

Israel: CROCS' Clog Registered as a 3 Dimensional Trademark

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The iconic Crocs' beach clog has been recognized as a 3 dimensional trademark in Israel.

The trademark application was filed back in 2008, and was originally refused as back then, 3D marks were generally not accepted. Now, over four years later, with applicant's representatives filing enormous amounts of evidence including surveys, etc., and several appeals and hearings, the mark has been registered.

To enable registration, the arbitrator of intellectual property, Ms. Yaara Shoshani Caspi has ruled that the functional and aesthetic considerations are minor, considering the iconic clog as being clumpy and unaesthetic, but acknowledging that there are at least contributory aesthetic and functional considerations. She was impressed that more than a million pairs were sold in Israel. She found persuasive the applicant's argument that without trademark protection, enforcement of their rights would be difficult.

She noted, however, that a Venice court recently came to a different conclusion where the trade mark was found to be invalid as the shape, though ugly, added value. Although Crocs lost the trade mark in Venice, they won the case because unfair competition was found. See Court of Venice, Decision of 15 February 2012, *Crocs, Inc. v. Supermarket Della Calzatura sas. and Progetti srl*.

The Ruling: Israel TM Nos. 212302 and 202303 by Yaara Shoshani Caspi, 15 January 2013.

COMMENTS

Despite having a reputation for Venetian blindness, I think the Italian court got it right.

The former commissioner, Dr Meir Noam, believed that objects that are registerable as designs should not be registerable as trademarks. He saw IP as a house, where different types of protection were like different rooms. It seems that this doctrine of not allowing double protection has now been abandoned by the patent office, and we see this development in a positive light.

We accept the applicant's argument that without trademark protection, enforcement of their rights would be difficult, but not that the argument is circular in that it assumes that Crocs has rights to the shoe design. Arguably, if they did not register a design in Israel for the shape of the clog, they do not have rights to stop others from making similar footwear. Then again, in the notorious Ashir case, the Supreme Court accepted the Tel Aviv District Court's arguments that copying a product not registered

as a design could be an actionable offence under the tort of Unjust Enrichment. We therefore, do not see that there is a need to allow the clog to be registered as a design.

The shape of Crocs' clogs is, of course, dictated by the shape of the foot and by manufacturing concerns using injection molding of the resin. The holes are necessary or at least recommended in plastic shoes which don't otherwise allow the feet to breath. The general design allows the foot to be inserted and removed easily. There is arguably nothing that is not either functional or aesthetic, and I would argue that most features of the Crocs clog are both.

On the other hand, the design is easily recognized and associated with the company Crocs. Furthermore, the original shoe design is now used for marketing purposes and as a sign.

If the shape is used as a sign on Crocs shops, then it is a 3D trademark being used as an indication of origin. But, in such a case, a beach clog carrying a clear non-Crocs logo, say a non-black stud with a tortoise on it or something, or simply without the stud, should be fairly vendable as generic resin beach clog. Unlike a distinctive bottle design for perfume or spirits, the Crocs clog is a functional shape. Bottles can have different dimensions and shapes and still function for storing the contents, whereas a clog shape is foot shaped.

What is a pity about this decision is that the interaction between design and trademarks is not explained.

I also suspect that this decision is generally too late, in that Crocs are no longer widely worn, and are mostly seen as beach wear. Like all fashion items, there is a limited shelf life. They seem to have mostly been supplanted by Havaianas' flip-flops, also beach wear that seem to have become ubiquitous a couple of years ago, when, fortuitously, I was in Rio de Janeiro, so could buy for friends and family. Personally, I don't find flip flops or Crocs comfortable. I suspect that this year beach goers will wear some other type of foot wear.

Arguably, as this pair of iconic footwear is referred to in Israel as Crocs, maybe the name is now a generic term for beach clogs and the trademark for the name should be struck from the register as well, as has happened for words like thermos, aspirin, elevator and escalator.

At the end of the day, the real question is one of policy. Should a successful design be registerable as a design before being available locally (current law), or should designs require world-wide novelty? should Israel adopt a grace period?

Should a design be available for anyone to use after a period? Should iconic shoe designs, such as Doc Martens (which I wore in college 20 years ago, **before** they became a worldwide trend – making me a fashion leader?), Crocs, flip-flops, etc. be protectable for ever by trademark registrations, or, should people be able to purchase cheaper competitors?

Maybe Israel should adopt a trade-dress register? Trade-dress is a separate type of intellectual property, recognized in the US, which is related to, but distinct from designs and trademarks. It was sort of recognized via the back door in a 2007 decision relating to a trademark application for Imperial Vodka that was quashed as the get up was a clear imitation of the Absolut Vodka bottle. See <http://blog.ipfactor.co.il/2007/05/24/imperial-vodka-trademark-rejected-as-too-similar-to-absolut-vodka/>

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