof of acquired distinctiveness. The Benelux Court of Justice ordered the cancellation of this Benelux trademark.

When a Benelux trademark is declared invalid, this decision has retroactive effect to the date of the application (see Article 2.30 nonies.5 BCIP). However, this retroactive effect does not affect a decision on an infringement that has become final.

However, Airwair lodged an appeal against this judgment with the First Chamber of the Benelux Court of Justice on the basis of Article 9 ter of the Treaty by means of a petition. Airwair argues that the Second Chamber of the Benelux Court of Justice violated Articles 2.2 bis(3), 2.2 bis(1)(b), 1.15 bis(1) and 2.30 nonies(1) and (3) of the BCIP. The timeliness and regularity of this appeal are not disputed by Redisco before this court.

An appeal limited to questions of law may be lodged with the First Chamber of the Benelux Court of Justice against the judgments of the Second Chamber of the Benelux Court of Justice. This appeal has suspensive effect (Article 9 ter, paragraph 3 of the Convention).

Airwair requests the court to stay the proceedings on both the counterclaim for annulment of this trademark and the infringement claim pending the

ruling of the First Chamber of the Benelux Court of Justice in the appeal proceedings against the judgment of 6 February 2024.

The court considers it appropriate, in the interests of the proper administration of justice and procedural economy, to grant this request.

A.2. Benelux trademark 0588726 ('DMS-sole pattern')

14. The court of first instance decided to invalidate Benelux trademark 0588726 on the basis of Article 2.2 bis, paragraph 1 b BCIP, due to a lack of distinctive character.

Airwair lodges an appeal against the invalidation of this trademark.

15. In accordance with Article 2.2bis(1)(b) of the BCIP, trademarks that lack any distinctive character shall not be registered or, if registered, may be declared invalid. This provision transposes Article 3 of Directive 2008/95 on the approximation of the laws of the Member States relating to trade marks (the Trade Mark Directive) and must therefore be interpreted in accordance with the Directive.

Distinctiveness may be intrinsic or acquired through use.

According to the established case law of the Court of Justice, distinctive character acquired through use, like the distinctive character that is one of the general conditions for registration of the trade mark, means that the trade mark is capable of identifying the goods or services to which it relates as originating from a particular undertaking and thus of distinguishing those goods or services from those of other undertakings (ECJ 4 May 1999, *Windsurfing Chiemsee*, C-108/97 and C-109/97, paragraph 46; ECJ 18 June 2002, *Philips Electronics*, C-299/99, paragraph 35).

Whether a sign has distinctive character must be assessed in relation to the goods or services in question and on the basis of its perception by the relevant public, which consists of the normally informed, reasonably observant and circumspect average consumer of those goods or services (ECJ 8 April 2003, *Linde and Others*, C-53/01 and C-55/01, paragraph 41; ECJ 12 February 2004, *Koninklijke KPN Nederland*, C-363/99, paragraph 34; ECJ 10 July 2014, *Apple*, C-421/13, paragraph 22). The assessment of the perception of the average consumer must be made on a case-by-case basis, taking into

account the relevant facts and circumstances (ECJ 12 February 2004, Koninklijke KPN Nederland, C-363/99, paragraph 34; ECJ 6 July 2017, Moreno Marin, C-139/16, paragraph 24 and ECJ 12 September 2019, #Darferdas, C-541/18, paragraph 21).

The perception of the relevant public is not necessarily the same for each category of trade marks, and it may therefore be more difficult to establish the distinctive character of trade marks in certain categories than in others. However, neither Article 3(1) of the Directive nor Article 2.2.bis(1)(b) of the BCIP distinguishes between categories of trade marks. It is settled case law that the criteria for assessing the distinctive character of three-dimensional marks consisting of the appearance of the product itself are no different from those applicable to other categories of marks (ECJ 18 June 2002, Philips Electronics, C-299/99, paragraph 48, and ECJ 8 April 2003, Linde and Others, C-53/01, paragraph 46).

However, when applying those criteria, it must be borne in mind that, in the case of a three-dimensional mark consisting of the shape of the product itself, the perception of the average consumer is not necessarily the same as in the case of a word or figurative mark consisting of a sign which is independent of the appearance of the product it designates. The average consumer is not accustomed to deducing the origin of the goods from their shape in the absence of any graphic or textual element, and in the case of such a three-dimensional mark, it may therefore be more difficult to determine its distinctive character than in the case of a word or figurative mark (ECJ 4 October 2007, C-144/06, Henkel, paragraph 36; ECJ 22 June 2006, Storck, C-24/05, paragraph 25).

Only a mark which differs significantly from the norm or from what is customary in the sector concerned, and therefore fulfils the essential function of indicating origin, has (intrinsic) distinctive character (ECJ 7 October 2004, Mag Instrument, C-136/02, paragraph 31 and ECJ 22 June 2006, Storck, C-24/05, paragraph 26).

16. Redisco, which is seeking the annulment of the registered Benelux trade mark, must provide proof of this invalidity. The invalidity must be assessed at the time of filing the trade mark application (see ECJ 5 October 2004, C-192/03, Alcon Inc v OHIM, paragraph 40).

The mere fact that cancellation proceedings are pending in respect of this figurative mark does not affect this, since a registered mark is valid until it is declared invalid.

Furthermore, the court points out that the sole pattern in question was also registered by the EUIPO as a European Union trade mark for footwear in class 25, as well as by the German trade mark office (Deutsches Patent- und Markenamt), without any mention of any application for a declaration of invalidity.

The documents submitted by Airwair show that not only Airwair, but also other brands such as Converse, Vans, Paraboot and Nike, put emphasis on a sole pattern as a distinguishing feature in old advertisements. The use of sole patterns as trademarks in the footwear industry is not unusual in itself. There is no reason to exclude such trademarks from protection in an abstract manner.

The undated exhibit 14 submitted by Redisco, in which the sole pattern corresponding to the registered trademark is depicted alongside eight other sole patterns, shows that this first sole pattern differs significantly from all other proposed sole patterns. The court does not agree with Redisco's assertion that the sole pattern in question is banal. Redisco does not substantiate its claim that this first sole pattern is part of a 'category of soles' commonly found on the market.

The documents submitted by Airwair, which constitute a selection of sole patterns from the 1990s, show that there was a wide variety of sole patterns on the market, the sole pattern registered as a trade mark under number 0588726 differs significantly from each of these sole patterns and deviates significantly from what was common or customary on the market. Redisco's assertion that the sign registered as a trademark by Airwair is in no way distinctive from the shape of the soles of countless other shoe models in the sector is not substantiated in any way by Redisco and is contradicted by the few documents it submits and by Airwair's own documents.

The court finds that this distinctive sole pattern allows the relevant public, consisting of the normally informed, reasonably observant and circumspect average consumer of footwear, to identify the goods for which this sole mark is used as originating from a particular undertaking and thus to distinguish them from those of other undertakings, and that the mark has distinctive character within the meaning of Article 2.2 bis(1) of the BCIP.

This finding is further supported by the other documents submitted by Airwair, such as the frequent references in the press to the '*unique*' sole pattern (document 10.2, document 10.8), the '*highly distinctive*' sole pattern (document 10.3), the '*characteristic*' sole pattern (document 104, Exhibit 10.7), the references by

independent distributors of the brand to the '*unique*' sole pattern (Exhibits 10.5, 10.6, 10.10, 10.11) and the '*unique imprint left by this sole*' in which this pattern is recognisable (exhibits 10.12 and 10.13), as well as the frequent references in fiction, and in particular crime novels, to the characteristic sole pattern of Dr. Martens footwear (Exhibit 18).

Redisco's reference to the considerations in the judgment of the Amsterdam District Court of 20 December 2019 does not affect this. This concerns a judgment rendered in summary proceedings between other parties, which has no *res judicata* effect in the current proceedings, and in which the court furthermore assumes that this shape mark is valid for its assessment of the merits of the claim.

Redisco further refers to the reasoning of the Amsterdam District Court, which stated that the shape of the sole mark would be a determining factor in the essential value of the goods, and argues that the same reasoning also applies to the present case. Redisco thus implicitly refers to the ground for invalidity under Article 2.2bis.1(e) of the BCIP, which stipulates that signs consisting exclusively of the shape that gives substantial value to the goods may be declared invalid. However, Redisco does not substantiate its claim that this would be the case for the shape mark in question in any way. There is no indication whatsoever that the specific appearance or design of the sole pattern can significantly determine the market value of the shoe in question.

The counterclaim for invalidation of sole mark 0588726 is unfounded. Airwair's appeal is well-founded.

A.3. Benelux mark 0588724 (yellow stitching in the edge between the upper leather and the sole of a shoe)

17. Redisco requests, by way of counterclaim, the annulment of Benelux trademark 0588724, registered in 1996, for class 25 'footwear', on the grounds of lack of distinctive character.

Redisco argues that the stitching in question is merely a decoration that is too simple to be considered distinctive, that there is a cancellation procedure pending against this trademark, and that Airwair would not have been the first to use such beige or yellow stitching. According to Redisco, the fact that the Dr. Martens footwear is widely sold and well known does not say anything about the public's perception of the stitching as a distinctive sign.

It also argues that it is undesirable to allow a technically necessary stitching technique to be monopolised as a trademark, arguing that Airwair claims exclusive rights to (all) other colours of Goodyear stitching in its infringement arguments. It concludes that the trademark should be declared invalid.

Airwair argues that the mark has intrinsic distinctiveness, or at least distinctiveness acquired through use. It refers to the worldwide fame and public recognition acquired by the '1460' shoe, one of the best-known shoes bearing the position mark, the annual sales of almost half a million Dr. Martens shoes in the Benelux, the vast majority of which bear the position mark, the considerable promotional efforts and investments it has made to promote the sale of footwear bearing the position mark, including the use of yellow stitching as part of its promotional material, decades of marketing drawing the public's attention to the yellow stitching ('*look for*' advertisements, which aim to accustom the public to look for the yellow stitching in order to recognise the origin of the shoes), and the abundance of press articles, from the general press such as RTBF, Het Nieuwsblad and the fashion press, and from websites of independent resellers, mainly from the period since 2010, which refer to '*the distinctive yellow stitching*', the '*characteristic*' yellow stitching, the '*distinctive yellow stitching*', the '*distinctive*' yellow stitching, the '*famous yellow thread*', the '*iconic*' yellow welt stitching or the '*striking*' yellow stitching.

It also refers to the registration of this trademark in the registers of various other trademark offices and the repeated case law of Belgian courts, which emphasises at least the distinctive character acquired through use.

18. The court rules as follows.

The documents submitted by Redisco concerning the Goodyear welting technique show that stitching in the edge between the upper leather and the sole of a shoe is characteristic of the Goodyear welting technique, a well-known and traditional method of manufacturing footwear. According to the documents submitted, the so-called 'Goodyear method' is one of the oldest methods of manufacturing footwear currently in use. This method is traditionally used for high-quality leather shoes, as well as for other types of footwear such as safety shoes and work boots.

The use of stitching in the edge between the upper leather and the sole of a shoe, in the position shown in the trademark registration, is characteristic of the Goodyear method. Airwair expressly confirms on its website that Dr. Martens boots are manufactured using the Goodyear method, whereby the upper leather and the sole are sewn together ('Goodyear-welted', exhibit 19 Redisco).

The use of the Goodyear stitching technique has been common since the beginning of the 20th century and continues to be so today for the goods for which the mark in question is registered, namely in class 25 'footwear'.

Prior to the registration of the trademark, contrasting stitching in the colour of the leather was also commonly used in the edge between the upper leather and the sole of a shoe. This is evident from exhibits 20 and 21 submitted by Redisco, the mountaineering-inspired shoes by Dirk Bikkembergs (including the 1986-87 collection), the Red Wing shoe model, sold since 1952, and the more than 100-year-old Wolverine brand, which mainly show the use of white or beige stitching contrasting with the colour of the leather, in addition to Caterpillar's use of stitching that appears to belong to the yellow colour spectrum for its Colorado model.

The mark does not deviate significantly from the norm or from what is customary in the sector concerned. The relevant consumer will perceive yellow stitching in the edge between the upper leather and the sole of a shoe as decorative and functional, unless this sign has acquired distinctive character through use.

The court ruled that the mark in question has no intrinsic distinctive character.

19. Airwair invokes distinctive character acquired through use, referring to the intensive and continuous use of the trademark in the Benelux and beyond for decades.

Pursuant to Article 2.2bis(3) of the BCIP, a trademark cannot be declared invalid on the basis of Article 2.2bis(1)(b) of the BCIP if, prior to the date of the application for invalidation, it has acquired distinctive character through use.

In order to determine whether a trademark has acquired distinctive character through use, the court must examine all factors that may indicate that the trademark has

become suitable for identifying the goods in question as originating from a particular undertaking. In assessing the distinctive character of a mark, account may be taken in particular of the market share of the mark, the intensity, the geographical spread and duration of use of that mark, the amount of the undertaking's advertising expenditure on the mark, the proportion of the relevant public which identifies the goods as originating from a particular undertaking on the basis of the mark, and the statements of chambers of commerce and industry or other professional associations. If, on the basis of these factors, it is considered that the relevant public, or at least a significant part of it, identifies the goods bearing the mark as originating from a particular undertaking, it must be concluded that the condition of distinctive character is satisfied (ECJ 4 May 1999, C-108/97 and C-109/97, *Windsurfing Chiemsee*, paragraphs 51 and 52).

The documents submitted by Airwair show that Dr. Martens shoes bearing the position mark 0588724 have been sold throughout the Benelux for decades, both online, via its own webshop and via resellers' websites, and in physical shops, both its own shops in major cities in the Benelux and shops of more than 100 official resellers. The mark in question has a prominent presence on the market, as evidenced by the sale of almost half a million shoes annually in the Benelux, the vast majority of which bear the position mark 0588724. The mark has therefore been used intensively for a very long time.

The marketing report and advertisements submitted show significant investment in advertising, in which the yellow stitching features prominently.

The abundance of press articles, mainly in the last 15 years, and articles from independent resellers, show that the yellow stitching itself is referred to as the distinctive element of Airwair footwear, using terms such as iconic, typical and characteristic.

The court considers it proven that the sign in question has acquired distinctive character through its use as a trademark to such an extent that the relevant circles identify the goods as originating from a particular undertaking.

Redisco's assertion that the trade mark should be declared invalid in order to prevent Airwair from monopolising a particular technique cannot be accepted. The trade mark in question does not relate to a particular attachment technique for footwear, but to the use of *yellow* stitching in the edge between the upper leather and the sole of a

shoe, whereby the colour yellow does not fulfil any technical function. There are no grounds for revoking the trademark on the basis of Article 2.2bis d BCIP.

In so far as the relevant public perceives the sign as an indication of the commercial origin of the goods or services, the fact that the sign may also fulfil a function other than that of indicating origin does not affect its distinctive character (see also Judgment of 10 October 2007, T-460/05, *Bang & Olufsen*, paragraph 44; ECJ 21 January 2010, C-398/08, *Vorsprung durch Technik*, paragraph 45). The fact that the mark in question also has a decorative function, in addition to its function as an indication of origin, does not affect the validity of the mark.

The various grounds for refusal must also be interpreted in the light of the public interest underlying each of them. The public interest underlying the ground for invalidity under Article 2.2bis(1)(b) of the BCIP is to protect the identity of the origin of the marked goods (see, *inter alia*, ECJ 16 September 2004, *Sat.1 v OHIM*, C-329/02, paragraph 27, and ECJ 12 January 2006, *Deutsche Sisi-Werke v OHIM*, C-173/04 P, paragraph 61). The specific case law on the distinctive character of colour marks (including ECJ 6 May 2003, *Libertel v OHIM*, C-104/01, paragraph 40) does not apply in this case, since the mark does not relate to a colour as such, but to a position mark consisting of yellow stitching in the edge between the upper and the sole of a shoe for goods in Class 25 (footwear).

The fact that Airwair argues in the current proceedings that shoes with white or orange stitching in the same position on a shoe also infringe its trademark, which Redisco considers to be incorrect, does not affect the validity of the trademark registration limited to yellow stitching.

Nor does the fact that cancellation proceedings are pending against this trademark affect its validity. In the meantime, the BOIP ruled in decision number 3000256 of 25 April 2023 to reject the claim for annulment.

The images submitted by Redisco as exhibit 14, which are not dated in any way, mainly contain images of shoes with white or red stitching in the edge between the upper leather and the outer sole of a shoe. The presence of such shoes on the market does not prevent the 'yellow stitching' trademark from being established through use.

The mere fact that one or a limited number of shoes with stitching in the yellow colour spectrum can also be found on the market does not detract from the above considerations.

The claim for annulment of Benelux trade mark 0588724 is unfounded.

B. Infringement

B.1. Application for an injunction based on Benelux trademark 0588726 (DMS sole pattern)

20. Airwair argues that all footwear distributed by Redisco that is the subject of the dispute infringe its Benelux trademark 0588726 ('DMS sole pattern') within the meaning of Article 2.20.2(a) and (b) of the BCIP.

Article 2.20 of the BCIP stipulates that the proprietor of a registered trademark is entitled to prevent any third party who has not obtained his consent from using a sign where that sign (a) is identical with the trademark and is used in the course of trade for goods or services which are identical with those for which the trademark is registered; or (b) is identical or similar to the trademark and is used in the course of trade in relation to goods or services identical or similar to those for which the trademark is registered, if this creates a likelihood of confusion on the part of the public, even if that confusion is the result of association with the earlier trademark.

- Article 2.20.2(a) BCIP

21. For an infringement of Article 2.20.2.a BCIP, it is cumulatively required that a sign is used in the course of trade, that this sign is identical to the trade mark, that it is used for the same goods or services for which the trade mark is registered, and that the use detracts from the functions of the trade mark (ECJ 11 September 2007, C-17/06, Céline, paragraphs 16 and 26).

The perception of similarity between a sign and a trade mark must be assessed as a whole from the perspective of the average, reasonably well-informed, observant and circumspect consumer. The average consumer has only a general impression of the sign. After all, he rarely has the opportunity to compare signs and trade marks directly, but must rely on the imperfect image that has remained with him. A sign is identical to a trade mark if it depicts all the components without modification or addition, or

when, considered as a whole, it shows differences that are so insignificant that they may escape the attention of the average consumer (ECJ 20 March 2003, LTJ Diffusion v Sadas Vertbaudet, C-291/00, paragraphs 52 and 54).

The question of what constitutes insignificant differences that may escape attention must be assessed on the basis of the relevant public. The perception of the relevant public varies according to the nature of the goods or services covered by a trade mark (ECJ 22 June 1999, C-342/97, Lloyd Schuhfabrik Meyer & Co GmbH, paragraph 26; ECJ 20 March 2003, LTJ Diffusion v Sadas Vertbaudet, C-291/00, paragraph 52).

It is not disputed that the signs contested by Airwair are used by Redisco in the course of trade and that this constitutes use in relation to goods. Nor is it disputed that the contested signs are used in relation to identical goods.

Finally, both parties agree that the average consumer in the clothing sector, and more specifically in the footwear sector, has a rather low level of attention.

However, Redisco disputes Airwair's assertion that the sole pattern of both the Apex and Rolling Business shoes is identical within the meaning of Article 2.20.2.a BCIP to the trademark 0588726.

The court finds, on the basis of the images submitted, that there are differences between the sole patterns and the trademark, and that these differences are not so insignificant that they could escape the attention of even a low-attention consumer.

Airwair's infringement claim based on Article 2.20.1.a BCIP is unfounded.

Article 2.20.2(b) BCIP

22. Airwair argues that there is a particularly high degree of similarity between the sole patterns of the Redisco footwear in question and its trademark, which it claims has a strong distinctive character, and asserts that the use of this sole mark on slavish imitations of its shoe models, together with the adoption of other distinctive elements, contributes to confusion among the public.

Redisco acknowledges that there is a certain degree of similarity between the design of the sole of the contested footwear and the mark, and that the mark and the sign are

used for similar goods. However, it argues that there is no likelihood of confusion, given the extremely low distinctive character of the sole pattern, which does not significantly deviate from the norm or customs in the sector, and the differences between the soles of the shoes for which the mark and sign are used: according to Redisco, the sole of the contested footwear has a different design due to the absence of a double colour shade, transparent effect or air cushion. According to Redisco, the shoes also have a different appearance, which is reflected in the price difference, which is so significant that the relevant public as potential purchasers of these shoes is not the same.

The court rules as follows.

23. There is no dispute that the mark in question is used in the course of trade for goods.

24. There is similarity between a trade mark and a sign where, in the eyes of the relevant public, they are at least partly similar in one or more relevant respects (ECJ 11 November 1997, Sabel, C-251/95, paragraph 23).

The assessment of the similarity of the conflicting signs involves a comparison of the conflicting signs to determine whether they show a certain degree of similarity visually, phonetically and/or conceptually. Although that comparison must be based on the overall impression that those signs leave in the mind of the relevant public, it must nevertheless be made in the light of the intrinsic qualities of the conflicting signs (CJEU, 4 March 2020, C-328/18, EUIPO v Equivalenza Manufactory SL, paragraph 71).

The question of whether the shoes or shoe soles in question are otherwise similar, and the circumstances of the marketing of the shoes in question, cannot be taken into account at this stage, but are only relevant in the overall assessment of the likelihood of confusion.

Where there is no word element, there is no reason for an auditory or conceptual comparison. The court finds, on the basis of the photographs submitted, that the sole patterns on the contested footwear show a high degree of visual similarity to the sole mark, *inter alia* due to the presence of two mirrored loops on the heel and the forefoot respectively, containing perpendicular parallel lines that sometimes run to the edge of the sole and sometimes do not, which dominate the overall impression.

25. The mark in question was registered in class 25 for footwear. The contested sign is also used for footwear. The goods for which the mark and sign are used are identical.

26. There is a likelihood of confusion when the public may believe that the goods or services in question originate from the same undertaking or, where applicable, from economically linked undertakings (ECJ 29 September 1998, Canon, C-39/97, paragraph 29; ECJ 22 June 1999, Lloyd Schuhfabrik Meyer & Co GmbH, C-342/97, paragraph 17).

The likelihood of confusion on the part of the public must be assessed globally, taking into account all relevant factors in the specific case (ECJ 11 November 1997, Sabel, C-251/95, paragraph 22; ECJ 29 September 1998, Canon, C-39/97, paragraph 16; ECJ 22 June 1999, Lloyd Schuhfabrik Meyer & Co GmbH, C-342/97, paragraph 18).

This global assessment presupposes a certain interdependence between the factors to be taken into account, in particular between the similarity of the trade mark and the sign and the similarity of the goods or services to which they relate. Thus, a slight similarity between the goods or services concerned may be offset by a high degree of similarity between the trade mark and the sign, and vice versa (see ECJ 29 September 1998, Canon, C-39/97, paragraph 17).

The impression left on the average consumer of the goods or services concerned plays a decisive role in the global assessment of the likelihood of confusion. The average consumer usually perceives a trade mark as a whole and does not pay attention to its various details (ECJ 11 November 1997, C-251/95, Sabel, paragraph 23).

The global assessment of the likelihood of confusion must also be based on the average informed, observant and circumspect consumer of the goods and services concerned. However, it must be borne in mind that the average consumer rarely has the opportunity to compare different marks directly, but relies on the imperfect image that has remained in his mind. It must also be borne in mind that the level of attention of the average consumer may vary depending on the type of goods or services in question (ECJ 22 June 1999, C-342/97, Lloyd Schuhfabrik Meyer & Co GmbH, paragraph 26).

Redisco's assertion that the mark in question does not significantly deviate from the norm or customs in the sector is not substantiated in any way and is contradicted by the documents submitted by Redisco itself and Airwair, as already indicated in paragraph 16 above. Airwair proves, on the basis of its exhibits 10 and 18, and in particular the intensive use of the mark in question in the Benelux over a period of decades, the extensive marketing and advertising campaigns drawing the public's attention to the sole pattern, and the frequent references in the press and in communications and advertising by independent sellers to the unique, distinctive or characteristic sole pattern, that the mark in question has at least an average degree of distinctiveness.

In view of the high visual similarity between the sign on the contested shoe models and the mark, the identical goods, and the at least average distinctive character of the mark, the court finds that there is a likelihood of confusion on the part of the relevant consumer, who has only a rather low level of attention. This confusion may be both direct and indirect, whereby the relevant consumer would believe that the shoes in question originate from companies economically linked to Airwair.

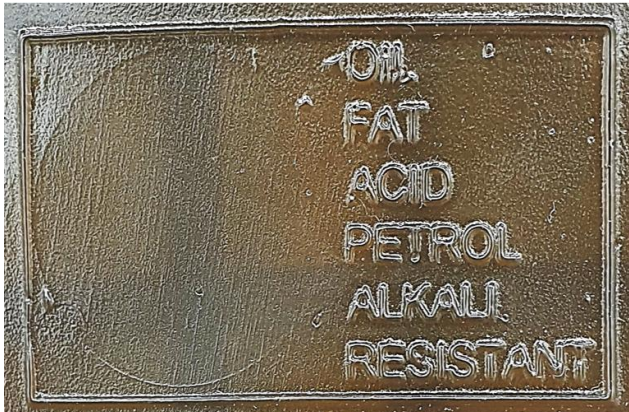
The alleged differences between the soles of the shoes on which the mark and mark were affixed do not affect this. Nor does the alleged difference in price and quality between the shoes affect this. When assessing the likelihood of confusion, account must be taken not only of the consumers who purchase the shoes in question, but also of the group of consumers who, regardless of any purchase, are confronted with the shoes in question and may see in this mark an indication that the shoes in question originate from Airwair (ECJ 12 November 2002, C-206/01, Arsenal, paragraph 57).

Airwair's claim under Article 2.20(2)(b) of the BCIP is well founded.

B.2. Application for an injunction on the basis of EU trade mark 000059089 ('resistance rectangle mark')

27. Airwair argues that Redisco's use of the sign shown below on the Rolling Business shoes (the second and third contested shoes with item numbers 441XM2J6

and 431XM6A5) infringes its EU trade mark 000059089, also known as its resistance rectangle mark.



It bases this on Article 9.2(b) of Regulation 2017/1001 on the European Union trade mark (hereinafter: EUTMR).

Redisco argues that the word elements '*Oil fat acid petrol alkali resistant*' are very secondary in Airwair's mark, given the purely descriptive nature of these elements, which means that their distinctive character is very low. The dominant elements of the mark are said to consist of the drawing of a cross, surrounded by the words '*Dr Martens aircushion sole*', which, however, do not appear on the soles of the Rolling Business shoes. It disputes that there is any likelihood of confusion.

28. There is no dispute that the contested sign is used for goods in the course of trade.

Nor is it disputed that the sign is used for goods identical to those for which the EU trade mark is registered.

29. The mark in question is a figurative mark consisting of both word and figurative elements.

Given their size and position, the word elements OIL FAT ACID PETROL ALKALI RESISTANT are not negligible in the mark. Furthermore, Redisco has not demonstrated that the English terms in question will be considered descriptive by the average consumer in the Benelux.

There is an average visual similarity due to the identical word elements OIL FAT ACID PETROL ALKALI RESISTANT in the same configuration, namely in the same order, position and size within a rectangle.

There is also an average degree of auditory similarity between the marks, due to the use of the same word elements.

The court concludes that there is an overall average degree of similarity between the sign and the mark, so that in the next phase, the likelihood of confusion must be assessed.

30. Taking into account the average similarity between the sign and the trademark, the use for identical goods, the normally distinctive character of the trademark in question, and the relatively low level of attention of the relevant public, the court finds that the relevant public may believe that the goods or services in question originate from the same undertaking or, where applicable, from economically linked undertakings, and that there is a likelihood of confusion.

This assessment is confirmed by the finding that this sign is used in the same way as the trade mark in question, namely on honey-coloured, semi-transparent shoe soles with a similar sole pattern.

Airwair's claim for an injunction under Article 9.2(b) of the Trade Marks Regulation against the shoes with item numbers 441XM2J6 and 431XM6A5 (Rolling Business shoes), which use the infringing sign, is well founded.

As this concerns a European Union trade mark, the injunction extends to the entire European Union.

B.3. Claim for cessation based on Benelux trademark 0588724 ('yellow stitching' trademark)

31. Airwair argues that Redisco's use of the orange (first and fourth contested shoes) or white stitching (second and third contested shoes) in the edge between the

upper leather and the shoe sole, infringes its Benelux trademark 0588724 within the meaning of Article 2.20(2)(a), (b) and (c) of the BCIP.

B.3.1. First and fourth contested shoes

- Article 2.20(2)(a) BCIP

32. Airwair first argues that the contested signs on the first (known to Redisco under item numbers 431XM5P7 and 437XM5P7) and fourth (known at Redisco under item numbers 431XS7B2 and 439XM7C7) contested shoes are identical to the invoked Benelux trademark 0588724 and that these signs infringe its Benelux trademark 0588724 within the meaning of Article 2.20(2)(a) BCIP.

The stitching in the edge between the upper leather and the sole of the first and fourth contested shoes is orange, whereas the registered mark relates to yellow stitching. The difference between orange and yellow stitching is not so insignificant that it could escape the attention of the average consumer.

In the absence of identity between the mark and the signs, Airwair's claim based on Article 2.20(2)(a) of the BCIP is unfounded.

- Article 2.20(2)(b) of the BCIP

33. Airwair argues that Redisco infringes its Benelux trademark 588724 within the meaning of Article 2.20(2)(b) BCIP by using orange stitching in the first and fourth contested shoes, shown under paragraphs 3 and 6.

34. There is no dispute that Redisco uses the contested sign for goods in the course of trade.

35. Nor can there be any dispute about the fact that the sign in question is used for identical goods, namely footwear.

36. Since the trademark invoked has no word element and no conceptual meaning, only a visual comparison is relevant. The court finds that, in this case, there is an average visual similarity between the sign and the registered trademark, due to the stitching in the edge between the upper leather and the sole of the shoe in an orange shade very close to yellow, which also uses large stitches around the circumference of the welt in broken lines with a space between each stitch.

The mark in question is registered for a 'yellow' stitch, without any specific colour shade being claimed. Even if the court were to take into account the specific shade of yellow used by Airwair, it would still have to conclude that there is an average visual similarity. It must be taken into account that consumers rarely have the opportunity to compare the mark and the sign directly, but rely on the imperfect image that has remained in their minds.

Redisco's reference to the public interest in ensuring that the availability of colours is not unjustifiably restricted for other market participants offering goods or services of the type for which the trade mark is registered is irrelevant in determining whether the trade mark and the sign in question are similar in the context of an infringement action. Not only does the *Libertel* case law cited by Redisco (ECJ 6 May 2003, C-104/01, *Libertel*, paragraph 71) apply only to the registration of a mark as a colour as such. Furthermore, when determining the scope of the exclusive right of the trade mark proprietor, the need for freedom cannot be taken into account, except in the case of a limitation of the legal effects of the trade mark within the meaning of Article 6(1)(b) of the Directive (ECJ 10 April 2008, C-102/07, *Adidas v Marca Mode and Others*, operative part). Article 6(1)(b) of the Directive, which refers to the use of indications concerning the kind, quality, quantity, intended purpose, value, place of origin, time of manufacture of the goods, in so far as such use is in accordance with honest practices in industrial and commercial matters, is not invoked in this case and does not apply.

37. Given the similarity between the mark cited and the sign, it is necessary to assess the likelihood of confusion on the part of the relevant consumer.

Taking into account the exhibits submitted by Airwair, discussed above in paragraph 19, concerning the long-term and intensive use of the mark, the marketing and advertising efforts made and the content of the press articles and articles from

independent resellers, it appears that the yellow stitching mark has acquired a high degree of distinctiveness in the Benelux due to its intensive use.

There is no dispute that the consumer in question has a rather low level of attention.

In view of the average visual similarity between the mark and the sign, the identity of the goods for which the mark is registered and for which the sign is used, and the high degree of distinctiveness of the mark, the Court of Appeal finds that there is a likelihood of confusion on the part of consumers who have only a low level of attention. The consumer may believe that the goods in question originate from the same or economically linked undertakings.

In this regard, account must be taken not only of consumers who encounter goods bearing the signs in question in the shop, but also of consumers who are confronted with the signs on the goods after they have been sold (ECJ 12 November 2002, C-206/01, Arsenal, paragraph 57). A mere difference in the selling price or quality of the goods does not affect the likelihood of confusion.

Airwair's claim for an injunction under Article 2.20.2(b) of the BCIP against the first and fourth contested shoes, namely the shoes with item numbers 441XM2J6, 431XM6A5, 431XS7B2 and 439XM7C7, which use the infringing sign as shown above, consisting of orange stitching in the edge between the upper leather and the shoe sole, is well-founded.

There is no reason to consider the arguments developed under Article 2.20.2(c) of the BCIP, as this cannot lead to a broader injunction.

B.3.2. Second and third contested shoes

- Article 2.20(2)(a) BCIP

38. Airwair argues that Redisco infringes its Benelux trademark 0588724 by using the white stitching depicted in paragraph 4 above in the edge between the upper leather and the sole of the shoes, described by Airwair as the second and third

contested shoes, and known at Redisco under item numbers 441XM2J6 (full calf boots) and 431XM6A50 (imitation snakeskin boots).

The stitching in the edge between the upper leather and the sole of these shoes is white. In addition, a thinner thread and a smaller stitch than that of the mark are used. These differences are not so insignificant that they can escape the attention of the average consumer.

In the absence of identity between the brand and the signs, Airwair's claim is based on Article 2.20(2)(a) BCIP unfounded.

- Article 2.20(2)(b) BCIP

39. Airwair argues that Redisco infringes its Benelux trademark 0588724 within the meaning of Article 2.20(2)(b) BCIP by using the white stitching shown above in the edge between the upper leather and the sole of a shoe.

There is no dispute that Redisco uses the disputed sign for goods in the course of trade. Nor can there be any dispute that the sign in question is used for identical goods, namely footwear.

40. Redisco disputes that there is any similarity between the trade mark and the sign.

When assessing similarity, the conflicting signs must be compared on the basis of the overall impressions they leave in the mind of the average consumer of the category of goods in question. At the stage of assessing similarity, neither the reputation of the mark, nor the distinctive character of the mark, nor the circumstances in which the goods are marketed are taken into account.

In this case, the court finds that there is no visual similarity between the trademark invoked, which is dominated by the yellow colour of the striking large stitches in the edge between the upper leather and the sole of a shoe, and the contested sign, which consists of white stitching in the same position. Airwair's assertion that white stitching also belongs 'to the yellow colour spectrum' is not serious. Nor can the argument that there is a 'slight difference in colour tone' be accepted either. The difference

between white and yellow is striking and cannot escape the attention of the relevant consumer.

The size of the stitching and the thickness of the thread also differ between the mark and the sign. Whereas the mark is characterised by large, coarse stitches around the circumference of the welt in broken lines with spaces between them, the contested sign features smaller stitches in a thinner thread.

Since the mark cited does not contain any word elements and has no conceptual meaning, only a visual comparison is relevant.

The overall impression left by the mark and the sign in the mind of the relevant public is different.

In view of the absence of similarity, there is no need to examine the likelihood of confusion.

41. Even if it were assumed that there is some similarity, it is in any case minor and limited to the position of the stitching in the edge between the upper leather and the sole of a shoe, and no likelihood of confusion has been demonstrated.

There is no dispute that the mark and the sign are used for identical goods, namely footwear.

The placement of stitching in the edge between the upper leather and the sole of a shoe is a well-known technique and is still common practice for quality shoes and work shoes. Mass-produced shoes also commonly use such stitching to give these shoes the appearance of a traditional, sturdy shoe. It is also common to use a colour that contrasts with the leather, in particular the colour white, including on military-style boots (see, inter alia, Redisco's exhibits 18 and 14). For the reasons stated above (in paragraph 19), the court ruled that the mark, consisting of yellow stitching in the edge between the upper leather and the sole of a shoe, which has no intrinsic distinctive character, has acquired a strong distinctive character through use.

Even in the case of a mark with a highly distinctive character, or even a well-known mark, there is no presumption of a likelihood of confusion, but this must be proven.

The court finds that Airwair has not demonstrated that there is any likelihood of confusion in this case, even among consumers with a low level of attention, and even taking into account the high distinctive character of the yellow stitching mark and the identity of the goods. Consumers will not believe that the goods in question, featuring fine white stitching on the edge between the upper leather and the sole of the contested shoes, originate from the same or economically linked companies, since it is precisely the use of the colour yellow that gives the mark its highly distinctive character, and this yellow colour is absent from the sign.

Nor is there any reason to assume that the average consumer would perceive the contested signs as a sub-brand of the yellow stitching brand, particularly in view of the common nature of such contrasting white stitching on the market. This cannot be inferred from the fact that Airwair now also offers shoes with white stitching.

This assessment is not affected by the fact that there are certain similarities between the contested shoe models 2 and 3 and certain models of shoes in the Airwair range. Exhibit 14 submitted by Redisco shows that the contested shoes 2 and 3 are part of a fashion trend for sturdy lace-up boots with thick soles and Goodyear stitching (or what appears to be Goodyear stitching). The claim that these are slavish imitations of Dr. Martens shoes is not proven by Airwair and is contradicted by the photographs submitted. Redisco points out the differences between these shoes and Dr. Martens shoes (its exhibit 8). For example, the shape of the laces and the colour of the eyelets differ, there is no upper strap, the shape of the welt differs, there is no heel loop in one of the models and the material and marking of the heel loop differ in the other model, etc.

Furthermore, Airwair's claim is based solely on trademark law, and it does not invoke any infringement of design or copyright on a specific shoe model.

Airwair's claim under Article 2.20(2)(b) of the BCIP is unfounded.

42. Airwair's claim under Article 2.20(2)(c) of the BCIP is also unfounded.

The application of this ground for infringement also requires that the sign *"is identical or similar to the trade mark, irrespective of whether it is used for goods or services which are identical, similar or dissimilar to those for which the trade mark is registered"* (Article 2.20(2)(c)(8) E).

It is required that there be such a degree of similarity between the well-known trade mark and the sign that the relevant public will establish a link between the trade mark and the sign, that is to say, that the relevant public will perceive a connection between the well-known trade mark and the sign, even if it does not confuse them (ECJ 14 September 1999, *General Motors*, C-375/97, paragraph 23; ECJ 23 October 2003, *Adidas/Fitness World*, C-408/01, paragraphs 29 and 31, and ECJ 10 April 2008, *Adidas v Marca Mode II*, C-102/07, paragraph 41). The fact that the sign brings the earlier mark to mind in the mind of the normally informed and reasonably observant and circumspect average consumer is equivalent to the existence of such a link. The existence of such a link is an essential condition for the application of this provision (CFI, 2 October 2015, *The Tea Board v OHIM*, T-624/13, paragraph 68).

To this end, the mark as registered and the sign as used must be considered globally, taking into account all relevant circumstances of the specific case. These circumstances include the degree of similarity between the conflicting marks, the nature of the goods or services for which the conflicting signs are registered, including the degree to which those goods or services are related or differ from each other, as well as the relevant public, the degree of recognition of the earlier mark, the degree of intrinsic or acquired distinctiveness of the earlier mark and the existence of a likelihood of confusion on the part of the public (ECJ 27 November 2008, C-252/07, *Intel*, paragraphs 41 and 42).

The court of appeal ruled that the yellow stitching mark is known to a significant part of the public. However, the exhibits submitted by Airwair, which mainly relate to the reputation and success of Airwair's 1460 shoe, on which the yellow stitching mark is applied, do not indicate that it is a 'particularly well-known' mark.

Airwair does not demonstrate that the well-known mark and the sign are so similar that a significant part of the relevant public would perceive a connection between the sign and the mark, even taking into account the identical goods, the reputation of the mark and the distinctive character acquired by the mark through use. In view of the significant visual difference between the white stitching in the sign and the yellow stitching in the mark, and in view of the different nature of the stitching, the Court of Appeal finds that the sign and the mark create a different visual impression and are not similar signs.

For the reasons stated above, which are deemed to be repeated here, the court also finds that there is no likelihood of confusion.

Nor has it been demonstrated that Redisco, by using the sign in question for Rolling Business shoes, is taking unfair advantage of or detracting from the distinctive character or reputation of the trademark. The court considers that the relevant consumer, even if he or she has a relatively low level of attention, does not establish a link between the trademark and the sign, given the significant difference in the most striking feature of the trademark, namely the yellow colour, even if both are used for leather boots that show certain similarities.

Airwair's claim under Article 2.20(2)(c) of the BCIP is unfounded.

C. Measures

43. The cessation of the infringements established above must be ordered.

The penalty payment must contribute to Redisco's compliance with the injunction. The amount must be sufficiently high to prevent Redisco from considering that the penalty payments claimed would cause less damage than the benefit it could derive from infringing Airwair's trademarks.

On the other hand, the credibility of the penalty payment system must not be undermined.

The court rules that the penalty payments claimed may be awarded, on the understanding that the penalty payments may only be forfeited per product and act performed in contravention of this cease and desist order after a period of one month following the service of the judgment. A maximum amount for the penalty payments to be forfeited must be determined.

44. Airwair requests the court to order Redisco to disclose to Airwair and the court (i) the names and addresses of the manufacturers and suppliers of all shoes bearing at least one of the contested signs; and (ii) the quantities received and sold, as well as the price obtained for the shoes in question.

It bases its claim on Articles 2.22(4) of the BCIP and Article XVII.16 of the CEL, read in conjunction with Article 8 of Directive 2004/48.

If, in the course of proceedings, the court finds that an infringement has occurred, it may, at the request of the party entitled to bring an action for counterfeiting, order the infringer to disclose to the party bringing the action all information known to him concerning the origin and distribution channels of the infringing goods or services and to provide that party with all relevant data, insofar as such a measure appears justified and reasonable (Article 2.22(4) of the BCIP). Article XI.334 § 3 CEL contains a similar provision.

When ordering the injunction, the president may order measures as specified in Article XI.334, §§ 2 to 4 WER, or by the Benelux Convention on Intellectual Property, depending on the law concerned, insofar as these measures may contribute to the cessation of the infringement established or its consequences, with the exception of measures to repair the damage caused by this infringement (Article XVII.16 CEL).

Redisco has already voluntarily provided full information about the identity of the suppliers of all the models in question, including the 'fourth contested shoe' found during the proceedings. Airwair has not provided any indication or evidence of any other infringing model, nor has it demonstrated that this information, which it has had at its disposal for some time, is incorrect or incomplete. Airwair's claim that the names and addresses of the manufacturers and suppliers of all shoes bearing at least one of the contested signs should be disclosed is without merit.

The injunction, subject to a penalty payment, already guarantees that the infringements will cease. Airwair has not demonstrated that additional information regarding the quantities received and sold, as well as information about the price obtained for the shoes in question, could in any way contribute to the cessation of these infringements or their consequences. On the contrary, this information relates to the extent of possible damages. It is not within the jurisdiction of the judge sitting in injunction proceedings to order the submission of this information.

D. Costs

45. Since the present judgment is not a final judgment, the costs of the proceedings are reserved.

FOR THESE REASONS

THE COURT OF APPEAL, judging after having heard the Parties,

Having regard to Article 24 of the Law of 15 June 1935 on the use of languages in court proceedings;

Suspends further proceedings in the counterclaim for annulment of Benelux trade mark No 1417807 and in the infringement claim relating to that trade mark until the First Chamber of the Benelux Court of Justice has ruled in the appeal proceedings against the judgment of 6 February 2024 of the Second Chamber of the Benelux Court of Justice,

Declares the appeal of Airwair International Limited admissible in all other respects and already well-founded as set out below.

Declares the incidental appeal by Retail Distribution Concepts BV admissible, but unfounded to the extent set out below.

It sets aside the contested judgment, except to the extent that the parties' claims were declared admissible and the costs of the proceedings at first instance were assessed.

Ruling again,

Dismisses the counterclaim for annulment of Benelux trade mark No 588726 of Airwair International Limited as unfounded.

Dismisses the counterclaim for annulment of Benelux trade mark No 0577724 of Airwair International Limited as unfounded.

Declares the principal claim of Airwair International Limited to be well-founded to the extent set out below.

Finds that Retail Distribution Concepts BV has infringed the Benelux trade marks 0588724 and 0588726, and the EU trade mark 000059089 of Airwair International Limited.

Prohibits Retail Distribution Concepts BV from using the contested orange stitching sign (as present on the first and fourth contested models, shown above under paragraphs 3 and 6) and the contested sole pattern signs (as present on the four contested models, shown above under paragraphs 3, 4 and 6) in the Benelux for footwear.

Prohibits Retail Distribution Concepts BV from using the contested 'resistance sign', shown above under paragraph 4, in the European Union for footwear.

Dismisses the claim for cessation based on Benelux trade mark 0588724 against the white stitching sign (shown above under paragraph 4) as unfounded.

Declares that a penalty of 25,000 euros per day commenced will be incurred if Retail Distribution Concepts BV uses one of these infringing marks in contravention of this injunction, and a penalty of €1,000 per product bearing at least one of the infringing signs that Retail Distribution Concepts BV would continue to market or offer in violation of this injunction, after a period of one month following the service of the present judgment, with a maximum of €250,000.

Dismisses the claim for the provision of information.

Reserves its decision on the costs of the proceedings.

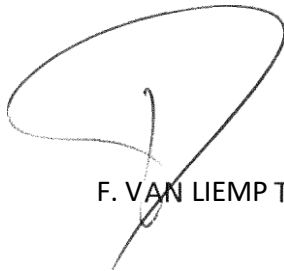
This judgment was rendered and signed by the Eighth Chamber of the Court of Appeal in Brussels, composed of:

H. VANPARYS,
F. VAN LIEMPT,
A. VERSCHAEVE,
who attended the hearings and deliberated on the case.

Judge,
Judge,
Judge,



A. VERSCHAEVE



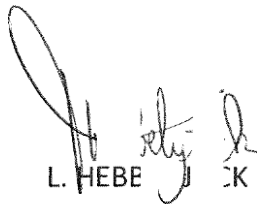
F. VAN LIEMPT

H. VANPARYS

This judgment was pronounced at the public hearing on 30 September 2025 by:

H. VANPARYS
L. HEBBELIJNCK

Judge
Clerk



L. HEBE J. K.



H. VANPARYS