

adidas:

Footwear toe as a device trademark.

Backgrounds

On May 05, 2016, ADIDAS AG from Germany applied for the registration of a “device” trademark Reg. N° 473.901 in international class 25 in Uruguay aiming to protect its distinctive and characteristic footwear toe of its recognized “Superstar” model. This application intended to avoid infringements of ADIDAS AG Industrial Property rights referred to this distinctive design and to take action against fake and counterfeited products that may be available.

Client	adidas AG.
Trademark	Figurative / Footwear toe.
Competent Authority	National Intellectual Property Office.

Points considered

1. **Viability analysis concerning the footwear toe registration as a device trademark in Uruguay.**
2. **Procedure details before the TMO.**

Viability analysis concerning the footwear toe registration as a device trademark in Uruguay

On this specific case, the filing of the application of this trademark had to be strategically analyzed, in order to successfully achieve its registration, as intended by adidas AG.



Considering all regulation requirements under our trademark legislation on the registration of device trademarks and, in view of the special characteristics of this trademark, the client was advised to file this application as shown in Figure 1.

It is possible to visualize this way (in figure 1) all the elements that constitute the “Figurative” trademark application which refer to an original creation of the client, and make this design distinctive and innovative, fulfilling all the requirements in order to obtain the trademark registration.

The image presented when filing the trademark application at the TMO should demonstrate the distinctiveness and originality of the design.

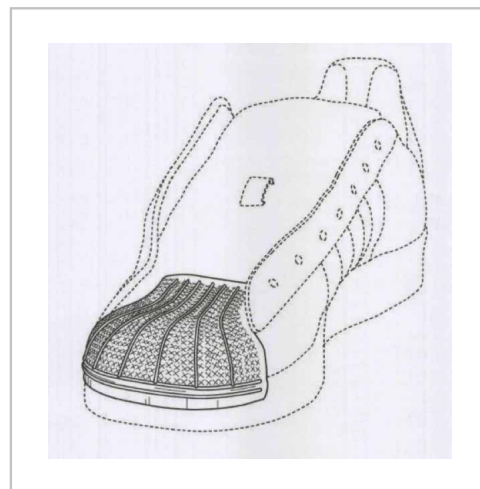


Figure 1

Innovation and distinctiveness of the trademark consists specifically of the lines and crosses in the footwear toe, which provide enough distinctiveness and originality in order to be eligible for registry and exclusive ownership by adidas AG.

Important considerations of the procedure before TMO

Said application was published in the Property Industrial Bulletin dated June 30, 2016, and neither objections nor oppositions were filed by third parties or the Examiner in charge.

It was the Examiner’s opinion that this trademark complies with all legal requirements stated by Law No.17.011 in order to be successfully registered, not being included among the nullities established by Arts. 4th and 5th of the above-mentioned law nor existing records of opposition.

“On the filing of this trademark, all requirements stipulated by Arts. 29, 30, 34, 80 and 99 of Trademark Law N°17.011 dated September 25, 1998, were fulfilled; not being this trademark included among the nullities established by Arts. 4th and 5th of said Law and not being found any prior opposition records, we suggest, in this case the granting of the applied trademark.”

In view of the above, by resolution dated June 11, 2018, the TMO granted the registration of the “Figurative” trademark application N° 473901:

“Granting the trademark registry “Figurative” N° 473.901 in the name of ADIDAS AG. from Germany to cover all goods/services included in Int. class/ es 25 (footwear).”

Examples of infringing products



Consequently, by granting exclusive rights to the use of this distinctive “Figurative” trademark, the TMO protected our client ADIDAS AG. interest: the protection of one of the most distinctive characteristics that identifies their product.

Trademark infringement actions

In virtue of the trademark granting several procedures have been performed in Uruguay, based on Trademark Law N°17011, mainly referring to what is provided in articles 81 and 83 of said law.

On September 26 of 2018, police officers of Artigas Police Headquarters Investigations Department performed a raid in a formal store and a warehouse, based on registered trademark N°473.901 (toe).

The store is located in the city of Artigas business area, being available different types of products, as clothing, footwear, toys, bazaar items, cosmetics, food, etc. On the other hand, the warehouse is located just a few blocks away from the store, further from the city business center. In the raid it was possible to seize more than 500 pairs of shoes with the “toe” trademark registered by adidas AG.

The case is currently pending in Artigas Prosecution Office of 2nd term, in charge of Dr. Raúl Iglesias, awaiting for the order to perform the expert examination. Nevertheless, the infringer recently expressed its willingness to reach an agreement and we are engaged in negotiations to close it, to accomplish the merchandise destruction, revealing its origin, among other things.

TRADEMARK LAW N°17,011 PROCEDURE OF TRADEMARK REGISTRATIONS

Article 29. Trademark registry applications shall be filed before the Industrial Property Office attaching all the required documents for this purpose.

Article 30. Trademark registration priority shall be granted according to the date and time when the corresponding application is filed.

Article 34. The Industrial Property Office shall issue the corresponding resolutions granting or dismissing the trademark’s registry applications totally or partially, as appropriate, taking into account the classes said applications refer to.

TRADEMARK LAW N°17,011 CIVIL AND CRIMINAL ACTIONS

Article 81. Anyone that with a profit motive or to cause damage, uses, manufactures, counterfeits, alters or imitates a registered trademark owned by other person, shall be punished with six months of prison up to three years of penitentiary.

Article 83. Anyone who knowingly manufactures, stores, distributes or commercialize the merchandise referred to the trademarks mentioned in the previous articles, shall be punished with six months of prison up to three years of penitentiary.



Conclusions

A figurative trademark application was submitted, in which the fulfilment of current regulations was carefully considered and with particular emphasis on its original and distinctive characteristics, so no formal or legal obstacles present referred to its registry.

As a consequence, the figurative trademark registry entailing the toe of the sport shoe design was obtained in order to protect the footwear in international class 25 and based on it prevent the commercialization of products that imitate the shape of the toe of the sports shoe, and avoid the commercialization of infringing products.

by:



**Dr.
Natalia Paladino**

Partner
npaladino@cmlawyers.com.uy



**Dr.
Anabel Frachia**

Partner
afrachia@cmlawyers.com.uy



**Dr.
Madelón Landa**

Lawyer
mlanda@cmlawyers.com.uy