

0/0727/25

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION

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

Background and Context of this remitted decision

1. Coswell S.p.A (“Coswell”) is the registered proprietor of two trade mark registrations (collectively “the contested marks”) as shown on the front cover of this decision and as follows:

(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 previously stood registered for goods in classes 3, 5 and 21 as set out below:

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, Dr. Kurt Wolff GmbH & Co. KG (“Dr Wolff”) applied to invalidate the contested marks claiming that they were descriptive and non-distinctive

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*’. The terms, however, are effectively identical in substance and nothing turns on the slightly different wording used in each mark’s specification.

of the all the aforementioned goods for which the marks were registered pursuant to section 47(1) and sections 3(1)(b) and (c) of the Trade Marks Act 1994 (“the Act”).

4. As part of the original proceedings Coswell issued a counter application requesting that Dr Wolff’s claims be struck out as an abuse of process.

5. In a decision dated 9 September 2024 under number BL/0865/24 (“my earlier decision”) I rejected Coswell’s application to strike out Dr Wolff’s claims and upheld Dr Wolff’s claims in full. I found that the contested marks were descriptive and non-distinctive for all the goods for which the marks were registered and consequently the trade mark registrations were subsequently invalidated.

6. The reasons for my decision were set out at paras 83 to 109 of my earlier decision and can be summarised as follows:²

- a. Coswell’s argument that Dr Wolff’s 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 was a member of the general public or those in the profession such as dentists, hygienists and the like. The level of attention paid was 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 words in 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;

² As summarised by Dr Whitehead in his appeal decision BL O/0301/25.

- 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;
- 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.

7. On 11 December 2024 my earlier decision was appealed, coming before Dr Brian Whitehead sitting as the Appointed Person soon after.

8. Coswell's Grounds of Appeal were 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.

9. In his decision numbered BL O/0301/25, issued on 31 March 2025, Dr Whitehead upheld my earlier decision in part, dismissing the grounds of appeal numbered 1, 2, 4 and 5. Consequently it was accepted that the contested marks were to be invalidated for all the goods for which the marks were registered in classes 3 and 5. However, the appeal was partially successful in relation to Coswell's goods in class 21 namely

'dental floss/floss for dental purposes'³ and 'toothbrushes'. The matter was, therefore, remitted back to me for reconsideration.

10. The reasons for Dr Whitehead's decision were given at paragraphs 34-38 which read (my emphasis):

"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]⁴, namely toothbrushes and dental floss, are so closely connected to the class 3 and 5 goods, then the objection extends to these goods also.⁵ 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".

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

³ The term is phrased slightly differently in the respective marks but nothing turns on this point.

⁴ This should read as class 21 rather than 12.

⁵ *Fourneaux De France Trade Mark*, Case BL-O/240/02.

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 be 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.”

11. As a result of the partial success of the appeal, Dr Whitehead also set aside the costs order in relation to my earlier decision; he also ordered that the costs of the appeal be reserved to me. The off-scale costs award relating to the strike out application contained within my earlier decision was, however, to remain undisturbed.

12. Following resumption of the proceedings before the tribunal, Coswell requested a hearing which was held before me on 26 June 2025. Neither party filed further evidence or submissions but filed skeleton arguments prior to the hearing. At the hearing Dr Wolff was represented by Mr Rob Jacob of Stephenson Harwood LLP and Coswell was represented by Ms Sarah Husslein of Bristows LLP.

My approach

13. I have already outlined the evidence as well as the relevant applicable sections of the Act, the caselaw and relevant principles in my earlier decision and therefore I do not propose to repeat these again here but adopt them in this decision. Further, given the narrow nature of the matters to be redetermined, where my findings align with my earlier decision, I do not propose to repeat those. Therefore, this decision is to be read in conjunction with my earlier decision. At the hearing the parties agreed with this approach. Further it was accepted that the section 3(1)(b) and (c) grounds succeeded or fell together given that the only basis for the section 3(1)(b) ground was that the marks were non-distinctive because they were descriptive. I shall, therefore, focus my attention on the section 3(1)(c) ground of invalidity, because if Dr Wolff does not succeed under this ground it was accepted based on their pleadings that they would not succeed under 3(1)(b).

14. In so far as a number of propositions advanced by Ms Husslein on behalf of Coswell in her skeleton arguments, Mr Jacob argued that given the nature of Dr Whitehead’s findings it was not open to Coswell to interfere with his decision and

therefore, where he upheld my findings of fact on appeal those findings stood in so far as this decision is concerned. It was argued that the meanings that I had attributed to the individual words BIO, REPAIR, PRO and CLEAN in my earlier decision could not be re-challenged. When pressed Ms Husslein agreed with this proposition and clarified that her arguments related to the use of the words in combination and whether they were descriptive of toothbrushes and dental floss in class 21. The extent of this decision is therefore not a rehearing of the original decision but rather whether the findings that I made in my earlier decision extend to the goods at issue in class 21 namely 'toothbrushes' and 'dental floss'. The decision before me will also include a reconsideration of the costs award.

Decision

Section 3(1)(c)

15. I previously found that the dictionary definitions of the words BIO, REPAIR, PRO, and CLEAN as produced by Dr Wolff accorded with my own understanding of the words. These are as follows:

REPAIR: as a verb *"to put something that is damaged broken or not working correctly back into good condition or make it work again"* or when used as a noun *"the act of fixing something that is broken or damaged."*⁶

BIO: a word that originates from the Greek word BIOS meaning life; *'connected with life and living things used as a prefix at the beginning of nouns and adjectives that refer to life or to the study of living things'*.⁷

The word BIO is used throughout the English language as mostly biological, natural, organic and uncontaminated and is commonly used to refer to goods containing natural, organic ingredients, uncontaminated with synthetics.

⁶ Cambridge dictionary.

⁷ Cambridge dictionary.

PRO: *for on behalf of or used in modern language as in favour of supporting or approving of or as professional [21-23].*

CLEAN: *free from dirty marks, pollution, bacteria etc.*⁸

16. Further, I accepted the meanings that would be attributed to the words by the average consumer, in the context of the goods, as advanced by Mr Jacob, as:⁹

“Bio - biological, organic, natural;

Repair - restore, to put something damaged back into good condition, improve;

Pro - favourable or short form for professional;

Clean - free from dirt or bacteria.”

17. In my earlier decision I made the following finding regarding the meaning of the words BIO and REPAIR:

“90.....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. I consider that this perception will be arrived at immediately and without any further thought process. The meaning of the word REPAIR is obviously descriptive in the context of the goods.”

18. And further, regarding the words in combination (emphasis for the purposes of this decision):

“93....the words BIO and REPAIR in combination, do not ... detract from 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.**

[...]

⁸ Paragraph 65 and 84 of my earlier decision.

⁹ Paragraph 66 and 84 of my earlier decision.

99.... The words PRO CLEAN will be seen as directly related to the goods, namely that they professionally clean or the cleaning properties of the products are endorsed by professionals. Neither the stylisation nor the typeface used is remarkable and the use of the additional words PRO and CLEAN to Biorepair are no more distinctive in combination than they are when regarded individually. Overall, the device and stylisation used in the figurative '865 mark are banal additions which do not divert attention away from the descriptive meaning of the words themselves. The '865 mark as a whole is still descriptive of the nature, type and purpose of the characteristic of the goods.

100. When coming across Coswell's 'BIOREPAIR' and 'BioRepair PRO CLEAN' marks the average consumer will believe that there will be a positive outcome as a result of using its goods; the same conclusion being reached by both the general public and professionals.....

101. 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.”

19. These findings were upheld by Dr Whitehead in relation to the class 3 and 5 goods.

20. Turning now to consider these findings in the context of the goods at issue in class 21, namely, *toothbrushes* and *dental floss*.

Dr Wolff's submissions

21. Mr Jacob submitted at the hearing that there was no error in law nor that the earlier decision was rationally unsupportable or wrong, but rather that some additional explanation was required as to why toothbrushes and dental floss were so closely connected to toothpaste and/or mouthwash so as to be an integral part of the commercial context in which the meaning and significance of the marks are to be regarded as essentially descriptive resulting in the same findings in accordance with the principles in *Fourneaux De France*. Given the way in which the submissions were advanced at the hearing it appeared to be accepted that the words PRO and CLEAN were descriptive and, therefore, the success or otherwise of the claims were

dependent on the meaning of the words BIO REPAIR. Consequently, I shall focus my attention on these words initially.

22. Dealing with toothbrushes first, Mr Jacob's primary position in line with *Fourneaux De France* was that toothpaste cannot be used without a toothbrush and, therefore, such is the close connection between the respective goods that it cannot be said that the marks are descriptive of one and not the other. He argued that the intended purpose of a toothbrush is the same as toothpaste, because both goods work together to complete the act. Toothbrushes are said to be used in conjunction with toothpaste to clean teeth and gums, restoring and repairing them back to good/original condition.

23. In the alternative, Mr Jacob argued that the marks describe a characteristic of the intended purpose of the goods, in their own right, namely, to put something that is damaged back into good condition. He submitted that the word Bio was commonly used as a prefix to refer to goods that contained natural or organic ingredients, uncontaminated with synthetics or a reference to respecting the planet or environment using natural materials. The fact that more than one meaning can be given to the words is immaterial provided that one of those meanings is descriptive.¹⁰ The mark BIO REPAIR will, therefore, be perceived by average consumers as descriptive of the intended purpose of toothbrushes.

24. In support of the contention that the descriptiveness of the marks also applies to dental floss, Mr Jacob drew my attention to a screenshot taken from Coswell's marketing material¹¹ (reproduced below):

¹⁰ *Starbucks* para 92

¹¹ Page 7 exhibit RMJ12

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Using just a toothbrush, however, it is impossible to clean the surfaces in the narrow spaces between the teeth, and it is there that plaque can accumulate easily. These spaces may be small but the plaque deposits can still cause serious gum problems and inflammation. From the moment adult teeth are fully formed, it is essential to clean the spaces between them every day with the right instruments: floss and dental picks.



The **Biorepair®** interdental cleaning range is unique and complete for all needs thanks to two useful **Biorepair** innovations:

- all the accessories feature **microRepair®** too, the enamel **repairing** active principle that penetrates the spaces between teeth where toothbrushes cannot reach. This combats bacterial plaque build-up and helps prevent cavities and gum disease.
- all the materials that make up the accessories (handles, containers, floss, rubbers and bristles) are made with SCP to ensure constantly active anti-bacterial protection.

25. Mr Jacob argues, that Coswell refers to the properties of its own interdental cleaning range, accessories and materials as '[combatting] bacterial plaque build-up and help[ing] prevent cavities and gum disease' and featuring 'enamel repairing active principle that penetrates spaces between teeth where toothbrushes cannot reach' (my emphasis). He submits that this is an example of the way in which Coswell markets the intended purpose of its goods under the mark, namely, to repair i.e. restore to good condition. On this basis, he argues that dental floss also shares the same intended purpose as a toothbrush, the only difference being that these goods focus on areas where a toothbrush cannot reach.

26. In so far as the word BIO, Mr Jacob argued that, in the context of toothbrushes and dental floss, it would indicate to consumers that the design or composition of the goods is both natural and eco-friendly and may contain properties that in conjunction with toothpaste assist in dental repair and/or that the design or the material used in their production, for example, the string, bristles or shaft were made from natural or environmentally friendly material. He contended that the use of the word 'REPAIR' would be perceived as a clear indication that the oral care products, dental floss and toothbrushes together with toothpaste are intended for dental repair. Such is the close connection between toothbrushes and dental floss and toothpaste/mouthwash which are used in conjunction with each other, that the term BIOREPAIR would be descriptive of such goods. It does not matter that the mark does not specify which parts of the

tooth, gums, enamel or oral cavities are referred to, it is sufficient that it directly refers to the intended purpose of the goods.

27. In conclusion he submitted that there was no requirement for the goods to be sold together for this meaning to be perceived. The issue was whether the goods were so closely connected in a commercial setting that they would be used in combination once purchased. Further he argued that it matters not whether the words used are the most common or the most obvious ones to use, the fact that in combination with toothpaste and mouthwash, toothbrushes and dental floss also have cleaning properties does not detract from their intended purpose to repair, namely, to bring back into good condition.

Coswell's submissions

28. In response Ms Husslein, on Coswell's behalf, contended that the circumstances relating to these goods are not on all fours with the decision in *Fourneau De France*, since toothbrushes and dental floss are not goods that are sold together. She stated that it is not relevant that they may be used in combination with toothpaste, because the interpretation of the mark and the perceived meaning in relation to the goods is fixed on the packaging and at the point of purchase. She argued that a toothbrush is a device/tool comprised of a shaft with either natural or synthetic bristles intended to remove and clean plaque and food debris from teeth. Similarly, dental floss is a thread of typically waxed nylon silk or similar material that is used to clean teeth in the cavities between. These products, it was argued, are not intended to repair and do not repair. Their intended purpose is to remove dirt, food debris and plaque from teeth and gums i.e. to clean. Consequently, the term BIOREPAIR:

“12... is not immediately decipherable as a descriptive term by the average consumer in relation to Toothbrushes and dental floss. The term BIOREPAIR does not provide any suggestion as to the general purpose or any other characteristics of these goods. BIOREPAIR is not a term of art in dentistry or oral hygiene. It is neither generic nor used by professionals or consumers to describe a type of toothbrushes or dental floss. In fact there is no dictionary definition of BIOREPAIR relevant to oral hygiene tools, and there is no dental

consensus that toothbrushes or dental floss alone can “repair” biologically or biological tissue.”¹²

29. Ms Husslein went through the factors as set out in *Doublemint*¹³ stating as follows:

“(a) How factual and objective is the relationship between an indication and the product or one of its characteristics?

The relationship between BIOREPAIR and “toothbrush and floss” does not exist.

(b) How readily is the message of the indication conveyed?

The message conveyed by the Registrations is not obvious, let alone in relation to “toothbrush and floss”.

(c) How significant or central to the products is the characteristic?

‘Toothbrush and floss’ are not repairing tools, they are cleaning tools. The characteristics of “repairing” is therefore not expected from these products.”

30. It was argued therefore that neither a toothbrush nor dental floss have any repairing properties, the latter not delivering any active agent onto the teeth, their sole purpose is in cleaning and removing dirt and food debris.

31. Whilst the individual meaning of the words was accepted (extending to the words PRO CLEAN), it was not accepted that the words in combination would describe a characteristic of toothbrushes or dental floss. Neither product, it is said, repair teeth or gums or could be perceived as such.

Assessment

32. Taking the ordinary meaning of the goods at issue from the average consumer’s perspective, a toothbrush is a utensil to clean teeth, gums and the oral cavity, which is used in conjunction with toothpaste to remove plaque and food debris and in so doing prevents tooth decay, gum disease and bad breath. Toothbrushes are used by consumers in combination with toothpaste and, sometimes, mouthwash to brush teeth in order to maintain good oral health, keeping teeth and the mouth in good order.

¹² Coswell skeleton arguments.

¹³ [2003] ECR I-12447 at [61]-[64].

Consequently, I consider when the consumer sees the mark BIOREPAIR in relation to toothbrushes they will perceive the mark as descriptive of the intended purpose of the goods, namely, when used in combination with toothpaste that they clean and restore teeth, gums and the oral cavity to a good condition by using natural or environmentally friendly materials. Whilst I note Coswell's argument in terms of the accuracy of the description, namely, that toothbrushes clean teeth but do not repair, whether the goods actually repair is irrelevant. What is important is the perception of the average consumer. The test for descriptiveness is whether the average consumer would, at the relevant date, immediately perceive, without thought or explanation, that the mark designates a characteristic (including an ancillary characteristic) of the goods.¹⁴ In my view, Coswell's toothbrushes will be not only be perceived as goods for cleaning but also that they have some repairing qualities, namely restoring teeth to their original condition, which is in keeping with the descriptive meaning of the word. As such, I consider that the average consumer when coming across Coswell's BIOREPAIR mark for toothbrushes, would immediately perceive that there is a repair element to the product in so far as they bring the teeth and gums back into good/original condition and that they are made from natural or environmentally friendly materials.

33. I do not consider, as argued by Ms Husslein, that it is determinative that the goods must be selected or purchased together for this view to be formed. This is not in my view what the decision in *Fourneaux* found. The question it posed is whether the relevant consumer would treat the relevant goods as so closely related that they would be regarded as an integral part of the commercial context in which the meaning and significance of the words [of the mark] attributed to all the goods at issue as essentially descriptive. Whilst I accept that a toothbrush doesn't necessarily have to be purchased at the same time as toothpaste, the connection between the one and the other is, nonetheless, undeniable. Toothpaste cannot be used in isolation without a toothbrush and vice versa. It follows, therefore, that so intrinsically linked are the toothpaste and brushes, being used together as part of the same dental hygiene routine, that it is immaterial whether they are purchased together or not. Consequently, I am not persuaded by Ms Husslein's arguments.

¹⁴ *Affinity Leasing Limited v Total Motion Limited*, Case BL O/522/20

34. In so far as the '865 mark, I have already found in my earlier decision that the stylisation and banner device do not detract from the words themselves. Therefore, in relation to the use of PRO CLEAN in combination with 'Biorepair' it will project a perception that the toothbrushes are either endorsed by professionals or that such are their cleaning properties that when used they will achieve an enhanced or elevated result to a professional standard, using natural or environmentally friendly materials. The intended purpose of the goods being of restoring the teeth, gums and oral cavity to good health/condition. I am fortified in this view given that Coswell on its own website refers to 'all materials that make up the accessories (handles, floss, rubbers and bristles) are made with SCP¹⁵ to ensure constantly active anti-bacterial protection'.

35. I take the view that consumers upon seeing the mark BIOREPAIR will perceive it as descriptive of the characteristics of toothbrushes, namely whilst cleaning the teeth, gums and cavities intending to restore them to their original condition, using environmentally friendly ingredients or materials. The element PRO CLEAN in the '865 mark does not add any non-distinctive element to detract from this view. The addition of the words PRO CLEAN merely reinforces the descriptive nature of the mark BIOREPAIR that the goods are endorsed by professionals or the use of the products would be comparable to that given by a professional.

36. Moving on to consider the marks as against dental floss. Dental floss is a thin piece of material used to remove plaque and dirt from the cavities between the teeth and the gumline. Flossing with dental floss, before brushing teeth with toothpaste, is recommended by dentists and hygienists to form part of a daily oral hygiene routine to promote healthy gums and teeth. Whilst I accept that dental floss does not have a close connection to toothpaste in the same way as toothbrushes, nevertheless removing dirt and plaque is the practice of preventative care. Therefore, when viewing the mark BIOREPAIR for dental floss, in my view consumers will consider that it has some restorative qualities of putting teeth and gums back into good order/condition. I consider that the intended purpose of the characteristics of the goods would be understood as removing plaque and food debris from the cavities between the teeth and gumline, and in so doing restoring teeth/gums back to original condition. Whilst

¹⁵ Self-cleaning polymer

Ms Hussein argued that dental floss contained no active agents, this is at odds with Coswell's own marketing material which show that the materials they use contain SPC to ensure 'constantly active anti-bacterial protection'. Whilst I accept that the use of dental floss removes food debris, plaque and bacteria in so doing they also restore oral health. I consider that BIOREPAIR would to the average consumer invoke a descriptive meaning of the repairing properties and intended purpose of dental floss putting the teeth and gums back into good condition using natural or environmentally friendly material and that in so far as the PRO CLEAN element of the '865 mark as endorsed by professionals or to put teeth back into original condition to a professional standard.

37. Taking the principles as outlined in *Doublemint*, I find that the relationship between the marks and the characteristics of the intended purpose of the goods is clear and that the message to be taken from the marks by the words is obvious and readily conveyed without further thought. In so far as the average consumer is concerned the intended purpose of both toothbrushes (in conjunction with toothpaste) and dental floss is to clean and remove debris, putting teeth, gums and oral cavities back into good/original condition i.e repair, using environmentally friendly materials/and to a professional standard. I find that this meaning will be perceived immediately with no further mental effort required in respect of both goods. Consequently, having found that the marks BIO REPAIR/BIOREPAIR PRO CLEAN were descriptive of the goods in classes 3 and 5, I also find that they are descriptive of the characteristics and intended purposes of the class 21 goods.

38. Given this finding it is unnecessary to consider the invalidation brought under section 3(1)(b) as it follows that if the marks are descriptive of the goods they will also be non-distinctive.

Conclusion

39. Subject to appeal, the invalidation action under section 3(1)(b) and (c) succeeds. Trade mark registrations numbered 90629877 and 913028865 are invalidated for the purposes of this decision as against Coswell's goods in class 21.

Final Remarks

40. Given that this decision is to be read in conjunction with my earlier decision which was upheld in relation to classes 3 and 5, trade mark registrations numbered 90629877 and 913028865 are invalidated in their entirety and are deemed never to have existed.

Costs

41. In so far as costs, Dr Wolff has been successful and is entitled to a contribution towards its costs, in line with the scale set out in Tribunal Practice Notice 2/2016.

42. In my earlier decision, costs of £24,882.10 were awarded to Dr Wolff, made up of £21,982.10 off scale costs in relation to the abuse of process/strike out application and £2,900 on scale costs. Following the appeal hearing Mr Whitehead set aside that original costs award, save that the costs in relation to the strike out application were to remain undisturbed. He remitted the costs of the initial hearing and also reserved the costs of the appeal to be dealt with as part of this remitted decision.

43. In the circumstances I award costs to Dr Wolff, which is calculated as follows:

(i) In respect of the initial proceedings (reinstated):

Preparing two statements of case and considering the other side's defences: ¹⁶	£500
Preparing evidence and considering the other side's submissions:	£1,000
Preparing for and attending a hearing:	£1,000
Official fee (x2):	£400

(ii) Off scale costs

In relation to defending the strike out application:	£21,982.10
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(iii) In respect of the appeal proceedings:

Considering the appeal and preparing a response:	£650
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¹⁶ Whilst 2 separate sets of proceedings were issued, I note that there was considerable overlap in the statements of case filed in each and this has been reflected in the award of costs given.

Preparing evidence and considering and commenting on the other side's evidence:	Nothing further
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Preparation for and attending hearing:	£1,600
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(iv) In respect of the remitted proceedings:

Preparing a statement and considering the other side's statement:	Nothing further
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Preparing evidence and considering and commenting on the other side's evidence:	Nothing further
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Preparation for and attending hearing:	£1,500
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Total	£28,632.10
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44. I order Coswell S.p.A to pay Dr Wolff GmbH & Co. KG the sum of £28,632.10. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of August 2025

Leisa Davies

For the Registrar