

# D YOUNG & CO TRADE MARK NEWSLETTER *no.140*

May 2025

In this issue:

<b>Pedantry on ice</b> High Court explores the relationship between trade marks and their descriptions	<b>04</b>
<b>Birkenstock sandals are not art</b> German Federal Court denies copyright protection for classic Birkenstock models	<b>05</b>
<b>Oh glow up!</b> Another TV format case fails	<b>06</b>
<b>UK Government's response to second consultation</b> Trade marks and designs update	<b>07</b>
<b>3D mark with a technical function</b> High Court re-enforces difficulties in registration	<b>08</b>
<b>ECOVIE and ECOVER</b> General Court finds likelihood of confusion	<b>09</b>

## Chickens come home to roost Morley's (Fast Foods) v Nanthakumar & Ors

Full Story Page 02



Welcome to our May newsletter in which we are pleased to announce recent promotions within the team. Rachel Pellatt has been promoted to Senior Associate, Rechtsanwältin Jacqueline Feigl and Solicitor Agnieszka Stephenson have been appointed Associate, and Nadia Wort takes on the role of Trade Mark and Design Specialist.

We also bring important news with regard to EU design reform where, as of 01 May 2025, registered Community designs (RCDs) have been renamed as registered European Union designs (REUDs) and use of the marker “D in a circle” (©) is now allowed in the EU. A number of other technical changes regarding design renewals and deferment of publication rules are also now in place. Your usual D Young & Co advisor can fill you in with more details.

**Jana Bogatz**  
Partner, Rechtsanwältin

Events



**INTA Annual Meeting**  
**San Diego USA, 17-21 May 2025**  
Jana Bogatz, Richard Burton, Matthew Dick, Gemma Kirkland, Anna Reid and Yvonne Stone will be joining trade mark and brand professionals from around the world.

**ECTA Annual Conference**  
**Berlin Germany, 18-20 June 2025**  
Peter Byrd and Jennifer Heath will be attending the 43rd ECTA Conference, which will focus on creativity.

[www.dyoung.com/events](http://www.dyoung.com/events)

Subscriptions



Email subscriptions / mailing preferences:  
[subscriptions@dyoung.com](mailto:subscriptions@dyoung.com)

Read online and view previous issues:  
[www.dyoung.com/newsletters](http://www.dyoung.com/newsletters)

Our privacy policy is published at:  
[www.dyoung.com/privacy](http://www.dyoung.com/privacy)

Follow us



LinkedIn: [dycip.com/linkedin](https://www.linkedin.com/company/dyoungip)  
X: [@dyoungip](https://twitter.com/dyoungip)

Settlement agreements

# Chickens come home to roost

## Morley's (Fast Foods) Ltd v Nanthakumar & Ors

A recent High Court decision concerning London chicken shops highlights the importance of robust and forward thinking settlement agreements.

Founded in 1985 and now with around 100 franchises and presence on various delivery apps, Morley's chicken shop is ever-popular and has various trade marks protecting the Morley's brand. It also has trade marks protecting one of its popular chicken burgers, the “TRIPLE M” or “TRIPLE-M” burger. Around 1998, a copy-cat clucked up the courage to launch a rival chicken shop: Mowley's. It was set up by Mr Kunalingam Kunatheeswaran (KK). KK even secured a UK trade mark for this rival brand (see below) and a dispute followed when Morley's brought an action to invalidate this trade mark.



Morley's brand logo left, source [2025] EWCA Civ 186: [dycip.com/2025-ewhc-civ-186](https://dycip.com/2025-ewhc-civ-186). Mowley's logo right, source UKIPO: [dycip.com/ukipo-mowleys](https://dycip.com/ukipo-mowleys)

The dispute ended with the parties entering into a settlement agreement in 2018. At the time, no doubt, the parties would have been happy to put the dispute to bed without escalation to lengthy and expensive litigation. Use of the Mowley's sign would end and the UK trade mark would be surrendered. However, it was false economy. The settlement agreement opened the door to future problems.

Settlement agreement problems

The settlement agreement contained a term in which KK was permitted to use “Metro's Fried Chicken” in the form of the settlement logo (see below). It also expressly permitted KK to register the settlement logo as a trade mark and to use the settlement logo on any packaging. These express terms created a trade mark licence from Morley's to KK to use the settlement logo:



The settlement logo. Source [2025] EWCA Civ 186: [dycip.com/2025-ewhc-civ-186](https://dycip.com/2025-ewhc-civ-186)

The settlement agreement contained the

ambiguous wording that KK could use the settlement logo “and any reasonable modifications thereto”. This wording left Morley's a hostage to fortune as to how KK would “reasonably modify” the settlement logo in future.

The decision to permit the use of the settlement logo failed to mitigate the chance of future contentious issues. The settlement logo was very similar to the Morley's brand. There was the similar red colour background, similar use of a large “M”, and use of a similar cursive font. Maybe Morley's was assuming that the use of the sign would be limited to shop signage and packaging, and that consumers would see the difference. However, it failed to consider the potential future growth of Metro's and the proliferation of other similar chicken shops.

Another oversight was the failure to consider how the Morley's brand and the settlement logo would be perceived in the online and digital environment. By the time of the settlement agreement, Deliveroo had been in the UK for five years and Uber Eats for two years. When viewed in the context of an app or website thumbnail, the Morley's brand and the settlement logo were even more likely to be confused.

KK and its franchisees did not waste time launching Metro's outlets. It quickly became apparent that those outlets were using signage with (un)reasonable modifications. The modified Metro's logo looked incredibly similar to the Morley's brand:



Morley's brand left, Metro's signage right. Source [2025] EWCA Civ 186: [dycip.com/2025-ewhc-civ-186](https://dycip.com/2025-ewhc-civ-186)

Social media quickly saw the similarities: “A fake Morleys called Metros. Wtf.”; “WHY TF IS THERE A MORLEYS KNOCK OFF MY BLIND ASS WANTED TO ORDER MORLEYS I FRICKING ORDERED METROS, WTF IS METROS??!”; “Genuinely how have morleys not sued metros for their logo lol”; “Did Morley's rebrand as metros or something”; “Odd trend lately - Morley's seem to be devolving into same-colour-

new-name variants. Seen “Marley’s”, “Mawley’s”, “Maaley’s”, “Metro’s” etc”.

### Chickens come home to roost at the IPEC

Morley’s took action against KK for use of the Metro’s logo and court proceedings in the English Intellectual Property Enterprise Court (IPEC) followed. Whilst this appeared to be a straightforward trade mark infringement case, the chickens that came home to roost were the grant of the licence to KK and the “reasonable modifications” wording. In the IPEC, KK argued that the express grant of the licence permitted him to use the settlement logo with reasonable modifications, and the modifications made in order to create the Metro’s logo were reasonable. The IPEC judge rightly found that modifications that increased similarity with the Morley’s brand could not be reasonable, regardless of the licence granted. The Metro’s logo was found to be confusingly similar to the Morley’s brand and to infringe Morley’s trade mark rights under s. 10(2)(b) of the Trade Marks Act 1994, with the similarities between the signs being the main focus, including:

- A medium degree of visual similarity between the Morley’s brand and the Metro’s logo (white lettering on a red background, the distinctive letter “M” as the first letter of the main word, and the similar font).
- Conceptual similarity, when considering the marks/sign as a whole, owing to the similar concepts portrayed by the straplines “It Tastes Better” on the Morley’s brand and “It’s the real taste” on the Metro’s logo.

The “MMM Burger”, a feature on the Metro’s menu, was also found to infringe Morley’s trade mark rights under s. 10(2)(b) of the Trade Marks Act 1994. The IPEC judge found that the “MMM Burger” had a medium-high degree of similarity with the Morley’s trade mark for “TRIPLE M”/“TRIPLE-M”. This was on the basis that the “MMM Burger” would have to be requested orally in store and that a substantial subset of consumers would request a “Triple M” burger (as opposed to ordering an “mmm” burger). And so, there was aural and conceptual similarity, although low visual similarity.

### Creative arguments at the Court of Appeal

The problems already deep-fried into the

settlement agreement provided KK and his franchisees the opportunity to deploy some creative points on appeal. The IPEC judge’s decisions on similarity were upheld by the Court of Appeal with relatively little fanfare. However, two arguments deployed by Morley’s are worth noting.

Morley’s argued that the licence granted to KK under the settlement agreement also constituted the grant of an implied sub-licence to the Metro’s franchisees. However, the settlement agreement contained numerous provisions excluding the rights of third parties (for example, the contract was unenforceable by third parties under the Contracts (Rights of Third Parties) Act 1999 and the defined term “related parties” expressly excluding third parties). The settlement agreement also did not expressly grant any rights to sub-licence. Any licence granted to KK under the settlement agreement would not have extended to the franchisees. And, in any event, the Metro’s logo was not a “reasonable modification” of the settlement logo and so a sub-licence would not have covered use of the Metro’s logo by the franchisees in any event.

Another interesting point in the judgment related to the issue of the “drunken consumer”. The IPEC judge had found there to be two classes of average consumer for chicken shops:

1. Children, young, people, students and families who make purchases from chicken shops at lunch, dinner and in the early evening. This group chooses by convenience of location, shopfront and potentially adverts on delivery websites. They will pay a low-medium degree of attention.
2. Late-night and early-morning revellers who are likely tired, hungry and a significant subset of which will be intoxicated. This group chooses by convenience of location, shopfront and what is open late. They will pay a low degree of attention.

Various issues were raised about the validity of the second class of consumers, including that consumers that were intoxicated could not be “reasonably well informed or circumspect”, and so could not fall within the definition of

the average consumer. The IPEC judge was, therefore, wrong to find a likelihood of confusion for the second class of consumers.

The Court of Appeal accepted that there should not be a second class of consumers. However, it gave a clear reminder that the purpose of the likelihood of confusion test is to assess how the average consumer would select the relevant goods and services and the level of attention they would pay. The IPEC judge may well have got it wrong by formulating the average consumer into two groups, and should have defined this group simply as a single class of consumers that go to chicken shops. However, this did not affect the IPEC judge’s final conclusion on likelihood of confusion. Both classes of consumer would choose their chicken shop by convenience of location and shopfront, and their levels of attention would overlap (that is, low or low-medium).

Ultimately, in the context of the whole likelihood of confusion test, the IPEC judge would have found infringement regardless of whether the average consumer had a low or low-medium degree of attention. The Court of Appeal confirmed that it would have come to the same conclusion.

### Avoiding chicken-shop regret

The Morley’s-Metro’s dispute exemplifies how settlement agreements can be perilous, if not properly future-proofed.

It is important to remember that settlement agreements are not just backward-looking and concerned with shutting down prior disputes. They are also forward-looking, contractual arrangements that define the continuing relationship between parties within certain spaces.

Brands should carefully consider how they expect the marks in issue, and the market, to develop in the future. This can be very helpful to ensuring settlement terms are drafted to be sufficiently robust and to mitigate the possibilities of future disputes with a third party.

**Author:**  
**Phil Leonard**



# Pedantry on ice

## High Court explores the relationship between trade marks and their descriptions

Case details at a glance

Jurisdiction: England & Wales

Decision level: High Court

Parties: Babek International Limited v Iceland Foods Limited and Nathan Heparke

Date: 11 March 2025

Citation: [2025] EWHC 547 (IPEC)

Decision: [dycip.com/2025-ewhc-547-ipecc](https://dycip.com/2025-ewhc-547-ipecc)

British supermarket chain Iceland applied for a summary judgment regarding a dispute over Babek International's registered trade mark (shown below). Initially, Babek claimed the mark had been infringed by Iceland selling a product bearing the sign; as a result, Iceland counterclaimed for invalidity of the mark.

At the core of this case is the relationship between the visual and written representations of the trade mark. The trade mark registration was accompanied by a description that read "Gold oval with embossed BABEK writing. Colour claimed: Gold, Black".



Babek International's registered trade mark. Source [2025] EWHC 547 (IPEC): [dycip.com/2025-ewhc-547-ipecc](https://dycip.com/2025-ewhc-547-ipecc)

### Clarity and precision

Iceland asserted that the trade mark failed to comply with s1(1) of the Trade Marks Act 1994. It is well established that to satisfy s1(1), a trade mark must satisfy the Sieckmann criteria: it must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. Iceland claimed the mark lacked the requisite clarity and precision to meet the criteria.

To support its position, Iceland put forward six distinct arguments. Broadly, these arguments asserted that the description of the mark was inconsistent with its visual representation. Consequently, the mark lacked clarity and precision, undermining Sieckmann and by extension s1(1) of the Trade Marks Act 1994.

Iceland's arguments can be summarised as follows:

- The mark was described, in the original European Union trade mark (EUTM), which was later cloned following Brexit, as figurative yet could be interpreted as three-dimensional due to references to embossed elements.

- The description failed to specify the style, placement, or precise hues of the writing and colours.
- There were several inconsistencies between the verbal description and the visual representation, including: only "BABEK" was described as embossed, while other elements appeared embossed visually; the description referred to an oval, but the graphic displayed an ellipse; and the colour black was claimed in the description, yet was absent visually, with only shadows present.
- The visual representation displayed various hues of gold, none of which were identified in the description.
- The description did not specify the particular shade of black claimed and black was not even visually present.
- Colours beyond gold and black appeared in the visual representation, despite only those two being claimed.

These arguments were rejected in their entirety as the judge concluded that finding the two representations of the mark to be inconsistent would demand an "assumed degree of pedantry" and "make the trade mark system unworkable".

The pedantic nature of these arguments is exemplified by the judge's analysis that the shadows in the mark could not reasonably be described as gold or any other colour, leading to the inclusion of black in the verbal description, despite no black appearing visually.

Similarly, the judge quickly dismissed the subtle distinction between an oval and ellipse as "high grade pedantry" given both are variations of elongated circular shapes.

### Colour hues

The most interesting point of contention surrounded the lack of specified colour hues. On this issue, the judge drew from Sainsbury's v Babybel, in which it was considered that colour hues of the famous Coca-Cola and Tesco marks could "vary without affecting the

mark's capacity to distinguish". Consequently, in the judge's view, specific colour hues or Pantone numbers are unnecessary to satisfy the Sieckmann criteria, for marks of this type. Overall, this conclusion on the colour hue issue is emblematic of the judge's reasoning for rejecting most of Iceland's arguments. The view that a trade mark description, which does not detail every element of a mark, is not automatically inconsistent with the visual representation. To conclude otherwise would make trade marks completely impractical.

As a result, the mark was found to satisfy the Sieckmann criteria and consequently s1(1).

### Author:

Frankie Thomas



### In short

A key takeaway from this case is that the judge adopted a pragmatic approach to interpreting trade mark descriptions, placing emphasis on the functional purpose of trade marks. Accordingly, when drafting descriptions, the focus should be on clearly identifying the essential features of the mark, rather than overloading the description with overly technical detail. A lack of minute specificity is unlikely to be problematic, supporting a trade mark system that remains both accessible and commercially sensible.

Moreover, this case reinforces the principle that compliance with the Sieckmann criteria does not typically require the inclusion of specific Pantone references, for every type of mark.

# Birkenstock sandals are not art

## German Federal Court denies copyright protection for classic Birkenstock models

👉 Case details at a glance

Jurisdiction: Germany  
Decision level: Bundesgerichtshof  
(German Federal Court of Justice, BGH)  
Parties: Birkenstock v Tchibo et al  
Date: 20 February 2025  
Citations: I ZR 16/24; I ZR 17/24; I ZR 18/24  
Press release (with links to judgments):  
[dycip.com/bgh-press-release-20feb2025](https://dycip.com/bgh-press-release-20feb2025)

**G**erman sandals producer Birkenstock sued three entities which sold and/or produced sandals that are similar to its models Arizona, Madrid, Boston and Gizeh. It is now clear that Birkenstock cannot rely on copyright to prevent competitors from offering similar models in Germany.

Birkenstock has been in business for more than 250 years. The models in suit were all designed decades ago. Over the years, Birkenstock sandals has gained a status close to a heritage asset in Germany. Once dubbed as hippy sandals (“Ökolatschen”), their image has transitioned to iconic fashion items. Yet, the Bundesgerichtshof (German Federal Court of Justice, BGH) ruled they are not art.

### Requirements for copyright protection

In order to be protected by copyright, a work, including such of applied art, needs to be an original and an expression of author's own intellectual creation. The latter requires an objectively identifiable subject matter. If, on the other hand, the creation was determined by technical considerations, rules or other constraints that left no room for the exercise of creative freedom, the threshold of originality is not met. In principle, sandals can be protected by copyright. A two-step test, asking whether there was sufficient creative freedom and whether that freedom was artistically exploited by the author, has become common practice to determine copyrightability in Germany.

### Assessment of the BGH

The BGH held that while the sandals had a characteristic overall impression, it could not be established that they were originals in the sense of their author's own intellectual creation. In particular, exercising choices regarding various design elements (for example, form of footbed, buckle, fastening system) as such is not sufficient to bestow copyright protection.

The court found that the designer took reference in prior models so that the sandals were within the realm of the craftsmanship of an orthopaedic shoemaker. They did not artistically deviate from health sandals known at the time of creation and from the models it was not apparent that Karl Birkenstock had

In principle, works of applied art including sandals can be protected by German copyright



exploited the existing scope for design in a creative way that reflected his personality. On the contrary, the court assumed that the designs were primarily oriented towards the result of a product that was particularly “healthy” for the foot, but also marketable.

The BGH also found that the questions currently pending before the Court of Justice of the EU (CJEU) in the USM Haller and Mio cases are not relevant for the decision. These questions inter alia concern the relevance of (1) the subsequent assessment of the work as a design classic by experts and (2) the subjective view of the creator.

### Outlook

The decisions set a high bar for copyright protection in Germany. However, they are in line with prior decisions of the BGH and the CJEU. In the past, Birkenstock had successfully claimed copyright protection before lower instance courts, that found the design choices of the designer were sufficient to meet the threshold of originality. With the decisions of the BGH, it will be more difficult to substantiate copyright protection for fashion items in Germany.

Birkenstock does not own trade mark or design rights regarding the design of its classic sandals as a whole. It is also questionable if Birkenstock could successfully claim passing off according to unfair competition laws for some of its sandals. In one decision, a German court found that unfair competition law cannot be asserted because similar models to the Arizona sandal had become common on the German market.

The decision is based on the assumption that Birkenstock failed to ensure competitive protection of its products at an early stage.

### Prior instances

- Regional Court of Cologne decision of 11 May 2023.
- Higher Regional Court of Cologne decision of 26 January 2024.

### Author:

Jacqueline Feigl



### In short

In principle, works of applied art including sandals can be protected by copyright in Germany.

Copyrightability requires an original and the author's own intellectual creation manifested in an identifiable object.

Combining previously known design elements is not sufficient to meet the threshold of originality.

Asserting passing off rights in due time is crucial to prevent designs with competitive character becoming common.

# Oh glow up! Another TV format case fails

Case details at a glance

Jurisdiction: England & Wales

Decision level: High Court

Parties: Gladness (also known as Tumi)  
Jukic v British Broadcasting Corporation  
and Wall To Wall Media Limited

Date: 10 February 2025

Citation: [2025] EWHC 221 (Ch)

Decision: [dycip.com/2025-ewhc-221-ch](https://dycip.com/2025-ewhc-221-ch)

The BBC has succeeded in getting a seemingly spurious case against it thrown out. This case concerns an allegation by an individual that the BBC and Wall To Wall Media had infringed her rights in relation to a TV show format, resulting in the show Glow up: Britain's Next Make-Up Star.

The claimant was a litigant in person. She initiated the claim, made an application for summary judgment and then stopped engaging completely and did not even show up to the hearing.

The defendants made an application to strike out the claim, on the basis that there were no reasonable grounds for bringing the case and that the pleadings did not reveal a legally recognised cause of action.

## The pleadings

The claimant claimed that she shared a show "Treatment" with the BBC in 2018. The BBC subsequently went on to develop the show and that this was an infringement of her IP rights. The particulars also contained a number of other allegations including harassment and computer hacking. The judge concluded that these were extremely poorly specified and did not relate to either of the defendants, so were not relevant to this action.

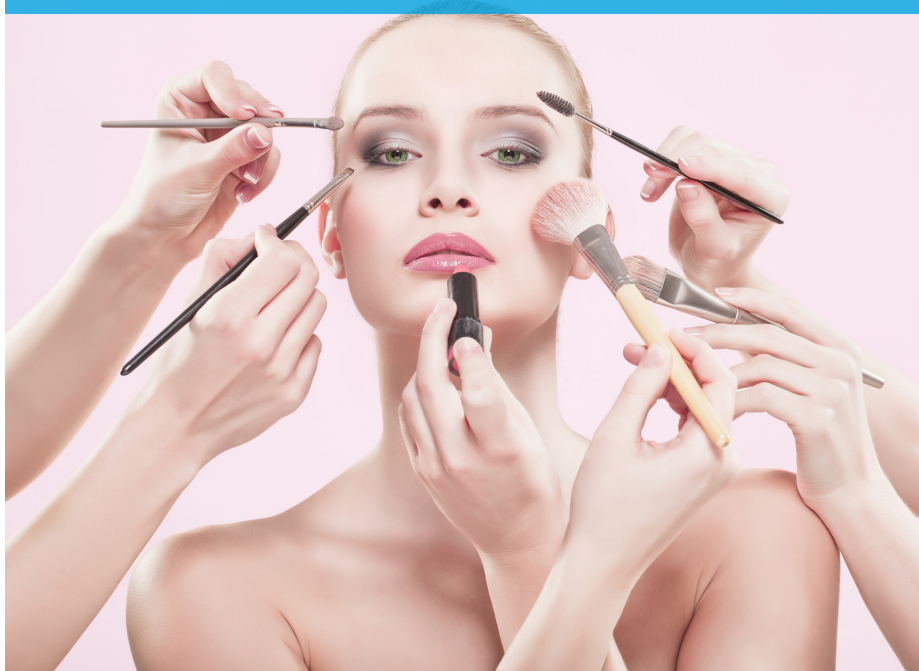
The defendants denied that they had received the Treatment, or created the show with reference to it. They applied for strike out and summary judgment.

## Strike out

The court has discretion to strike out a claim in certain circumstances, including (as asserted here) where the claim sets out no facts indicating what it is about, or when it makes no sense, or when it does make sense but does not reveal a legally recognised claim.

Strike out is a very draconian measure and the court should always consider whether the pleadings can be remedied instead of struck out. However, in this case the defendants argued that strike out would still be appropriate.

The claimant claimed that the BBC had infringed her IP rights as well as other allegations



The judge agreed, finding that no case had been made out in relation to any of the claims.

## Summary judgment

Summary judgment may be awarded when a case has no reasonable prospect of success. Given the above, it will be no surprise that the judge also found that the defendants were entitled to summary judgment. However, the judge nonetheless decided to look at the claimant's IP claim. On this he said the following:

1. The format of the show set out in the Treatment was relatively high level (that it was a reality show, a competition, and that there was more than one judge). There was no originality in these ideas.
2. Some of the points relied on did have a bit more substance, but these did not amount to copying (that the title BOSSIIIE: 10 Minute Makeover was similar to Glow Up: Britain's Next Make-Up Star, and that use of a picture of Kim Kardashian was similar to use of the picture of Stacy Dooley).
3. Some of things she relied on in her pleadings were not even in the Treatment.

The judge said he was being as fair to the claimant as he possibly could be but, even ignoring all of the deficiencies in the pleadings, there was simply not enough similarity to establish that the Treatment had been copied. Thus the copyright claim would have failed, even if it was properly made out.

## Finally

The judge ordered costs on an indemnity basis and even a civil restraining order stopping the claimant from making further applications without the court's permission.

It is of course an important feature of our justice system that everyone should be able to seek justice where they have been wronged. However, this case highlights the burden on the court and on represented parties where litigants in person are not able to properly plead and rationalise their claims. The judge should be commended for doing what he could to help the litigant in person, but ultimately the right conclusion (including on costs) was reached in this case.

Author:  
Peter Byrd



# UK Government's response to second consultation

## Trade marks & designs update

The UK Intellectual Property Office (UKIPO) launched its "One IPO Transformation" programme in 2021, with the ambition of enhancing and modernising its digital services for intellectual property rights in the UK. Between 22 August 2023 and 31 October 2023, the UK Government ran a consultation on how the trade mark, design and IPO tribunal system can better deliver accessible and efficient digital services. The government's response to this second consultation was published on 10 April 2025. In this article, we will discuss a few key outcomes from a trade mark and design perspective.

### Online public file inspection service for trade marks and designs

At present, to view trade mark and design documents, interested parties can order copies of documents via email and pay a fee (or visit the UKIPO), and only limited details are available online.

The government intends to introduce an online file inspection service for trade mark and design documents, similar to the existing service available for patents. Interestingly, this could include examination reports.

This change should improve the efficiency of conducting research and due diligence. It would also better align the UKIPO's records capabilities with other IP offices such as the EUIPO. The government notes the new inspection service will take into account concerns about data scraping, confidentiality and AI tools.

### Change to inspection of design documents and requests for confidentiality

The government intends to remove the 14-day delay to design documents becoming available for public inspection, so that it is quicker for the public to access published design applications.

When the online public file inspection service launches, the government also intends to amend the trade mark, patent and design rules so that confidentiality requests

can be made at any time, by anyone.

It is noted that the current high bar for granting confidentiality requests will not change.

### Series trade marks to be discontinued

A series mark is defined as "a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark". Under the current series mark system, an applicant can apply for up to six versions of a mark that meet the criteria of a series mark.

UKIPO statistics from the last five years indicate that:

- Series applications represented around 10% of all domestic trade mark applications.
- On average, 65% of series mark applications were filed by unrepresented applicants.
- In 2022, 39% of series mark applications filed by unrepresented applicants were objected to and 17% of series mark applications filed by represented applicants were objected to.
- On average, 74% series applications were filed to cover only two versions of a mark.

Many respondents to the second consultation were in favour of retaining at least some protection for series marks. Nevertheless, the government intends to discontinue the series mark service for **new** applications when the new digital service launches.

The government believes that the majority of users will benefit through simplification of the trade mark application process, with only a small proportion of applicants being adversely affected. Further rationale includes the government's concerns that the current system is being misused (for example to try and achieve dual protection at a reduced cost for what should be separate applications); and that unrepresented applicants who have difficulty with series mark applications can be financially

### Related article

"UKIPO One IPO Transformation Programme second consultation, a trade mark and design update": [dycip.com/ukipo-transformation-consult2](https://dycip.com/ukipo-transformation-consult2)

### Useful links

UKIPO press release, "Government publishes second transformation consultation response": [dycip.com/ukipo-transformation-news](https://dycip.com/ukipo-transformation-news)

UKIPO, "Government response to IPO Transformation programme: second consultation": [dycip.com/ukipo-consultation-2025](https://dycip.com/ukipo-consultation-2025)

disadvantaged as there are no refunds issued for invalid series applications. Importantly:

- Existing series marks will remain valid.
- It would still be open to applicants to file for two (or more) separate trade mark applications to cover variants of a mark, which may be appropriate to consider in certain cases, for example to support priority claims in other territories.
- It is anticipated that this change will create harmonisation, as often series marks are not an option in international trade mark systems.

We can expect transitional provisions and guidance to be issued in due course. The government also intends to monitor the impact of this change.

### Encouraging mediation in IPO tribunal proceedings

The UKIPO already encourages parties to mediate during IPO tribunal proceedings. Respondents were not in favour of compulsory mediation and it was noted that professionally represented parties resolve many cases via negotiations.

From Summer 2025, the UKIPO will pilot the use of mediation information and assessment meetings (MIAMs) for some disputes in cases where both parties are unrepresented. The government will also further explore the power of hearing officers to encourage voluntary mediation.

It is possible that this service may be extended to represented parties in future and if so, we expect further information and guidance to be issued.

### Implementation

Development of the new trade mark, design and IPO tribunal services is expected to start in Autumn 2025. The UKIPO also intends to launch its updated digital patent service later in 2025.

### Author:

Jennifer Heath



# 3D mark with a technical function? High Court re-enforces difficulties in registration

Case details at a glance

Jurisdiction: England & Wales

Decision level: High Court

Parties: Abbott Diabetes Care Inc and

Sinocare Inc, Sinocare Meditech Inc, and

Sannuo Health Management Co Ltd

Citation: [2025] EWHC 206 (Ch)

Date: 07 February 2025

Decision: [dycip.com/2025-ewhc-206-ch](https://www.dycip.com/2025-ewhc-206-ch)

In this recent High Court case, Mr Justice Smith re-enforced how difficult it can be to acquire and maintain rights in a 3D trade mark, particularly when its shape protects features with a technical function.

## Background

The claimant, Abbott Diabetes Care Inc (Abbott), specialises in the development, manufacture and sale of continuous glucose monitoring (CGM) systems.

The three defendants at trial were: Sinocare Inc, Sinocare Meditech Inc and Sannuo Health Management Co Ltd (Sinocare). Sinocare manufactures and sells, *inter alia*, CGM systems.

In 2022, Abbott registered a 3D trade mark in the UK for the following mark, which comprises the “on-body-unit” (OBU) within which sensor components and transmission electronics are found, in class 10 (“the Mark”):



Source [2025] EWHC 206 (Ch): [dycip.com/2025-ewhc-206-ch](https://www.dycip.com/2025-ewhc-206-ch)

Sinocare’s CGM system (shown below) was launched in China in 2023, followed by the UK in January 2024.



Source [2025] EWHC 206 (Ch): [dycip.com/2025-ewhc-206-ch](https://www.dycip.com/2025-ewhc-206-ch)

Abbott brought trade mark infringement and passing off proceedings against Sinocare, which in turn counterclaimed for the invalidity of the Mark both because of a lack of distinctiveness, and because the shape protected features having a technical function.

## Validity of the Mark

It was agreed that the average consumer comprises health care professionals, diabetics (and their carers), and people who monitor glucose levels for health and fitness purposes. These persons generally pay a high degree of attention in respect of the relevant goods.

Abbott argued that the Mark had acquired distinctive character in the UK. Evidence to support this included details of marketing, advertising and sales of the OBU, as well as survey evidence (some of which had been prepared to help Abbott get the Mark registered in 2022).

It was held that the evidence failed to show that any of the categories of the average consumer understood the shape of the Mark to indicate its commercial origin. Rather, Abbott’s presentation of the Mark (for example, within marketing materials) was as a product, and the emphasis was on its functional aspects, with its “traditional” trade marks (word and logo marks) carrying “the burden of badge of origin”. The Mark was therefore invalid.

As regards the survey evidence, this was largely criticised due to its lack of adherence to the Whitford Guidelines (established in *Imperial v Philip Morris* [1984] RPC 293). Specifically, there was a lack of information surrounding the disclosure of the sources and circumstances of the survey; it was therefore difficult to draw any reliable inference from it.

Further, with respect to Sinocare’s claim that the Mark consisted exclusively of the shape of goods necessary to obtain a technical result, it was held that four of the six pleaded features fell foul of this; the Mark was therefore also invalid on this basis.

## Abbott’s claims

In case the validity finding was incorrect, the judge went on to consider Abbott’s infringement and passing off claims.

The judge found that there was no likelihood of confusion, and the fact there was no evidence of actual confusion was “not

without significance”: if confusion was going to occur, some actual confusion would have been expected by the time of trial, whether in the UK or China.

Abbott’s claim to a reputation in the Mark and that Sinocare’s use, being without due cause, took unfair advantage of, or was detrimental to, the distinctive character or repute of the Mark also failed. It was held the average consumer wouldn’t make any connection in their minds with the allegedly infringing sign, nor change their economic behaviours in consequence of the use.

Furthermore, it was also held that, had there been infringement, Sinocare would have been able to rely on the defence of use of a non-distinctive sign in accordance with honest commercial practices.

As regards passing off, while there was no dispute that Abbott had acquired goodwill in the UK, the question was whether consumers identified that goodwill with the Mark. It was held they did not. As consumers also did not view Sinocare’s design as denoting origin, there was no misrepresentation either. This claim also failed.

## Author:

Olivia Oxtan



## In short

This case serves as a useful reminder both regarding the high threshold required to register and maintain a 3D mark (particularly without other branding elements) in the UK, as well as the requirements for adducing survey evidence in English proceedings.



# D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

## Likelihood of confusion

# ECOVIE and ECOVER General Court finds likelihood of confusion

In a recent decision, the General Court overturned the EUIPO Board of Appeal's finding in an opposition between the EU figurative mark shown below and the earlier ECOVER marks, which are known for their use on eco-friendly cleaning products. The opposition was based on a likelihood of confusion under Article 8(1)(b) EUTMR, with both marks covering identical or highly similar goods: ECOVIE for soap dispensers and similar goods in class 21, and ECOVER for cleaning products in class 3.



The ECOVIE figurative mark. Source T-281/24: [dycip.com/t28124-ecovie-ecover](https://dycip.com/t28124-ecovie-ecover)

While the Board of Appeal found no likelihood of confusion, citing the non-distinctiveness of the shared prefix "ECO" and low visual, phonetic and conceptual similarity between the signs, the General Court disagreed. The General Court clarified that the assessment must be made from the perspective of the relevant public displaying the lowest level of attention, typically the average consumer.

In its comparison of the signs, the court held that ECOVIE and ECOVER were visually similar to an average degree, emphasising their shared

prefix and the fact that both include the letter "v" in the same position and end with "e"-containing suffixes (-vie /-ver). Contrary to the Board of Appeal's findings, the General Court found that these similarities could not be discounted based solely on the descriptiveness of "eco".

The General Court confirmed that the earlier ECOVER mark had at least average inherent distinctiveness, enhanced by the "VER" element, which formed a significant part of the mark.

Ultimately, the General Court ruled that the Board of Appeal had erred in its global assessment. Considering the identity of the goods, average distinctiveness of the earlier mark, and average degree of visual and phonetic similarity, the General Court concluded there was a likelihood of confusion, offering valuable guidance on the nuanced evaluation of overlapping yet partially descriptive marks.

**Author:**  
Mia McIntyre



### Case details at a glance

**Citation:** T-281/24,  
**Date:** 05 March 2025  
**Decision:** [dycip.com/t28124-ecovie-ecover](https://dycip.com/t28124-ecovie-ecover)

## Contact details

London  
Munich  
Southampton

T +44 (0)20 7269 8550  
F +44 (0)20 7269 8555

[mail@dyoung.com](mailto:mail@dyoung.com)  
[www.dyoung.com](http://www.dyoung.com)

Email [subscriptions@dyoung.com](mailto:subscriptions@dyoung.com) to update your mailing preferences or to unsubscribe from this newsletter. Our privacy policy is available at [www.dyoung.com/privacy](http://www.dyoung.com/privacy).

This newsletter is intended as general information only and is not legal or other professional advice. This newsletter does not take into account individual circumstances and may not reflect recent changes in the law. For advice in relation to any specific situation, please contact your usual D Young & Co advisor.

D Young & Co LLP is a limited liability partnership and is registered in England and Wales with registered number OC352154. A list of members of the LLP can be viewed at our registered office. Our registered office is at 3 Noble Street, London, EC2V 7BQ.

Copyright 2025. D Young & Co LLP. All rights reserved. 'D Young & Co', 'D Young & Co Intellectual Property' and the D Young & Co logo are registered trade marks of D Young & Co LLP.

## Contributors

**Partner, Rechtsanwältin**  
Jana Bogatz  
[jab@dyoung.com](mailto:jab@dyoung.com)  
[www.dyoung.com/janabogatz](http://www.dyoung.com/janabogatz)



**Senior Associate, Solicitor**  
Peter Byrd  
[pdb@dyoung.com](mailto:pdb@dyoung.com)  
[www.dyoung.com/team/peterbyrd](http://www.dyoung.com/team/peterbyrd)



**Associate, Rechtsanwältin**  
Jacqueline Feigl  
[jmf@dyoung.com](mailto:jmf@dyoung.com)  
[www.dyoung.com/jacquelinefeigl](http://www.dyoung.com/jacquelinefeigl)



**Senior Associate, Trade Mark Attorney**  
Jennifer Heath  
[jxh@dyoung.com](mailto:jxh@dyoung.com)  
[www.dyoung.com/jenniferheath](http://www.dyoung.com/jenniferheath)



**Associate, Solicitor**  
Phil Leonard  
[pel@dyoung.com](mailto:pel@dyoung.com)  
[www.dyoung.com/philleonard](http://www.dyoung.com/philleonard)



**Legal & Trade Mark Administrator**  
Mia McIntyre  
[mim@dyoung.com](mailto:mim@dyoung.com)  
[www.dyoung.com/miamcintyre](http://www.dyoung.com/miamcintyre)



**Senior Associate, Solicitor**  
Olivia Oxtan  
[oho@dyoung.com](mailto:oho@dyoung.com)  
[www.dyoung.com/oliviaoxtan](http://www.dyoung.com/oliviaoxtan)



**Legal & Trade Mark Administrator**  
Frankie Thomas  
[fot@dyoung.com](mailto:fot@dyoung.com)  
[www.dyoung.com/frankiethomas](http://www.dyoung.com/frankiethomas)

