3PB
BARRISTERS

Genericism

Where is the line between a protectable trade mark, a descriptive product name and ordinary trade language in light of Dryrobe v D-Robe and Wang Zeng and Bing Bing Food

Victoria Jones



Absolute grounds – section 3(1)(d)



3. Absolute grounds for refusal of registration

(1) The following shall not be registered –

…

(d) Trade marks which consist **exclusively** of signs or indications which have become **customary in the current language or in the bona fide and established practices of the trade**:

Provided that…if, **before the date of application for registration**, it has in fact **acquired a distinctive character** as a result of use made of it.

Absolute grounds – section 3(1)(d)

- Can include but does not require descriptiveness
- Assessment is (i) by reference to g/s and (ii) based on the perception of average consumer
- A relatively high evidential bar
- Generic use does not always => customary term e.g. Google [§119 Dryrobe]

Section 3(1)(d) at the UKIPO

- UKIPO Work Manual examples include "The Red Lion" for pubs or five stars for hotel services

- Recent decisions:

  LAVA (O/0588/26)

  DEAD FLAT (O/0503/25)

Revocation – section 46(1)(c)

46. Revocation of registration

(1) The registration of a trade mark may be revoked on any of the following grounds-

…

(c) that, **in consequence of acts or inactivity of the proprietor**, it has become the **common name in the trade** for a product or service for which it is registered.



Revocation – section 46(1)(c)

Hormel Foods v Antilles [2005] EWHC 13 (Ch):

- Being *a* common name in the trade will suffice
- Action or inaction need not be the sole cause of the mark becoming generic
- A proprietor with a highly descriptive mark bears a heavier burden to take steps to prevent it becoming a common name
- Becoming a household name does not necessarily mean the mark is generic

Revocation – section 46(1)(c)

Distinctive		Common Name
HOOVER	→	TRAMPOLINE
GOOGLE		ESCALATOR
VIAGRA	↘	ASPIRIN
VELCRO		GRILLZ
JACUZZI		
SELLOTAPE		

The VELCRO campaign

- 2017 campaign by Velcro to educate the public
- “Don’t Say Velcro”
- The lawyers are the singers!

https://www.youtube.com/watch?v=rRi8LptvFZY

Dryrobe Ltd v Caesr Group Ltd
[2025] EWHC 3167 (IPEC)

- C's product was the first drying and waterproof changing robe on the UK Market
- C applied to register various "Dryrobe" marks between 2013 and 2022
- C enjoyed a monopoly until around 2018/2019

dryrobe – The findings:

- Descriptive at the filing date(s) (s.3(1)(c))
- Not generic (s.3(1)(d) and s.46(1)(c))
- Had acquired distinctiveness

Why was DRYROBE descriptive?

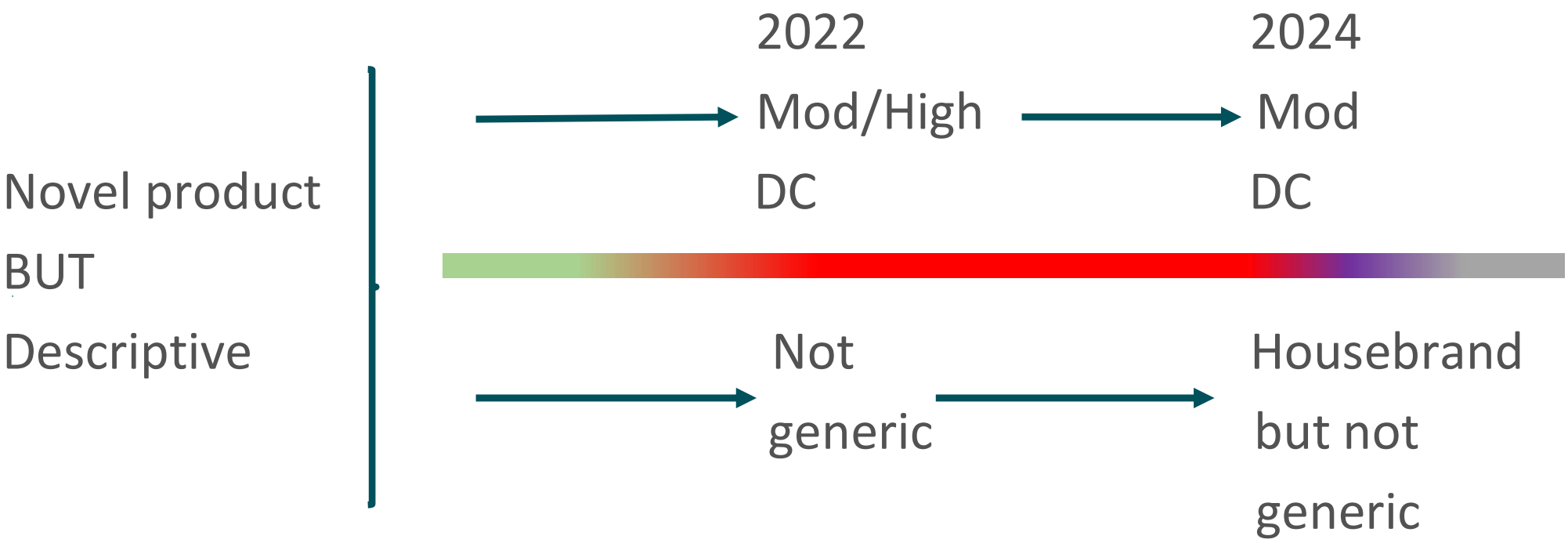
- C argued it was a **VETSURE** case
- D argued it was an **OVENCHIPS** case:
    - No prior knowledge of what a dryrobe was

    BUT

    - Once launched, consumer can recognize aptness and appropriateness and take it as a description rather than a trade mark [at §96]



The race is on!



The two-pronged brand battle

Acquiring distinctiveness:

- C was *"the biggest player in the [UK changing robe] market in 2024"*
- The appearance of the Marks on the garment with 750,000 orders b/w 2017 and 2024
- Relationships with Team GB and Red Bull and appearances on Top Gear and Comic Relief

Combatting genericism:

- C kept records of all social media posts it had objected to since 15 October 2020 (during 2021 no less than 25 posts per month)
- Educating the public how to use the term "DRYROBE" and asking them to use the ®
- Using internet crawler technology and third party PR Agencies to monitor generic use.

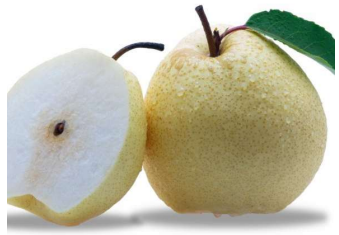
Examples from D's evidence of genericism:

"I donned my dry robe and got out of my wet gear"

"I'm not a "wild swimmer". I don't own a dry robe or bang on about icy seas curing everything…"

"Fast becoming the Hoover of changing robes, Dryrobe is the market leader here"

Wang Zeng Int'l Ltd v Bing Bing Foods Ltd & Ors [2026] EWHC 360 (IPEC)



MOUNTAIN PEAR & YU LU FRAGRANT PEAR:



- Not descriptive (s.3(1)(c))
- Not devoid of distinctiveness (s.3(1)(b))
- Not generic (under s.3(1)(d) or s.46(1)(c))

Why did it all go pear shaped for the Defendants?







Why did it all go pear shaped for the Defendants?

- Failure to challenge C's evidence and/or address issues
- Unreliable witnesses
- Irrelevant evidence
- Difficulty proving descriptive use
- Evidence of side by side use of the mark with the descriptive term for the product

Take away points…

- Generic use alone is not enough; the mark must also have lost the ability to denote a particular undertaking
- Distinctiveness is a dynamic feature of a brand which requires active maintenance
- If a mark for a novel product is descriptive, attack early
- Re-emergence of the ® and ™ symbols?
- Instruct a lawyer to help with evidence!

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