

D YOUNG & CO TRADE MARK NEWSLETTER *no.141*

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In this summer edition of our newsletter, we are pleased to share recent recognition and developments from our trade mark teams in Germany and the UK. Congratulations to Gabriele Engels and Yvonne Stone on being recognised in The Best Lawyers in Germany™ and Best Lawyers: Ones to Watch in Germany™, respectively. In the UK, Matthew Dick is named as one of only 60 leading private practitioners in WTR Global Leaders, and Gemma Kirkland is featured in Managing IP's Top 250 Women in IP. Our UK team also retained top-tier status in IPSTARS. We're also delighted to welcome new UK Trade Mark Attorney Partner Charlotte Duly, a seasoned practitioner with over 16 years of experience, as well as Associate Solicitor Ella Lane. June also saw our Munich team relocate to new offices, an exciting step for our presence in Germany!

Richard Burton
Partner, Trade Mark Attorney

Events



IPO Annual Meeting

San Diego, USA, 07-09 September 2025

Jackie Johnson will be attending.

MARQUES Annual Conference

The Hague, Netherlands, 16-19 September 2025

Jana Bogatz, Matthew Dick, Charlotte Duly, Gabriele Engels and Anna Reid will be attending the 39th MARQUES Annual Conference.

PTMG Autumn Conference

Budapest, Hungary, 08-10 October 2025

Yvonne Stone will be attending this two day event.

INTA Leadership Conference

Florida, USA, 18-21 November 2025

Jana Bogatz and Anna Reid will be attending.

www.dyoung.com/events

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Edwards v boohoo UK unregistered designs on trial

Design rights play an important role in the fashion industry. In this case between the designer, Sonia Edwards, and the fast-fashion company, Boohoo, it was UK unregistered design rights that were in the spotlight.

UK unregistered design rights

UK unregistered design rights have some unique characteristics, as outlined in the four points below. These not only help to explain the outcome of this case (spoiler alert: Ms Edwards does not win!), but help with understanding how UK unregistered design rights protect designs more generally.

1. UK unregistered design rights protect the shape and configuration of an article.

UK unregistered design rights do **not** protect: surface decoration (for example, a polka dot pattern); methods or principles of construction (for example, organza fabric); or features which enable the article to perform its function. In addition, UK unregistered design rights cannot protect parts of an article that cannot be seen (for example, a "concealed waistband").

2. UK unregistered design rights protect designs for 10 - 15 years.

15 years from the date the design is recorded in a document or an article is made to the design, 10 years if that design is commercialised.

3. Designs that are recorded in design documents (for example, sketches, CAD drawings) and with dimensions specified can be far easier to enforce as UK unregistered design rights.

Specific dimensions are useful because enforcement of UK unregistered design rights will involve proving that the design is original (for example, is different from other designs on the market) and the design has been copied. For instance, it will be simpler to demonstrate that a cuff of [x]mm length is original or copied than showing the same for an "extended cuff". However, design documents are not a requirement for subsistence of UK unregistered design rights, which can also be defined by reference to broad descriptions, images, or photographs.

4. UK unregistered design rights cannot be defined by reference to the way the design interacts with the wearer, as that will vary from person to person.

It would be unworkable for the protectable shape and configuration of UK unregistered design rights to vary depending on the individual who is wearing it. For clothing designs in particular, UK unregistered design rights should be described in their off-the-body configuration, not when being worn.

The designs are cut down to size

This case ultimately concerned five designs. These design were defined broadly and by reference to images of the products originally designed by Ms Edwards. Ms Edwards did not have, or rely on, original design drawings with specific measurements.

Design 1

Design 1 had been commercialised more than ten years ago, and so the IPEC deemed that UK unregistered design rights could not subsist in this design at all given the term of protection had expired.

Only limited features of designs 2 to 5, as broadly defined by Ms Edwards, were deemed to be protectable as UK unregistered design rights for the following reasons.

Design 2

Features protectable as UK unregistered design rights: the puff sleeve connected to an extended cuff.

The court disagreed that UK unregistered design rights subsisted in certain features of design 2 because these:

- Described the nature of materials being used and so would amount to a method or principle of construction. For example, "a rib fabric top".
- Described how the article interacted with the wearer. For example, how the cuff reaches "from past the wrist" and "under the elbow".

Designs 3 & 4

Features protectable as UK unregistered design rights: 1) the chevron shape at the

Case details at a glance

Jurisdiction: England & Wales

Decision level: IPEC

Parties: Sonia Edwards (claimant) v BOOHOO.COM UK LIMITED, PRETTYLITTLETHING.COM, NASTY GAL LIMITED, MISS PAP UK LIMITED, and DEBENHAMS BRANDS LTD (defendants)

Date: 03 April 2025

Citation: [2025] EWHC 805 (IPEC)

Decision: dycip.com/2025-EWHC-805-IPEC

back and front of the waist/hem; 2) the ruching which is gathered in the centre; 3) the folds that run down the front and rear centre of the design; and 4) the draping at the leg.

The court disagreed that UK unregistered design rights subsisted in certain features of designs 3 and 4 because these:

- Described how the article interacted with the wearer. For example, the “high waistline”.
- Relied on components that cannot be seen and/or form no part of the shape and configuration. For example, the “lack of seams on the side” and “absence of zips or other fastenings”.

Design 5

Features protectable as UK unregistered design right: a pair of ruched leggings with a “small” chevron at the top, and with ruching only present in the top half of the area between the crotch and the waistline.

The court disagreed that UK unregistered design rights subsisted in certain features of design 5 because these:

- Described how the article interacted with the wearer. For example, the “high fitting waistline”.
- Relied on components that cannot be seen and/or form no part of the shape and configuration. For example, the “Waistband concealed by the material forming the rest of the design”.

Boohoo! No infringement of the UK unregistered design rights

Working from the features protectable as UK unregistered design rights, the IPEC went on to consider whether there was infringement of the UK unregistered design rights in each design by Boohoo. This involved consideration of two key factors:

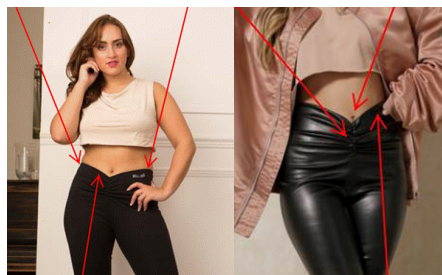
1. whether the Boohoo products are **made exactly or substantially** to the UK unregistered design rights; and
2. whether there was **copying** of the designs by Boohoo.



Design 2 (left), Boohoo product (right).



Design 3 (left), Boohoo product (centre & right).



Design 5 (left) and Boohoo product (right).

Source (all images) [2025] EWHC 805 (IPEC): dycip.com/2025-EWHC-805-IPEC

Made exactly or substantially to the design

These broad, protectable features of the UK unregistered design rights and the absence of any precise measurements made it relatively simple for Ms Edwards to show that the Boohoo products were made exactly or substantially to the design of the UK unregistered design rights.

Taking design 5 as an example, the protectable features of “a pair of ruched leggings with a “small” chevron at the top, and with ruching only present in the top half of the area between the crotch and the waistline” can be found in the Boohoo product. A similar conclusion was found for designs 3 and 4. However, for

design 2, the broad description counted against Boohoo. The protectable features were “the puff sleeve connected to an extended cuff”. The Boohoo product had a much shorter cuff and so was not made exactly or substantially to the UK unregistered design right.

Copying

It was on the requirement to prove copying that Ms Edwards case against Boohoo fell down. Boohoo provided substantial evidence (including witness evidence at trial) on its design process, which broadly involved reviewing the designs: present on social media feeds, pushed by influencers, worn by celebrities and displayed on catwalks. The Boohoo design teams created designs based upon these influences. Boohoo also bought designs directly from third party designers. This meant there was a high probability that: a) Boohoo came to these designs independently; b) from drawing on other influences; and/or c) that any similarities with Ms Edwards’ designs arose from happenstance given the very high volume of goods and limited design space. The broad definitions also meant that the designs were relatively common and so similarities could have arisen independently.

In addition, there was limited opportunity for Boohoo to copy Ms Edwards’ designs because Ms Edwards’ images would not appear on social media feeds given the time elapsed and the low profile of Ms Edwards’ social media accounts (with a handful of likes and comments on Facebook and only 268 followers on Instagram). Ms Edwards’ images had also not become stock images on sites such as Pinterest.

The ultimate position on infringement was:

- **Design 1:** no subsistence of UK unregistered design right due to design in 2011.
- **Design 2:** Boohoo product not made exactly or substantially to the design of the UK unregistered design right.
- **Designs 3, 4 & 5:** No copying of UK unregistered design right.

Author:

Phil Leonard



PAN 1/25

Change to UKIPO trade mark specification practice following SkyKick

➤ Useful link

UKIPO statutory guidance, "PAN 1/25: required behaviour, and the impact on examination practice, following the Supreme Court's judgment in SkyKick UK Ltd and another v Sky Ltd and others", 27 June 2025: dycip.com/ukipo-PAN125

The UK Intellectual Property Office (UKIPO) has issued new guidance covering the examination of UK trade marks following the Supreme Court judgment in SkyKick UK Ltd and Anor v Sky Ltd and Ors ([2024] UKSC 36) (SkyKick).

Practice Amendment Notice 1/25 (PAN 1/25), effective immediately, means examiners will proactively consider whether a specification is "manifestly and self-evidently broad". Where a specification is considered to be too broad an objection under bad faith will be raised during the examination process.

The UKIPO aims to take a pragmatic approach, and is not applying firm rules as to the number of classes or terms that will trigger an objection. Broad specifications do not automatically equate to bad faith but trade mark applicants must have a commercial rationale for the terms covered, particularly where specifications cover a range of seemingly unconnected goods and services. Following PAN 1/25, there will be greater scrutiny of specifications at the application stage.

Whether bad faith is raised as an objection will depend on the nature of the applicant's business and their possible motivations for filing for the goods and services concerned. The UKIPO makes it clear that an identical specification may constitute a good faith filing for one applicant but bad faith for another, depending on the particular circumstances.

There is now an explicit requirement that applicants seek registration for goods or services which "represent fair and reasonable claims in the context of their businesses, for the purpose of denoting trade origin". Whilst UK trade mark applicants have always had to

An objection under bad faith will be raised at examination if a specification is too broad



declare a *bona fide* intention to use a trade mark for the specification covered when filing an application, this change in practice allows examiners to question whether this is indeed the case.

Paragraph 11 of PAN 1/25 provides particular guidance about when caution should be exercised, including:

- filing claims covering vast numbers of goods and services in large numbers of classes;
- when the terms used to describe the listed goods/services are themselves broad;
- use of class headings, particularly where class headings are used across a multitude of different classes;
- the selection of general terminology such as computer software, pharmaceuticals, clothing;
- covering all 45 classes will lead to an automatic objection, as will attempting to cover all goods in class 9.

If an objection is raised, applicants will have the opportunity to either explain the commercial rationale for their choice of specification or narrow the terms covered to a more relevant selection.

What this means for UK trade mark applicants

The change of practice does not mean broad terms and varied specifications cannot be covered. It also does not mean that an applicant cannot cover terms they do not yet use the mark on. This remains permitted and is important to encourage growing businesses to protect their trade marks. However, there should be a commercial rationale for all of the terms covered, ensuring they are fair and reasonable in relation to current and anticipated business activities. As ever, specifications should be carefully drafted.

With more stringent examination, perhaps this will lead to fewer oppositions claiming bad faith as a ground down the line.

Author:
Charlotte Duly



Small sales, (just) enough evidence 132 perfume sales reverse non-use finding

The European Union Intellectual Property Office (EUIPO) Board of Appeal partially annulled a decision that revoked Laurice El Badry Rahme Ltd's (Laurice) EU trade mark (EUTM) for BOND NO. 9 MANHATTAN, on the basis that sales of 132 bottles of perfume across a three-year period were sufficient to demonstrate genuine use of the trade mark.

Background

The Bond No. 9 MANHATTAN mark was registered for various goods in classes 3 and 4, including cosmetics, fragrances, and scented candles. Roja Parfums Holdings filed a non-use cancellation action against the mark under Article 58(1)(a) European Union Trade Mark Regulation (EUTMR). At first instance, the EUIPO revoked the mark in its entirety, noting that the extent of use evidence was "manifestly insufficient".

Laurice appealed the decision in relation to perfumery, fragrances for personal use, perfumes and eau de parfums in class 3.

Decision

The Board of Appeal ruled that the appeal was "well-founded in part": the evidence supplied showed use of the mark which was public, outward-facing, external, and in the course of trade, which was real use and not merely token.

Time and place of use

Much of the supplied evidence fell within the relevant period and indicated that Laurice had perfume in several EU member states: Hungary, France, Italy, Romania, and the United Kingdom (pre-Brexit). The Board of Appeal stated that genuine use does not require extensive geographical coverage.

Whilst some of the sales invoices provided fell slightly outside the relevant period, they were taken into consideration as they contributed towards the overall picture that there was a degree of continuous, real use of the trade mark by Laurice. The Board of Appeal remarked that invoices constitute a clear and objective means of proving the extent of trade mark use, without reliance on speculation.

Sales of 132 bottles of perfume across a three-year period demonstrated genuine use



Extent of use

The Board of Appeal also indicated that the assessment of genuine use entails a degree of interdependence between various factors. In this case, modest commercial sales volumes were offset by the breadth of distribution of the goods in question: the use of the mark was territorially extensive, the relevant invoices were addressed to various entities, the distribution was conducted in a selective manner, and the perfumes were also sold at a price point which was at the higher end of the range for perfumes (which could explain why the sales volumes were not high).

The Board of Appeal contrasted the case with previous ones, where the sale of 21 perfumery items was insufficient to establish genuine use, noting that the sales volumes in the present case were "substantially higher".

The evidence also showed that Laurice had sold testers of its perfumes, which demonstrated an intention to actively promote goods by reference to the trade mark and attract a wider consumer base within the EU.

As a result, the first instance decision revoking the mark for perfumery for personal use; fragrances for personal use, namely perfumes; eau de parfums in class 3 was annulled.

Reasons for non-use

Laurice additionally argued that International Fragrance Association (IFRA) regulations hindered production and sales of its perfume in the EU, as the perfume had to undergo a reformulation process, and that the regulatory change justified non-use. However, the Board of Appeal noted that reasons for non-use are construed narrowly, and found

that Laurice's arguments on the point lacked clarity and specificity, finding the mark not to have been genuinely used in relation to perfumery, except perfumery for personal use.

Among other things, Laurice did not provide a detailed explanation about the nature of the impact of the regulatory changes (for example, it was unclear whether ingredients were prohibited, restricted to specific quantities, or permitted under defined conditions; and it was also contradictory for the proprietor to claim that proper reasons for non-use existed at a time when they had in fact been using the relevant trade mark).

The Board of Appeal also rejected the proprietor's argument that the disruption caused by the Covid-19 pandemic justified non-use.

Author:

Agnieszka Stephenson



In short

The decision underscores the importance of demonstrating consistent, outward, and commercial use of registered trade marks across the EU. Whilst low sales volumes are not necessarily fatal when defending a non-use revocation action, it is important to document widespread market presence with clear, objective evidence.

Vape wars Interim injunctions, unjustified threats and the battle for the “Crystal Bar”

Case details at a glance

Jurisdiction: England & Wales

Decision level: High Court

Parties: Bargain Busting Ltd v Shenzhen

SKE Technology Co Ltd & Others

Date: 21 May 2025

Citation: [2025] EWHC 1239 (Ch)

Decision: dycip.com/2025-ewhc-1239ch

This recent High Court decision concerning an application for an interim injunction by the defendant to restrain the claimant from making further unjustified threats of trade mark infringement proceedings against the defendant's distributors highlights the importance of statutory unjustified threats provisions. The defendant based its application on the provisions in sections 21 to 21F of the Trade Marks Act 1994, which restrict the making of unjustified threats of trade mark infringement.

Background

The case concerns a dispute between Bargain Busting Ltd and various Shenzhen SKE Technology Co Ltd entities (collectively SKE) regarding alleged trade mark infringement in the vaping products sector. Bargain Busting is a non-specialised wholesaler. SKE is a manufacturer of e-cigarettes and vaping devices and has achieved success marketing these devices under the name “CRYSTAL BAR” and other signs using the word “CRYSTAL”. Bargain Busting owns two registered trade marks containing the word “CRYSTAL” and an application for the mark “CRYSTAL BAR”, which was opposed by SKE.

There are various ongoing proceedings between Bargain Busting and SKE in the High Court of England and Wales and the UK Intellectual Property Office (UKIPO). All of the claims relate to rights associated with vapes sold under the sign (or signs) containing “CRYSTAL”.

The High Court trade mark infringement proceedings were issued by Bargain Busting against SKE in September 2024. Two months later, in December 2024, Bargain Busting sent letters to eleven distributors and retailers of SKE's products, threatening trade mark infringement proceedings if they did not stop selling the allegedly infringing products. Bargain Busting subsequently joined four of these parties into the existing High Court proceedings against SKE.

The High Court's approach

The following approach was taken by the High Court in respect of SKE's interim injunction application:

Bargain Busting sent letters to eleven distributors and retailers of SKE's products



1. The starting point for interim injunctions is *American Cyanamid v Ethicon* [1975].
2. The injunction sought would (to a very limited extent) affect Bargain Busting's freedom of expression rights under Article 10 of Schedule 1 to the Human Rights Act 1998 and Section 12 of the Human Rights Act is therefore engaged. Accordingly, before granting an injunction, the court must be satisfied that the applicant is likely to establish that publication should not be allowed.
3. The court must also consider the guidance in *Cream Holdings v Banerjee* [2004] that an applicant would generally have to show that it would “more likely than not” succeed at trial. However, the guidance acknowledged there would be cases where it would be necessary to depart from this general approach. On this basis, the judge applied a flexible approach to Section 12 of the Human Rights Act and found that that SKE had satisfied the requirement to show that there was a serious issue to be tried which might well succeed at trial.
4. It was concluded that damages would not adequately compensate SKE due to the difficulty in establishing a link between threats and losses, particularly given that SKE's UK sales were over \$400 million in 2024.
5. SKE's offer to pay £100,000 into court as a cross-undertaking in damages was deemed sufficient.

Conclusion

An interim injunction was granted and Bargain

Busting was ordered not to make further threats against SKE's distributors pending trial.

It was decided that the impact of an injunction on Bargain Busting's Article 10 rights would be limited and proportionate, representing an appropriate balance with SKE's competing rights. It was emphasised that the injunction should be narrowly tailored to apply only to customers in respect of goods supplied by SKE and should reflect the qualifications and exceptions provided for in the Trade Marks Act.

This decision underscores the High Court's willingness to intervene where threats of legal proceedings may be unjustified and cause commercial harm.

Author:

Ella Lane



In short

This case emphasises the significance of statutory unjustified threats provisions (contained in Section 21 of the Trade Marks Act 1994) in protecting businesses from commercial harm caused by potentially groundless legal threats and clarifies the High Court's approach to balancing IP enforcement with the prevention of commercial harm.

The neutralisation principle

Board of Appeal overturns EUIPO decision

CFL Australia Pty Ltd (the applicant) applied for the mark GOTCHA, covering a range of goods (tea, coffee, snacks, etc) and services (snack bars, etc). Gong Cha Global Ltd (the opponent) operates a chain of bubble tea restaurants around the world, and filed an opposition to the application on the basis of its GONG CHA marks covering an array of similar and identical goods/services.

First instance decision

At first instance, the European Union Intellectual Property Office (EUIPO) rejected the opposition on the basis that:

- Visually and aurally, the marks are similar to a below average degree.
- GOTCHA has a meaning for English speakers.
- Where at least one of the signs at issue has a clear and specific meaning, the resulting conceptual differences may offset the visual and aural similarities between the signs (the so-called “neutralisation principle”).
- Consequently, there was no likelihood of confusion and the opposition was rejected.

Appeal

Gong Cha Global appealed, arguing that whilst conceptual similarities must be taken into account when making the overall assessment, neutralisation can only be applied **exceptionally**, and it is only a part of the overall assessment. The global appreciation of the marks as a whole is what is important. CFL Australia disagreed, highlighting the aural, visual and conceptual differences between the two marks, and asserted that the neutralisation principle should be applied here

as the conceptual differences are enough to counteract the aural and/or visual similarities.

Decision

Given the unitary character of the European Union trade mark (EUTM), an earlier mark can be a basis for opposition even if it only relates or applies to consumers in part of the EU. Therefore, the Board of Appeal focused on the Polish speaking part of the relevant public. In redoing the global assessment, the Board of Appeal found:

- GONG CHA as a whole does not have any meaning in Polish and is therefore normally distinctive.
- GOTCHA also does not have any meaning in Polish so is normally distinctive.
- The marks are visually similar to an average degree.
- Phonetically, the marks differ only in the pronunciation of the middle letters “NG” verses “T”. They are therefore aurally similar to a high degree.
- Given that both marks are meaningless, the conceptual comparison is neutral.

The Board of Appeal held that it could not follow the approach of the EUIPO, and found that there would be a likelihood of confusion: the appeal was allowed.

Neutralisation principle

On the neutralisation principle, the Board of Appeal held that this refers to the situation where a particularly pronounced and obvious conceptual difference between the signs at issue may counteract any visual and phonetic similarity.

However, in the case at hand:

- The earlier sign GONG CHA does not convey any clear and obvious meaning, therefore the neutralisation principle could not apply.
- In at least part of the EU, the sign GOTCHA also would not convey any clear and obvious meaning.

Thus the conceptual differences were not enough to neutralise the visual and phonetic similarities in this particular case.

Comment

The Board of Appeal reasoned that the neutralisation principle could not apply here for two reasons:

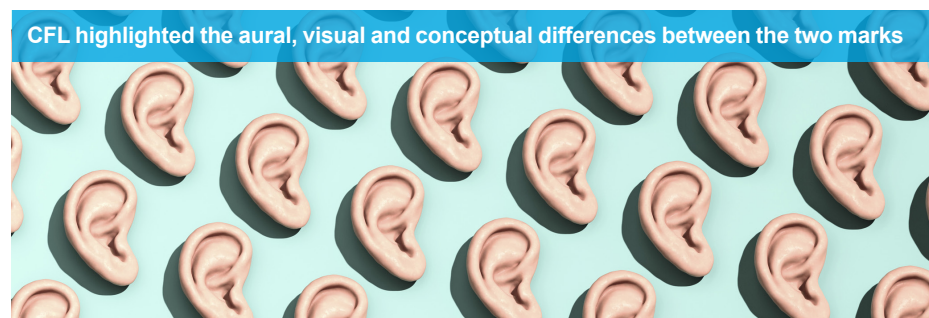
1. Not all of the relevant public would grasp the conceptual meaning of the opposed mark; and
2. The earlier sign, as a whole, had no conceptual meaning, which means that the conceptual differences were not sufficient to neutralise the visual and aural similarities.

The first reason makes sense: although it is not clear on what evidence the Board of Appeal was basing its views, as the decision merely asserts that the Polish speaking public would not understand the term GOTCHA (which may well be correct). For neutralisation to apply, the meaning of the sign must be clear and specific for the **entire public for whom the signs are visually and phonetically similar**.

The second reason seems to be a nuanced departure from previous practice. The EUIPO Guidelines suggest that the neutralisation principle can be applied if **one of the signs** has a clear and specific meaning that can be grasped immediately by the relevant public. The Board of Appeal’s decision here seems to be heavily based on the fact that one of the signs did not have a conceptual meaning.

In any event, it appears for now at least that the neutralisation principle will remain the exception rather than the rule.

Author:
Peter Byrd



CFL highlighted the aural, visual and conceptual differences between the two marks

Inherent distinctiveness and signs depicting products

Norms and customs test insufficient in itself

Case details at a glance
Jurisdiction: England & Wales
Decision level: UKIPO
Parties: HAVE&BE Co Ltd
Citation: O/0042/25
Date: 16 January 2025
Decision (PDF): dycip.com/UKIPO-o004225

This *ex partes* decision concerns the refusal of a figurative trade mark depicting a product (the lid of a lip mask), namely (UK) international registration no. WO0000001789520 (see below) filed in relation to goods such as lip balm and cosmetics (the application). The application was refused on the basis that it lacked distinctive character, in contravention of section 5(2)(b) of the Trade Marks Act 1994.



Source: O/0042/25 dycip.com/UKIPO-o004225

Following the initial refusal, the applicant requested a hearing, whereby it was argued that the mark departed significantly from the norms and customs of the lip balm and cosmetic sector (the norms and customs test). However, the refusal was maintained. This case, which sets out the registrar's reasons for the decision, provides useful guidance on the assessment of inherent distinctiveness in relation to trade marks depicting products or their packaging. Key points include:

The assessment criteria and the norms and customs test

The hearing officer set out various established principles related to the assessment of inherent distinctiveness in relation to marks depicting the appearance of a product, including various Court of Justice of the European Union (CJEU) decisions (such as *Henkel KGaA v OHIM*; Case C-144/06 P).

In summary, the case law provides that the criteria for assessing distinctiveness is no different to any other category of mark. However, account must be taken of the

fact that consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or packaging. In such circumstances, "only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character": the norms and customs test.

In the UK, the norms and customs test has been found ([2017] EWCA Civ 1729, *London Taxi*) to have three steps:

1. A determination of what the sector is.
2. The identification of the norms and customs, if any, within that sector.
3. A decision as to whether or not the mark departs significantly from those norms and customs.

Is the norms and customs test a sufficient test: CJEU jurisprudence not "acte Claire"

In the decision, the hearing officer noted that whilst CJEU jurisprudence may be saying that the norms and customs test is the only necessary test to establish distinctiveness, the UK courts do not regard the jurisprudence of the CJEU as being *acte claire*, despite it being assimilated law.

According to the hearing officer, "whilst the UK Courts seem to acknowledge that the question of 'departing significantly from the norms and customs' is a necessary test, they do not appear to agree that it is also a 'sufficient' test."

The approach taken: additional step required

The hearing officer considered that whilst the norms and customs test is necessary, there still must be (a seemingly separate) consideration as to whether the mark is distinctive.

The hearing officer noted from case law (*Robinson's Squash Bottle* decision (BL o-263-18) and *Yakult* [2001] RPC 39) and *Kerly* (a leading trade mark law text) a difference between the concept of distinctiveness *per se* (that is the ability to stand out in a general sense) and distinctiveness in a trade

mark sense (that is to denote trade origin). In line with these authorities, the hearing officer stated that simply being novel, eye-catching or standing out is insufficient.

Consequently, in illustrating the inherent distinctiveness of a sign depicting a product, as well as satisfying the norms and customs test, it seems that the Registry must also be satisfied that the mark is distinctive in a trade mark sense.

Application to the facts

In applying these principles, it was found that whilst the application **did** significantly depart from the norms and customs of the trade in the cosmetic sector, the application was nevertheless **non-distinctive**.

The hearing officer stated "The final test is a statutory one, 'is the sign devoid of distinctive character', not whether the shape happens to be novel or original or even distinctive in a purely general sense."

Consequently, it was found that whilst the average consumer would view the shape as an aesthetically pleasing, they would be unlikely to perceive it as a trade mark.

Author:
Sophie Rann



In short

This Registry decision sets out a seemingly high burden to establish inherent distinctive character in trade marks that depict the appearance of a product. On the basis of this decision, it seems likely that applicants will struggle to achieve trade mark registrations for signs depicting products without providing evidence of acquired distinctive character or including additional distinctive elements.

D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

Exhaustion of IP rights

Exhaustion of intellectual property rights after Brexit Clarity from UK Government in response to consultation

Following the UK's departure from the EU, the UK ceased to be bound by the EU's rules on intellectual property exhaustion. Instead, the UK has adopted the UK+ scheme, as follows:

- Goods placed on the UK market by, or with the consent of, the rights holder are not considered exhausted in the European Economic Area (EEA) and so businesses exporting these goods to the EEA need the right holder's consent.
- The IP rights in goods placed on the EEA market by, or with the consent of the rights holder, are considered exhausted in the UK.

In 2021, the UK Government launched a public consultation to consider four potential options for the UK's future exhaustion regime:

1. Maintain the UK+ scheme.
2. National exhaustion regime: IP rights in goods would be exhausted in the UK when placed on the UK market, preventing the parallel importation of goods into the UK.

3. International exhaustion regime: IP rights in goods would be exhausted in the UK when placed on the market in any country.

4. Mixed exhaustion regime: A bespoke approach, applying different exhaustion rules to specific goods, sectors, or IP rights.

The consultation concluded there was insufficient evidence to justify departing from the current UK+ regime.

In May 2025, the UK Government published its response confirming the retention of the UK+ model.

While the legal position remains unchanged, the government's confirmation that the UK+ scheme is here to stay provides welcome clarity for rights holders and businesses operating in the UK.

Author:
Kamila Geremek



Useful link

UK Government response to the consultation on the UK's future exhaustion of IP right regime:
dycip.com/ip-exhaustion-uk-gov-response

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