

# AA THORNTON

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## INTELLECTUAL PROPERTY LAW

2022

### Making Walking Greener with Intellectual Property

The recent pandemic has changed the daily commute for many from a time consuming journey to the office using a car, train and / or bike into a slipper-clad wander from kitchen to study (or makeshift bedroom office). Hopefully those that can will continue to use their feet to commute to work as restrictions are lifted and a regular trip to a non-home office becomes more likely.

Whether your commute to work is a 'smart casual' walk to your office from home or train, a 'sporty' 5k jog through the park, a 'dress to impress' trip for an evening event, or it remains a wander from your kitchen to a home office, the right shoes can be crucial, but can they enhance the environmental benefits of switching to foot power?

Companies spend a huge amount of time and money creating new products and Intellectual Property (IP) rights help them to continue to do so by protecting their R&D, design and marketing effort and, hopefully, ensuring that the consumer gets the quality they expect when they buy from a trusted brand. With the environment becoming an ever greater concern companies are seeking to develop environmentally friendly products.

You might be surprised to realise just how much IP can potentially subsist in items as everyday as footwear. Below, we will take a look at how businesses can use IP to protect their investment in the design, development and marketing of new environmentally friendly footwear.

#### Trade Marks

Trade marks help consumers to identify that goods originate from a particular entity and this helps them to make choices about which goods to purchase, for example based on past purchases from that entity or good reviews about that entity from others. This is particularly important for businesses with a focus on sustainability and environmentally friendly goods as their trade mark informs consumers of the green nature of the goods and allows them to make more eco-friendly choices.

Traditionally, businesses rely on their name and/or their logo as their primary trade mark. Well known and long running businesses can use new marks which incorporate their house mark to inform consumers that the business is taking action to change for the better. An example is the Timberland Earthkeepers collection. The new trade mark 'Earthkeepers' helps consumers to understand this collection uses responsible materials and production methods which make the goods more sustainable, whilst combining that mark with the reputable 'Timberland' mark assures consumers of the same high quality goods they have come to expect from that brand.

Trade marks are equally as important for the many new businesses trying to enter the footwear market which are adopting a sustainable model from the outset. Companies such as VEJA and Rothy's have set out to be disruptors in the footwear industry. Both companies produce footwear out of discarded waste materials such as plastic bottles and are constantly working to improve their manufacturing and distribution processes to be more eco-friendly.

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Investment in developing a sustainable business model and innovating new products which benefit the environment is costly and time consuming and this is a cost that businesses need to recoup if they are to continue improving and benefitting the planet. Trade marks have a key part to play in informing consumers in a quick and simple manner about the nature of the products and the business they originate from. In addition, the trade marks enable consumers to understand why the products are worth more and may need to be sold at a premium price.

### Designs

Designs are used to protect the visual appearance of a product. In the UK and the EU, it is common for businesses to try to protect the appearance of their more iconic and commercially valuable footwear designs by filing an application for a Registered Design, which can give protection for up to 25 years. For those short lived collections, unregistered rights arise automatically where the qualifying criteria are met and give a shorter term of protection.

For registered designs, it is important to apply careful thought to the images used in the application, as it is those images that will define the scope of protection granted. Whilst it is easy to think that it would be sufficient to simply file a photograph of your footwear, relying on a photograph of the product has caused some registered design owners difficulty enforcing their brands in the past. At the time of filing the design application, it is difficult to predict exactly how your design might be infringed in the future. To try and secure a broad range of protection, consideration should be given to filling applications using images showing different aspects of the product as well as images which show the most distinctive and unusual parts of your design alone. An example can be seen in these designs owned by Allbirds, Inc (a New Zealand-American company) which protect the sole, upper and part of the upper of the shoe separately:



*(Registered Community Design No. 008528863-0005, 008554877-0001 and 008554877-0002)*

Thought should also be given to protecting the design using different kinds of image, such as photographs and line drawings, as the Courts can interpret these as giving different forms of protection. This approach can be seen in action in this EU design where Allbirds, Inc protects the same shoe design using both a line drawing and a black and white photograph:

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*(Registered Community Design No. 008414346-0002 and 008414346-0003)*

For Swiss company On Clouds GmbH (commonly known simply as “On”), which produces running shoes, registered designs have been central to the development of the business. On developed a new style of shoe sole which gives a cushioned landing and cleverly incorporates the technical aspect of the design into its appearance, giving On running shoes their distinctive sole design and a unique visual appeal. The business is open about the difficulties of becoming sustainable, particularly for a small business, but is dedicated to innovating in this area and later this year their first fully recyclable running shoe will be launched. On has made use of the Hague System to simplify the process of protecting the appearance of its shoes as a Registered Design in a number of its key commercial markets around the world. The business already has a very high profile and continues to grow; we have no doubt that the company has already encountered a number of infringing products on the market and that it will continue to do so, making those design registrations a very good investment.

### Patents

Patents are used to protect technical innovations in a product or process and can be crucial for protecting investment in technical research and development. Without patents any third party could potentially benefit for free from the time, money and resources spent by someone else to develop a new product or process.

Sports shoes have long been a focus for technical developments as manufacturers try to provide athletes, both professional and amateur, with a few extra %. A great example is the Nike running shoes that Eliud Kipchoge wore when he broke 2 hours for the marathon. The shoes are full of innovative technology for which patent protection has been sought and this was covered in an earlier article: <https://www.aathornton.com/nike-vaporfly/>. Those innovations focus on performance, but Nike is also focussing on the environmental impact of its products, for example Nike has applied for patent protection for methods for forming footwear using recycled plastics ([WO2019232024A1](#)).

Allbirds aims to keep its products as eco-friendly as possible and its first product the Wool Runner, was made from New Zealand superfine Merino wool. The use of new, eco-friendly materials can present technical problems that need to be overcome and the solutions to those problems may enable patent protection to be obtained. For example, Allbirds have filed a patent application ([WO2020223382A1](#)) for a shoe including a “*continuous knit textile comprising eucalyptus fiber*”.

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The process of seeking patent protection requires companies to disclose their innovation in detail and this can allow others to benefit from, and build on, that innovation. If a patent is granted, the patent owner can prevent unauthorised use of the innovation while the patent remains in force, but after the patent expires the technology is free for anyone to use. In the case of environmentally beneficial technology this is clearly advantageous.

Patents have a maximum normal lifespan of 20 years but they can create a legacy that extends far beyond their expiry. In 1871 Charles Goodyear, Jr. was awarded a patent ([US111197A](#)) for a machine for stitching boots and shoes which allowed the creation of the “Goodyear Welt”. This is a manufacturing technique still used today and it is likely that it has been refined and improved over the years. Goodyear welted shoes are considered desirable as they are relatively waterproof, but the construction also allows for relatively easy resoling and repair. This means that shoes using a Goodyear welt are more likely to be repaired and used for longer, and this reduces waste. It is unlikely that environmental considerations were foremost in the mind of Charles Goodyear, Jr when he developed his machine in the 19<sup>th</sup> Century, but this is an example of an early “green” innovation which still provides benefits over 150 years later.

### Using IP to Support your Sustainable Efforts

Whether you are a global luxury fashion brand, a budding business developing a new running shoe, or a local start-up offering slippers for consumers to lounge around in, IP can be a valuable tool to help you build eco-friendly products and sustainable business models.

Sustainability does not come easily or cheaply. It can take years of investment to create new products and build brand recognition. New product developments can be rewarded with the grant of a patent or registered design, and your brand can be protected by good use of trade marks. Using IP in this way can help to protect against copycats, imitations or any others looking to benefit unfairly from your hard work and investment.

If you have any queries regarding using IP to protect new footwear, or any other development, please contact Sarah Neil ([smn@aathornton.com](mailto:smn@aathornton.com)) or Alex Bone ([amb@aathornton.com](mailto:amb@aathornton.com)), or visit [aathornton.com](http://aathornton.com).