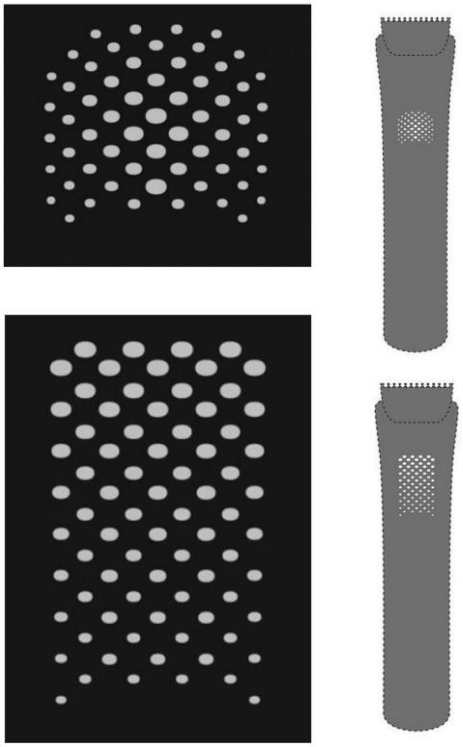
BL O/0240/26

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



DECISION

1. This is an appeal against a decision to refuse the above applications under s.3(1)(b) Trade Marks Act 1994 on the grounds that they are devoid of any distinctive character.

2. The Applicant is Koninklijke Philips N.V. and the relevant goods in Class 8 are as follows:

> 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.

3. The applications were refused following a hearing before Hearing Officer Matthew Davies on 28 May 2025 and a written decision O/0954/25 dated 10 October 2025.

4. As below, before me the Applicant/Appellant was represented by Chris McLeod of Elkington and Fife LLP.

Standard of Appeal

5. There was no dispute as to this. The principles are set out in the well-known cases of *Axogen v Aviv Scientific* [2022] EWHC 95 (Ch), *Lifestyle Equities v Amazon* [2024] UKSC 8 and *Iconix v Dream Pairs* [2025] UKSC 25. I summarised the approach in SOCIAL WORK NEWS (O/0050/24) at [13]:

> To paraphrase, an appeal should only be allowed where the decision of the lower court was "wrong". Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible". In the case of a multifactorial assessment and in the absence of a distinct error of principle, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere.

6. I have sought to apply those principles. It is not enough that a different tribunal might have reached a different conclusion; I must be satisfied that the Hearing Officer was wrong in the conclusions he reached.

The Hearing Officer's Decision

7. The Hearing Officer dealt with all the marks together. Before me, Mr McLoed referred to the marks shown on the left hand side of the title page of this decision as "the device marks" and those on the right as "the position marks". He suggested that as the device marks could be used anywhere, their use also covered the use of the position marks. But, as before the Hearing Officer, he was content that I deal with them together.

8. The Hearing Officer set out the relevant legal principles by reference to CJEU caselaw explaining the assimilated law from which s.3(1)(b) is derived. In particular

he referred to *Bio ID v OHIM*, C-37/03P, *Celltech R&D Ltd v OHIM,* C-273/05P, *SAT.1 SatellitenFernsehen GmbH v OHIM*, C-329/02P and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (Postkantoor)* (C-363/99). He also referred to the proposition that signs that are too plain or basic are incapable of performing the essential function of a trade mark, and cited the following passage from the decision of the OHIM Board of Appeal (R-860/2012-8):

> 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).

9. There was no challenge to these principles before me. Indeed, Mr McLeod relied on the reference to basic geometric shapes in the OHIM extract and submitted that this was not such a case.

10. The Hearing Officer conducted a careful analysis of the issues before him, but his core findings are summarised in §§23-25 of the decision, which I reproduce below:

> 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.

The Appeal

11. Mr McCleod submitted a very brief skeleton argument on the appeal, and was brief in his oral submissions. I make no criticism of him for that, but it means I can also deal with the issues succinctly.

12. The first point made orally by Mr McLeod was to submit that as the EUIPO had allowed the equivalent marks to proceed to registration without objection, the Hearing Officer who is meant to be applying the same law should have done the same.

13. But on an appeal such as this, this submission amounts to no more than saying that another reasonable tribunal has come to the opposite conclusion as the one below. As the authorities recognise, this does not reach the threshold required to allow an appeal.

14. Moreover, I was not provided with any of the commentary from the EUIPO proceedings. Further Mr McLeod explained during the course of his submissions that the EU equivalent of the position marks had in fact been objected to, and his client was attempting to reverse this decision in the higher courts of the EU. Again, I was not provided with any details of these cases. But they just go to show that the issue was nowhere near as clear as Mr McCleod had initially submitted, and that different tribunals can reach different conclusions in relation to the issues before me. My only task is to ascertain whether the Hearing Officer erred in reaching the conclusion he did.

15. As to this, Mr McCleod had two substantive criticisms. He submitted that the Hearing Officer had mischaracterised the marks and had failed to conduct the required global assessment. This was because the marks were inherently abstract, and the variation

in size, location and configuration of the ellipses created an optical illusory effect which was enough to lift them above the base line.

16. He also submitted that the Hearing Officer had misapplied the case law on geometric shapes, which he said did not apply to the present case.

17. I do not accept either of these criticisms.

18. As I have already mentioned, I consider the Hearing Officer made a careful analysis of the marks before him. He applied the correct legal principles and took into account all of the considerations which he was required to do by the authorities in relation to the notional consumer and their perception of the marks on the goods to which it was proposed they should be applied.

19. Mr McLeod sought to criticise the length of the decision by saying that the Hearing Officer had to go into quite a level of detail to categorise the marks, and this meant they had enough complexity to be distinctive. I reject this criticism. The Hearing Officer was just being careful to analyse the arguments from every angle and to give reasons for his conclusion.

20. For example, the Hearing Officer assessed the situation with and without application of the legal presumption from the *Henkel* case (C-144/06) that consumers are not in the habit of viewing the appearance of a product as an indicator of trade origin.

21. He also analysed the marks using the norms and customs test from the *London Taxi* case [2017] EWCA Civ 1729 and even if the marks fell outside this. On the facts it was his firm belief that the appearance of a shaver incorporating the marks did not depart from the norms and customs of the sector. I agree.

22. The Hearing Officer further held that the simple arrangement of ellipses will not strike the average consumer as being a badge belonging to a single undertaking. In this regard he was entitled to treat the marks as containing simple geometric shapes, and he correctly applied the relevant caselaw. I reject the submission that the reference to geometric shapes in the caselaw is limited to triangles or ovoid shapes, as Mr McLeod submitted. In any event the ultimate test is one of overall impression, which the Hearing Officer carried out. So I also reject the other criticism of the Appellant.

23. Finally, Mr McLeod suggested that the Hearing Officer had not analysed whether the marks departed from sector norms and provided insufficient explanation for this. But he did do this, as I have noted above, including by reference to depictions of use

of the marks in real life. Even if the marks act as an optical illusion, they do no more than suggest that there is some curvature to the case to which they are applied. The notional consumer would not recognise that as being a badge of origin within the relevant market sector. Without more they are devoid of distinctive character.

24. Moreover, in the end the question is simply one of whether the threshold in s.3(1)(b) is exceeded or not. Mr McLeod was effectively asking me to substitute my own opinion for that of the Hearing Officer. But in the absence of any error of approach, as I have found, there is no basis for me to do so. Indeed, I would have reached the same conclusion.

25. In short, there is no reason to interfere with the conclusions of the Hearing Officer in §39 that none of the signs:

> ""step up out of the morass of nondistinctive material" and consumers would not attribute any trade mark significance to the signs. … 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.

Conclusion

26. For all these reasons I dismiss the appeal. All of the applications should be refused.

Thomas Mitcheson KC
The Appointed Person
23 March 2026