

O/0496/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF REGISTRATION NOS.

917938276 & 917938275

IN THE NAME OF

NOOS SRL

IN RESPECT OF THE TRADE MARKS:

REUTERIN

IN CLASS 5

AND

Reuterin

IN CLASS 5

AND

AND THE APPLICATIONS FOR INVALIDATION UNDER NOS.

506892 & 506897

BY BIOGAIA AB

BACKGROUND AND PLEADINGS

1. NOOS SRL (“the proprietor”) is the registered proprietor of the two trade marks shown below (“the contested marks”):

UK00917938276

“The first contested mark”

REUTERIN

UK00917938275

“The second contested mark”

Reuterin

2. Both were filed on 1st August 2018 and proceeded to registration on 30th November 2018. They are registered for the following goods:

Class 5: *Pharmaceuticals; Pharmaceuticals and natural remedies; Milk ferments for pharmaceutical purposes; Nutraceutical preparations for humans; Nutraceuticals for use as a dietary supplement; Food supplements; Nutritional supplements; Anti-oxidant supplements; Prebiotic supplements; Probiotic supplements; Anti-oxidant food supplements; Mineral food supplements; Dietary and nutritional supplements; Mineral nutritional supplements; Dietary supplements with a cosmetic effect; Dietary supplements and dietetic preparations; Vitamin preparations in the nature of food supplements.*

3. The contested marks are comparable marks. Under Section 7A of the European Union (Withdrawal) Act 2018, which gave effect to Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM. As a result, the contested marks were converted into comparable UK trade marks. Comparable UK marks are recorded in the UK trade mark register and have the same legal status as if they had been applied for and registered under UK law, with the original filing dates remaining the same.
4. On 12th January 2024, BioGaia AB (“the applicant”) filed applications seeking to invalidate the contested registrations. The applications for invalidity are brought under section 47(1) of the Trade Marks Act 1994 (“the Act”) and are reliant upon sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Act. The proceedings were consolidated on 30th April 2024, as communicated to the parties by way of letter on the same day.

5. The applicant claims that REUTERIN is (and was at the time of filing of the contested registrations) an established and well-known name for an antimicrobial substance discovered in the 1980s. With respect to the second contested mark, it recognises the stylisation of the text but considers this minimal, likely to go unnoticed and “so *de minimis* as to have no significant impact on the distinctive character of the overall mark”.¹ According to the applicant, the average consumer would not perceive REUTERIN as an indication of the commercial origin of the goods but instead recognise it as the active ingredient (or some form of chemical or biological compound) used within the goods. It claims that the marks fail to fulfil the essential function of a trade mark as an indication of the commercial origin of the goods. Therefore, the contested marks:
- are devoid of any distinctive character;
 - designate the kind and/or other characteristics of the goods; and
 - are signs which have become customary in the current language or in the bona fide and established practices of the trade.
6. The proprietor filed counterstatements denying the claims made. Further, it argues that consumers associate the contested marks with the goods, in particular the quality of the goods produced by the proprietor. With respect to the second contested mark it argues that the “original stylization” which includes “a particularly bright red” and “original font where each letter of the mark is framed in a dark contrasting colour” means the mark is distinctive and fulfils the essential function of a trade mark. It also argues that both marks (in the alternative for the second contested mark) have acquired distinctiveness as a result of the use that has been made of them.
7. In these proceedings, the applicant is represented by Dehns and the proprietor by IP21 Limited.² Both parties filed evidence and written submissions in these proceedings, and the proprietor filed written submissions in lieu of a hearing. No hearing was requested therefore this decision is taken following careful

¹ Statement of grounds for UK00917938275 (first paragraph of section D).

² The latter was appointed via Form TM33 received on 23rd February 2024.

consideration of all the papers before me. I have not summarised the evidence or submissions in full but will refer to these to the extent that is necessary.

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

PRELIMINARY ISSUES

9. I note that there are references in the submissions from both sides to grounds which are not relevant to these applications for invalidation. I will deal with these briefly here. The witness statement filed on behalf of the proprietor makes claims (at paragraph 8) regarding the applicant's behaviour being "contrary to established acceptable business practices" in light of the previous collaborative working arrangement between the two parties. This appears to be an accusation of bad faith, however this is not relevant to my assessment under section 3(1), therefore I will say no more on this matter. In its written submissions, the applicant references increasing use of the term REUTERIN in academic literature and this indicating "a failure on the part of the Registered Proprietor to effectively police their marks".³ For clarity, I emphasise here that the assessment with respect to sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Act relates to the marks and their validity at the time of filing. Therefore, this does not rely upon any enforcement activities of the proprietor post-registration.

EVIDENCE AND SUBMISSIONS

10. Both parties have filed evidence during these proceedings. The applicant filed written submissions and evidence in the form of a witness statement, dated 16th August 2024, from Charlotte Ginnaw. Ms Ginnaw is a trade mark attorney for the applicant's authorised representative, Dehns, where she has worked since

³ Paragraph 10.

October 2021. Her witness statement is accompanied by 11 exhibits (Exhibits CG1-11). It includes the following evidence in support of the contested marks being descriptive, devoid of distinctive character and customary in the current language or bona fide and established practice of the trade:

- Details on the chemical composition of REUTERIN including its systematic name, “3-Hydroxypropanal” and chemical formula “C₃H₆O₂” at Exhibit CG1, which is a screenshot from www.chemspider.com. I have no further details on the provenance of this website, though I note a reference to the Royal Society of Chemistry is found at the top righthand corner. It is dated only in so far as the date accessed, i.e. date the evidence was being prepared (31st July 2024).
- Exhibit CG2 features a screenshot from www.cas.org explaining the significance of a CAS Registry Number as “a unique and unambiguous identifier for a specific substance” often used by Governmental agencies for identification. Ms Ginnaw states that Exhibit CG1 shows the CAS Registry Number of REUTERIN. However, there is no reference to the CAS Registry on the www.chemspider.com webpage. I can see a reference to “2134-29-4” as the “search term” and the page having been found by an “approved synonym”, and I note that this same number is quoted in paragraph 1 of the applicant’s written submissions, but (despite the statement) the supporting documentation does not confirm this as a CAS Registry number.
- Exhibit CG3 details search results from Google Scholar for articles which include the term REUTERIN published up to and including 31st December 2017. Preview results for only six articles are shown but the page references “About 3,840 results”. The applicant claims that the antimicrobial effects of REUTERIN have been widely researched and that the number of articles present emphasises “the frequency with which this descriptive term appears in medical/scientific literature”.⁴ Exhibit CG11 is the same search to include articles up to the present day – that being 30th July 2024, when the search was conducted. The page quotes “About 7,820” results. Exhibit CG4 are copies of six articles that include references to REUTERIN, three of which featured in the

⁴ Paragraph 2 of written submissions.

results page shown in the Exhibit CG3. These are dated (the publication date in chronological order) 1989, 1999, 2003, 2007, 2008 and 2017. The articles are from different academic journals and appear to originate from universities and research centres in a variety of countries, including Belgium, USA, Sweden, Switzerland, Mexico, Spain and Canada. None appear to have originated from (or be affiliated with) UK-based institutions. Another academic article is quoted at Exhibit CG5 which the applicant claims shows “probiotics are recognised as a pharmaceutical product in certain territories”.

- Ms Ginnaw provides at Exhibit CG6 a range of screenshots from online retailers (including Boots and Superdrug, among others) depicting products where she deems the active ingredient is prominently displayed on the packaging. All are dated from when the evidence was collated in 2024. The applicant deems these examples are indicative of the name of active ingredients often being predominantly displayed on packaging for medicaments.⁵
- The remaining exhibits all relate to screenshots of Google search results and the Wikipedia entry for REUTERIN. Exhibit CG7 is a Wikipedia entry courtesy of the Wayback Machine internet archive dated 26th July 2014, while all others are dated July 2024. Ms Ginnaw highlights Exhibit CG10 as showing the proprietor’s product for sale (via Amazon) within the Google search results for REUTERIN. I note the product name is “Moviscom Reuterin Gg 10 Stick”.

11. The proprietor filed evidence in the form of the witness statement dated 5th November 2024, from Giancarlo Moretti, the CEO of the proprietor. This is accompanied by 9 exhibits.⁶ A second witness statement (with 3 exhibits) was filed in the name of Laura Franco Rivas, which provide translations (including partial translations) from Italian into English for some of the content from Mr Moretti’s evidence. Together, this evidence goes to the prior collaborative relationship between the parties, marketing and promotional activity for the contested marks

⁵ Paragraph 4 of written submissions.

⁶ Mr Moretti’s witness statement also contains submissions. However, I do not consider it too onerous a task to separate the opinions of Mr Moretti’s from his statements of fact. I will adopt a pragmatic approach, treating the submissions as legal arguments and/or opinions rather than factual statements, even though they are conveyed in a witness statement accompanied by a statement of truth.

and survey and website data to support the proprietor's claims regarding acquired distinctiveness through use. It includes the following:

- NOOS SRL is an Italian pharmaceutical company, founded in 1999, which designs, tests and develops food supplements and medical devices. Its REUTERIN product was launched in 2003. Mr Moretti claims that: "In the United Kingdom, the marks containing the term "REUTERIN" has [sic] been maintained during the years as well as being intensively used in the market since the early 2000s".⁷
- The proprietor's REUTERIN products have been included in the Codifa and Farmadati Italia database since September 2003. Mr Moretti clarifies that this is a database of "approved branded products aimed at the pharmaceutical sector and used by almost all pharmacies, health and wellbeing stores, herbalist shops, health shops, large-scale retailers, distributors and general practice surgeries". Excerpts are provided at Mr Moretti's Exhibit 1 (the partial translations for which can be found in Ms Franco Rivas' Exhibit 1). I note the database (in its original form) appears solely for use in Italian and is therefore aimed at the Italian market.
- Mr Moretti's Exhibit 2 shows promotional spend for brochures, GP surgeries, "gadgets" and medical conferences from 2005 to 2024. Most is provided with no further (or very limited) context; for example I have no details on the distribution of promotional brochures or location and target audiences of the medical conferences listed.⁸ I note pages 2 to 16 of the exhibit do feature geographic locations with the vast majority relating to Italian cities. Only one instance is readily identifiable in relation to the UK, a spend of €10,800 attributed to Glasgow across five days in 2013. This does not appear to have been replicated any other year. Spends are also attributed to "online" but I have no further detail on the geographic target or reach of these.
- Mr Moretti's Exhibit 2 (pages 19-31) also depicts newspapers and magazines which appear to include advertisements (or promotional articles) of REUTERIN

⁷ Paragraph 4 of Mr Moretti's witness statement.

⁸ Pages 1 and 17, respectively.

products. Mr Morretti's narrative evidence confirms these as "being circulated throughout the EU and the UK".⁹ I note the article at page 19 from the "European Business Journal" is in English and features a price of GBP 5.00 (alongside other currencies) which confirms a UK target audience. The article includes an interview with Mr Moretti with the final page (page 21 of the exhibit) including a passing reference to Glasgow: "Most recently I was in Tel Aviv and Glasgow for trade events". REUTERIN products are shown within the article but the accompanying text only links the product to the proprietor insofar that it "has a license to conduct studies on the Reuterin line". The remaining advertisements within the exhibit (pages 22-31) are all written in Italian, which (despite the partial translations provided for the purpose of these evidence rounds) confirms they were intended for an Italian audience, rather than any UK-based readership.

- Mr Moretti's Exhibits 3 and 4 feature correspondence and documentation relating to a previous collaborative relationship between the two parties, which I address in more detail below. Similarly, Exhibit 5 details purchases of products between the two parties.
- Finally, Mr Moretti's Exhibits 6-9 all relate to use of the contested marks which the proprietor adduces in support of its claims for acquired distinctiveness (considered in detail at paragraphs 47-48 and 51-52 below). This takes the form of survey/interview evidence, turnover figures, invoices and pharmacy purchase data. Of particular note is Exhibit 8 which the proprietor specifically claims demonstrates the availability of products using the contested marks in the UK.

DECISION

12. Section 47(1) of the Act states:

"The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

⁹ Paragraph 5.

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

[...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

Section 3(1) of the Act provides as follows:

“3(1) The following shall not be registered –

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(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, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

13. As already addressed at paragraph 3, the contested marks were previously protected in the UK as EUTMs then became comparable UK trade marks following the UK's departure from the EU. For these comparable marks, the original EU filing dates remain the same, however they have the same legal status as if they had been applied for and registered under UK law. Therefore, the relevant date for determining whether the contested marks are objectionable under sections 3(1)(b), 3(1)(c) or 3(1)(d) is their filing date, 1st August 2018, and the relevant territory for this assessment is the UK.¹⁰ Thus, the above grounds must be assessed from the perspective of the average UK consumer, who is deemed to be reasonably observant and circumspect.¹¹

14. The applicant makes submissions in respect of the average consumer for the goods, setting out that this includes the general public and professionals in the pharmaceutical, medical and veterinary sectors.¹² I agree and will proceed on this basis. I note that the proprietor's assertions are consistent with this, quoting the general public and professionals such as chemists and pharmacists. Turning to consider the level of attention paid by the consumer, the proprietor submits that this would be high for the general public (noting that the goods are ingested), but even higher for professionals who "spot the slightest nuance associated with the goods in question".¹³ I am of the view that non-professional users of the goods (i.e. the general public purchasing the pharmaceuticals and dietary/nutritional supplements found within in the proprietor's class 5 specification) will take reasonable care to ensure they obtain suitable products to meet their health and personal needs. Therefore, while the goods may not be particularly expensive (or dangerous) the relevant public is likely to pay an above average degree of attention when selecting an appropriate product. In terms of the professional consumer, I believe that that they are likely to pay a higher degree of attention (but not the highest) on the basis that they buy goods in larger quantities than the public and

¹⁰ *Athleta (ITM) Inc v Sports Group Denmark A/S and another* [2024] EWHC 2449 (Ch) specifically considered the relevant date and consumer for comparable marks and confirms at paragraphs 20-21 this assessment must be made from the point of view of the UK consumer. I note *Athleta* was reversed in part on appeal, but not on this point.

¹¹ *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04.

¹² Paragraph 4 of written submissions.

¹³ As per pages 1-2 of its counterstatements.

they may be subject to additional accountability, e.g. the need to ensure their offerings adhere to particular industry standards/responsibilities. Furthermore, ensuring that the goods they offer meet the requirements of their customers is likely to have an impact on the success of their business.

15. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, that a mark may not fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b).¹⁴ However, the basis of the applicant's case under section 3(1)(c) is that proprietor's marks are a well-known antimicrobial substance and therefore are descriptive of the active ingredients used within the goods. If this is indeed found to be the case, then the marks will also lack distinctiveness. Therefore, if the 3(1)(c) ground succeeds, it follows that the same outcome will apply in respect of section 3(1)(b). I shall therefore consider the section 3(1)(c) ground first.

Section 3(1)(c)

16. Section 3(1)(c) prevents the registration of marks which are descriptive of the goods or a characteristic of them. I bear in mind when undertaking the assessment that the objective of this section is to ensure signs designating a characteristic of the services remain free for use by traders.

17. The case law relating to this section (which corresponds to Article 7(1)(c) of the EU Trade Mark Regulation, formerly the Community Trade Mark ("CTM") Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) (with most case notes omitted) as follows:

"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:

¹⁴ *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P at paragraph 25.

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services...

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it.

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services.

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.

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. 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.

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that

regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive.

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation, Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article

7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics.”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) If at least one of its possible meanings designates a characteristic of the goods or services concerned.”

18. In deciding whether the proprietor’s marks contravene section 3(1)(c), I will initially consider the first contested (word only) mark. Following this, I will consider what impact (if any) the stylisation plays in relation to the second contested mark.

19. The applicant claims that the registration of the contested marks “contradicts the underlying public policy to keep descriptive terms free for all traders to use, as the Registered Proprietor could, at present, seek to prevent a third party wanting to sell probiotics/pharmaceutical goods including the active ingredient reuterin, from using the descriptive term “reuterin”.¹⁵

20. To recap, the applicant’s primary argument relates to REUTERIN being the well-known and well-established name of an antimicrobial substance (with a molecular formula $C_3H_6O_2$) produced from *Lactobacillus reuteri* (*L. reuteri*). I am content that the scientific literature provided in evidence at Exhibit CG4 is in support of this. Whilst the articles provided do not appear to have specific links to the UK, I am content that they demonstrate broad geographical use of the term within the scientific community and I have no reason to believe this would not travel to UK-based academics within the same scientific fields. I also note the entry in the ChemSpider database (Exhibit CG1) which, whilst dated only in so far as the page was accessed, is provided by a UK institution. In my assessment, I take into account the Google Scholar results at Exhibit CG3 (identifying approximately 3,840 articles by the end of 2017) and this emphasising the frequency in which the term appears in scientific literature in relation to microbiology and food biotechnology. I also note Exhibit CG11 which includes Google Scholar articles up to 30th July 2024

¹⁵ Paragraph 3 of written submissions.

and totalling approximately 7,820 results. For this exhibit and the screenshot of the ChemSpider website at Exhibit CG1, I bear in mind that whilst I must consider the descriptiveness of the words as at the relevant date, given the wording of section 3(1)(c), this is also a forward looking provision. As such, it is necessary for me to consider the position not only at the filing date but also as to whether the sign 'may serve in trade'. Therefore, the evidence at Exhibits CG1 and CG11 that is dated beyond the relevant date is not to be dismissed outright. Any descriptive use is relevant, provided it was foreseeable at the relevant dates. In this case, they demonstrate a steady increase in the inclusion of the term REUTERIN within academic journals and its presence within a chemical database, both of which were conceivable (and thus foreseeable) at the relevant date.

21. One of the proprietor's arguments in response to the applicant's evidence is that "obscure scientific content is not equivalent to being descriptive in the sense of the Trade Marks Act".¹⁶ It counters that "the general public, who are not specialists in microbiology and pharmaceuticals, would not be familiar with the compounds [sic] names and will remember the mark and associate the goods marked by the registered trade marks with the goods of the registered Proprietor".¹⁷ Similarly, in its counterstatements it states that the term REUTERIN is not used "in everyday life". On this I recall *Exalation v OHIM*, Case T-85/08, where the General Court confirmed that, at least where technical terms are concerned, it is appropriate to take account of meanings known to those in the trade. The court stated that:

"40. First, that technical term [lycopin] designates a food supplement necessarily known by some of the relevant public, in particular professionals dealing with dietetic, pharmaceutical and veterinary preparations.

41. Secondly, the Board of Appeal established in the contested decision that the meaning of the term 'lycopin' was easily accessible to consumers of all the goods covered by the application for registration. The meaning of the term 'lycopin' does in fact appear in dictionaries and on web sites. It is probable

¹⁶ Paragraph 7 of written submissions "in reply" dated 16th October 2024.

¹⁷ Ibid. Paragraph 8.

therefore that the substance designated by that term is also known by some of the consumers of all the goods listed in paragraph 3 above.

42. Thirdly, consumers of pharmaceutical, veterinary, dietetic and sanitary preparations for medical use who are not aware of the meaning of the term 'lycopin' will often tend to seek advice from the informed section of the relevant public, namely doctors, pharmacists, dieticians and other traders in the goods concerned. Thus, by means of the advice received from those who prescribe it or through information from various media, the less well informed section of the relevant public is likely to become aware of the meaning of the term 'lycopin'.

43. The relevant public must therefore be regarded as being aware of the meaning of the term 'lycopin', or at least it is reasonable to envisage that the relevant public will become aware of it in the future”

22. Therefore, I am not swayed by the proprietor's arguments regarding the general public. It is clear from the caselaw that the individuals within this section of the relevant consumer do not *need* to be “specialists in microbiology and pharmaceuticals” to be familiar with the antimicrobial compound. Non-specialists within the relevant public could possibly (and typically be expected to) seek advice from the informed (professional) members of the relevant public and therefore be exposed to the term through this route. Linked to this, I agree with the applicant's counterargument (found at paragraph 4 of its written submissions) that, even where a member of the general public may not have a detailed knowledge of the specific compound being referred to, they may still perceive that the term, REUTERIN, relates to some sort of chemical or biological compound within the product. For example, I consider that a member of the public could have heard it mentioned when seeking professional advice on dietary health, without knowing exactly what it is, beyond being some form of chemical or biological ingredient. Therefore, in this sense, the mark would still be considered descriptive even if being perceived as referring to something merely in the abstract (a chemical ingredient) rather than specific (a precise antimicrobial compound), since the mark is still not functioning as an indication of source.

23. In relation to the section of the relevant consumer made up of professionals, the proprietor asserts that:

“Doctors and pharmacists are familiar with the correct name “*L.reuteri*” or “*Lactobacillus reuteri*” and will associate the marks Reuterin with certain goods manufactured and sold by NOOS SRL”.¹⁸

It is not clear what the proprietor means by “correct name” in this context. If the suggestion here is that *Lactobacillus reuteri* or *L. reuteri* is the “correct name” used by the professional subset of the relevant consumer for the antimicrobial substance in discussion, then this is clearly dispelled by the evidence. It is apparent from the scientific literature at Exhibit CG4 that *Lactobacillus reuteri* and its abbreviation, *L. reuteri* refers to the bacteria used in the production (or synthesis) of the antimicrobial substance known as REUTERIN.¹⁹ Therefore the terms *Lactobacillus reuteri* (or its abbreviation *L. reuteri*) and REUTERIN clearly relate to different things. However, I have also considered whether the proprietor’s argument here is that it is the bacteria, *Lactobacillus reuteri* that is the active ingredient in the goods at issue (pharmaceuticals, dietary/nutritional supplements), whereas REUTERIN is merely the name of the substance that is synthesised in the body after someone has taken/ingested the product. If so, my view is that the term REUTERIN would still be descriptive insofar as it designates the intended purpose of the product.

24. The proprietor presents similar arguments in response to Exhibits CG3-GC4 suggesting that this evidence uses other terms, not REUTERIN.²⁰ In particular, it argues that:

- In Exhibit CG3 the first and second link reference “Reutericyclin” rather than REUTERIN and the remaining links are mainly references to *Lactobacillus reuteri*. On this, I note that whereas the titles of the first and second links only reference “Reutericyclin”, the summaries underneath clearly do reference REUTERIN and the remaining links all reference *Lactobacillus reuteri* and

¹⁸ Paragraph 8 of written submissions.

¹⁹ This is addressed by multiple sources within Exhibit CG4 but is summarised succinctly in the scientific article at page 16 by El-Ziney et al. published in 1999: “Reuterin is a neutral broad-spectrum antimicrobial substance formed during anaerobic growth of *Lactobacillus reuteri* in the presence of glycerol.” (reference omitted)

²⁰ See paragraph 4 of its written submissions.

REUTERIN (in the context of the synthesis/production of the latter by the former).

- The articles in Exhibit CG4 are mainly the same articles from Exhibit CG3 but cite the production or the synthesis of probiotic from *Lactobacillus reuteri*. On this, I note that there is some overlap with articles from Exhibit CG3, but these all include reference to REUTERIN (as well as *Lactobacillus reuteri*) by virtue of this being the product created from *Lactobacillus reuteri*. Therefore, once again, I do not see how this assists the proprietor's case.

25. The proprietor's other primary argument (outside of its claims for acquired distinctiveness, which I will address later in my decision) relates to a prior business arrangement between the two parties. The proprietor summarises the relationship as the following:

"Since 2003, NOOS SRL and BioGaia entered into an Exclusive Distribution Agreement in Italy for the Biogaia's Dietetary [sic] supplement tablets and Probiotic Drops launched in the Italian market under the brand name "REUTERIN", as a result of ongoing commitments to clinical development and scientific research. This agreement was replaced with a further Exclusive Distribution Agreement signed in 2009."²¹

26. It includes in its evidence the signed 2009 agreement (Mr Moretti's Exhibit 3) which replaced the original exclusive distribution agreement from 2003. I note there is no reference to REUTERIN within the text of the agreement, the closest being a reference to "BioGaia's Reuteri dietary supplement tablet".²² In terms of trade mark use, this is addressed in paragraph 7.8.1 of the agreement (page 6 of the exhibit) which states "Nóos shall be entitled to market and sell the Product under its own trademark under the condition that BioGaia's trademark as duly announced is also attached on the Trade Dress, unless such act is otherwise legally prohibited."

27. Mr Moretti's Exhibit 4 details correspondence from 2012 between the parties on the extension of the agreement along with a proposed (unsigned) Addendum IV.

²¹ Paragraph 6 of Mr Moretti's witness statement.

²² Page 3 of Exhibit 3.

The proprietor draws specific attention to paragraph 12 of the draft addendum (page 6 of the exhibit) which does include a reference to REUTERIN. It reads:

“Nóos hereby grant BioGaia an option at the time The Agreement expires or is terminated irrespective of the reason hereto, to acquire the trademark Reuterin and any other trademark used by Nóos in its marketing of BioGaia’s product except for BioGaia’s own trademark used by Nóos.”

Further, the proprietor asserts that the applicant did indeed intend to buy the REUTERIN mark (along with a later possible acquisition of all the proprietor’s shares) but confirms that these negotiations ultimately concluded without success.²³

28. The proprietor claims that this evidence “establishes that at least during the period from 2003 to 2023, BioGaia believed that the marks in question...fully complied with the validity requirements outlined in the Trade Marks Act 1994 in particular that the mark was not descriptive, was distinctive and thereby clearly capable of functioning as a badge of origin, particularly as they sought to purchase the registered marks”.²⁴ I am not satisfied anything meaningful regarding the inherent validity of the contested marks can be inferred from these documents. Both the addendum and the email communication adduced at Exhibit 4 only goes as far as to confirm the applicant’s interest in having the *option* to acquire a mark (or marks) owned by the proprietor for REUTERIN. The addendum itself is unsigned (and appears to have only been produced in draft format) and therefore was never binding upon the parties and further, the distribution agreement (adduced at Exhibit 3) appears to apply to activity within Italy not the UK.²⁵ Even if the applicant’s interest in having the option of owning the trade mark, REUTERIN is taken as confirmation of the applicant believing the marks were valid, this relates to marks being used in Italy and for which the relevant dates are unknown. The validity (or not) of a trade mark registration for REUTERIN active in Italy sometime between

²³ As per paragraph 7 of Mr Moretti’s witness statement.

²⁴ Paragraph 2 of written submissions.

²⁵ The text within the distribution agreement adduced at Exhibit 3 focusses on “the Territory” without further definition, however I note that the narrative evidence firmly places the working relationship in Italy. For example, paragraph 6 of the Mr Moretti’s witness statement. Further, the printed article at page 8 of Exhibit 3 describes (via translation) the proprietor as the exclusive licensee of Reuterin for Italy.

2003-2012, provides no insight into the assessment for the marks that are the subject of these UK proceedings.

29. Therefore, I am content that REUTERIN was used as a descriptive term at the relevant date in that it designated the kind of goods (as a name for the active ingredient present) or the intended purpose of the goods. I am fortified in this view by the fact that the proprietor appears, on several occasions, to refer to REUTERIN as “the compound” or “the compound name” (for example in its counterstatement and at paragraph 8 of its written submissions). I also summarise an example of this at paragraph 35 below.

30. In relation to the goods, the applicant contends that REUTERIN is “clearly descriptive in relation to all of the Class 5 goods covered by the registrations of the Contested Marks, on the basis that reuterin is, or could be, the active ingredient of those goods”.²⁶ I am content that the evidence covers use of the contested mark in scientific literature relating to microbiology. Some of the articles are focussed upon specialised applications, such as meat and dairy product preservation, however the term is clearly recognised and used descriptively in the field of probiotics (as the substance produced/synthesised from *Lactobacillus reuteri*). In particular, the article by Cleusix et al. (Exhibit CG4 at pages 30-38) covers probiotics, including for human consumption. With respect to REUTERIN, it highlights that “it has been postulated that reuterin could play a role in the probiotic effects of *Lb. reuteri*.”

31. Exhibit CG5 also makes a link between probiotics and pharmaceuticals (which goes uncontested by the proprietor). It notes that probiotics are traditionally consumed via foods or nutritional supplements but have also “found a place in pharmaceutical formulations and are supplied as pharma products”. The article acknowledges there are differing approaches worldwide and covers some of the challenges surrounding probiotics as pharmaceuticals, for example the lack of consistency in regulation and lack of studies/large scale trials to develop probiotics as therapeutic drugs. Nevertheless, I am satisfied that the evidence shows that probiotics can be marketed and/or administered via various channels which include

²⁶ Paragraph 3 of written submissions.

as foodstuffs, nutritional supplements and pharmaceuticals. I also note, that “*L. reuteri*” is referenced twice within the article. Therefore, I am content to conclude that the first contested mark is descriptive on the basis that REUTERIN may serve in trade to designate a substance, be it the “compound” (as the proprietor calls it) or the “active ingredient” (as the applicant calls it) present in pharmaceuticals, dietary preparations, and/or nutritional supplements to cover all the class 5 goods listed in the proprietor’s specification. If I am incorrect in this finding, in that REUTERIN is not the active ingredient in the product, but instead is the resulting substance synthesised from an product containing *Lactobacillus reuteri*, then I consider the first contested mark is descriptive on the basis that REUTERIN may serve in trade to designate the intended purpose of all the class 5 goods listed in the proprietor’s specification.

32. I turn now to the second contested mark. This features the same wording REUTERIN as the first contested mark, therefore is subject to the same findings that I have summarised above.²⁷ However, this second contested mark features stylisation not present in the first (word only) mark. I will now consider what extent, if any, this has on my assessment under section 3(1)(c).

33. On this, I recall that in *Starbucks*, Arnold J (as he then was) held that the descriptive word NOW with a minor figurative ‘starburst’ device was descriptive and/or devoid of any distinctive character.²⁸ A similar point (closer to the current case, since it relates to stylised text rather than an additional device) arose in *Thomas Pink Ltd v Victoria’s Secret UK Ltd*, [2014] EWHC 2631 (Ch), when Birss J. (as was) found that the registration of the descriptive word PINK (for clothing) with the letters in the colour pink, in a unique form of script and within a rectangular box, did not prevent the mark being prima facie unregistrable under s.3(1)(c). In the alternative, the mark was excluded by s.3(1)(b). Additionally, I recall the findings in *Hormel Foods Corporation v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch), [2005] ETMR 54 (“SPAMBUSTER”) which considered whether the use of a “coloured cartoon font” impacted the otherwise entirely descriptive message of the

²⁷ I note the first contested mark is capitalised whereas the second contested mark is in title case, however this is immaterial in terms of this assessment.

²⁸ See also paragraph 57 of *Cannabis Clinic* (BL O/777/21).

word 'SPAMBUSTER'. Here, it was held that the stylisation contained nothing additional, it merely represented that word "in one particular manner".

34. On the second contested mark (which, for ease, I show again below), the parties disagree regarding the significance of the stylisation.

Reuterin

The proprietor asserts that its "original stylization" includes "a particularly bright" red, also drawing attention to the "original font" and each letter being "framed in a dark contrasting colour".²⁹ Whereas the applicant considers the stylisation minimal or trivial in nature, noting each letter is presented in a single colour with a narrow border, deeming it likely to go unnoticed and having no significant impact on the distinctive character of the mark. Despite the proprietor's assertions, I do not consider the typeface or font used particularly unique or original. Nor can I find anything particularly striking about the shade of red used in combination with a contrasting black outline. These do not strike me as an unusual or unique combination of colours. Therefore, I agree with the applicant that the stylisation is minimal in nature. I note that the proprietor deems the packaging of third party products shown in the applicant's Exhibit CG6 as "showing active ingredients in standard characters and without any stylization".³⁰ However, I do not consider the stylisation (font, colours or typeface used) of the proprietor's second contested mark any more elaborate or novel than those shown within those examples. While there is no example in Exhibit CG6 using red lettering with a black outline, there are examples of red lettering (page 80) and white lettering with a darker coloured outline (page 79).

35. The proprietor goes further in its counterstatement, arguing that:

"whilst relatively obscure compounds are sometimes used as the basis for the creation of the names for pharmaceutical goods which then acquire distinctiveness through use, the creation of the present mark goes far beyond this by also adding distinctive elements and/or stylization. Therefore seemingly

²⁹ In its counterstatement for UK00917938275.

³⁰ Paragraph 6 of written submissions.

minor stylization or distinctive features are in this field sufficient to provide a clear sign post [sic] to a particular undertaking. Hence these add the required level of distinctiveness for the marks registered for the goods of class 5.”

This is interesting on a number of levels. Firstly, it alludes to an admission that the first contested mark is a compound name, with the proprietor emphasising that the second contested mark “goes far beyond this” due to what it sees are its distinctive elements and/or stylisation. A similar example can be found within page 2 of the proprietor’s counterstatement: “Having in particular a bright colour, the mark on its own therefore differs from the compound”. Secondly, the proprietor suggests that even minor stylisation and/or distinctive features are sufficient “in this field” (relating to goods in class 5) to achieve the “required level of distinctiveness”. It does not elaborate further on the rationale behind this (i.e. why minor stylisation within a mark could or should have more significance in this field compared to others) or provide any evidence to support this claim. I have already found that the stylisation in the second mark is minimal (and there are no other additional elements within the mark) and I am unable to agree with the unsubstantiated assertion that even minor stylisation within a mark is sufficient to make a mark distinctive for goods within class 5.

36. Therefore, with these findings and the above authorities in mind, I find that the limited stylisation in the second contested mark does not divert any attention away from the descriptive nature of the term, REUTERIN. Neither the stylisation nor the typeface used is remarkable. They are banal additions. Due to this, I find that the second contested mark, as a whole, is still *prima facie* descriptive of a characteristic of the goods, namely that it includes the compound/active ingredient REUTERIN for all the class 5 goods listed in the specification. The mark consists exclusively of a description of characteristics of the goods. This is the case for both of the contested marks and, consequently, the section 3(1)(c) ground succeeds.

Section 3(1)(b)

37. Section 3(1)(b) prevents registration of marks which are devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation

(which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

38. I can deal with this ground reasonably swiftly. As noted at paragraph 15 above, the applicant's claims under this section do not go beyond its claims under section 3(1)(c), i.e. that the contested marks are a well-known antimicrobial substance. I have found under my assessment of the 3(1)(c) ground that REUTERIN will be considered descriptive of the kind of goods, in that it refers to goods that contain (or may contain) the antimicrobial substance by that name, or which is the intended purpose of the goods. Given my findings above that the contested marks are descriptive, it follows that they are devoid of distinctive character and, therefore, not capable of distinguishing the goods of one undertaking from another. As a result, I conclude that the contested marks are also objectionable prima facie under section 3(1)(b) of the Act for all of the contested goods. Once again, the proprietor argues that the stylisation of the second contested mark adds distinctiveness to the extent that it becomes capable of fulfilling the essential function of a trade mark. However, I reject this argument based upon the same reasoning summarised at paragraphs 34-36 above.³¹ It is my view that the limited stylisation is not sufficient to add distinctiveness to the non-distinctive element, REUTERIN.

Section 3(1)(d)

39. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the GC summarised the case law of the CJEU under the equivalent of s.3(1)(d) of the Act, as follows:

³¹ I recall that at paragraph 8 of *Thinking of You* (BL O/0431/24), Mr Phillip Johnson acting as the Appointed Person confirmed: "I can see no logical reason why the approach from SPAMBUSTER (and CANNABIS CLINIC) should be appropriate for descriptive signs, but inappropriate for non-distinctive words."

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

40. The enquiry under section 3(1)(d) is not whether the mark is descriptive of a characteristic of the goods, although that could also apply to a mark which falls foul of section 3(1)(d). It is whether the mark was customary in the current language or was customary in the bona fide and established practice of the trade in the UK (i.e. where the trade means the contested goods) at the date of application. Proving this requires the filing of evidence of fact supporting the claim that it was customary for other traders to use REUTERIN at the relevant date, but not in a trade mark sense.³² There is a relatively high evidential bar: in *Affinity Leasing Limited v Total Motion Limited*, Mr Daniel Alexander QC, sitting as the Appointed Person, reviewed the authorities and concluded that the overall message was that section 3(1)(d) “requires specific evidence that it is specifically customary.”³³ Mr Alexander also observed at paragraph 12 of his decision that section 3(1)(c) “does not require the same degree of proof that the term has in [sic] been used in the specific descriptive way.”

41. I have already summarised the applicant’s evidence (see paragraph 10), much of which is focussed on use within academia (such as the scientific entries and journals at Exhibits CG1, CG3, CG4, CG5 and CG11) or Wikipedia entries for REUTERIN (at CG7 and CG9), rather than use by traders of the class 5 goods. Further, none of these exhibits depict use specifically attributable to the UK.

42. The sole piece of evidence linked to the UK, appears to be a hyperlink shown in the Google search results provided at Exhibit CG10 to an Amazon UK webpage for “Moviscom Reuterin Gg 10 Stick”. This is dated by Ms Ginnaw from when the Google search was conducted on 31 July 2024. Unlike section 3(1)(c), which is forward-looking, section 3(1)(d) looks backwards from the relevant date. Therefore, this piece of evidence is clearly far beyond the 1st August 2018 relevant date for the assessment. Additionally, the applicant clarifies (again, via Ms Ginnaw’s witness statement) that this is the proprietor’s Amazon listing. Therefore, this relates to the proprietor using its mark and gives no insight into customary use by

³² *Nude Brands Ltd v Stella McCartney Ltd*, [2009] EWHC 2154 Ch.

³³ Case BL O/522/20, at paragraph 22.

other traders. Therefore, I have no evidence to show what is necessary to support the objection under the section 3(1)(d) ground, which consequently fails.

Acquired distinctiveness

43. Having found the contested marks objectionable prima facie under sections 3(1)(b) and (c), I recognise that the applicant has pleaded that the contested marks have acquired distinctiveness through use, which I must now consider.

44. In accordance with the proviso at s.47(1) of the Act, the relevant date for assessing the proprietor's claim that REUTERIN has acquired distinctive character through use is the date of the applications to invalidate the contested marks, i.e. 12th January 2024. The burden is on the proprietor to show that the mark had acquired a distinctive character by that date.³⁴

45. The Court of Justice of the European Union provided guidance in *Windsurfing Chiemsee*, Joined cases C-108 & C-109/97, about the correct approach with regard to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark,

³⁴ *Oberbank AG & Banco Santander SA and Another v Deutscher Sparkassen- und Giroverband eV* (Joined cases C-217/13 and C-218/13).

it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

46. The proprietor submits that, due to the duration and extent of its use, the first contested mark is capable of fulfilling the essential function of a trade mark through having become distinctive for the goods of the proprietor.³⁵ I recall that Mr Moretti claims that: “In the United Kingdom, the marks containing the term “REUTERIN” has [sic] been maintained during the years as well as being intensively used in the market since the early 2000s”.³⁶ Further, the proprietor states that “the brand awareness [for REUTERIN] is outstanding in its trade channel as a result of extensive sales and promotional activities”.³⁷ However, as per the evidence summary already provided at paragraph 11 above, the bulk of the proprietor’s evidence is focussed on use, awareness, market share and marketing in Italy. This includes REUTERIN products featuring on the “Codifa and Farmadati Italia” professional database at Mr Moretti’s Exhibit 1 and the Italian language articles adduced, along with the target cities for the promotional spends given at Mr Moretti’s Exhibit 2.

47. Mr Moretti’s witness statement places particular emphasis on survey figures adduced at Exhibit 6 which he deems “indicate that paediatricians and wholesalers have a 100% “REUTERIN” brand awareness and that pharmacists have a 94,6%

³⁵ See the counterstatement for the first contested mark (UK00917938276)

³⁶ Paragraph 4 of his witness statement.

³⁷ Paragraph 9 of written submissions.

awareness of the brand”.³⁸ I find page 1 of the exhibit ambiguous since the figures quoted by Mr Moretti appear under a heading of “North” whereas there are another set of figures (for another sample with a different proportion of pharmacists and paediatricians) showing a lower percentage of 76%. Nevertheless, the 76% figure still appears considerable, as it is deemed “significantly higher than the market average of 56%”. However, this survey evidence is clearly focussed upon Italy, with the report detailing “the Reuterin probiotic is most known in the Northeastern and Central regions of Italy”.

48. Mr Moretti’s Exhibit 9 features a random sample of invoices spanning 2005-2021 supplied by the proprietor detailing its sales of REUTERIN products. These are supplied in Italian, though Ms Franco Rivas’ Exhibit 3 provides a translation into English of the invoice template and she confirms in her accompanying witness statement that all invoices follow this same format. With regard to the “CLIENT” and “DESTINATION OF GOODS” sections of the invoices at Exhibit 9, none of the invoices feature text readily identifiable as a UK-based customer or delivery destination.³⁹

49. With the bulk of the evidence adduced being in relation to Italy, it is clear clarity is needed on the relevant territory for the assessment. I note that the proprietor, in its submissions, argues that:

“...evidence pertaining to the use in the EU must entirely be taken into account up to 1 January 2021 and as such both EU and UK evidence has been provided as evidence in the then common market from which the UK post-Brexit market has been derived.”

I disagree. I have already highlighted at paragraphs 3 and 13 that the contested marks were previously protected in the UK as EUTMs, subsequently becoming comparable UK trade marks. These comparable UK marks have the same legal status as if they had been applied for and registered under UK law. Namely,

³⁸ Paragraph 10.

³⁹ I note the invoices at pages 73-90 and 97-119 do take a slightly different format to the translated template but still feature a recognisable section for customer/client and shipping/delivery address for my assessment.

Schedule 2A of the Act, contains specific provisions relating to comparable marks, with Part 1 stating (my emphasis):

“1.—(1) A trade mark which is registered in the EUTM Register immediately before IP completion day (an “existing EUTM”) is to be treated on and after IP completion day as if an application had been made, and the trade mark had been registered, under this Act in respect of the same goods or services as the existing EUTM is registered in the EUTM Register.

(2) A registered trade mark which comes into being by virtue of sub-paragraph (1) is referred to in this Act as a comparable trade mark (EU).

(3) This Act applies to a comparable trade mark (EU) as it applies to other registered trade marks except as otherwise provided in this Schedule.”

50. Schedule 2A sets out modifications to the Act for comparable marks, e.g. with respect to relative grounds in opposition proceedings for non-use and grounds for invalidity based upon an earlier trade mark being a comparable mark. However, there are *no* such provisions within Schedule 2A relating to s.47(1) of the Act, i.e. no modifications with respect to invalidations based upon absolute grounds of refusal for comparable marks. Therefore, there is no basis for comparable marks to be subject to a different assessment other than through the eyes of the UK consumer, or to be able to rely on use outside the UK for acquired distinctiveness. Therefore, it follows that the relevant consumer is the UK consumer and that the relevant territory is the UK.

51. With this in mind, I turn now to the evidence showing use in the UK.⁴⁰ This includes:

⁴⁰ Other parts of Mr Moretti’s evidence are not clearly attributed to any geographical location so I have no basis upon which to attribute it to the UK. This applies to:

- The medical conferences listed at page 17 of Exhibit 2.
- The investment in “gadgets” at page 18 of Exhibit 2.
- The product purchase quantities and turnover figures for both parties at pages 13-28 of Exhibit 4 and all of Exhibit 5, the interview data provided at Exhibit 6.
- The statement and accompanying sales data adduced at pages 1-4 of Exhibit 7 (though I note this references the proprietor being “based in Italy” and declaring use of the mark “on the market” which, while ambiguous, strongly suggests the use applies solely to Italy).
- The “sell-in pharmacy data” and annual data at pages 5-19 of Exhibit 7.

- Mr Moretti's Exhibit 2 shows a one-off promotional spend specifically attributed to the UK, €10,800 for Glasgow in 2013. No other UK payments are listed for the years 2008 to 2022.
- Of the promotional articles adduced in Exhibit 2, only the "European Business Journal" appears to be aimed at a UK audience (amongst other countries, noting it includes mention of Glasgow), though I have no detail on actual UK circulation or readership.

52. Mr Moretti's Exhibit 8 is specifically highlighted by the proprietor as demonstrating the availability of products using the contested marks in the UK. Despite this, there appears to be no content specifically directed at the UK market and, more importantly, nothing to show what the UK average consumer has seen of the marks. The exhibit comprises:

- Screenshots from eBay showing the proprietor's products for sale. I note the link is a ".co.uk" URL however, the product listed is in euros ("EUR 28.16") with a secondary amount underneath showing the value converted into GBP ("£23.58"). Further, the packaging of the product in the accompanying photograph is in Italian. The same is true for the other two eBay products shown. Therefore, while it seems possible for UK users to purchase these items, they are clearly intended and targeted at a different market, and I have no evidence of this reaching UK consumers.
- Page 4 of the exhibit shows products for sale by "Pharmacy Loreto" which are all priced in Euros and accessed via a ".com" URL. Despite the proprietor's claims, I cannot see anything within the screenshot that supports the notion that this demonstrates use of the marks in the UK or these reaching UK consumers.
- The Amazon listing at page 5 is a ".co.uk" URL and shows the item priced in GBP, however (as was the case with the eBay listing) shows product images featuring Italian text, therefore it is clearly not targeted at the UK market, and I have nothing to confirm its UK reach. I also note there is no 'buy' button on the screenshot provided, so I cannot see any means through which a UK based user may purchase the product.
- Pages 5-18 fall under the title "Feedback Report on Amazon Platform for Noos Products by Reuterin Brand". These show predominantly positive reviews for various products featuring the REUTERIN mark. All appear to be related to

verified purchases made on the Amazon platform but they are all labelled “Reviewed in Italy” and therefore appear to be linked to Italian sales only.

- Pages 19-60 features data of visits to the website www.noosit.com from July 2014 to 31st December 2023. The results are broken down by “URL path” with additional data, e.g. a numerical and percentage value for “Views”. I have nothing in the exhibit to confirm to what extent this data represents or relates to UK page views.

53. To conclude, from the evidence provided, the only dedicated UK-centric use of the contested marks is a €10,800 promotional spend for Glasgow in 2013 which falls far below the required threshold for the marks to enjoy any enhanced distinctiveness through use. Therefore, the proprietor’s claims for acquired distinctiveness, as a basis to overcome the marks being objectionable under sections 3(1)(b) and 3(1)(c) of the Act, fail.

CONCLUSION

54. The invalidations succeed in full, for both marks, under sections 3(1)(b) and (c) of the Act and for all the goods registered. Under section 47(6) of the Act, the registrations are deemed never to have been made. The grounds based upon Section 3(1)(d) of the Act fail.

COSTS

55. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. I award the applicant the sum of £2300, calculated as follows:

Official fees (£200 each)	£400
Preparing statements and considering the other side’s statements (noting the duplication in content)	£400
Preparing evidence and considering the other side’s evidence	£1500
Total	£2300

56. I therefore order NOOS SRL to pay BioGaia AB the sum of **£2300.00**. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 11th day of June 2026

C IRELAND

For the Registrar