O/0954/25

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBERS:

WO0000001838573

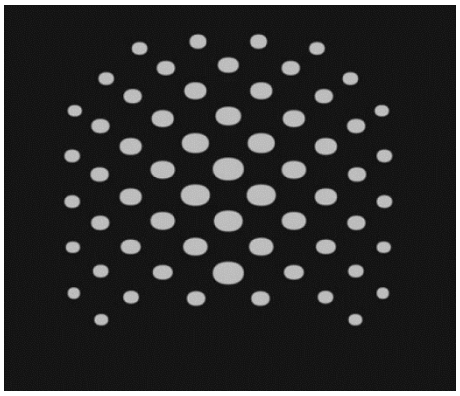
WO0000001838574

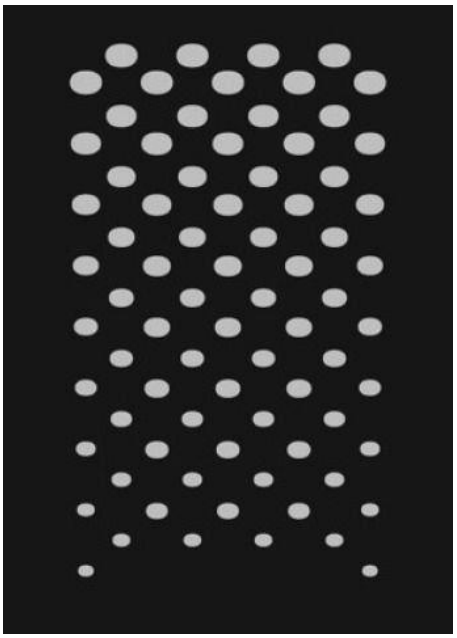
WO0000001838575

WO0000001838576

BY KONINKLIJKE PHILIPS N.V.

TO PROTECT THE FOLLOWING TRADE MARKS IN CLASS 8:





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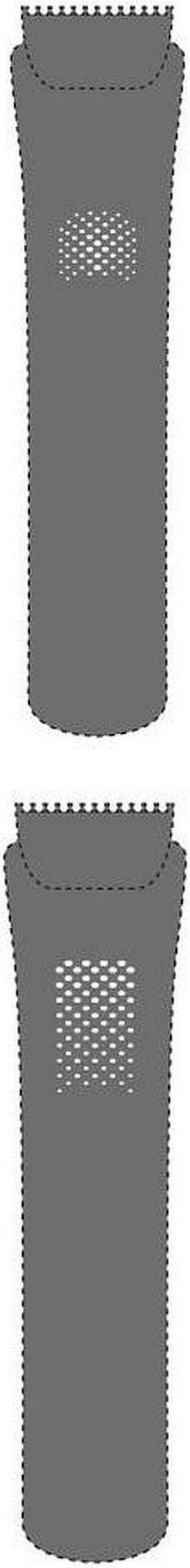

O/0954/25

TRADE MARKS ACT 1994
IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBERS: WO0000001838573 AND WO0000001838574 AND WO0000001838575 AND WO0000001838576
BY KONINKLIJKE PHILIPS N.V.
TO PROTECT THE ABOVE TRADE MARKS IN CLASS 8

Background

1. On 26 December 2024 and 27 December 2024, Koninklijke Philips N.V. ('the holder') designated the United Kingdom to protect the above marks for the same list of goods as follows:

   Class 8
   Razors; electric shavers; shavers; battery powered shavers and beard trimmers; hair trimmers, beard trimmers, hair clippers; apparatus for shaving and trimming body hair; nose and ear trimmers; epilators; blades and shaving foils for electric shavers; hair clippers; cleaning devices for shavers, hair trimmers, hair clippers and beard trimmers; replacement heads for shavers, hair trimmers, hair clippers and beard trimmers; electric and non-electric depilation devices; electric hair curling apparatus, hair stylers and hair waving apparatus; intense pulsed light and laser hair removal devices for in-home use, not for medical purposes; electrical hand instruments being scrubbers for facial cleansing; parts and fittings for the aforesaid goods; cases and holders specifically adapted for the aforesaid goods.

2. On 20 February 2025, in relation to WO0000001838573 ('573), the Intellectual Property Office ('IPO') issued a Notification of Provisional Total Refusal of Protection to the World Intellectual Property Organization ('WIPO'). In that report, an objection was raised under section 3(1)(b) of the Trade Marks Act 1994 ('the Act') which read as follows:

   Absolute grounds for refusal

   Section 3(1)(b)

   The designation is not acceptable in Class 8. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the mark consists of a pattern of ellipses that, when applied to goods such as razors and hair clippers, would be seen first and foremost as a nondistinctive embellishment or decoration. The average consumer would therefore be unlikely to attribute any trade mark significance to the mark.

   On 18 February 2025, in relation to WO0000001838574 ('574), the IPO issued a Notification of Provisional Total Refusal of Protection to WIPO. In that report, an objection was raised under section 3(1)(b) of the Act which read as follows:

   Absolute grounds for refusal

Section 3(1)(b)

The designation is not acceptable in Class 8 There is an objection under Section 3(1)(b) of the Act. This is because the mark is devoid of distinctive character. This is because the mark consists of an image consisting of a pattern of circles that when depicted on razors and hair clippers, would be seen as nothing more than a decoration that doesn't denote trade origin.

Whilst aesthetically pleasing, when presented with the sign, the average consumer would still be looking for an indicator of trade origin. As a result, the mark does not convey the minimum level of distinctive character needed to function as a badge of origin to one undertaking.

On 18 February 2025, in relation to WO0000001838575 ('575), the IPO issued a Notification of Provisional Total Refusal of Protection to WIPO. In that report, an objection was raised under section 3(1)(b) of the Act which read as follows:

Absolute grounds for refusal

Section 3(1)(b)

The designation is not acceptable in Class 8. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the mark consists of a pattern of ellipses, that when depicted on razors and hair clippers, would be seen as nothing more than a decoration that doesn't denote trade origin.

Whilst aesthetically pleasing, when presented with the sign, the average consumer would still be looking for who is supplying the goods.

As a result, it does not convey the minimum level of distinctive character needed to function as a badge of origin in totality.

On 18 February 2025, in relation to WO0000001838576 ('576), the IPO issued a Notification of Provisional Total Refusal of Protection to WIPO. In that report, an objection was raised under section 3(1)(b) of the Act which read as follows:

Absolute grounds for refusal

Section 3(1)(b)

The designation is not acceptable in Class 8. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the mark consists of a pattern of ellipses that, when depicted on razors and hair clippers, would be seen as nothing more than an embellishment or decoration and not denoting trade origin.

Whilst aesthetically pleasing, when presented with the sign, the average consumer would still be looking for the trade origin of the goods. As a result, it

does not convey the minimum level of distinctive character needed to function as a badge of origin.

3. On 17 April 2025, the holder requested an *ex parte* hearing in relation to all four UK designations which were to be heard at the same time due to the obvious similarities between the marks.

4. The hearing was held before me on 28 May 2025 with the holder's representative Mr Chris McLeod of Elkington and Fife LLP in attendance.

5. From the outset, Mr McLeod stated that given the nature of the marks and their similarities, his arguments in favour of the acceptance of all four designations would, in essence, be the same. At the hearing, Mr McLeod's principal arguments may be summarised as follows:

    - In respect of '573 and '574, they have been accepted and published by the EUIPO and the colour claim ('The mark contains the colours grey and black.') narrows protection and this more specific claim adds to the mark's distinctiveness

    - Mr McLeod raised a number of earlier registrations that he believed were comparable and he pleaded for equal treatment

    - Whilst the marks are not highly distinctive, they do not need to be, and they possess the minimal degree of distinctiveness required

    - The marks consist of a certain unique and striking arrangement which cannot be ignored, and the mark's configuration creates an optical illusion effect

    - Mr McLeod described the marks in detail and argued that they stand out and they are acceptable under section 3(1)(b) of the Act

    - In respect of '575 and '576, the representations of the position marks show that the signs are not mere decoration, and the marks show exactly where the device/logo will be placed on the product, and they will be seen as trade marks by average consumers

    - The examiners provided no information or evidence to support the objections taken in the Provisional Total Refusals of Protection

    - Mr McLeod referred to a Court decision (*Aktiebolaget Östgötatrafiken v Patent- och registreringsverket* (C-456/19)) and argued that comparisons can be drawn here and therefore these designations should be accepted

    - The examiners applied an overly excessive test and when we consider the perception of the public, the signs are memorable and capable of indicating trade source

- There is no evidence of this mark, or anything similar, being used by other traders

- Mr McLeod conceded that, in his view, there is a clear distinction between '573/'574 ('figurative') and '575/'576 ('position'), with the position marks *perhaps* being slightly more problematic; nevertheless, he maintained that the holder is firm in their view that all the designations are acceptable

- The figurative marks and the position marks (which show the figurative marks applied to the goods) are sufficiently unique and unusual and have the necessary minimal degree of distinctiveness

6. Following the conclusion of Mr McLeod's submissions, as part of a stringent and full assessment, I requested from the holder any additional information or material under Rule 62 of the Trade Marks Rules 2008 which showed, *inter alia*, actual use of the marks in trade.

7. I then deferred my decision at the hearing to fully consider the arguments put forward and to await any supplementary information that may be provided by Mr McLeod.

8. Mr McLeod duly furnished me with additional material in the form of a link to the holder's website showing use of the marks in trade (www.philips.co.uk/c-m-pe/multigroomers).

9. Taking all this into account, I subsequently issued my hearing report on 10 June 2025 maintaining the section 3(1)(b) objections against all four UK designations and against all the goods applied for.

   As I did not give my decision at the hearing, I allowed a period of two months for a response.

10. Without presenting any additional substantive arguments and without the designations being formally refused, on 8 July 2025, the IPO received form TM5 requesting a statement of reasons for the registrar's decision for all four UK designations.

11. I am now asked under section 76 of the Act and rule 69 of the Trade Marks Rules 2008 to state in writing the grounds for my decision and the materials used in arriving at it. No formal evidence of use has been put before me for the purposes of demonstrating acquired distinctiveness and therefore in respect of the goods listed at paragraph 1, I have only the *prima facie* case to consider.

12. Due to the overriding similarities regarding the nature of the marks for which protection is sought, and the identicality of the goods, and the fact that they were all dealt with at the same hearing, I am dealing with all four UK designations in this statement of grounds. I believe that the differences between the marks, and the mark type, does not present as a material reason to suggest that the marks need to be treated entirely differently.

I would note here that none of the signs have been taken to have any 'relief' element, that is to say, the design or sign does not stand out from the surface of the product and does not appear to be 'raised' or 'ridged' as to contain a three-dimensional aspect. Furthermore, none of the signs have been viewed as having a 'lit' effect, that is to say, it is assumed there is no external 'back lighting' or any lighting effect whereby, and for example, any or all of the oval shapes may be lit in some way. The signs are treated as they have been presented and subject to any limitations as to colour.

These marks are, in essence, all linked and should be viewed as a 'package'. The 'position' marks illustrate the use of the 'figurative' marks within a necessary and wider context; to treat the marks in separate groups or individually would, in my opinion, be illogical in this case and to do so would compromise the stringent examination I am required to undertake.

The Law

13. The relevant part of section 3 of the Act reads as follows:

> ***3 Absolute grounds for refusal of registration***
>
> *(1) The following shall not be registered—*
>
> *(a) […]*
>
> *(b) trade marks which are devoid of any distinctive character,*
>
> *(c) […]*
>
> *(d) […]*

Relevance of EU Law

14. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision may refer to decisions of the EU courts which predate the UK's withdrawal from the EU.

The relevant legal principles

15. The Court of Justice of the European Union ('CJEU') has repeatedly emphasised the need to interpret the grounds of refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (*Bio ID v OHIM*, C-37/03P paragraph 59 and the case law cited there and *Celltech R&D Ltd v OHIM*, C-273/05P).

16. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provision referred to above) the Court has held that "*…the public interest…is, manifestly, indissociable from the essential function of a trade mark*", *SAT.1 SatellitenFernsehen GmbH v OHIM*, C-329/02P. The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. Marks which are devoid of distinctive character are incapable of fulfilling that essential function.

17. Section 3(1)(b) must include within its scope those marks which, whilst not designating a characteristic of the relevant goods and services (i.e. not being necessarily descriptive), will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating trade origin. In terms of assessing distinctiveness under section 3(1)(b), the ECJ provided guidance in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (Postkantoor) (C-363/99) where, at paragraph 34, it stated:

> *A trade mark's distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to 55/01 Linde and Others [2003] ECR I- 3161, paragraph 41, and C-104/01 Libertel [2003] ECR I-3793, paragraphs 46 and 75).*

18. In addition to these well-known and established legal principles, I believe that there is good authority for the proposition that signs that are too plain or basic are incapable of performing the essential function of a trade mark. In this regard, I am mindful of the following comments from the OHIM Board of Appeal (R-860/2012-8) at paragraphs 9 and 10:

> *According to the case-law, a sign which is excessively simple and is constituted by a basic, geometric figure, such as a circle, a line, a rectangle or a conventional pentagon, is not, in itself, capable of conveying a message which consumers will be able to remember, with the result that they will not regard it as a trade mark unless it has acquired distinctive character through use (see judgments of 12 September 2007, T-304/05, 'Representation of a pentagon', par. 22, and of 29 September 2009, T139/08, 'Half a Smiley smile', par. 26).*
>
> *That being so, a finding that a mark has distinctive character within the meaning of Article 7(1)(b) CTMR is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark distinguish the goods and services from those of other undertakings (see judgment of 16 September 2004, C-329/02, 'SAT.2', par. 41 and judgment of 9 September 2010, C-265/09 P, 'α', par. 38).*

19. I should make clear that I am fully aware that the registrar is not bound by decisions of the OHIM Board of Appeal. In any case, the above decision of the OHIM Board

of Appeal also placed reliance on higher authorities from the General Court itself (Representation of a pentagon/Half a Smiley smile) which are all usefully expressive of underlying legal principle regarding signs that are so simplistic that consumers are unlikely to attach any trade mark significance to them.

The application of legal principles

The Consumer

20. In relation to identifying the relevant consumer, the goods could be purchased by any member of the general public. The goods are not *per se* specialist goods in my view.

21. Whilst the goods do not necessarily constitute everyday products and they would be purchased infrequently, the average consumer of the goods concerned is not obviously specialist.

22. I am happy to accept that the personal grooming purchasing public are likely to pay particular attention to a shaver's or grooming item's functional features such as comfort, speed and power, ease of use, size and weight, parts and accessories, etc. In this regard, average consumers are likely to be attentive in their consideration and selection of such products and in my opinion, consumers are likely to display no more than a medium level of attention and knowledge.

Consumer Perception

23. In respect of the inherent characteristics of the signs applied for, I regard them to be geometrically simple, notwithstanding that the colours grey and black have been claimed as a feature of marks '573 and '574. Whether in relation to the standalone figurative marks ('573/'574), or to those same figurative marks being positioned on what is clearly a shaver or groomer ('575/'576), all the signs are unlikely to be perceived by the average consumer as a badge of trade origin of a single undertaking, without education.

24. In essence, the marks consist of 'a series of ellipses of varying sizes in a polka dot arrangement'. This is how I have chosen to describe the signs for which protection is sought, but the holder may wish to express their appearance in a slightly different manner, notably including the optically illusionary effect whereby the whole configuration assumes a 3D 'curved' effect on the eye. Nevertheless, regardless of how one wishes to describe the marks in question, the legal test I must apply is the consumer's likely perception of the signs by reference to the goods concerned and in normal and fair use. The holder submits that the marks possess the 'minimal' degree of distinctiveness to merit registration but unfortunately, I do not concur.

25. I recognise, of course, that the signs here are not a single 'pentagon' or 'lines representing half a smiley mouth', as in the cases before the General Court referred to above (paragraph 18). I accept that the signs in suit are not a single geometric shape; however, to my mind, it is the principle of such a sign being

incapable of functioning as a trade mark in the *prima facie* in those particular cases that is applicable in these cases also.

26. As I have said, I believe that it is reasonable to assess these signs as a 'package', which brings me to consider what I have labelled as 'simplistic' in figurative terms, and whether the same can be said of the figurative design when positioned on the index object – a shaver or groomer. In respect of designations '575 and '576 they include the following mark description:

> The trademark consists of an arrangement of superellipses positioned on the body of a shaver in a colour that contrasts with the body of the shaver. The contours and surface of the body of the shaver are merely included to indicate the relative position and colour of the superellipses.

27. It is clear that '575 and '576 show a representation of a shaver or groomer and it has been included merely to indicate the position and relative scale of the figurative element. Given the inclusion of the dotted lines I am assuming that this disclaims any rights in the shaver or groomer *per se* and Mr McLeod did not give any opposing view to this proposition at the hearing. Although it would seem that protection is not attempted to be obtained for the shape of the shaver or groomer itself (due to the dotted lines intended to disclaim any rights) I believe that I am nonetheless required to examine '575 and '576 in the context of, and by reference to, the index product's inherent characteristics.

28. The 'position' marks show me how, and in what exact position, the figurative marks will be used on the index product. This then raises the question regarding the 'legal presumption' that consumers are not in the habit of viewing the appearance of a product as an indicator of trade origin (C-144/06 P *Henkel v OHIM* [2007]) and I therefore need to explore this question. But lest I be wrong to apply this 'legal presumption' in relation to the 'position' signs, I will also make a separate and contingent finding, not taking account of the 'legal presumption' and solely directed to the positioning and configuration of the signs in situ. Taking the 'legal presumption' option first, it is common that from the starting position that consumers are not in the habit of taking the appearance of a product or packaging to indicate its trade origin, there is, then, an assessment of what the 'norms and customs of the trade' may be and whether the signs in question differ significantly from those norms and customs.

29. At the hearing, Mr McLeod did not refer to the shape of the shaver itself and did not comment on the 'norms and customs of the trade'. Therefore, I shall outline, very briefly, the relevant law and principles:

- In respect of signs that consist of the appearance of the goods they are not subject to a stricter test (C-344/10 P and C-345/10 P *Freixenet SA* paragraphs 45-47)

- Insofar as deciding whether a mark departs significantly from the norms, Lord Justice Kitchin identified three steps ([2017] EWCA Civ 1729 *London Taxi* paragraph 45)

- In respect of the 'European test' and the 'norms and customs test', this was commented on in the 16th Edition of Kerly's Law at chapters (10-035 – 10-039)

- As well as the commentary in Kerly's Law, the same principles were explored in *Bongrain* [2004] EWCA Civ 1690 at paragraph 26 – 28

30. In applying the above principles to '575 and '576, and absent any arguments to the contrary by the holder, I firmly believe that the appearance of the shaver or groomer incorporating the figurative marks does not depart from the norms and customs of the sector. I do not deem the shaver and the figurative element appearing thereon to possess any distinguishing features in a trade mark sense; it is a stereotypical depiction of a shaver or groomer along with a simplistic design element and in my view, average consumers will not consider the position marks to constitute a significant departure from the norms and customs of the trade.

31. Without education, such design features as are claimed in the position marks may often, and for example, be perceived by consumers as mere finishes or mere decorative embellishments applied to the surface of shavers and groomers and I believe that this is the case here with the position signs. I have already commented on the inherent simplicity of the signs in suit.

32. Of course, fundamentally, the burden of proving otherwise sits with the holder here (see e.g. *Valrhona* O/0638/24 paragraph 23) and as I stated previously, no evidence or submissions to this effect were made out at the hearing or subsequently.

33. Nevertheless, regarding the 'norms and customs test', if my view here that the position signs are normal variants and not outside the norms and customs of the trade is felt to be wrong, it does not necessarily follow that a sign which is outside the norms and customs of the trade is necessarily entitled to protection or registration as a trade mark (see *inter alia* Shape of a Lawnmower O/555/22 paragraph 66).

    Therefore, even if I found that the representation of the shaver along with the design detail does in fact depart from the norms and customs of the trade (which I do not), this would not automatically result in a sign being possessed of an inherent distinctive character. When the average consumer is seeking out the goods in question, they would consider the shaver along with a simplistic design feature, as represented by the images in designations '575 and '576, as being unpossessed of a distinctive trade mark character – that is, without education.

34. But I said in paragraph 28 above that I wanted to make a contingent finding which did not take, as its starting point, the 'legal presumption' against signs constituting the appearance of a product and a necessary analysis of the 'norms and customs of the trade'. The contingent finding is simply based on the inherent features of the signs as presented and in the context of the index product. My contingent finding is that, from the perspective of the average consumer, in my opinion, when confronted by the figurative marks *per se* or the figurative marks positioned on a shaver or groomer, I do not believe that they would have the requisite resonance

or capacity to indicate to the consumer the trade origin of the goods concerned. That is, again, without education.

35. Notwithstanding, in particular, the optically illusionary effect, I consider the position signs to not be possessed of the requisite resonance or capacity to present themselves as communicating a trade mark message. I remind myself that there is, of course, no verbal element engaged here, and the probability of the signs being viewed, for example, merely decoratively cannot be dismissed.

36. As referred to above at paragraph 8, Mr McLeod accepted my request under Rule 62 and provided me with a link to the holder's website which showed real-life use of the marks in trade. I should make it very clear here that whilst I would have reached the conclusion that I did in the absence of such material, I provide below some screenshots by way of example which helped to reinforce and fortify my overall appraisal:

37. I do not believe that consumers will perceive the signs as a trade mark in the *prima facie* – the simple arrangement of ellipses will not strike the average consumer as being a badge belonging to a single undertaking due to their simplicity.

38. The holder argues that the marks are inherently distinctive and that they possess at least the "minimum degree" of distinctiveness as required by the law. On the contrary, from the perspective of the average consumer, I believe that the signs are devoid of any distinctive character. I can appreciate that this situation can often result in a circular argument; however, I am under no obligation to rule on any dividing line between the concept of a lack of distinctiveness and that of minimum distinctiveness (e.g. *Feedback Matters* (O/185/12) paragraph 42).

    I am also mindful of the following comments made by Ms Anna Carboni acting as the Appointed Person in the same decision at paragraph 41:

    > '*…It assumes that there is a specifically measurable point below which a mark will be distinctive and above which it will not. Unfortunately, assessing distinctiveness is an art and not a science or a mathematical calculation; it has to be done by judging the mark, the goods/services and the relevant consumers in issue in a way which ensures that only those marks which "step up out of the morass of nondistinctive material" (as it is put by the authors of Kerly's Law of Trade Marks and Trade Names, 15th ed at para. 8-048) are accepted for registration.*'

39. I am of the opinion that the signs do not "*step up out of the morass of nondistinctive material*" and consumers would not attribute any trade mark significance to the signs. When considering the figurative signs, as well as those signs affixed to the goods (as demonstrated by the holder's own use above), the intrinsically simple marks will, in a trade mark sense, be relegated to insignificance and consumers will be left seeking other indicia to establish the commercial origin of the goods concerned.

40. The average consumer will not overanalyse the marks and they will take them at face value. Indeed, I note that four different IPO examiners reached the same conclusion that the signs are devoid of any distinctive character, and I believe that, absent education through use, this will be the perception of the average consumer seeking out such products.

41. At the hearing, Mr McLeod argued that the position marks (which show the figurative marks situated on the goods) are perhaps slightly more problematic than the figurative marks *per se*. Without wanting to misrepresent Mr McLeod's submission in this regard, I believe his rationale to be that once the figurative marks are placed on the goods themselves this may diminish the signs capacity to function, but, in his submission, if we consider the figurative marks in isolation and as standalone logo or device marks, then '573 and '574 are distinctive in their own right and are not devoid of any distinctive character i.e. they can function as badges of trade origin.

42. Whilst I understand the point, I do not see that this makes much difference. In terms of a stringent and full assessment, with a serious consideration for notional

and fair use, in my view, the figurative marks are devoid of any distinctive character due to excessive simplicity, and the position marks (which in turn show how the figurative marks *could* be used) are also devoid of any distinctive character. In accordance with the principles underpinning notional and fair use, such as, *inter alia*, use on packaging, literature, or the product itself, I must consider the average consumer's perception in respect of various modes of use.

43. The point I am making is that, in my opinion, it is irrelevant that '573 and '574 are 'figurative' and '575 and '576 are 'position'. All four marks are representative of signs that are entirely devoid of any distinctive character regarding all manner of potential, or actual, use in trade.

Scope of the absolute grounds objection

44. Regarding the extent of the objection taken in relation to each of the four designations, I must be convinced that the objection applies to all the goods applied for. If there are goods that are free of objection under section 3(1)(b) then they must be allowed to proceed.

45. In connection with marks '573 and '574, the inherent characteristics of the marks do not vary depending on the individual goods applied for; it remains an excessively simple sign irrespective of which particular good it is applied to and will not be perceived as a badge of trade origin.

46. In relation to designations '575 and '576, I also remain of the view that the section 3(1)(b) objection applies across the board.

47. I note that when a 'position' mark is applied for it often includes the specific feature for which protection is sought positioned upon one particular index product, even though that particular good is generally disclaimed (as I assume is the case here given the dotted lines and the mark description). It can nonetheless render it somewhat debateable when applying the section 3(1)(b) objection to products in the specification other than the exact index product.

48. Nevertheless, the goods in class 8 can easily be categorised into razors (including electric razors), shavers, trimmers, clippers and epilators etc. that could all take the form as presented in marks '575 and '576.

    In relation to all remaining goods, such as, blades and shaving foils, cleaning devices, replacement heads for shavers, cases and holders, they all have a strong nexus and are all directly related as they may constitute parts and fittings for a shaver. In this regard, although not shavers or groomers *per se*, all the goods have an innate association with each other and they are not arbitrary or unconnected, and therefore I believe that this is sufficient to deprive designations '575 and '576 of any distinctive character for the full range of goods applied for.

49. All four UK designations are devoid of any distinctive character. From the perspective of an average consumer, they will in my opinion consider the signs to be origin neutral and the marks, without education, will not allow consumers to

associate the simple elliptical features and positioning, to the commercial origin of the goods applied for.

Acceptances by other jurisdictions and the state of the register

50. At the hearing, Mr McLeod submitted that other designated countries, including the EUIPO, have already protected the designations in suit. In this regard, I am mindful of the comments made by the ECJ in *POSTKANTOOR* C-363/99 where it was stated:

> *43. Therefore, the fact that a mark has been registered in one Member State in respect of certain goods and services cannot have any bearing on whether or not any of the grounds for refusal set out in Article 3 of the Directive apply to a similar mark, registration of which is applied for in a second Member State in respect of similar goods or services.*

I recognise that these comments, which have long been established in trade mark law, refers to other 'Member States'. Nevertheless, I believe that the same must, in principle, be true of the position of the registrar with regard to the decisions made by other countries or IP Offices party to the Madrid Protocol.

The protection of the marks in any other designated countries or IP Offices bears no impact on the examination of the same marks in the United Kingdom.

51. Regarding the earlier rights referred to by Mr McLeod at the hearing, they do not persuade me that these designations are inevitably acceptable in the *prima facie,* and I do not believe that I am setting the bar too high for acceptance. I am bound to determine the acceptability of the signs, by reference to the goods, in accordance with the relevant legal principles rather than assessing the designations based on the state of the register. This well-established principle in trade mark law was cited in the *Treat* case and was summarised in BREXIT O-262-18, where the AP (James Mellor QC, as he then was) stated:

> *11. In addition, just because a mark is on the Register does not mean it will be held valid when challenged. Furthermore, if the touchstone for registration was to be a comparison with marks already on the register, then registration would come to depend on the lowest common denominator. In any event, it is quite clear that the application of the section 3(1)(b) ground requires an assessment not against other marks on the register, but against the standard laid down in that provision, as interpreted in the case law.*

Conclusion

52. All four UK designations are considered in the *prima facie* case to be devoid of any distinctive character and subsequently fail under section 3(1)(b) of the Act.

53. All four UK designations are therefore refused in their entirety under the terms of section 37(4) of the Act because they fail to qualify under section 3(1)(b) of the Act.

Dated this 10th day of October 2025

Matthew Davies
For the Registrar,
The Comptroller-General