0/0865/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

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 Pleadings

1. Coswell S.p.A.("Coswell") is the Proprietor of two trade mark registrations (which I will refer to collectively as the contested marks) registered in the UK as comparable marks following the Withdrawal Agreement between the UK and the EU. As part of that agreement each registration retained their EU filing dates. These marks are set out 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

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

("the '865 mark")

2. Both marks stand 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") filed two invalidation actions against each of Coswell's marks pursuant to section 47(1) and

[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. For the purposes of this decision I shall consider the terms collectively.

sections 3(1)(b) and (c) of the Trade Marks Act 1994 ("the Act"). In essence it claims that each of the contested marks are descriptive and lack distinctiveness. It contends that the contested marks consist of the prefix "BIO" meaning "connected with life and living things" and the suffix "REPAIR" meaning "to put something that is damaged, broken, or not working correctly, back into good condition or make it work again" or "the act of fixing something that is broken or damaged". It is said that the words in combination will be understood by the relevant public as a meaningful expression in the context of the goods to relate to oral hygiene and of putting something back into good condition by means that have respect for the natural environment. The message conveyed is said to be clear, direct and immediate to the relevant public such that they will simply perceive 'BIOREPAIR' as providing information that the relevant goods are intended to repair teeth and/or gum damage through nature imitating technology or by the use of natural or organic substances. In so far as the '865 mark, the addition of the elements PRO and CLEAN to the element BIOREPAIR, would be regarded as a meaningful expression of putting something back into good condition as aforesaid and "cleaning either to a professional standard or developed by professional experts or supportive of cleaning". The marks, therefore, will simply be perceived by the relevant public as providing information as to the kind or intended purpose of the goods.

4. Coswell filed a defence and counterstatement to each invalidation application, denying the claims and putting Dr Wolff to strict proof. I note that it did not seek to claim that its marks had acquired distinctive character through use.

5. The proceedings were consolidated on 2 July 2022 such matters being communicated to the parties by way of letter on the same day.

Coswell's strike out application

6. During the evidence rounds to the substantive case, Coswell applied by way of letters dated 7 November 2022 and 12 January 2023 to strike out Dr Wolff's claims and be granted summary judgment on the basis that the proceedings had been brought as an abuse of process. Coswell claims that the parties had a prior commercial relationship and by virtue of an agreement between them (to which I shall refer in greater detail below), Dr Wolff is prevented from being able to contest Coswell's rights and pursue a claim challenging the validity of the contested marks in the UK.

7. Dr Wolff denied the allegations in its response dated 19 January 2023 contending that the agreements did not extend to cover the UK as they were limited in geographical scope to Germany, Austria and Switzerland ("the Dach contract territories"). In any event even if it was found to extend beyond these areas, the agreements were terminated in 2020 and so any obligation such as there was ceased at that time. It was claimed that once the relationship ended the parties were not bound by the agreement or any terms therein.

8. Following my initial indication that the application to strike out had no merit and upon receiving further information that Coswell still wished to pursue its application, I gave directions that the parties file evidence/submissions in support and defence of their respective positions and directed that I would consider the application during any hearing (if requested) and as part of my final decision.

Representation

9. Dr Wolff is represented by Stephenson Harwood LLP and Coswell is represented by Armstrong Teasdale Limited. In relation to the substantive case, Dr Wolff filed evidence in chief. Coswell chose not to file evidence but rather filed submissions in reply by way of letter dated 7 November 2022. Both parties filed evidence in relation to the strikeout application. A hearing was requested which took place before me on 18 October 2023, via video conference. Ms Charlotte Blythe (counsel) of Hogarth chambers instructed by Armstrong Teasdale Limited appeared for Coswell and Mr Robert Jacob of Stephenson Harwood LLP, appeared for Dr Wolff. Both parties filed skeleton arguments prior to the hearing.

Evidence and submissions to the substantive case

10. Dr Wolff's evidence in chief consists of the witness statement of Mr Robert Mathew Jacob dated 2 September 2022 accompanied by twenty six exhibits marked RMJ1-RMJ26. Mr Jacob is a partner at Dr Wolff's representative's firm and is duly authorised to make the statement on its behalf based on information from his own knowledge or information provided to him from identifiable sources.

11. The Proprietor chose not to file evidence but filed submissions dated 7 November 2022.

Evidence in relation to the strike out application

12. Coswell's evidence consists of the witness statement of Andrea Gualandi ("AG") dated 4 November 2022, accompanied by two exhibits marked AG1-AG2 and the witness statement of Jacopo Gualandi ("JG") dated 17 May 2023 and two exhibits marked JG1-JG2.

13. Dr Wolff's evidence consists of the witness statement of Jörn Harguth von Lackum dated 13 March 2023 and two exhibits marked JHL1-JHL2.

14. I have considered all the evidence, submissions (both written and oral) and authorities in coming to my decision and whilst I do not propose to summarise any of the documents in full here, I have taken them all into account and shall refer to any salient points to the extent that I consider necessary at the appropriate stages of my decision.

Confidentiality

15. By way of a confidentiality order dated 13 February 2022 the documents contained within exhibits AG1 and AG2 of Mr Andrea Gualandi's witness statement which relate to an Exclusive Marketing Contract and Addendum Agreement are not open to public inspection. However, in accordance with the terms of that order and by agreement of the parties the contents of those documents may be referred to in this decision. The confidentiality order, therefore, only extends to the disclosure of the actual documents themselves. At the hearing Ms Blythe initially stated that the Exclusive Contract Agreement had in fact been put in the public domain by the EUIPO during related proceedings between the parties and therefore there seemed little merit in maintaining the confidentiality order in relation to this document. Later, this statement was corrected and it was believed that the document in question was the Addendum Agreement. Given that there was some confusion as to which document was in the public domain, I considered it appropriate for the Confidentiality Order to remain in force for both documents.

Relevance of EU Law

16. 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.

Strike out Application

17. I shall consider Coswell's application to strike out first as this will have a bearing on the substantive decision. At the hearing both parties accepted that I had the appropriate authority to strike out the applications in accordance with my inherent powers albeit that Dr Wolff submitted that it had not been properly pleaded and was not provided by Rule 62. It is not in dispute that:

- the parties entered into an Exclusive Marketing Contract ("the Contract") on 19 September 2008 which appointed Dr Wolff as the exclusive distributor of BIOREPAIR branded dental products (and other unrelated brands) in the Dach contract territories.
- the parties entered into a further Addendum agreement ("the Addendum") on 2 April 2009.
- the commercial relationship continued until 31 December 2020 when the Contract was terminated.

Coswell's case

18. The basis of Coswell's application is as follows:

> (a) Its primary case is that Dr Wolff is contractually bound not to challenge the validity of the contested marks by a 'no challenge clause' and has brought the applications in breach of that clause.
>
> (b) In the alternative, Dr Wolff has behaved unconscionably and/or vexatiously by seeking to deny the validity of the contested marks as a result of the trading history between the parties and additionally these cancellations have been brought for an improper collateral purpose.

19. Coswell relies on the following clause of the Addendum which it submits is the clause which prevents Dr Wolff from challenging the validity of the contested marks:

> "[Dr Wolff] shall not at any time claim any right, title and interest, in or to the Trademarks (BioRepair and MICROREPAIR) by registration or otherwise other than the right to use the same under all the terms and conditions of the Contract and shall not at any time question the validity of the Trademarks through use or otherwise." (my emphasis)

20. Whilst its original application purported to submit that the Addendum was a freestanding agreement whose terms continued beyond termination of the substantive Contract, Ms Blythe amended Coswell's position at the hearing. It was therefore accepted that the Addendum was an addendum to the contract that did not necessitate being terminated separately. It was argued, however, that upon termination the clauses within the Addendum were intended to survive termination of the principal terms of the Contract. It is said that the Addendum placed a contractual obligation on Dr Wolff which was intended to have worldwide effect beyond the substantive Contract and to remain in force even when the Contract was terminated.

21. If its primary case fails, Coswell argues that Dr Wolff's application should be struck out as it was improperly brought and filed in an abusive manner because of the previous commercial relationship that existed between the parties. Given this relationship, Coswell must be allowed to assume that Dr Wolff would respect its exclusive and unitary rights in the EUTM registrations under the Contract, which would extend to provide protection in the UK to the contested comparable marks at issue.

22. Coswell submits that Dr Wolff has no legitimate basis for pursuing the invalidation actions, other than to gain leverage over Coswell and to exert pressure on it to drop the proceedings it brought against Dr Wolff in Germany. I was told that, soon after the termination, Dr Wolff launched its own toothpaste in Germany under the brand 'BIONIQ REPAIR' which Coswell is currently challenging. It is against this backdrop that it is said Dr Wolff filed its invalidation action in the UK and its parallel cancellation

actions at the EUIPO.[2] Thus it is contended that the invalidation proceedings were brought for an improper collateral purpose.[3]

23. It was contended that the 'BioRepair brands' and 'Trademarks' to which the Contract and Addendum refer could only relate to the contested marks since Coswell only owned three trademarks at the time namely (i). EUTM no. 006295877, (ii). EUTM no. 13028865 and (iii). Swiss Trade mark no. P-584474. EUTMs (i) and (ii) were converted into comparable UK marks on IP completion day. The agreements, therefore, could only relate to these 'protected' registrations and given the wording of paragraph 19(1), Schedule 2A of the Act any agreement in relation to the EUTMs would extend to cover the contested marks as their comparable equivalents.

24. In support of its strike out application Coswell filed witness statements from AG and JG, both of whom are the Managing Directors of Coswell having held their respective positions since 1997 and 2006. Both witnesses provide the standard paragraph regarding their authority to act, and knowledge of the information provided.

25. AG's evidence primarily served to introduce the Contract and the Addendum into proceedings, copies of which are produced at Exhibits AG1 and AG2.

26. Further AG states that the negotiations and execution of the Addendum were purposely signed by the parties in order to protect the use and the property of the intellectual property rights.[4] He explains that the word "integrate" included in clause '(B)' of the Addendum is taken from the Italian "integrare" which can be translated as "supplement" and as such, clause '(B)' should read "*The Parties are desirous to supplement the content of the Contract …"*.[5] He argues that the Addendum is a standalone agreement and the undertakings given by Dr Wolff survive the termination of the Contract which took effect from 31 December 2020.[6]

27. AG also provides background information as to Dr Wolff's use of its BIONIQ REPAIR products said to have been designed and used in similar packaging to the

[2] I understand that the EUIPO upheld the cancellation action against the EU equivalent '877 word only BIOREPAIR mark. This decision is currently the subject of an appeal. The cancellation action against the EU equivalent '865 mark is ongoing.
[3] See O/015/17.
[4] Paragraph 7.
[5] Paragraph 9.
[6] Paragraph 10.

contested marks. He also provides background information relating to the proceedings issued in Germany.

28. In so far as JP's evidence is concerned, he states that it was Coswell's intention when negotiating the Addendum to provide contractual protection for its brands not only for the duration of the contract but also for the period thereafter, once Dr Wolff in its capacity as the Authorised Dealer, no longer had the contractual right to use those brand names. It was said that Coswell's intention to make such an obligation survive the termination of the contracts can be suggested by the intentional use of the unrestricted wording "at any time" instead of "at any time during the term".[7]

29. JP also states that the Addendum contains other surviving provisions namely the second clause which reads "*for the protection of the trade marks, [Dr Wolff] shall cooperate with [Coswell] in order to give proof of the use of the brand names in the contract territory*;.." It is argued that this 'cooperation obligation' is to be interpreted as continuing beyond the termination date of 31 December 2020, as to interpret it otherwise would mean that it could no longer ask Dr Wolff for proof of use evidence in the event of a challenge to its registration.

Dr Wolff's case

30. Dr Wolff's case can be summarised as follows:

1. The Addendum is not valid as it lacks consideration.

2. Neither the Contract nor the Addendum cover the UK.

3. The Addendum was not a freestanding agreement and did not survive termination of the substantive Contract. When the Contract was terminated this extended to include the Addendum and therefore any 'no challenge' clause is no longer applicable.

4. The 'no challenge' clause is unenforceable under UK competition law.

5. It has a legitimate claim in challenging the validity and registrability of the contested marks in the UK. It denies that its application was to gain leverage in order to persuade Coswell to withdraw the proceedings in Germany.

[7] Paragraph 7.

6. The Contract makes no reference specifically to any EUTMs and therefore paragraph 19(1) Schedule 2A of the Act is not triggered.

31. In support of its case Dr Wolff filed evidence from Mr Von Lackum. Mr Von Lackum is the Executive Director of Dr Wolff a position he has held since 1999. He also provides the standard clause regarding his authority to provide the statement and his knowledge as to the facts advanced.

32. The following can be taken from his statement:

- his responsibilities included the contractual relationship with the manufacturer [Coswell] and he was involved significantly in the termination of the Contract and Addendum.
- The Contract granted Dr Wolff exclusive distribution rights over Coswell's BIOREPAIR oral products, in a limited territory known as the Dach region, this right also included a unilateral right to extend the scope of the agreement into the Benelux region. [See clause 4.1 – 4.3 of the Contract.]
- The clauses reflected the discussions between the parties and there was never any consideration to extend the Contract to the UK or even the EU more generally.
- The Addendum was not regarded as a free standing agreement that would continue in force post termination of the substantive Contract.
- When Dr Wolff received the termination letter from Coswell it was understood to mean that the entire agreement was terminated with effect from 31 December 2020. He understood this to be Coswell's position also.
- The BIOREPAIR products were only marketed in non-English speaking countries and were always under the house mark Dr Wolff.
- The Intellectual property rights are not clearly defined and therefore the Contract's effect as to what rights it relates is ambiguous.

My assessment

33. I have taken account of all the submissions advanced by the parties in their respective skeletons and at the hearing.

34. At the hearing Ms Blythe submitted that Dr Wolff had only advanced the arguments numbered 1. and 4. (as set out at paragraph 30 above) for the first time in its skeleton

arguments and therefore it should not be able to rely on these arguments as they had not been given a proper chance to deal with them. Equally, Mr Jacob submitted that the strikeout application was not properly pleaded at the outset, nor was the TM8 subsequently amended and therefore Coswell should not be able to bring an action in the manner that it did i.e. by way of letter. Given that both parties were put on notice regarding the respective arguments, I see no issue in the manner in which the arguments were advanced. Furthermore, neither party asked me to adjourn the proceedings or to be given additional time to file further evidence. I shall, therefore, consider the arguments as advanced by both parties to the extent that they are relevant.

35. I consider it useful at this stage to reproduce the applicable clauses of the Contract and the Addendum in so far as I consider them to be relevant to the decision. Where reference is made to the 'Manufacturer' this is to be read as Coswell and the 'Authorised Dealer' as Dr Wolff.

36. The relevant terms are reproduced as follows:

The Contract

"**Preamble:**

The manufacturer produces tooth cream and a mouth rinsing solution.. under the protected brand names of BioRepair and MICROREPAIR. The authorised dealer wishes to establish a marketing organisation for these products and to introduce them on the market first of all in the countries of Germany, Switzerland and Austria, and possibly in addition thereto in the Benelux countries. The parties agree that during the initial years considerable costs are entailed for the authorised dealer and …..For this reason the contract relationship of the parties shall have a long running time and a compensation shall be payable to the authorised dealer …..if the contract – for whatever reason - terminates.

§1

Exclusive Marketing

1. The manufacturer confers to the authorised dealer with effect as of 01 September 2008 the sole marketing rights of the tooth cream and the mouth rinsing solution BioRepair …(“the contract products”) in the contract territory.

[…]

§2

Contract territory, territorial protection

1. The exclusive marketing rights extend over the territory of the Federal German Republic, Switzerland and Austria….the “*Contract territory*”.

[…]

3. For the term of this contract the authorised dealer has the right by unilateral declaration to the manufacturer to demand that this contract is also extended to the territory of Belgium, the Netherlands and Luxembourg subject to the conditions set forth in the contract.

This right of option must be exercised with a lead period of one year….

§3

Rights of designation

The authorised dealer has the right, when marketing the contract products to use the brand names of the manufacturer, in particular the brand names BioRepair and MICROREPAIR. The manufacturer guarantees that these brand names are protected and may be used there and that using them does not infringe any third party rights. If the authorised dealer is attacked by a third party because of using the brand name BioRepair and MICROREPAIR the parties shall coordinate the defence. The manufacturer will indemnify the authorised dealer with regard to all costs arising in this connection, in particular court costs, solicitor costs and third party claims for damages. If the authorised dealer is forbidden in legally binding form to use the brand name BioRepair and/or MICROREPAIR or if the coordination of the parties brings as result that no defence against inaction for injunction shall be

made, the manufacturer is obliged to reimburse the authorised dealer for all further resulting damage.

§9

Contract Term, notice of termination

1. The contract is definitely concluded initially for the term until 31.12.2018. Notice for termination of the contractual relationship can be issued with a period of two years terminating at the end of the year - for the first time on 31.12.2018 or in the case of exercising the option defined below, for the first time on 31.12.2023.

[…]

6. Notice of termination must be issued in writing.

§10

Execution /compensation payment

[…]

3. …

In the event of a termination by the authorised dealer the manufacturer has to submit to the authorised dealer within four weeks after the receipt of the termination letter, in writing, whether the manufacturer will sell the contract products or compatible competitive products in the contract territory herself or via third parties. In the event of a termination of the manufacturer the manufacturer has to submit this declaration together with the termination notice.

§13

Written form, partial ineffectiveness, applicable law , legal venue

1. Subsidiary agreements appertaining to this contract have been made only in the form of the sideletter mentioned in §4 Section 1. Modifications of and supplements to this contract must be made in writing in order to become legally effective. This also applies to a waiver of the written form.

2. If individual conditions of this contract are entirely or partially ineffective, or if the contract contains a gap, the contract parties will agree a legally effective alternative condition coming as close as possible to the intention of the legally ineffective condition, or will close the gap as the parties would have done, if they had been aware of the need at the time of contract agreement.

3. The contract is subject to the law of the Federal German Republic, with the exception of the regulations of the UN purchase right.

…..

The Addendum

WHEREAS

(A) This Agreement is a supplemental to the Exclusive Marketing Contract dated September 19, 2008 made by and between “the Manufacturer” ..and “the Authorised Dealer”.. (hereinafter referred to as the “Contract”);

(B) The Parties are desirous to integrate the content of the Contract, regarding the use and the property of the intellectual property rights connected to the Contract Products and of the trademarks BioRepair and MICROREPAIR, owned by Coswell.

NOW, THEREFORE, in consideration of the recitals which form an integral part of this Agreement, the Parties agree as follows:

- In case, if for any reason or cause (included but not limited to, any eventual right which could rise by the use of the trademarks/brand names and/or by the marketing of the contract products) the Authorised Dealer should become titular of any Intellectual Property Right, he shall formally and immediately assign it to the manufacturer, for no consideration;
- For the protection of the trademarks, the Authorised Dealer shall cooperate with the Manufacturer in order to give the proof of the use of the brand names in the contract territory;

- Authorised Dealer shall not at any time claim any right, title and interest, in or to the trademarks (BioRepair and MICROREPAIR) by registration or otherwise other than the right to use the same under all the terms and conditions of the Contract and shall not at any time question the validity of the Trademarks through use or otherwise.
- For no consideration the Authorised Dealer hereby assigns to the Manufacturer all property, right, title and interest in and to the domain names…..
- All the provisions and rules of the Contract dated September, 19 2008 shall remain in full force and effect."

37. The remaining terms of the Contract and Addendum relate to clauses addressing the sale and delivery of the goods, the prices payable and standard clauses one would expect in a contract of this kind, none of which I consider are relevant to the decision and therefore I have not reproduced them.

38. In considering the terms of the Contract Ms Blythe referred me to 'Chitty on Contracts'[8] which in turn referred to the principles applied by the courts and which were summarised in *Lukoil Asia Pacific Ltd v Ocean Tankers* (Pte) Ltd (*The "Ocean Neptune"*) as to the construction or interpretation of commercial documents.[9] Neither party argued that the applicable law for me to take into account differed to the legal principles applied in England and Wales, I shall, therefore, proceed on the basis of established principles. At the hearing I referred the parties to the decisions in *Wood v Capita Insurance Services*[10] and *Arnold v Britton*[11] which outlined the correct approach to be adopted on the interpretation or construction of contracts. This approach was summarised by Lord Nuremberg as follows[12]:

> "15. When interpreting a written contract, the court is concerned to identify the intention of the parties by reference to "what a reasonable person having all the background knowledge which would have been available to the parties would have understood them to be using the language in the contract to mean", ..focussing on the meaning of relevant words,… in their documentary, factual

[8] 34th Edition Incorporating 1st Supplement at para 15-053
[9] No citation provided - see paragraph 25 of Coswell's skeleton arguments.
[10] [2015] UKSC 36.
[11] [2015] AC 1619.
[12] *Arnold v Britton*

and commercial context. That meaning has to be assessed in the light of (i) the natural and ordinary meaning of the clause, (ii) any other relevant provisions [of the lease], (iii) the overall purpose of the clause and the lease, (iv) the facts and circumstances known or assumed by the parties at the time that the document was executed, and (v) commercial common sense, but (vi) disregarding subjective evidence of any party's intentions." [13]

39. And in *Woods v Capita*, Lord Hodge stated in so far as contractual interpretation that:

> "10. The court's task is to ascertain the objective meaning of the language which the parties have chosen to express their agreement. It has long been accepted that this is not a literalist exercise focused solely on a parsing of the wording of the particular clause but that the court must consider the contract as a whole and, depending on the nature, formality and quality of drafting of the contract, give more or less weight to elements of the wider context in reaching its view as to that objective meaning.
>
> 11. Interpretation is, as Lord Clarke stated in *Rainy Sky* (para 21), a unitary exercise; where there are rival meanings, the court can give weight to the implications of rival constructions by reaching a view as to which construction is more consistent with business common sense. But, in striking a balance between the indications given by the language and the implications of the competing constructions the court must consider the quality of drafting of the clause …. and it must also be alive to the possibility that one side may have agreed to something which with hindsight did not serve his interest: *Arnold* (paras 20 and 77). Similarly, the court must not lose sight of the possibility that a provision may be a negotiated compromise or that the negotiators were not able to agree more precise terms.
>
> 12. This unitary exercise involves an iterative process by which each suggested interpretation is checked against the provisions of the contract and its commercial consequences are investigated: *Arnold* para 77 citing *In re Sigma Finance Corp.*[14] To my mind once one has read the language in dispute and

[13] *Arnold v Britton*.
[14] [2010] 1 All ER 571 para 10 per Lord Mance.

> the relevant parts of the contract that provide its context, it does not matter whether the more detailed analysis commences with the factual background and the implications of rival constructions or a close examination of the relevant language in the contract, so long as the court balances the indications given by each."

40. It is clear from these authorities that any interpretation applied to contracts must identify the intention of the parties by reference the construction of the agreement which is something to be determined from the terms and the language of the agreement itself, taken in the context of the relevant background, at the time the contract was entered into, rather than any subsequent events and statements. It does not appear, therefore, that future events can be relied upon to construe the meaning of the agreement.

41. I bear in mind that the extent of my jurisdiction is not to determine as to whether a breach of contract has occurred, the parties have other recourse available to them to pursue such a claim. My assessment of Coswell's application is to determine whether there is any legitimate claim for an abuse of process or whether there is anything that prevents Dr Wolff from bringing the claim that it has. I bear in mind when assessing the Contract and Addendum that the purpose of these documents was to govern the commercial relationship that existed between the parties and the operation of the marketing of BioRepair branded goods (and other brands/trade marks unrelated to this decision). Of particular note is that the contracts themselves were not ones entered into as part of a coexistence or settlement agreement following a dispute regarding any conflicting rights.

42. At the hearing and in her skeleton Ms Blyth referred me to several authorities in support of Coswell's case namely *Punter of England v Chancellor, Masters and Scholars of the University of Cambridge*[15], a first instance decision numbered O/286/20 and a CJEU decision numbered C-62/21.[16] I note that the first of those decisions related to a breach of a settlement agreement and the other was a breach of a coexistence agreement, where the courts determined that it was possible in principle, for an abuse of process claim to be brought in breach of these types of

[15] [2015] EWHC 3678 – only a case analysis extract was provided taken from Westlaw.
[16] At paragraph 22 of her skeleton.

agreements. I consider, however, that the cases referred to are not on all fours with the decision in suit and, therefore, they do not assist Coswell, nor are they ones that I am obliged to follow. Firstly, it was accepted by Ms Blythe that the CJEU decision numbered C-62/21 was withdrawn before the matter of whether an abuse of process had arisen was determined and even if it had been determined by the CJEU, it would not have applied the principles of contract law in England and Wales which are the relevant principles to be applied as aforesaid. More importantly the other two cases namely *Punter* and the decision numbered O/286/20 were fact specific. The Contract and Addendum before me relates to the management of an ongoing business relationship between two entities and not a negotiated agreement to settle a dispute. Those decisions it appears to me turned on their own facts. Therefore, whilst I accept that it is possible for a case to be struck out as having been brought as an abuse of process, in order for me to come to this conclusion it is necessary for me to consider the particular circumstances of the case in hand.

43. In so far as geographical scope, from the construction of the Contract it is quite clear that, at the time the Contract was entered into in 2008, the parties' intention was to grant Dr Wolff exclusive rights to operate in the 'Dach territory'[17] with an additional clause to allow it, during the term of the contract, to expand into the Benelux region.[18] The Contract itself explicitly sets out the extent of the applicable territory to which it applies. Clause §2.1 headed "Contract territory, territorial protection" states that the "*exclusive marketing rights extend over the territory of the Federal German Republic, Switzerland and Austria….the "Contract territory*"." It appears clear, therefore, that the exclusive marketing rights were limited in geographic scope to the three named countries. There is nothing imprecise or ambiguous in the construction of the language used at clause §2.1 of the Contract that would suggest a wider interpretation. Furthermore, there are no other clauses within the Contract or the Addendum which could be construed as including the UK or the wider EU.

44. Whilst the decision in *Lukoil Asia,* as relied upon by Coswell, states that the court must not lose sight of the possibility that a provision may be a negotiated compromise or that the negotiators were not able to agree more precise terms, nothing has been placed before me to suggest that the Contract had a wider reach, and it cannot be

[17] See clause §2.1.
[18] See clause §2.3.

inferred from the language used that such an interpretation was intended by the parties. Had such an intention been contemplated, then the Contract would, in my view, have been drafted more broadly so that it would have been open to interpretation. The fact that the UK was part of the EU at the time is immaterial, given that the territorial scope of the Contract is clearly defined.

45. Furthermore, the Contract allows for any ambiguity to be modified or clarified,[19] so that if the Contract did not reflect the parties' intentions at the time, it was always open to either one of them to seek to rectify any ambiguity. Coswell did not exercise this right at any time during the term of the Contract (nor incidentally in any period thereafter). Once the Contract was terminated in December 2020, its scope and any obligations arising therefrom ceased at that date. There has been no evidence put before me as to any agreement that could construe the terms of the Contract as having an effect in the UK, post termination.

46. Moving on to the Addendum. It was initially argued by Coswell, that the Addendum was a free standing document, but at the hearing Ms Blythe confirmed that Cowell was not maintaining this position. Its amended position was that after termination, the clauses in the Addendum were intended to survive. For clarification, in so far as the Addendum being a freestanding contract I was not persuaded by this argument. An addendum is defined as "*a thing that is added typically in order to correct, clarify or supplement something, esp. an item added at the end of a book, an appendix. Also: an additional clause amending an agreement, a resolution, etc."*[20] In legal terms an addendum would be regarded as an addition to a completed written document and becomes a binding part of the contract. Its function is to update and modify the terms of the original contract and where necessary clarify any ambiguous terms. The way the Addendum is constructed and the fact that it was completed some 7 months after the date of the substantive Contract (whilst the commercial relationship was still in force) suggests that it was to be read as an extension to the Contract and not separate to it. It is not in my view a free standing contract in its own right. I come to this conclusion from the wording used in the Addendum itself as set out below:

"This Agreement is a supplemental to the Exclusive Marketing Contract…

[19] See clause §13.1 and §13.2.
[20] www.oed.com/dictionary/addendum

The Parties are desirous to integrate the content of the Contract, regarding the use and the property of the intellectual property rights connected to the Contract…

All the provisions and rules of the Contract.. shall remain in full force and effect."

47. Consequently, when the Contract was terminated it follows that the Addendum did also. I also do not accept AG's argument that the use of the word 'integrate' can be given a different meaning as suggested. The ordinary dictionary meaning of the word is to 'incorporate', 'add' and 'amalgamate' which are consistent with the intended purpose of the Addendum.

48. In so far as the argument that the no challenge clause survived termination of the Contract, whilst I accept that certain obligations do survive termination, for example, obligations regarding the resolution of disputes or the payment of compensation, ongoing obligations do not normally survive without an express provision. Any restrictive covenant for example would have to be expressly specified and even then, such a clause would be open to challenge as to its fairness and enforceability. Further, given that the territorial scope of the Contract did not include, or contemplate, granting Dr Wolff any right to market goods under the contested marks in the UK, it seems unlikely that the parties intended the 'no challenge' clause to apply to the UK. This is important because even though the comparable marks are partial replacements for EU-wide trade marks, they are not EU trade marks. They are UK-specific marks retaining rights of priority from EU marks. This means that in the context of a claim that an application for invalidation should be struck out as an abuse of process, the relevant question is whether the application to invalidate the UK-only marks is in breach of the contract and/or an abuse of process.

49. Neither party has produced evidence of how the termination came about or provided details of the particulars of the termination. Given that it is Coswell who is advancing the argument that the parties intended certain clauses of the Addendum to survive termination, the onus rests with it to produce cogent evidence to support such a contention. No evidence has been provided by Coswell such as minutes of meetings, email exchanges or transcripts/notes of oral discussions that would suggest that the parties intended the terms of the Addendum to survive independently of the Contract, and I do not find that it is a reasonable inference for me to take. I have no evidence of

any post termination agreement having been entered into or any document setting out what the respective parties' future obligations were and, therefore, I can only conclude that none existed. When the notice of termination was given to Dr Wolff, this terminated the whole relationship between the parties and it applied to both the Contract and the Addendum.

50. Ms Blythe argued that the wording of the third clause of the Addendum (reproduced below) clearly places Dr Wolff under an obligation not to question the validity of the mark at any time in the future and had the parties intended this to be limited it would have used the wording "not at any time during the term":

> *"[Dr Wolff] shall not at any time claim any right title and interest in or to the Trademarks by registration or otherwise other than the right to use the same under all the terms and conditions of the Contract and shall not at any time question the validity of the trademarks through use or otherwise."*

51. This term, however, is clearly to be read in conjunction with the Contract which was itself limited in time with an option to extend it subject to certain limitations. In absence of evidence to the contrary I am not persuaded by Coswell's arguments. This clause, in my view, can only be interpreted as preventing Dr Wolff from exercising any ownership rights over the marks other than the right to use the marks in accordance with the terms and conditions of the Contract and only whilst the Contract was in force. If it can be said that the interpretation of this wording extended to prevent Dr Wolff from ever being able to challenge its validity, any such obligation has to be balanced against the public interest of removing invalid marks from the register and therefore such a clause would be disproportionate, unreasonable and unfair. It would be incongruous for a party to bind itself ad infinitum, or curtail its ability to challenge the validity of a mark post termination. Even if it can be construed that the clause "*not at any time question the validity of the Trademarks through use or otherwise*" intended to prevent Dr Wolff from bringing an invalidation action this term can only be construed as applying in the Dach territories and once the Contract and Addendum were terminated it had no ongoing effect. Without any post termination agreement having been entered into, all obligations under the Contract and Addendum such as there was, ceased as at December 2020. In so far as Coswell's argument regarding the provision of proof of use evidence being indicative of the intention of an ongoing

obligation, when reading this clause it appears to me that the purpose of the clause was to prevent Dr Wolff from exercising any rights over Coswell's brands, during the course of the Contract and to defend the trade marks in the Dach territories.

52. In so far as Coswell's secondary argument that the proceedings were brought for an improper collateral purpose,[21] it is only an abuse of process if the proceedings were brought solely for a collateral purpose and there is nothing before me in terms of cogent evidence to suggest that this in fact was the case. Whilst AG and JG state that this must have been Dr Wolff's intention, no evidence has been filed that shows Dr Wolff had an ulterior motive for issuing the invalidation proceedings. There is no evidence for example that Dr Wolff intended on registering the BIOREPAIR mark itself in the UK or that it had attempted to exert pressure on Coswell to drop the proceedings in Germany. Even if Dr Wolff had intended to apply pressure on Coswell to assist it in the dispute in Germany, this does not mean that it didn't also have a legitimate purpose in bringing proceedings asserting that the BIOREPAIR trade marks are descriptive of the goods in English. In fact, I am fortified that Dr Wolff's intentions were legitimate by the fact that it pursued a similar claim against the equivalent EU '877 mark at the EUIPO which was successful at first instance. I am not persuaded, therefore, as to the suggestion that the proceedings were brought for an improper collateral purpose and I reject this argument.

53. To conclude I consider that the extent of the Contract and Addendum was limited to the Dach territory and had no effect in the UK. The parties main business was covering the sales and distribution of goods in Germany, and there is nothing within the terms of the contracts, either express or implied, that can be said to cover the UK. The termination notice brought to end the entirety of any contractual relationship that existed between the parties and with it any ongoing obligations.

54. I do not find that Dr Wolff was prevented from bringing the invalidation action or that it was an abuse of process to do so. Coswell's strike out application fails.

55. The arguments advanced in relation to paragraph 19(1) Schedule 2A, of the Act is only relevant if I consider that the terms of the agreement were intended to have

[21] See O/015/17.

effect in the UK and survive termination, which I have found that they do not. On that basis there is no need for me to address this point any further.

56. Further, given that I have found in favour of Dr Wolff on its primary arguments, it is unnecessary for me to consider the additional arguments advanced, as set out earlier in paragraph 30. I shall now consider the substantive case.

Sections 3(1)(b) and (c)

57. Section 3 states as follows:

> "3.— Absolute grounds for refusal of registration
>
> (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) […]
>
> 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."

58. Section 47 gives application to section 3 as follows:

> "47. (1) 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).

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."

Average Consumer

59. The above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect: *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. Nothing turns on the assessment of the average consumer as both parties are in agreement that it includes both the general member of the public and those in the profession such as dentists, hygienists and the like. Given the nature of the goods I do not consider that a particularly high level of care would be undertaken, whether by the member of the public or the professional having regard to the nature of the goods, cost and frequency of the purchase. Overall I consider that an average degree of attention will be undertaken.

Relevant Dates

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

Section 3(1)(c)

61. Sections 3(1)(b) and (c) are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b) of the Act.[22] In reality, since Dr Wolff's case under section 3(1)(b) is that Coswell's mark is descriptive, then it follows that if this is found to be the case it will also lack the necessary distinctiveness. Consequently if the section 3(1)(c) claim succeeds or fails, then the same outcome will apply to the Dr Wolff's claim under section 3(1)(b). I shall, therefore, consider the section 3(1)(c) ground first.

62. 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.

63. The case law under section 3(1)(c) (corresponding to Article 7(1)(c) of the EUTM Regulation, formerly Article 7(1)(c) of the 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) 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:
>
> > "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 (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728

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

[2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

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 (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

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 (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (*Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779*, paragraph 35, and *Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619*, paragraph 38). It is, furthermore, irrelevant whether

there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (Koninklijke *KPN Nederland*, paragraph 57).

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 (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

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 (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), 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 (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

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: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

64. More recently, Zacaroli J summarised the key question in *Puma SE v Nike Innovate C.V.*, [2021] EWHC 1438 (Ch):

"21. Ultimately, as Ms Himsworth Q.C. submitted, the question is whether the mark applied for, when notionally and fairly used, is descriptive of the goods and services in question within the meaning of section 3(1)(c). A sign can be refused registration '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 [the characteristics in section 3(1)(c)]': *Technopol* (above), at [50]. Moreover, a sign will be descriptive 'if there is a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of one

of the characteristics of the goods and services in question': Case T-234/06 *Giampetro Torresan* (above) at [25]."

65. In support of its claim, Dr Wolff filed evidence from Mr Jacob. He states that Coswell is an Italian company that manufactures and markets personal care products. Included in his statement is a range of print outs of dictionary definitions of the words BIO, REPAIR, PRO and CLEAN as set out below:[23]

> 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*."[24]
>
> 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.*[25]
>
> 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.

66. The word BIO, it is said, 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. Mr Jacob drew my attention to a number of General Court decisions where it was found that 'Bio' refers in particular to the concept of respecting the planet and environment, using natural materials or being manufactured in an ecological way.[26] The words CLEAN and REPAIR will be given their ordinary meanings. It is suggested that when seeing the word PRO in the context of the goods, it will be perceived as short hand for professional. In conclusion Mr Jacob contends that the meaning of the words attributed by the average consumer will be:[27]

> 'Bio' - biological, organic, natural;

[23] See paragraph 14-25 and exhibits RMJ1-4.
[24] Cambridge dictionary.
[25] Cambridge dictionary.
[26] See T-586/08 'BioPietra' and T-610/14 'Bio organic' and T-427/11 Bioderma [at 18].
[27] Paragraph 81 and 82 o0f skeletons.

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

‘Pro’ - favourable or short form for professional;

‘Clean’ - free from dirt or bacteria.

67. It is said that these meanings will be easily understood by the English speaking average consumer throughout the UK, even more so for professionals such as dentists, pharmacists, orthodontics and medical staff. In the context of oral healthcare it is contended that REPAIR could be used as indeed the Proprietor uses it to illustrate that the product helps to repair tooth enamel, helps repair gums or overall oral hygiene.

68. Mr Jacob produces a large volume of extracts (a selection of which are reproduced below) taken from various third party retailer’s websites such as Boots, Superdrug and Holland and Barret where it is said that the words BIO and REPAIR are in common use for toiletries, oral healthcare and cosmetics.[28]

[28] Taken from Boots, Superdrug and Holland and Barret’s website.

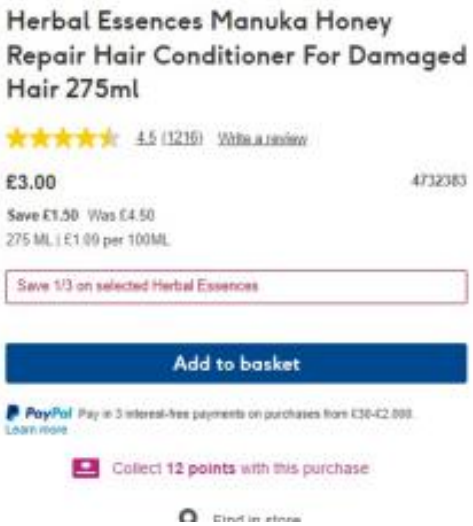
69. Mr Jacobs said just by inputting the word BIO into the Google internet search engine it brought up 400 results of the use of the word.[29]

70. A similar search was undertaken for the use of BIO particularly in relation to toothpastes and mouthwashes a selection of which are reproduced at page 7 of Mr Jacob's statement and include terms such as 'Biomed', 'Biotène', 'Bio-dent', and 'bio-enzyme'. The term BIO is also said to be used by producers in the form as reproduced below as a certification mark to show at a glance that the products are truly natural or organic.[30]

71. Similar searches were undertaken for the words Repair, Pro and Clean. For example it is said that over 400 products were found to be available for sale in the UK which contain the word REPAIR on their packaging claiming that they have repairing

[29] See Exhibit RMJ5.
[30] Paragraph 31.

properties and improve damages or deficiencies of the face, body or hair. These include hair products and hand lotions as set out below:



72. It is said these entities use the word ‘repair’ descriptively. An example includes Herbal Essence’s Deep Repair Conditioner which is said “deeply penetrates to repair very damaged hair to smoothness and reveal its natural beauty”.

73. The use of word ‘Repair’ is also said to be prevalent in the UK on dental products such as mouthwashes and toothpastes. Mr Jacob produces examples of such use by

third parties to include “Colgate’s ‘sensitive instant relief enamel repair” toothpaste and Oral B’s ‘gum and enamel repair’ toothpaste.[31]

74. The use of REPAIR is said to show that the product corrects, damages and improves oral related irregularities, particularly the enamel and gums. The use is not only on the packaging but also in its advertising material. Examples include Sensodyne ‘Repair And Protect’ toothpaste which ‘*helps to repair deep inside the dentine*”[32] and use by Oral B’s Gum & Enamel PRO-REPAIR toothpaste which “*helps repair enamel and defends teeth against acid erosion*”.[33]

75. Mr Jacob produces screenshots taken from Coswell’s own website,[34] which it is said shows that Coswell describes its ‘BIOREPAIR’ toothpaste as the “first and only

[31] See Exhibit RMJ11.
[32] See paragraph 37.
[33] See paragraph 38.
[34] See Exhibit RMJ12.

toothpaste in the world that repairs tooth enamel".[35] Mr Jacob states that Coswell promotes its products by contending that its microrepair technology consists of crystals with biomimetic capacity which "chemically bond to the natural tooth enamel and repair it without the need for additional components acting as glue".

76. Mr Jacob provides examples of Coswell's goods displaying the claim that its goods "repair 100% of enamel at every use". Such goods include 'Bio Repair Total Protective Repair toothpaste', 'Biorepair Fast Sensitive Repair toothpaste' and 'Biorepair Pro White toothpaste'. He also states that Coswell promotes its goods as being good for the environment that do not contain certain allergens and chemicals.

77. Further examples are produced (at Paragraph 40) of Coswell's use of the word REPAIR in its marketing material emphasising the repairing effect of its Biorepair products.

78. In so far as the use of the word PRO it is said to be commonly used in the cosmetic and dental sectors and Mr Jacob produces examples of a range of products showing

[35] See paragraph 8.

such use. Mr Jacob states that in the dental industry the word PRO is a widely used term as short for ‘professional’ indicating to the consumers that the goods have been developed by professional experts or that the goods meet professional standards. An example includes Sensodyne’s ‘Pronamel’ toothpaste, Arm and Hammer’s ‘WHITENING PRO PROTECT’ toothpaste and Oral B’s ‘PRO Care’ toothbrush.

79. The same exercise was undertaken for the word CLEAN showing that it is used widely in the cosmetic, toiletries and dental hygiene industries on toothbrushes and toothpastes.

80. Mr Jacob also produced a range of examples where it is said that the words BIO, REPAIR, PRO and CLEAN are frequently used in combination, especially in the cosmetic, toiletry and dental hygiene sectors. This it is said indicates that the product's ingredients or components may be natural or that the products' function is to restore or improve damaged parts of the body. Various products featuring the combination of the words BIO and Repair available throughout the UK are shown.[36]

[36] See paragraph 41 and RMJ13-14.

81. It is said that these products were not only being used as at the time of filing the invalidation action but also at the time Coswell applied for its marks. Exhibits RMJ24

and RMJ25 is said to show a variety of products consisting of the words PRO, BIO, CLEAN and REPAIR on or before the relevant dates. I acknowledge that only pictures 2 and 5 shown above show the combination BIO REPAIR in use as a description, the others are, or may be, trade mark use.

82. In conclusions Mr Jacob states that the wide availability of products in the cosmetic and dental care sectors containing these words is a clear demonstration that they are, were and are likely in the future to be used descriptively. The use is said to be extensive on the packaging of the products and on the products themselves. The words should, therefore, be available for others to use as they do not and are incapable of fulfilling their essential function as a trade mark as an indicator of trade origin. In each of these products, the use of BIO is done to indicate that a characteristic of the product is natural or uncontaminated or that the product is comprised of natural ingredients. Further the average consumer would immediately and without further thought, understand and perceive the message conveyed by the words, either singularly or in combination, particularly in relation to dental and oral health, that the products are ones that organically repair/make good the teeth or gums.

My Assessment

83. In assessing the matter it is important for me to consider the evidence and particularly the dictionary definitions filed. I must bear in mind the meaning that would be attributed to the words by the average consumer in the UK and whether they could be used descriptively of the goods or whether they are merely allusive as to their characteristics.[37] Ms Blythe criticises the evidence as not reflective of the position as at the relevant date. Of course, whilst it is true that I must consider the descriptiveness of the words as at the relevant date, given the wording of section 3(1)(c) it is necessary for me to consider the position not only as at the filing date but also whether the sign 'may serve in trade', which is a forward looking provision. The evidence, therefore, that is dated as at the date the statement was completed, is not to be dismissed outright. Any descriptive use is relevant, provided it was foreseeable at the relevant dates.

[37] Para 38 *Agencia Wydawnicza Technopol sp. z o.o. v OHIM*, as quoted by Arnold J. (as he then was) in Starbucks.

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

85. The definitions of the words are not disputed by Coswell, save for the meaning of the prefix BIO which it accepts is connected with 'life' and 'living things' but nothing more. Ms Blythe argues that the concept of the prefix BIO ".. can be interpreted in context to have numerous meanings, such as the notion of respect for the environment, the use of natural ingredients or substances, the use of ecological manufacturing processes, a product which is not harmful to nature and health and goods which are biological, organic, ecological or biodegradable." Given these different meanings she argues that the average consumer would find the meaning of BIO as "vague" and "hard to decipher with any certainty in relation to dental products."

86. Dealing with the '877 mark first, when the word BIO is used in combination with the word REPAIR, Ms Blythe argues that:

> "…the combination of the elements does not convey a clear descriptive meaning……the consumer is required to interpret the meaning of the mark as a whole with the result that the relationship between the sign BIOREPAIR and the contested goods is insufficiently direct and specific such that the public concerned cannot immediately perceive without further thought, description of the goods or a characteristic thereof"; and
>
> "the conjoining of those two words into the composite term BIOREPAIR results in a combination that is not immediately decipherable as a descriptive term by the average consumer."

87. She challenges Mr Jacob's evidence of third party use as reflective of the position as at the relevant date, and that the evidence shows "brand name or product name"

use and not as a descriptor. The GC decisions upon which Dr Wolff relies[38] as to the meaning of the word BIO, are not said to reflect the descriptiveness of the signs, given that the meaning of the words may have changed or become more prevalent in use after the contested marks were filed.[39] Ms Blythe argues that the meaning of the words BIO and REPAIR would be understood across the EU, including by German and French speakers and therefore there would be no difference in perception of the terms in the UK.

88. I note the comments made by James Mellor K.C. in BREXIT O-262-18 namely:

> '11. …. just because a mark is on the Register does not mean it will be held valid when challenged. Furthermore, if the touchstone for registration was to be a comparison with marks already on the register, then registration would come to depend on the lowest common denominator. In any event, it is quite clear that the application of the section 3(1)(b) ground requires an assessment not against other marks on the register, but against the standard laid down in that provision, as interpreted in the case law.'

89. The fact that the terms were accepted in the EU does not prevent the trade mark being deemed invalid due to their descriptive nature in the UK, given that it is the view point of the English speaking UK consumer that is key to the assessment. The position in the EU has little bearing on my assessment, therefore.

90. Notwithstanding, that the prefix BIO may have more than one dictionary meaning, in the context of the goods at issue, Mr Jacob's evidence shows that within the cosmetic, toiletries and dental health industries, the term will be understood as meaning natural, environmentally friendly, free from chemicals and is good for health. The fact that the word BIO does not have one tangible meaning does not prevent it from invoking a positive response from the consumer as to the characteristics of the goods which are environmentally friendly, green, organic and natural, in a similar way to the word 'green' or 'eco' for example. 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.

[38] See T-586/08, T-610/14, and T-427/11 at footnote 26.
[39] See paragraph 61(b) of Ms Blythe's skeleton.

91. Of course I am not considering the word BIO or REPAIR in isolation as the sign must be regarded as a whole.

92. It is settled law that merely combining descriptive words does not provide them with a distinctive character unless there is a perceptible difference between the combination and the mere sum of its parts: *Campina Melkunie BV and Benelux-Merkenbureau,* Case C-265/00, EU:C:2004:87 (CJEU) at [39] to [41].

93. In this regard the words BIO and REPAIR in combination, do not in my view 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.

94. Moving on to consider the '865 mark. Coswell accepts that individually the words PRO and CLEAN are descriptive words, but it contends that their addition to the mark brings in additional semantic content that goes further to prevent the mark as a whole conveying an immediately perceivable descriptive message. It is said that the additional words requires even more of a mental effort on the part of the average consumer. Further, the presence of typographical and stylistic features and the geometric shape around the words PRO CLEAN will encourage the relevant public to perceive the mark as an indication of origin rather than a purely descriptive term.

95. In *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2013] F.S.R. 29, Arnold J. (as he then was) held that a descriptive word with a minor figurative embellishment was, as a whole, devoid of any distinctive character. He found that:

> "116. Taking all of the evidence into account, I conclude that the CTM is precluded [from registration by Article7(1)(c)] in relation to the services in issue because NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the service. The figurative elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word NOW, I consider that the CTM is devoid of distinctive character and thus unregistrable by virtue of Article 7(1)(b).

117. I would comment that it appears to me that PCCW only succeeded in obtaining registration of the CTM because it included figurative elements. Yet PCCW is seeking to enforce the CTM against signs which do not include the figurative elements or anything like them. That was an entirely foreseeable consequence of permitting registration of the CTM. Trade mark registries should be astute to this consequence of registering descriptive marks under the cover of a figurative figleaf of distinctiveness, and refuse registration of such marks in the first place."

96. A similar point arose in *Thomas Pink Ltd v Victoria's Secret UK Ltd,* [2014] EWHC 2631 (Ch), when Birss J. found that the registration of the descriptive word PINK (for clothing) with the letters in the colour pink, and 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).

97. And, further, in *Hormel Foods Corporation v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch), [2005] ETMR 54 ("SPAMBUSTER") at Decision at [24]:

"Additionally, whilst not specifically relating to Section 3(1)(b) alone, I note the findings in 'Spambuster' where it was held that in instances where words which are descriptive are presented in a format which encompasses elements of stylisation such as, for example, an unusual font, it may be considered that the sign merely represents those words 'in one particular manner'. This makes it clear that if there are other graphic elements present, along with descriptive words, we must consider whether such elements are sufficient to divert the consumer's attention away from, or modify, the descriptive elements. I believe the principal to be the same when it comes to non-distinctive words presented in a stylised typeface. In my opinion the graphic elements do not divert or modify the non-distinctive nature of the words."

98. In '*The Cannabis Clinic'* (BL O/777/21) At paragraph 57 Emma Himsworth K.C. commented as follows in so far as the use of devices and additional matters:

"In the context of an assessment of an application that is comprised of several elements where one or more of such elements are such as to designate a characteristic of the goods or services it is necessary for the decision taker to consider whether the other elements are such as to divert the average

consumer's attention away from or to modify the descriptive element or elements of the mark. That this is appropriate is confirmed both in the judgment of Arnold J. as he then was in *Starbucks (HK) Ltd v. British Sky Broadcasting Group Plc* [2013] FSR 29; and Case T-223/17 *Adapta Color, SL v. EUIPO* which were cited by the Hearing Officer. Any suggestion that the Hearing Officer should not have referred to the judgment of Arnold J. in this context is in my view unfounded."

99. Contrary to Coswell's submissions I find that the limited stylisation of the word 'Biorepair' and the use of the word in combination with 'PRO CLEAN' with the latter presented on a banner type device, which can only be described as a background, do not, in my view, divert attention away from the descriptive nature of the words BIO, REPAIR, PRO and CLEAN. 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. Despite there being some evidence to show that some members of the public regard the term BIOREPAIR/Biorepair PRO CLEAN as operating as a badge of origin, in the form of reviews uploaded by UK customers on Amazon's marketplace as filed by Dr Wolff, these are limited in number and in my view are not indicative of the market as a whole where generally the use is shown to be descriptive use and not use as a trade mark.[40]

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

[40] See Exhibit RMJ26.

elements of which it is composed. No further mental step would be necessary in order to understand the meaning perceived.

102. 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, namely toothbrushes and dental floss, are so closely connected to the class 3 and 5 goods, then the objection extends to these goods also.[41] It cannot be said that such is the close connection between the goods, that the terms are descriptive for one class and not the other and so the same findings would apply to all of Coswell's goods.

103. Consequently, I find that the invalidation action based on 3(1)(c) is made out.

Section 3(1)(b)

104. I now turn to the section 3(1)(b) objection. Section 3(1)(b) prevents the registration of a mark which is devoid of distinctive character. Where a sign is descriptive of particular goods it follows that it will also be non-distinctive. *C-90/11 and C-91/11 Alfred Strigl and Securvita,* EU:C:2012:147, [39]; C-363/99 *Koninklijke KPN Nederland NV* [2004] ECR I-161, [86].

105. 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.

[41] *Fourneaux De France Trade Mark*, Case BL-O/240/02, Mr Geoffrey Hobbs K.C.

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)."

106. I am of the view that I can deal with this ground relatively swiftly. This is because, Dr Wolff's pleaded case under 3(1)(b) is that the contested mark is devoid of distinctive character, on the basis that it is descriptive in accordance with section 3(1)(c). Given my findings above, it follows that as the invalidation reliant upon the 3(1)(c) ground has succeeded, Dr Wolff's reliance upon the 3(1)(b) ground must also succeed.

107. It is clear from the caselaw that for a mark to possess distinctive character it must serve to identify the services in issue as originating from a particular undertaking. Where a mark is wholly reliant on a descriptive word or words then it is unable to distinguish between various entities, such that it is incapable of fulfilling its essential function as a trade mark. The minimal stylisation in the '865 mark is insufficient to provide distinctive character to the words.

108. I am fortified in this view by Dr Wolff's evidence of third party use of the words as a trade mark which includes the words BIO, REPAIR, PRO and CLEAN being used descriptively in combination with house marks such as Colgate, Sensodyne and Oral B or with additional matters namely additional words or devices. This suggests to me that the proprietors of these marks do not see the aforementioned words in isolation or in combination as distinctive or sufficient by themselves to denote trade origin. This supports my view that the words BIOREPAIR/ Biorepair PRO CLEAN (fig) are incapable of fulfilling their essential function as trade marks to denote trade origin for dental/oral hygiene goods and are therefore incapable of identifying those goods as originating from a particular undertaking.

109. I find that the marks BIOREPAIR and BIOREPAIR PRO CLEAN (fig) are non-distinctive, under section 3(1)(b) of the Act.

Overall conclusion

110. Given that Coswell has not advanced a claim as to acquired distinctiveness then the invalidation actions under sections 3(1)(b) and (c) succeed in their entirety. Subject to appeal, the trade marks numbered 90629877 and 913028865 are invalidated and are deemed never to have existed.

Costs

111. Dr Wolff has been successful and is, therefore, entitled to a contribution towards its costs. Both parties advanced arguments that the costs relating to the strike out application should be determined off scale in favour of the successful party. On the substantive matter, that is on the section 3 grounds of invalidity, I agree with the parties that costs on scale costs are appropriate.

112. In assessing the off scale costs award sought by Dr Wolff, I note that Coswell's request to strike out Dr Wolff's claim was made at the tail end of the proceedings of the substantive claim. I consider that the timing of the application was a last ditch attempt to frustrate the invalidation action, either as a delaying tactic to frustrate the invalidation action itself or so as to delay the proceedings whilst it pursued its appeal at the EUIPO. It pursued this application despite my initial reservations when it was originally brought, that it had no merit.

113. I find that Dr Wolff was put to the extra costs of having to consider and prepare evidence and submissions in response to the strike out application. There appeared to be no basis for the claim that the invalidation action was brought as an abuse of process with no substantive or solid evidence to support its contention that the parties intended the previous commercial agreements to have effect in the UK, that the clauses within the Addendum were to survive termination and no suggestion that this is what the parties intended in 2008 and 2009. Coswell could have pursued a separate claim for breach of contract, if it considered there was sufficient cause for such an application. In my view bringing the application in the manner it did, was without merit and unreasonable. On this basis I find that Coswell should bear the burden of the costs incurred by Dr Wolff on an off scale basis in having to defend this claim.

114. Consequently, the above decision concludes my determination of the substantive issues in these proceedings, save in relation to the costs which I determine will be awarded to Dr Wolff on scale in relation to the section 3 invalidation action in accordance with Tribunal Practice Notice 2/2016 and off scale for the work undertaken in defending the strike out application. This decision will take effect as a decision when the question of costs is decided, and at that point but not before, the provisions relating to the right of appeal will come into operation.

115. I direct that within 14 days of this decision, Dr Wolff files submissions and a breakdown of the costs incurred in relation to the strikeout application. Coswell shall be given 14 days thereafter to file any submissions in reply. A letter accompanying this decision sets out the procedure for the filing of submissions on costs.

Dated this 6th day of September 2024

Leisa Davies

For the Registrar