

O-264-20

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 3333647
BY BIOCARE LIMITED
TO REGISTER THE FOLLOWING TRADE MARKS IN CLASS 5.**

BioAcidophilus

BIOACIDOPHILUS

(Series of two marks)

Background

1. On 23 August 2018, BIOCARE LIMITED ('the applicant') applied to register the above trade marks, as a series of two, for the following goods:

Class 05: *Preparations and substances for therapeutic or prophylactic use, including probiotic preparations and substances; probiotic preparations and substances in liquid, powder, and tablet form; probiotic preparations and substances sold in bottles, blister packs, pouches, sachets and stick packs; naturopathic, homeopathic, nutraceutical and probiotic preparations and substances; tonics; herbal tonics; vitamins; vitamin and mineral preparations and substances including in liquid, powder, and tablet form; vitamin and mineral preparations and substances sold in bottles, blister packs, pouches, sachets and stick packs; enzyme preparations and substances; antioxidant preparations and substances; combined probiotic and vitamin preparations and substances; combined probiotic and mineral preparations and substances; combined probiotic and antioxidant preparations and substances; combined probiotic and enzyme preparations and substances; products and preparations being therapeutic, prophylactic, naturopathic, homeopathic, nutraceutical or probiotic in liquid, powder, and tablet form; vitamin products and preparations containing lipids; combined probiotic and vitamin preparations containing lipids; products and preparations being therapeutic, prophylactic, naturopathic, homeopathic, nutraceutical or probiotic all containing fatty acids; vitamin products and preparations containing fatty acids; dietetic preparations and substances; dietary supplements including such supplements containing probiotic preparations and substances; food additives and supplements including such additives and supplements containing probiotic preparations and substances; food additives and supplements for therapeutic or prophylactic use; nutrients, nutritional supplements, nutritional preparations and substances; food additives for human use; infants' and invalids' foods; nutritional drinks, sports nutritional drinks; dietary preparations of freeze-dried emulsions of essential oils to be used primarily in the correction of nutritional deficiencies; products and preparations for making nutritional drinks and sports nutritional drinks; medicated sports nutritional drinks; powdered nutritional supplement drink mix; powders, syrups,*

concentrates and other preparations for making nutritional drinks and sports nutritional drinks; nutritional supplements for adding to drinks; suppositories; plant compounds and extracts for use as dietary supplements; vaginal suppositories; vaginal suppositories being pessaries; chemical pessaries; naturopathic, homeopathic and probiotic suppositories; naturopathic, homeopathic and probiotic preparations for use as pessaries; suppositories for therapeutic or prophylactic use; pessaries (being suppositories) for therapeutic or prophylactic use; veterinary preparations and substances; medicated or pharmaceutical preparations and substances for therapeutic or prophylactic use in animals; animal feed additives for use as nutritional supplements; veterinary preparations for the treatment of alimentary conditions in livestock; veterinary preparations for the treatment of alimentary conditions in domestic animals; dermatological preparations.

2. On 30 August 2018, the Intellectual Property Office ('IPO') issued an examination report in response to the application. The examination report contained objections under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act').
3. The section 3(1)(c) objection was raised on the basis that the mark consists exclusively of signs which may serve in trade to designate the kind of the goods, e.g. pharmaceutical preparations containing biological acidophilus. The examination report referred to the Collins English Dictionary definition of 'biological' as meaning "relating to biology or living organisms", and the Penguin English Dictionary definition of 'acidophilus' as meaning a "bacterium used to make yoghurt that has a beneficial effect on the digestive system". The examination report stated that the relevant consumer would understand that acidophilus refers to the active bacteria commonly found in goods such as dietary supplements and capsules, and that when combined with an additional descriptive term (Bio), the sign would be viewed as referring to an ingredient of the goods for which protection is sought.
4. The Section 3(1)(b) objection was not independent of the objection under section 3(1)(c), and the finding of non-distinctiveness was the automatic consequence of the sign being considered to be descriptive.
5. On 19 October 2018 Kieran Taylor of Swindell & Pearson who is the applicant's representative in this case requested a Hearing, and the date of 5 December 2018 was appointed. At the Hearing, Mr Taylor's main submission was that 'acidophilus' was not the name of a substance, but rather the correct term is 'lactobacillus acidophilus', and that the applicant had not seen or been presented with any evidence of the term 'acidophilus' being used alone.
6. On 10 December 2018, the IPO issued a Hearing Report which included the following extract from Merriam-Webster Dictionary:

Definition of acidophilus: a lactobacillus (*Lactobacillus acidophilus*) that is added especially to dairy products (such as yogurt and milk) or prepared as a dietary supplement, is part of the normal intestinal and vaginal flora, and is used therapeutically especially to promote intestinal health.

The Hearing Report stated that the Collins and Oxford English Dictionaries also refer to 'acidophilus' as being a lactic-acid product. The Hearing Report provided images of

supplements which are referred to as containing 'acidophilus', rather than 'lactobacillus acidophilus', including an image of the applicant's own product.

The Hearing Officer maintained the objection on the basis that the addition of the word 'bio' does not add any distinctive character to the descriptive word 'acidophilus'. She maintained that 'bio' is a well-known abbreviation for the term 'biological' and is commonly added to other words to indicate a biological factor. She concluded in her decision that consumers would not give any trade mark significance to the sign, but they would perceive the words as describing a type of supplement. The applicant was provided a period of 3 months to submit evidence of acquired distinctiveness.


7. On 11 March 2019, the attorney responded with a Witness Statement of Ms Emma Ellis, the Managing Director of BioCare Limited. The Witness Statement explained that BioCare Limited have been continuously selling probiotics under the signs BioAcidophilus and BIOACIDOPHILUS since 1993. The witness statement was accompanied by Exhibits EE001 – EE014. They are summarised below, and the summaries include the Hearing Officer's (HO) response found in the correspondence of 22 March 2019.

- EE001 – Extract from Companies House showing registration of the applicant's company BIOCARE LIMITED.
- EE002 – images of first use of the signs on probiotics in the UK - The Hearing Officer responded that the goods are sold under the mark 'BioCare®', with the term 'Bio-acidophilus' appearing as a description.
- EE003 – a copy of the applicant's catalogue, of which roughly 2000 were made - The HO responded that it shows the goods are sold under the mark 'BioCare®', with the term 'Bio-acidophilus' appearing as a description.
- EE004 – an extract from dolphinfitness.co.uk - The HO responded that it shows the goods are sold under the mark 'BioCare®' with a distinctive logo, and that the term 'Bio-acidophilus' appears as a description.
- EE005 – examples of packaging - The HO responded that it shows the goods are sold under the mark 'BioCare®', or a distinctive logo with the term 'Bio-acidophilus' appearing as a description
- EE006/007/008 – snapshot of results from a Google search of the term BioAcidophilus - The HO responded that although the applicant company appears extensively within the searches, the HO did not see any trade mark use of 'bioacidophilus'.
- EE009 – a table of units and total sales of goods sold under BioAcidophilus and BIOACIDOPHILUS between 2013 to February 2019. Total sales equal £6,257,064 - The HO found that although there had been considerable sales, the relevant market is big and it is unclear what market share the applicant has.
- EE010 – a table of units and total sales of exported goods sold under BioAcidophilus and BIOACIDOPHILUS between 2013 to February 2019, on a country to country basis - The HO found that although there had been considerable sales, the relevant market is big and it is unclear what market share the applicant has.
- EE011 – a table showing market spend between 01/03/2011 and 01/12/2018 - The HO found that the spend varied from year to year and did not seem to be considerable, with the highest amount dedicated to the sign BioAcidophilus being £76,568 in 2018 and the lowest being £21,536 in 2015.
- EE012 – further evidence of BioAcidophilus used on products - The HO found that the term appears to be used descriptively and sold under the trade mark BioCare®.

- EE013 – further evidence of BioAcidophilus used on products, appearing in publications - The HO found that the term appears to be used descriptively and sold under the trade mark BioCare®.
 - EE014 – evidence of the applicant’s attendance at trade shows and exhibitions - The HO did not consider there to be any use of the mark.
8. On 22 March 2019, the Hearing Officer informed the attorney that the evidence was insufficient for the purposes of demonstrating distinctiveness had been acquired through use. The Hearing Officer informed the attorney that they were entitled to request a further Hearing to discuss the evidence only.
 9. On 9 April 2019, Mr Taylor requested a Hearing to discuss the finding.
 10. The Hearing was held on 18 June 2019 with myself. At the Hearing Mr Taylor submitted that the sign was not descriptive, and made submissions to support the sign’s inherent distinctive character. I explained that the sign’s distinctive character in the prima facie, or lack thereof, had already been decided, and that the purpose of the Hearing was to discuss the probative value of the previously filed evidence of acquired distinctiveness. Mr Taylor disagreed that the prima facie acceptability of the sign had been decided, and was under the impression that the previous Hearing Officer was going to provide the “original papers” which indicated the mark was descriptive. Mr Taylor explained that he expected to receive dictionary extracts referred to in the previous hearing report issued on 10 December 2018. I explained that the dictionary extracts merely supported the Hearing Officer’s decision to maintain the objection.
 11. Mr Taylor submitted that all the hits from the Google search results, shown in exhibits EE006 – EE008, refer to the applicant and their products. Mr Taylor argued that this fact should be interpreted as proving the sign identifies trade origin. I explained that in a significant number of headings in the Google hits, the term BioCare® is used with the mark in suit, and that once the webpage is actually opened all of the applicant’s products, are used with the sign BioCare® or the following logo:



12. Mr Taylor stated that simply because BioAcidophilus is used in conjunction with BioCare®, or the logo does not mean that the sign BioAcidophilus is not recognized as an indicator of trade origin. Mr Taylor argued that it is common in trade for more than one sign to appear on the product, and that in this particular trade, it is normal for any descriptive elements to appear in small print, which is not the way the term BioAcidophilus has been used. Mr Taylor also submitted that because the products are relatively expensive, the consumer will be more attentive, and will have a heightened awareness of the sign.
13. On 1 July 2019, I issued my decision. In the decision I provided definitions of ‘Acidophilus’ from Merriam-Webster, Collins and Oxford English dictionaries, complete with screenshots and hyperlinks. For the avoidance of doubt I also provided my reasoning why I consider the mark is objectionable in the prima facie, which agreed with Ms Smith’s decision. I maintained that the term Acidophilus is used extensively in trade in a descriptive capacity to designate that the goods contain a bacteria supplement, and the additional term ‘Bio’ does not add distinctive character to the sign, but merely acts as an adjective/modifier/identifier to indicate that the Acidophilus is biological.

14. In the Hearing Report I further analysed the previously submitted evidence. In particular I calculated that the total sales of BioAcidophilus labelled products between 2013 – 2019 (EE009) equated to £1million per year, which I did not consider substantial. I also pointed out that the sales figures in EE010 were not specified as relating to the UK. In analysing the market spend data in EE011, I calculated that although the grand total was £3,751,214.48, the amount spent on marketing the sign specifically BioAcidophilus was actually only £375,117, which over a 7 year period equated to roughly £53,588 per annum. In addition, I referred to the fact that the examples of invoices for the exhibition stands, submitted at pages 5-20 of EE014, all showed use of BioCare® and the logo.
15. In the Hearing Report I also commented on the fact that in exhibits EE002, EE004 – EE009, and EE0012, all of which were examples of the products and their packaging, the term BioAcidophilus appeared exclusively in addition to the term BioCare® and/or the previously identified logo. I referred to the judgment of 7 July 2005, C-353/03 “*Have a break...*”, and submitted that whilst distinctiveness can be acquired as a result of use in conjunction with a separate mark, it was imperative that the relevant class of persons actually perceive the product, designated exclusively by the mark applied for and in and of itself, as originating from a given undertaking. I did not find this to be the case.
16. I provided the attorney the deadline of 2 September 2019 in order to file further evidence of acquired distinctiveness, and I referred to the criteria established in the joint judgments C-108/97 and 109/97, *Windsurfing Chiemsee* as a guidance, in particular the market share, geographical spread and trade recognition factors.
17. On 29 August 2019 a 2-month Extension of Time (EOT) was requested and granted. On 22 October a 3-week EOT was requested. This was granted but I made it clear that the extension should be considered final.
18. On 22 November 2019, a Witness Statement by Mr Jason Oakley, the Managing Director of BioCare Limited, was submitted. The Witness Statement contained submissions as to the mark’s acceptability in the prima facie, including the submission that the mark should not be considered to be descriptive based on any dictionary meaning as “there are some poorly drafted online dictionaries, rather than accurate scientific dictionaries”. In correspondence of 3 January 2020, I briefly explained that the issue of the sign’s inherent distinctiveness had previously been established, and pointed out that I disagreed the Oxford English Dictionary is a poorly drafted dictionary. The witness statement was accompanied by Exhibits JOAK1 – JAOK22. They are summarised below, and the summaries include my response as found in IPO correspondence of 3 January 2020:
 - JOAK01 – examples of packaging of the applicant’s goods – I found every sample of the packaging had both the additional term BioCare®, and the logo

 - JOAK02 – examples of advertising – I found every example of advertising included either the sign BioCare® or the logo (all further reference to “the logo” should be considered as the image above)
 - JOAK03 – a spreadsheet showing export sales from the UK into the overseas market – I found over £1,000,000 of export sales were recorded over a period of 6 years. This calculates to £166,666 per annum. Whilst this seems a reasonable figure, it is difficult to determine the prominence of the sign in the relevant mark

without other factors such as the applicant's market share. Also, there is no use of the mark applied for on the spreadsheets.

- JOAK04 – details of trade fairs and exhibitions the applicant has attended – I found the presence of the applicant at a trade show does not necessarily equate to trade mark use, and in the absence of exhibits showing use of the sign at the trade show, this exhibit carries little weight. I also note that the invoices for the trade-shows were all headed with the sign BioCare® and/or the logo.
- JOAK05 – JAOK16 – redacted invoices, showing a wide spread of sales throughout the UK – I found that whilst the invoices include sales of BIO-ACIDOPHILUS as the name of a product, every invoice was headed with the trade mark BioCare® and logo. The invoices were for internal purposes and, in my opinion, would likely be understood as a description of the product.
- JOAK17 – redacted invoice pertaining to a period of time after the date of application (2019).
- JOAK18 – evidence of product testing in 1994 and 1995, intended to show that the correct way to refer to the goods descriptively is *Lactobacillus Acidophilus*. The purpose of the evidence is to prove distinctiveness had been acquired as a result of use. The exhibit did not show use of the mark applied for.
- JOAK19 – examples of advertising from 1997 and 1999. Due to the fact that the samples were from a period of time of more than 20 years ago I did not consider them to add probative value.
- JOAK20 – articles from the Daily Mail dated 24 January and 4 July 1995. In response to a reader's question on how to combat chronic indigestion and Crohn's disease, the answer given was to take bioacidophilus twice daily. The article is over 25 years old, is isolated, and does not add probative value.
- JOAK21 – third party reviews of the applicant's products by Amazon.co.uk, Dolphinfitness.co.uk, and Foodsmatter.com – I found that in each instance, the product being reviewed was accompanied by the distinctive trade mark BioCare® and/or the logo.
- JOAK 22 – a problem summary list for goods sold under the sign BioAcidophilus between 2010 and 2019. I understand this is an internal document using product codes, and although the term BioAcidophilus is referred to as a product, the document is headed by the signs BioCare® and the logo. I do not consider this to reflect trade mark recognition from the perspective of the consumers.

19. Having reviewed the further evidence, in addition to the evidence previously submitted throughout the proceedings, I informed Mr Taylor that I did not consider the evidence to have demonstrated that distinctiveness had been acquired as a result of use of the sign. I subsequently refused the mark under Section 37(4) of the Trade Marks Act 1994 on the basis that the mark was descriptive of goods containing biological acidophilus and that acquired distinctiveness had not been shown to my satisfaction, taking account of the evidence in its totality.

20. On 28 January 2020, the applicant filed a Form TM5.

Decision

21. The relevant parts of section 3 of the Act read as follows:

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

(a) ...

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

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

(d) ...

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.”

The relevant legal principles - Section 3(1)(c)

22. There are a number of judgments from the CJEU which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 (recoded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1)(c) of the Community Trade Mark Regulation (the 'CTMR'), whose provisions correspond to section 3(1)(c) of the UK Act.
23. The main guiding principles which are relevant to this case are noted below:
- The words 'may serve in trade' include within their scope the possibility of future use even if, at the material date of application, the words or terms intended for protection are not in descriptive use in trade (see, to that effect, CJEU Cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots and Segelzubehor Walter Huber* and others;
 - As well as the possibility of future use, the fact there is little or no current use of the sign at the date of application is also not determinative in the assessment. The words 'may serve in trade' are to be interpreted as meaning, 'could' the sign in question serve in trade to designate characteristics of the goods/services, see e.g. BL O/096/11 'Putter Scope', a decision of the Appointed Person at para 11;
 - Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all. The provision therefore prevents such signs or indications from being reserved to one undertaking alone because they have been registered as trade marks (see judgment of 4 May 1999 in Joined cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots-und Segelzubehör Walter Huber and Franz Attenberger (Chiemsee)* [1999] ECR I-2779, at paragraph 25).
 - It is also a well-established principle that the Registrar's role is to engage in a full and stringent examination of the facts, underlying the Registrar's frontline role in preventing the granting of undue monopolies, see to that effect CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z.o.o. v OHIM* [2011] ECR I-1541 (*Technopol*).

- There must be 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 the goods and services in question or one of their characteristics - see CJEU Judgment C-468/01 P to C472/01 P *Procter & Gamble Company v OHIM* (Three-dimensional tablets for washing machines or dishwashers) at paragraph 39, and General Court Judgment T-222/02 *Robotunits* at paragraph 34.
- In light of all the foregoing, a sign's descriptiveness cannot be assessed other than by reference to the goods or services concerned, on the one hand, and by reference to the understanding which the relevant persons have of it, on the other (see judgment of 15 October 2003 in Case T-295/01 *Nordmilch eG v OHIM* ('*Oldenburger*') [2003] ECR - 4365, at paragraphs 27 to 34).

Application of legal principles – Section 3(1)(c)

The mark in the prima facie

24. The series of two marks applied for consists of BioAcidophilus and BIOACIDOPHILUS. For ease of reference when referring to the application for two marks I will only use the term BioAcidophilus, as the marks are considered to be conceptually identical. It is well established that upper or lower case font makes no difference in a case such as this.
25. The term 'BioAcidophilus' consists of the words 'Bio' and 'Acidophilus'. I consider the meaning of the words to have been firmly established during the proceedings and, in respect of the term 'Acidophilus', it has been supported by reference to highly reputable dictionaries, including hyperlinks to their online format. Nevertheless, I shall explain my opinion anew. The term 'Bio', I would argue, is categorically known as referring to 'Biological', or in the alternative, 'Biology'. For the avoidance of doubt I refer to the judgment of 5 December 2002, T-91/01, *BioID*, paragraph 28, where it was found that the prefix 'Bio' may constitute either an abbreviation of the adjective biological or biometrical, or the abbreviation of the noun biology. This was confirmed in C-37/03 P, *BioID*, at paragraph 12. The second term 'Acidophilus' is defined as a lactic-acid producing bacterium which is useful in restoring bacterial balance in the intestine (Collins Dictionary). It is frequently referred to in dictionaries as being used therapeutically to promote intestinal health. As a whole, the concept of the sign does not create an impression far removed from the simple combination of the descriptive parts. Rather, the concept of the sign BioAcidophilus is that of biological, lactic-acid producing bacterium designed to promote intestinal health.
26. The combination of words follows the rules of English grammar and syntax in so far as the adjective 'Bio' precedes the noun 'Acidophilus'. The sign will be read as Bio (adjective) Acidophilus (noun). The pause between the terms will be immediately obvious due to placement of the capital letters in the sign applied for, and/or by the natural break caused by the recognition of the prefix 'Bio'. I disagree with the attorney's submission that the term 'Bio' adds distinctive character to the sign, and will instead be understood in a purely descriptive capacity.
27. An assessment of the relevant consumer is important in coming to a conclusion as to the likely perception of the mark in the first instance. In *Matratzen Concord AG v Hukla Germany SA*, C-421/04 (*Matrazen*), the CJEU stated that:

"...to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, who are reasonably well informed and reasonably observant and circumspect, in the territory in respect of which registration is applied..."

28. I am also mindful of the decision of the General Court (formerly the Court of First Instance) in *Ford Motor Co v OHIM*, T-67/07 where it was stated that:
- “...there must be 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 the category of goods and services in question or one of their characteristics”.
29. It is clear from the aforementioned case law that I must determine whether or not the mark applied for will be perceived by the relevant consumer as a means of directly designating a characteristic of the goods being provided. In order to do this, I must assess who I consider the relevant consumer of the goods to be. The specification in Class 5 covers a broad range of goods. It includes the type of goods purchased by the general public such as *vitamins; infant foods and nutritional sports drinks*, as well as goods purchased by more specialist consumers who may have a specific interest and focused requirement, such as *dietetic preparations; probiotic substances; enzyme preparations; vaginal suppositories and veterinary preparations*. In general, due to the pharmaceutical, medicinal and veterinary nature of the goods in Class 5, the consumer of the goods is considered to be reasonably well-informed and circumspect.
30. It is reasonable to assume that more specialist consumers of the goods in Class 5 may have a specific interest in intestinal or vaginal health, for humans or animals. This is due to the fact that the term *Acidophilus* is defined as a lactobacillus that is used to promote vaginal and intestinal health. Because a specialist consumer tends to have specific needs, it is a reality that such consumer will have conducted research and will display due diligence when purchasing products intended to remedy or prevent intestinal or vaginal issues. Such a consumer is therefore not only likely to be aware that *acidophilus* is used therapeutically to promote intestinal and vaginal health, but will also understand that ‘Bio’ means biological. Therefore, when searching for goods which could be used to help remedy or prevent vaginal or intestinal issues, they will understand the term *Bio-Acidophilus* to describe an active ingredient. This would apply to an extensive list of goods in Class 5, including those not specifically identified as relating to intestinal or vaginal health. For example, whilst a specialist consumer with a pre-existing knowledge of what *Bio-acidophilus* is will expect it to be contained within goods such as *vaginal suppositories; and veterinary preparations for the treatment of alimentary conditions in domestic animals*, they will also assume that it is contained within the majority of less specific goods applied for, such as *probiotic preparations; homeopathic substances; dietetic preparations; dietary supplements; medicated preparations for prophylactic use in animals; infants and invalid’s food* etc. The assumption that the term is descriptive of an ingredient can even extend to goods which ordinarily fulfil other purposes. For example, whilst it is clear that *vitamins and tonics* can be used for more everyday conditions, such as vitamin C or iron deficiencies, the specialist consumer will assume that in instances whereby *vitamins and tonics* are sold under the term *BioAcidophilus* it is because they have been designed for promoting intestinal and vaginal health. It is also possible that such an assumption could even extend to some of the remaining goods, including *nutritional sports drinks*.

31. In relation to the general consumer of Class 5 products, who does not necessarily have a pre-existing or pre-determined specific interest in goods containing acidophilus for the purposes of remedying/improving vaginal and intestinal health in either humans or animals, they will still nevertheless assume that the goods contain Bio-Acidophilus. As previously identified, the consumer of Class 5 goods is considered to be reasonably well-informed and circumspect. Such a consumer already knows that the prefix 'Bio' refers to biological (see C-37/03 P *BioID* para 12). Such a consumer will also simply assume that the term 'Acidophilus' refers to an element contained within the goods. This is based on two main reasons. The first reason is that it is practice in the trade of goods in Class 5 to readily present information pertaining to their content, in order to allow a consumer to select the relevant product. The second reason is that, as identified by Ms Linda Smith in her examples, the term 'Acidophilus' is a frequent feature in relation to medicinal, pharmaceutical and veterinary products. Therefore, it is highly likely that a well-informed and circumspect consumer will already be aware of the existing use of the term Acidophilus in trade, and will also be aware of the trend in the trade to place information as the content of the product front-and-centre, and will ultimately therefore assume that Bio-Acidophilus is descriptive of a component/ingredient/element contained within all of the goods applied for in Class 5 to some degree.
32. It is settled law that the registrability of a sign must be assessed in context first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the relevant public's perception of the mark (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPNNederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50). The goods applied for can be summarised into two categories. The first category of goods can be identified as containing probiotics, enzymes, antioxidants for the purpose of being therapeutic, prophylactic, naturopathic, homeopathic products/preparations/substances etc. In relation to such a category of goods the specialist consumer will expect the term BioAcidophilus to refer to an ingredient contained within the goods. The second category of goods contains terms with concepts which are so broad that they could consist of a plethora of different products, for example, *vitamins, tonics, minerals, nutritional and sports drinks*. In relation to such goods the general consumer will assume that some level of BioAcidophilus is contained within them without having any need to actually know exactly what BioAcidophilus is. As such, I find the mark to directly describe the kind, nature and intended purpose of the goods¹.
33. Based on all of the above, and having taken careful consideration of the submissions from the applicant and the previous Hearing Officer, I find the mark applied for will be viewed as a term which directly designates characteristics (in this case, nature, type or ingredient) of the goods applied for. In the prima facie, I find the mark to be excluded from registration for the goods applied for under section 3(1)(c) and (b) as a consequence of the finding under (c).

Legal principles of acquired distinctiveness

34. The applicant has filed evidence throughout the proceedings for the purposes of indicating that distinctiveness has been acquired through use. The first tranche of

¹ C-239/05, BVBA 34: "...an examination of the grounds for refusal listed in Art.3 of the Directive must be carried out in relation to each of the goods and services for which trade mark registration is sought and, secondly, that the decision of the competent authority refusing registration of a trade mark must, in principle, state reasons in respect of each of those goods or services". 37: "However, where the same ground of refusal is given for a category or group of goods or services, the competent authority may use only general reasoning for all of the goods and services concerned."

evidence was considered to be insufficient for the purposes of proving distinctiveness had been acquired on both 22 March 2019, by the original Hearing Officer Ms Linda Smith, and again by myself on 1 July 2019. The second tranche was also found to be insufficient for such purposes by me on 3 January 2020. The previously filed evidence will, however, be revisited in this Statement of Grounds.

35. The CJEU provided guidance in *Windsurfing Chiemsee* (see judgment of 4 May 1999 in Joined cases C-108/97 and C-109/97) about the correct approach to the assessment of distinctive character acquired through use, setting out the relevant test in paragraph 55:

“...the first sentence of Article 3(3) of the First Directive 89/104/EEC is to be interpreted as meaning that:

- *A trade mark acquires distinctive character following the use which has been made of it where the mark has come 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 goods of other undertakings;*
- *In determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;*
- *If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;*
- *Where the competent authority has particular difficulty in assessing the distinctive character of the mark in respect of which registration is applied for, Community law does not preclude it from having recourse, under the conditions laid down by its national law, to an opinion poll as guidance for its judgment.”*

36. I am also mindful of the CJEU decision in *Bovemj Verzekeringen NV v Benelux Merkenbureau (Europolis)* C-108/05, where it was held that a trade mark may be registered on the basis of acquired distinctiveness “...only if it is proven that the trade mark has acquired distinctive character through use throughout the territory of a member state”.

37. The proviso to section 3 based on acquired distinctiveness does not establish a separate right to have a trade mark registered. It allows an exception to, or derogation from, the grounds of refusal listed in section 3(1)(a) - (d) and as such, its scope must be interpreted in light of those grounds of refusal - see e.g. case T-359/12 *Louis Vuitton Malletier v OHIM* and case law referred to at para [83]. The established principles to consider when assessing a claim to distinctiveness acquired through use can be summarised as follows:

- Mere evidence of use, even if substantial, does not make the case for acquired distinctiveness.

- A significant proportion of the relevant consumers need to be educated that the sign has acquired distinctiveness.
 - If, to a real or hypothetical individual, a word or mark is ambiguous in the sense that it may be distinctive or descriptive then it cannot comply with the requirements of the Act for it will not provide the necessary distinction or guarantee.
 - It follows that, with regard to the acquisition of distinctive character through use, the identification by the relevant class of persons of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark. The expression 'use of the mark as a trade mark' in section 3 refers solely to use of the mark for the purposes of the identification, by the relevant class of person, of the product as originating from a given undertaking.
 - Acquired distinctiveness cannot be shown by reference only to general, abstract data such as predetermined percentages (see also *Windsurfing Chiemsee* (para [52]) case and others).
 - The mark must have acquired distinctiveness through use throughout the territory of the UK.
38. Also of relevance is the consideration that since a trade mark enjoys protection as of its filing date, and since the filing date of the application for registration determines the priority of one mark over another, a trade mark must be registrable on that date. Consequently, the applicant must prove that distinctive character has been acquired through use of the trade mark prior to the date of application for registration (judgments of 11/06/2009, C-542/07 P, *Pure Digital*, EU:C:2009:362, § 49, 51; and 07/09/2006, C-108/05, *Europolis*, EU:C:2006:530, § 22).

Application of the legal principles - acquired distinctiveness

39. Paragraph 51 of the joint judgments C-108/97 and 109/97 *Windsurfing Chiemsee* provided 5 criterion to be taken into account when assessing demonstration of distinctive character: i) the market share held by the mark; ii) how intensive, geographically widespread and long-standing use of the mark has been; iii) the amount invested by the undertaking in promoting the mark; iv) the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; v) and statements from chambers of commerce and industry or other trade and professional associations. The evidence submitted will be assessed against each factor.
40. i) and iii): The market share held by the mark has not been provided during the submissions. The lack of information pertaining to the market share was directly mentioned as a deficiency in the probative value of the evidence in the Hearing Report of 1 July 2019. The lack of market share affects the perception of the value of the financial figures provided. Within the first tranche of evidence was the exhibit EE009, which showed total sales of goods sold under the mark applied for to have been £6,257,064 during a 6-year period. This calculates to roughly £1,043,000 per annum. Within the first tranche was also exhibit EE010 showing sales of goods exported from the UK, and therefore not pertinent for the purposes of proving distinctiveness has been acquired in the relevant member state (see 108/05, *Europolis*). This applies also

to JAOK3. Also, within the first tranche was exhibit EE011, which referred to total marketing spend for BioAcidophilus branded goods of £375,117 between 1 March 2011 and 1 December 2018. This equates to roughly £53,500 per year. Without the market share it has proven difficult to gauge the significance of the financial figures provided. I will conclude, however, that in general terms £1,043,000 in sales per annum and £53,500 in marketing expenditure per annum does not immediately strike me as significant in relation to the goods claimed.

41. ii) Information pertaining directly to the geographical spread of the mark within the UK has not been provided, even though the lack of information relating thereto was identified as a deficiency in the probative value of the evidence in the Hearing Report of 1 July 2019. Although in the second tranche of evidence the exhibit JOAK04 referred to exhibitions and trade shows in the UK attended by the applicant, it is not possible to discern whether or not this resulted in trade mark exposure, especially because no evidence of use of the sign at the trade-shows had been provided, and also because the invoices for the trade-shows were all headed with the distinctive sign BioCare® and/or the logo, as opposed to the mark applied for.
42. No submissions or evidence have been provided during any stage of the proceedings referring to numbers iv) or v) of the *Windsurfing Chiemsee* criterion.
43. The *Windsurfing Chiemsee* criterion are by no means a tick-box list of essential criteria, and an assessment of the probative value of evidence of acquired distinctiveness should not be restricted to them. However, so far my analysis of the evidence has not found that a significant percentage of the relevant class of consumer has been educated to the fact that the sign applied for is an indicator of trade origin.
44. A significant further consideration for the evidence that has been submitted is the fact that in the majority of instances the manner in which the mark has been used is significantly different from the mark which has been applied for. In nearly every instance of use of the term BioAcidophilus on packaging, or in catalogues, or on invoices, or on 3rd party website, it is accompanied by the trade mark BioCare® and or



45. This fact does not automatically render the evidence submitted as irrelevant or insufficient. The judgment of 7 July 2005, C-353/03 "*Have a break...*" made it clear that a sign can acquire distinctive character as a result of secondary use or through its use in conjunction with another sign:

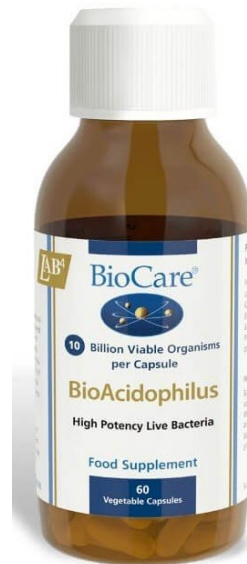
27 *In order for the latter condition, which is at issue in the dispute in the main proceedings, to be satisfied, the mark in respect of which registration is sought need not necessarily have been used independently.*

28 *In fact Article 3(3) of the directive contains no restriction in that regard, referring solely to the 'use which has been made' of the mark.*

30 *Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, **the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking [emphasis added].***

32 *In the final analysis, the reply to the question raised must be that the distinctive character of a mark referred to in Article 3(3) of the directive may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.*

46. An example of how the term applied for is used on the applicant's products is shown on the bottle of 60 BioAcidophilus Caps, sold on the applicant's website:



In my opinion I would view the term BioAcidophilus as a description of the product. That is to say I believe that the consumer would perceive the term BioCare® and the logo as being the indicators of trade origin, and the term BioAcidophilus as being a description of the kind of goods. I feel that this is compounded by the fact that the term BioCare® is a registered trade mark, which the consumer will pick up on, and also because on the applicant's website the goods are sold as 'BioAciophilus 60 Caps'. I interpret this to reflect the fact that the applicant uses the term to describe the content of the goods they sell.

47. This example reflects a number of the other forms of use provided in the evidence submitted, whereby the term BioAcidophilus appears descriptively in a document headed by the combination of BioCare® and the logo. So frequently and dominantly is this the pattern presented in the evidence that I do not believe that the consumer would ignore the two other distinctive elements, especially in the way they are presented and placed, and focus instead on the sign BioAcidophilus as the indicator of trade origin. I am of the view that the consumer of the goods in Class 5, who is considered to be relatively well-informed and circumspect, will not perceive the sign applied for as a designator of trade origin, but will rather see it as a descriptor of the goods sold under the marks BioCare® and the logo.

48. Taking the evidence as a whole, I am unable to conclude or infer that the applicant has educated a significant proportion of the relevant consumers to believe that the marks applied for indicate trade origin.

Conclusion

49. Having given due care and attention to all of the arguments put forward during the proceedings, the application is refused under Section 3(1)(c) for all goods in Class 5. This conclusion reflects the fact that the evidence of purported acquired distinctiveness was considered insufficient.

Dated this 28th day of April 2020

**Dafydd Collins
For the Registrar
Comptroller-General**

Annex

<https://www.merriam-webster.com/dictionary/acidophilus>

acidophilus noun

 Save Word

aci-doph-i-lus | \ , a-sə-ˈdā-f(ə-)ləs

Definition of *acidophilus*


: a lactobacillus (*Lactobacillus acidophilus*) that is added especially to dairy products (such as yogurt and milk) or prepared as a dietary supplement, is part of the normal intestinal and vaginal flora, and is used therapeutically especially to promote intestinal health

also : a preparation containing such bacteria

<https://www.collinsdictionary.com/dictionary/english/acidophilus>

Definition of 'acidophilus'

acidophilus

Word Frequency 



in British English

(.æsiˈdɒfɪləs)

NOUN

biology

a lactic-acid-producing bacterium primarily found in live yoghurt, useful in restoring bacterial balance in the intestine

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<https://www.oed.com/view/Entry/1568?redirectedFrom=acidophilus#eid>


acidophilus, *adj.* and *n.*

Text size: 

View as: [Outline](#) | [Full entry](#)

Quotations: [Show all](#) | [Hide all](#) | [Keywords: On](#) | [Off](#)

Pronunciation: Brit.  /,asiˈdɒfɪləs/, U.S.  /,æsəˈdɒfələs/

Frequency (in current use): 

Origin: A borrowing from Latin. **Etymon:** Latin *acidophilus*.

Etymology: < scientific Latin *acidophilus* in *Bacillus acidophilus* (now ... (Show More)

A. *adj.*

attributive. Designating milk and other food products and dietary supplements that contain certain fermenting bacteria, esp. *Lactobacillus acidophilus*, and are consumed esp. in probiotic diets; (also) designating such bacteria. Frequently in ***acidophilus milk***.

[Thesaurus »](#)
[Categories »](#)

Examples of supplements included in Hearing Officer Linda Smith's Hearing Report of 10 December 2018.

