BL O/0301/25

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATIONS NUMBERED 906295877 AND 913028865 FOR THE TRADE MARKS

BIOREPAIR

AND

Biorepair PRO-CLEAN

IN THE NAME OF COSWELL S.P.A.

AND APPLICATIONS FOR INVALIDITY UNDER NOS. 504622 AND 504623

BY DR. KURT WOLFF GMBH & CO. KG

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF L DAVIES (O/0865/24) DATED 6 SEPTEMBER 2024.

DECISION

Introduction

1. This is an appeal by COSWELL S.P.A. ("**Appellant**") from decision O/0865/24 of Ms Leisa Davies ("**Decision**") concerning the applications for invalidity by DR. KURT WOLFF GMBH & CO. KG ("**Respondent**") to the Appellant's registrations for the following marks ("**Registrations**"):

   (i) UKTM no. 906295877

   BIOREPAIR

   Filed on 20 September 2007 and registered on 21 August 2008.

   ("the **'877 mark**")

   (ii) UKTM no. 913028865

   Biorepair PRO-CLEAN

   Filed on 25 June 2014 and registered on 17 November 2014.

   ("the **'865 mark**")

2. Both marks are registered for the following goods:

Class 3: *Dentifrices; non-medicated preparations and oral hygiene preparations; breath freshening preparations, mouthwashes, not for medical purposes; whitening and stain removing preparations for teeth; dental gels.*

Class 5: *Dental abrasives; anti-bacterial mouthwashes; medicated whitening preparations for teeth.*

Class 21: *Toothbrushes, floss for dental purposes*[1].

3. On 25 February 2022 the Respondent filed invalidation actions against each mark pursuant to ss. 47(1) and 3(1)(b) and (c) of the Trade Marks Act 1994 ("**the Act**"). It contended that each of the marks is descriptive and lacks distinctiveness.

4. The Respondent filed evidence and a skeleton argument. The Appellant filed submissions in reply to the Respondent's evidence, and a skeleton argument. Following a hearing, L. Davies for the Registrar held that both marks were invalid under s. 3(1)(b) and (c) of the Act.

5. On 11 December 2024 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

The Hearing Officer's decision

6. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):

    a. The Appellant's argument that the claims should be struck out as an abuse of process by virtue of a prior agreement between the parties allegedly containing a "no challenge clause" was dismissed.

    b. The average consumer would be a member of the general public or those in the profession such as dentists, hygienists and the like. The level of attention paid would be average;

    c. The words 'clean', 'repair' and 'pro' are ordinary English dictionary words which have been in common use for a considerable period of time. Whereas the prefix BIO may have more than one dictionary meaning, in the context of the goods at issue the term will be understood as meaning natural, environmentally friendly, free from chemicals and good for health. That perception will be arrived at immediately and without any further thought process;

    d. The combination of BIO and REPAIR does not alter their descriptive character, and the meaning of the combination would be clear and obvious as to the nature of the goods and their purpose, namely, to put teeth or gums back in good working order using natural, organic or environmentally friendly ingredients;

    e. As for the '865 mark, the limited stylisation of the word 'Biorepair' and the use of the word in combination with 'PRO CLEAN' with the latter presented on a banner type device, do not divert attention away from the descriptive nature of the words BIO, REPAIR, PRO and CLEAN;

    f. The above findings apply to all the goods;

[1] The terms underlined are phrased slightly differently in the '865 mark's specification as 'tooth bleaching preparation and for removing stains from teeth' and 'dental floss'. Nothing turns on this, however.

g. The invalidation action based on s. 3(1)(c) was accordingly made out;

h. The invalidation action under s. 3(1)(b) was also made out, as the marks are devoid of distinctive character on the grounds that they are descriptive.

Grounds of Appeal

7. The Appellant's Grounds of Appeal are as follows:

a. **Ground 1**: The Hearing Officer failed to assess the alleged descriptive and non-distinctive characters of the Registrations at the respective filing dates.

b. **Ground 2**: The Hearing Officer based the definition of BIOREPAIR and PRO-CLEAN on assumptions rather than on relevant evidence, and so drew the wrong conclusion when assessing the descriptiveness of the Registrations.

c. **Ground 3**: The Hearing Officer erred in her assessment of the goods covered by the Registrations.

d. **Ground 4**: The Hearing Officer erred in her appreciation of the evidence submitted by the Respondent.

e. **Ground 5**: The Hearing Officer drew the wrong conclusion when assessing the distinctiveness of the Registrations.

8. The Appellant's trade mark attorney, Sarah Husslein, expanded upon the above in her skeleton argument and at the hearing, and I set out below further details as are necessary to understand my overall conclusions. The Respondent filed a skeleton argument and its solicitor, Rob Jacob, expanded upon those arguments at the hearing. I am grateful to both advocates for their clear and helpful submissions.

Standard of review

9. The approach to be adopted in an appeal hearing has been laid down a number of times in case law. It was summarised in *Axogen v Aviv* [2022] EWHC 95 (Ch) at §24-25:

"Appellate Function

24. Although I was referred to numerous cases on the subject (including *English v Emery Demibold & Struck Ltd* [2002] 1 WLR 2409, *REEF Trade Mark* [2003] RPC 5, *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, *Shanks v Unilever Plc* [2014] RPC 29, *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17, *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch), *Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 and *NINEPLUS* O/039/21), the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);

ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS* O/039/21 at [14]);

iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. 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" (*Actavis Group* at [81]);

iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.

v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).

vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).

vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], *Actavis Group* at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (*Shanks* at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).

viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], *Fage* at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).

10. To the above should be added:

- The judgment of the Court of Appeal in *Lidl Great Britain Ltd v. Tesco Stores Ltd* [2024] EWCA Civ 262, where Arnold LJ said at §110 "It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable"; and

- The Supreme Court's guidance in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 where it stated at §49 "…on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion".

11. I shall bear all the above in mind when reviewing the Decision.

Discussion

(1) The Hearing Officer failed to assess the alleged descriptive and non-distinctive characters of the Registrations at the respective filing dates

12. The Appellant makes three criticisms of the Decision under this ground. First, it contends that the Hearing Officer wrongly took into account evidence which post-dates the relevant dates for assessment of descriptiveness (the filing dates of the respective Registrations). Secondly, that nothing in the evidence submitted by the Respondent actually shows that the Registrations were or are or ever have been used in a descriptive way to describe the nature and intended purpose of the goods at issue, nor that they were perceived by the relevant consumers as being descriptive. Thirdly, the Hearing Officer failed to take into account that both the Respondent and the UK and EU IPOs have accepted the Registrations (or identical equivalents) as being valid trade marks in relation to the relevant goods.

13. Dealing with the criticisms in turn, the Hearing Officer said at §60:

> "The relevant dates under sections 3(1)(b) and (c) are the filing dates of the contested marks which in this case are 20 September 2007 for the '877 mark and 25 June 2014 for the '865 mark".

14. At §83 she said:

> "In assessing the matter it is important for me to consider the evidence and particularly the dictionary definitions filed. I must bear in mind the meaning that would be attributed to the words by the average consumer in the UK and whether they could be used descriptively of the goods or whether they are merely allusive as to their characteristics. Ms Blythe criticises the evidence as not reflective of the position as at the relevant date. Of course, whilst it is true that I must consider the descriptiveness of the words as at the relevant date, given the wording of section 3(1)(c) it is necessary for me to consider the position not only as at the filing date but also whether the sign 'may serve in trade', which is a forward looking provision. The evidence, therefore, that is dated as at the date the statement was completed, is not to be dismissed outright. Any descriptive use is relevant, provided it was foreseeable at the relevant dates".

15. The Appellant contends that the above is an incorrect statement of law – ss. 3(1)(b) and (c) are not forward looking, and foreseeability of use plays no part in the test.

16. Earlier in the Decision at §63, the Hearing Officer cited Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows (at §91):

> "The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. zo.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:
>
> > "…
> >
> > 38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).
> >
> > 39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

17. If the Hearing Officer, when referring to the test being "forward looking" and any descriptive use being "foreseeable at the relevant dates", was simply intending to state that no actual descriptive use at the filing date is required under s. 3(1)(c), she was not incorrect. If, though, she meant that any descriptive use commencing after the filing date can be taken into account under s. 3(1)(c), she fell into error insofar as any such use would not have occurred at the filing date (perhaps because the meaning of the mark has changed in the period after the filing date).

18. It is not clear which meaning she had in mind, and the Appellant contends that this was therefore an error of principle, which would justify the matter being remitted for re-assessment of the evidence. However, the authorities reviewed by Arnold J in *Starbucks*, cited above, also make clear that evidence from the marketplace is often likely to be of limited relevance in s. 3(1)(c) cases. In instances where the words in a mark have a clear meaning, evidence from the marketplace is unlikely to be decisive, and any available evidence is likely to be no more than confirmatory of the position as assessed from the dictionary definition of the words. The Hearing Officer recognised this when she said at §83 "In assessing the matter it is important for me to consider the evidence and particularly the dictionary definitions filed" (my underlining).

19. She went on to say at §84:

> "The definitions as produced by Dr Wolff accord with my own understanding of the words. Whilst I note that the majority of the screenshots of the definitions produced (discounting those that show use as a trade mark) are undated and appear to reflect the position when the dictionaries were accessed (presumably in or about when Mr Jacob completed his statement) I do not believe that the meaning of the words has changed substantially since 2007 or 2014. The words 'clean', 'repair' and 'pro' are ordinary English dictionary words which have been in common use for a considerable period of time. The word 'BIO' is also not a newly coined word such that consumers as at the relevant dates would not have understood the meaning of the word."

20. She regarded the descriptive nature of the words, therefore, as clear cut, based on the inherent meanings of the words. Even in the total absence of evidence from the marketplace, that would have been sufficient to provide rational support for her conclusions. As it happens, whereas most of the marketplace evidence submitted by the Respondent post-dated the filing dates, a small subset of it (Exhibit RMJ24, providing evidence of use of "BIO", "REPAIR" AND "BIOREPAIR" as at 12 September 2007, and Exhibit RMJ25, providing evidence of use of "PRO", "CLEAN" and "PRO CLEAN" as at 25 June 2014) does provide evidence as at the filing dates, thereby providing further rational support for her conclusions based on the dictionary definitions.

21. Accordingly, therefore, even if the Hearing Officer did fall into error with regard to the evidence post-dating the filing dates, it is highly unlikely to have affected her overall conclusion, given the clear view she reached based on the dictionary definitions.

22. Turning to the second criticism, it is clear from the authorities cited at §16 above that no actual descriptive use in the marketplace is required under s. 3(1)(c). The requirement is only that the sign could be used for such purposes. The Hearing Officer had this well in mind, and made no error.

23. As for the third criticism, the Appellant relies upon a prior agreement between the parties allegedly containing a "no challenge clause" as evidence that the Respondent has accepted the existence and validity of the Registrations in the past. This argument was considered by the Hearing Officer at length, and ultimately rejected, in the context of the Appellant's abuse of process argument. There is no appeal from that aspect of the Decision. In my view, by seeking to rely on the point here, the Appellant is attempting to relitigate the issue "by the back door", which I reject.

24. Furthermore, I am unable to see the relevance to this matter of what the UK IPO previously decided. As the Respondent rightly submits, "The whole rationale of being able to bring an invalidity action is on the basis that the original decision allowing the mark to proceed to registration was done in error. At paragraph 88 of the Decision, the Hearing Officer notes the comments of James Mellor KC in this regard in O-262-18, namely "…just because a mark is on the Register does not mean it will be held to be valid when challenged".

25. Nor do I understand the relevance of what the EUIPO may previously have decided. The Hearing Officer was required to determine the descriptive nature or otherwise of the Registrations, and decisions of other bodies (which may have been made on different evidence) are not a relevant consideration. I also understand that the EUIPO, having originally registered BIOREPAIR as EUTM No. 006295877, has since cancelled that mark on the ground that it was descriptive as at

the filing date (September 2007). This argument therefore does not assist the Appellant in any event.

26. The first ground of appeal is dismissed.

(2) The Hearing Officer based the definition of BIOREPAIR and PRO-CLEAN on assumptions rather than on relevant evidence, and so drew the wrong conclusion when assessing the descriptiveness of the Registrations

27. The Hearing Officer's findings were as follows:

- Whereas the prefix BIO may have more than one dictionary meaning, in the context of the goods at issue, the term will be understood as meaning natural, environmentally friendly, free from chemicals and good for health. The fact that the word BIO does not have one tangible meaning does not prevent it from invoking a positive response from the consumer as to the characteristics of the goods which are environmentally friendly, green, organic and natural, in a similar way to the word 'green' or 'eco' for example. This perception will be arrived at immediately and without any further thought process (§90).

- The meaning of the word REPAIR is obviously descriptive in the context of the goods (§90).

- The words BIO and REPAIR in combination retain their descriptive character. The meaning of the words either displayed separately or in combination as one word would be clear and obvious as to the nature of the goods and their purpose, namely, to put teeth or gums back in good working order using natural, organic or environmentally friendly ingredients. The fact that these two elements are combined does not alter their meaning. (§93).

- The words PRO and CLEAN individually are descriptive words (§94-101). In the '865 mark, the limited stylisation of the word 'Biorepair' and the use of the word in combination with 'PRO CLEAN' with the latter presented on a banner type device, which she described as a background, do not divert attention away from the descriptive nature of the words BIO, REPAIR, PRO and CLEAN (§94-101).

28. The Appellant contends that, first, the Hearing Officer erred in relation to her finding that the words BIO and REPAIR are descriptive, as this is not supported by the evidence. Secondly, the combination BIOREPAIR is not a natural description of the characteristics of the goods, and would not have a clear and obvious meaning as to the nature of the goods and their purpose. Thirdly, the term REPAIR is not descriptive in relation to all of the goods.

29. The third contention is effectively the same as that covered in Ground 3, which I consider in the next section below. In relation to the first contention, the difficulty for the Appellant is that the Hearing Officer's determination of the meaning of the words PRO and CLEAN individually was a finding of fact, which can be disturbed only if it is rationally insupportable (see §10 above). Even if the Appellant is right in saying that the evidence of use submitted by the RESPONDENT does not support her finding, the Hearing Officer primarily relied upon the dictionary definitions of the words, as discussed in §18 above. In this context, when considering ordinary words such as BIO and REPAIR, the consulting of a dictionary in my view provides sufficient support to defeat the contention that the finding is "rationally insupportable". That is so even for a word which has more than one meaning, provided at least one of those meanings is descriptive (*DOUBLEMINT* C-191/01).

30. With regard to the second contention, Ms Husslein very fairly conceded that in order to succeed, the Appellant needs to show that the Hearing Officer was "wrong" in the sense described at §9(iii) above: "outside the bounds within which reasonable disagreement is possible". That of course is a high hurdle.

31. The approach to combinations of descriptive words is summarised by the editors of Kerly's Law of Trade Marks and Trade Names at 10-105(9):

> "As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services, itself remains descriptive. However, the combination may not be descriptive if there is a perceptible difference between the resultant combination and the mere sum of its parts (POSTKANTOOR at [100]), where the unusual nature of the combination in relation to the goods or services creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts (POSTKANTOOR at [100]; BIOMILD at [41]; COLOR EDITION158 at [62]) or the combination has acquired its own meaning, with the result that it is now independent of its components (POSTKANTOOR at [104])".

32. The Appellant contends that BIOREPAIR can be seen as akin to BABY DRY, the validity of which was of course upheld by the EUIPO. I accept that it is arguable that BIOREPAIR is "more than the sum of its parts". In particular, as contended by the Appellant, I accept that it is arguable that BIOREPAIR is "an unusual combination of English words, which are syntactically unfamiliar". However, in my view it is equally arguable that the combination of the words adds nothing to the individual words. The Hearing Officer was required to make a decision. She took into account everything she was required to take into account, including the Appellant's arguments, which she rejected. The decision she made was one that was open to her on the facts and arguments before her. A different hearing officer may have reached a different conclusion, but it was a matter on which reasonable disagreement was possible.

33. The second ground of appeal is accordingly dismissed.

(3) The Hearing Officer erred in her assessment of the goods covered by the Registrations

34. At §§101-102 the Hearing Officer held:

> "The meaning of the individual components in combination do not create an impression which is sufficiently far removed from the meaning of the individual elements of which it is composed. No further mental step would be necessary in order to understand the meaning perceived.
>
> Whilst this finding applies particularly to Coswell's preparations (toothpastes), gels and mouthwashes and all its goods in classes 3 and 5, since its goods in class 12[2], namely toothbrushes and dental floss, are so closely connected to the class 3 and 5 goods, then the objection extends to these goods also[41]. It cannot be said that such is the close connection between the goods, that the terms are descriptive for one class and not the other and so the same findings would apply to all of Coswell's goods".

[2] I believe this is a typographical error, and the Hearing Officer meant to refer to class 21 rather than class 12

35. Footnote 41 was to *Fourneaux De France Trade Mark*, Case BL-O/240/02, Mr Geoffrey Hobbs KC. In that decision, Mr Hobbs said:

> "… the question which now confronts me is whether cooker hoods and extractor fans should, like electric apparatus for cooking foods, rotisseries, spit roasters and electric grills, be treated as goods so closely related to cookers as to be an integral part of the commercial context in which the meaning and significance of the words FOURNEAUX DE FRANCE is to be regarded as essentially descriptive.
>
> Having listened with care to the arguments that have been addressed to me on this appeal, I have come to the conclusion that cooker hoods and extractors are closely connected items of commerce, and that they are both so closely connected with cookers that it would be unrealistic to treat the words FOURNEAUX DE FRANCE as descriptive of the character of the latter but not the former".

36. The Court of Appeal in *J.W. Spear v Zynga* [2015] FSR 19 analysed the law on descriptiveness and gave approval to the analysis of the Advocate General in his opinion in *DOUBLEMINT* [2003] ECR I-12447 at [61]–[64], in which he identified the following as the relevant question for determining whether a mark is descriptive in relation to a specific product:

> "(i) how factual and objective is the relationship between an indication and the product or one of its characteristics? (ii) how readily is the message of the indication conveyed? and (iii) how significant or central to the product is the characteristic? Asking these questions will assist a fact-finding tribunal to determine whether it is likely that a particular indication may be used in trade to designate a characteristic of goods."

37. That approach necessitates a product by product (or service by service) analysis. Whereas it is permissible to consider goods or services in groups, care must to taken to ensure that all members of each group share the same characteristics. It is easy to see that cooker hoods, for example (as in *Fourneaux De France Trade Mark*), are so closely connected to cookers that they share the same characteristics. The same is not necessarily true, in my view, in relation to the class 21 goods (toothbrushes and dental floss) and the goods in the other classes (which are all consumables such as toothpaste and mouthwashes). In particular, I accept as arguable the Appellant's contention that toothbrushes and dental floss are not intended to repair, but rather to remove dirt and plaque etc. The Respondent says, in its skeleton argument, "the Hearing Officer was perfectly entitled to find that toothbrushes can 'repair'. A toothbrush is used, in conjunction with toothpaste, to clean teeth, restoring them and gums (and overall oral hygiene) to their original condition". If that was what the Hearing Officer had decided, I would agree with the Respondent. However, what the Hearing Officer actually did was i) find that BIOREPAIR is descriptive in relation to all the class 3 and 5 goods, and ii) read that finding across to the class 21 goods, but without asking whether those goods share the same characteristics. Whereas she was justified in her first step, in her second step she was inappropriately applying blanket reasoning across all goods, which is contrary to principle.

38. The third ground of appeal therefore succeeds in relation to the class 21 goods. The case will be remitted to the Hearing Officer to redetermine whether the Registrations are descriptive in relation to the class 21 goods.

(4) The Hearing Officer erred in her appreciation of the evidence submitted by the Respondent

39. The Appellant contends that the evidence submitted by the Respondent, even taken at its highest, simply does not support a finding that the Registrations are descriptive of the relevant goods. I can deal with this point shortly, as I have already addressed it above in relation to ground 1. Where, as here, the words in a mark have a clear descriptive meaning based on their dictionary definitions, evidence of their actual use in the marketplace is unlikely to be decisive. The Hearing Officer was entitled to reach her conclusion on the basis of the dictionary definitions alone, and any evidence of use was merely confirmatory.

40. The fourth ground of appeal is dismissed.

(5) The Hearing Officer drew the wrong conclusion when assessing the distinctiveness of the Registrations

41. The Appellant conceded during the hearing that its case in relation to s. 3(1)(b) stands or falls with the outcome of the s. 3(1)(c) case. Accordingly, this ground adds nothing to the others, and I do not need to consider it further.

Conclusion

42. The appeal is partially successful. The Registrations are invalidated for all the goods in classes 3 and 5. The matter is remitted to the Hearing Officer for redetermination of the validity of the Registrations in respect of the Class 21 goods.

Costs

43. Whereas the Appellant has succeeded in this appeal, it remains to be seen whether it is successful following reconsideration by the Hearing Officer. I accordingly reserve the issue of the costs of this appeal to the Registry.

44. As for the costs below, the Hearing Officer ordered that the Appellant should pay the Respondent £2,900 in respect of the costs of the invalidation action, and (off scale) costs of £21,982.10 in respect of the strike out application. The latter should remain undisturbed, however I set the £2,900 costs order aside, and the costs of the hearing below should be redetermined following reconsideration by the Hearing Officer.

Dr. Brian Whitehead

31 March 2025

Representation

Ms Sarah Husslein, trade mark attorney, of Bristows LLP for the Appellant/ Proprietor

Mr Rob Jacob, solicitor, of Stephenson Harwood LLP for the Respondent/ Applicant