

O/0624/26

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATIONS

UK00906235873 AND UK00906235501

IN THE NAME OF BIOGAIA AB

AND

RESPECTIVE APPLICATIONS 508373 AND 508374

BY NOOS SRL

FOR DECLARATIONS THAT THE AFORESAID REGISTRATIONS ARE INVALID

Background and Pleadings

1. This decision concerns a consolidation of two invalidation actions: CA508373 and CA508374.
2. The following trade marks¹ stand registered in the name of BioGaia AB, the Registered Proprietor ('the RP'):

UK906235873 ('the Prodentis Mark'): Lactobacillus reuteri Prodentis	UK906235501 ('the Protectis Mark'): Lactobacillus reuteri Protectis
The following details apply to both marks: Filing date: 29 August 2007 Date of entry in Register: 28 January 2009 <u>Priority details</u> Priority date: 15 March 2007 Priority country: Sweden	
The Prodentis Mark claims priority from the TM 2007/02402, which applies to the whole of the registration.	The Protectis Mark claims priority from the TM 2007/02403, which applies to the whole of the registration.
Both marks are word marks, ² registered for the following goods:	

¹ Both rights are comparable marks pursuant to Article 54 of the Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (2019/C 384 I/01), also known as the 'Withdrawal Agreement', based on EUTMs which were registered prior to the withdrawal of the UK from the European Union.

² In *LA Superquímica v EUIPO*, Case T-24/17, at paragraph [39] it was held that:

'[...] it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO — Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited).'

Class 3: *Medicated dental care preparations.*

Class 5: *Pharmaceutical preparations; dietetic substances adapted for medical use; food for babies; bacteriological cultures, bacteria and bacterial preparations, and biological and biochemical preparations for medical purposes and healthcare; lactic acid bacteria, lactobacillus; chewing-gum, lozenges, pastilles and mouthwashes for medical purposes.*

Class 29: *Milk, milk-based beverages, yoghurt, milk products.*

Class 32: *Non-alcoholic drinks.*

3. On 28 January 2025, NOOS SRL, the Cancellation Applicant ('the CA') applied to invalidate the Prodentis and Protectis Marks, pursuant to sections 47(1), 3(1)(b), 3(1)(c) and 3(1)(d) of the Trade Marks Act 1994 ('the Act').
4. The CA claims that each of the marks is incapable of indicating trade origin because it is: devoid of distinctive character (section 3(1)(b)); consists exclusively of indications which may serve, in trade, to designate the kind, quality, purpose and characteristics of the goods (section 3(1)(c)); and that these indications have become customary in the current language to describe certain goods with certain ingredients (section 3(1)(d)).³ For each invalidation action, all three grounds are directed to the entire registration.
5. The claims against the Prodentis Mark (CA508373):

(i) Under **section 3(1)(b)**, the CA claims that the 'Lactobacillus reuteri' element of the Prodentis Mark is a reference to the bacterium from the 'Lactobacillaceae family' that naturally colonises the gastrointestinal tract of humans and animals.⁴ It is claimed that Lactobacillaceae reuteri has 'health benefits' and that it is, therefore,

³ Final paragraph of CA's respective Statements of Grounds.

⁴ CA's Statements of Grounds, [3].

considered a 'probiotic'; with some 'strains' having therapeutic uses for various intestinal disorders such as infant colic.⁵ As to the 'Prodentis' element, the CA claims that this word 'implies protective qualities, suggesting a health benefit [...] pertaining self-evidently to dental health'.⁶ The CA argues that the Prodentis mark is, therefore, incapable of indicating the trade origin of the goods.

(ii) Under **section 3(1)(c)**, the CA claims that the Prodentis Mark consists solely of the descriptive terms 'Lactobacillus reuteri' and 'Prodentis', where:⁷

'LACTOBACILLUS' is the name of the genus;

'REUTERI' is the name of the species;

and

'PRODENTIS' suggests a connection with dental health, potentially alluding to the Latin root 'PRO' (meaning 'in favour'/'on behalf of') and the Latin word 'DENTIS' (being the singular form of the word 'dens', relating to 'teeth').

As to the 'Prodentis' element, the descriptiveness claimed by the CA is twofold; in that it has 'positive connotations' in terms of oral/dental health benefits, as well as indicating an intended purpose (i.e. oral health, dental protection).

(iii) Under **section 3(1)(d)**, it is claimed that 'Lactobacillus reuteri' is a scientifically recognised name for 'the specific probiotic strain widely used as a therapeutic agent in various health applications, particularly in oral health and as a supplement added to food products, dietary products, drinks, pharmaceutical preparations and the like'.⁸ The CA claims that the 'Prodentis' element will be understood by the relevant public in the way described above at [5(ii)].

6. The claims against the Protectis Mark (CA508374):

⁵ CA's Statement of Grounds for CA508373, [3].

⁶ As above.

⁷ CA's Statement of Grounds for CA508373, [4].

⁸ As above, [5].

(i) Under **section 3(1)(b)**, the CA makes essentially the same claims with respect to the words ‘Lactobacillus reuteri’ as noted above at [5(i)]. It is claimed that the word ‘Protectis’ ‘implies protective qualities, suggesting a health benefit associated with the probiotic strain’.⁹

(ii) Under **section 3(1)(c)**, the CA makes the same claims with respect to the words ‘Lactobacillus reuteri’ as noted above at [5(ii)]. It is claimed that ‘Protectis’ will be understood as noted above at [6(i)].

(iii) Under **section 3(1)(d)**, the CA claims that ‘Lactobacillus reuteri Protectis’ is a scientifically recognised name for ‘the specific probiotic strain widely used as a therapeutic agent in various health applications, particularly in oral health and as a supplement added to food products, dietary products, drinks, pharmaceutical preparations and the like’.¹⁰

7. Further, the RP claims that both the Prodentis and Protectis Marks have been used since 2007 and that they have acquired distinctive characters as a result of such use.¹¹ I will address this claim at [17], after setting out the relevant legislation.
8. The RP filed respective defences and counterstatements in which it denies the claims against it in their entireties and puts the CA to proof of all aspects of the aforesaid claims.¹² The RP argues that the presence of the distinctive and fanciful words ‘Prodentis’ and ‘Protectis’ automatically renders the respective marks, as wholes, ‘not descriptive’, but ‘distinctive’.¹³
9. The CA is represented by ip21 Limited. The RP is represented by Forresters IP LLP. Both parties filed evidence. The CA filed two ‘sets’ of written submissions; one to accompany its evidence (dated 3 June 2025), and another in reply to the RP’s evidence (dated 26 September 2025). A hearing was neither requested nor considered necessary. Only the RP filed written submissions in lieu of a hearing.

⁹ CA’s Statement of Grounds for CA508374, [3].

¹⁰ CA’s Statement of Grounds for CA508374, [5].

¹¹ RP’s respective counterstatements, [13].

¹² RP’s respective counterstatements, [10] – [14].

¹³ RP’s respective counterstatements, [11] – [12].

The following decision has been made after careful consideration of the papers available to me.

RELEVANCE OF EU LAW

10. 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.

EVIDENCE AND SUBMISSIONS

11. The CA's evidence comes from Giancarlo Moretti, CEO for the CA. Mr Moretti's Witness Statement is dated 11 June 2025 and is accompanied by exhibits 1-12. The CA's written submissions are dated 3 June 2025 and 26 September 2025, respectively.
12. The RP's evidence comes from Mark Bhandal, Chartered Trade Mark Attorney and Senior Associate of the RP's representative. Mr Bhandal's Witness Statement is dated 2 September 2025 and is accompanied by three exhibits: Annexes MB01 – MB03.
13. The RP's written submissions in lieu of a hearing are dated 29 October 2025.
14. I confirm that I have read all of the evidence and submissions and will refer to them in my decision to the extent that they are relevant.

DECISION

The relevant legislation

15. Section 47 of the Act states 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 that 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.’

16. Section 3 of the Act states as follows:

‘3(1) The following shall not be registered-

[...]

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

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

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

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

[my parentheses and underline added]

17. At this point, it is appropriate to comment on the RP's pleading on acquired distinctiveness, noted at [7]. The wording that I have underlined at [16] makes it clear that, for a mark to overcome an objection under sections 3(1)(b), 3(1)(c) or 3(1)(d) based on acquired distinctiveness, the aforesaid distinctiveness must have been acquired before the date of application for registration. As noted at [2], the Prodentis and Protectis Marks are both UK comparable marks. They have the same legal status as if they had been applied for and registered under UK law and retain the original filing dates of the EUTMs (which were valid at the end of the Exit period), as well as any priority dates (or seniority dates, where appropriate). The RP's claim that the marks have acquired distinctive character because of the use that was made of them 'since 2007' appears to refer to distinctiveness acquired after the filing dates (29 August 2007). Any distinctiveness acquired *after* the filing date is incapable of overcoming a section 3 invalidation claim. In any event, the RP has elected not to file any evidence to support its claims to acquired distinctiveness.¹⁴

18. I bear in mind that the grounds under section 3 of the Act operate independently of one another and call for separate examination.¹⁵ There is nevertheless some interplay between them. For example, a word mark which is descriptive of characteristics of goods/services and, therefore, falls foul of section 3(1)(c) of the Act, will necessarily be devoid of any distinctive character and, therefore, also fall

¹⁴ RP's written submissions in lieu of a hearing, [11].

¹⁵ *Postkantoor*, [2006] Ch.1, at [67].

foul of section 3(1)(b) of the Act.¹⁶ However, because descriptiveness is not the only condition that can render a mark devoid of distinctive character, a mark may fall foul of section 3(1)(b) without also falling foul of section 3(1)(c).¹⁷ Similarly, a mark may fall foul of section 3(1)(d) and/or 3(1)(b) without being objectionable under section 3(1)(c). In short, sections 3(1)(c) and 3(1)(d) deal with particular situations, whereas section 3(1)(b) might be said to be a general ‘sweep up’ provision.¹⁸

The relevant date

19. A declaration of invalidity is akin to declaring that the contested mark should not have been registered in the first place. The relevant dates under sections 3(1)(b), 3(1)(c) and 3(1)(d) are, therefore, the earliest effective dates of filing of the Prodentis and Protectis Marks. Both marks have a filing date of 29 August 2007 (‘the Relevant Date’).

The relevant public

20. The CA has submitted the following:¹⁹

‘According to the principle enshrined in section 3(1)(c) of [the Act], a sign cannot be registered if a non-negligible portion of the relevant public perceives it as purely descriptive of the goods and services it is used for. The community of scientists, patients, pharmacists familiar with this scientific ingredient [i.e. ‘*Lactobacillus reuteri*’] and its renowned benefits associated with the strains in question constitute each and/or collectively clearly a non-negligible portion of the relevant public in the United Kingdom’.

[My wording added in parentheses]

¹⁶ *Postkantoor*, [2006] Ch.1, at [86].

¹⁷ As above, at [87].

¹⁸ *Kerly’s Law of Trade Marks and Trade Names*, 17th Ed., at [10-064].

¹⁹ CA’s written submissions of 3 June 2025, [18].

21. I have two observations on this submission. Firstly, my view is that the CA's argument indicates an erroneous reading of the relevant law. The case law makes it clear that a mark does not have to be universally distinctive in order for it to be registrable; and that it is sufficient for it to be distinctive according to the perceptions of a significant proportion of the relevant public: *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* (C-299/99), at [59] – [61].²⁰ It therefore follows that even if a 'non-negligible portion of the relevant public' does understand a sign to be wholly descriptive, this is not necessarily enough to render the sign non-registrable.

22. Secondly, putting aside the CA's erroneous statement of the law, the construction of the (albeit unsound) argument indicates that it considers the relevant public to comprise scientists, patients and pharmacists at large (with the 'non-negligible portion' a reference to those scientists/patients/pharmacists who will be familiar with the aforesaid ingredient).

23. The RP submits that the average consumer is the ordinary public.²¹

24. I find that the goods in classes 3, 29 and 32 will typically be purchased by the ordinary public. The aforesaid goods are typically sold in shops, including supermarkets, and their online equivalents. However, I consider some of the class 5 goods to be specialised and typically aimed at professionals rather than the general public; whilst others will likely be purchased by both professionals and the public at large. The class 5 goods, therefore, deserve closer consideration.

Class 5:

Bacteriological cultures, bacteria and bacterial preparations, and biological and biochemical preparations for medical purposes and healthcare; lactic acid bacteria, lactobacillus

²⁰ Also known as: *Philips Electronics NV v Remington Consumer Products Ltd*.

²¹ RP's written submissions in lieu of a hearing, [34].

25. My view is that the above class 5 goods are specialised and likely aimed at professionals only. It is my understanding that biochemical, biological and bacterial preparations are typically substances used in laboratory or industrial settings, rather than products sold to the general public. Whilst there are products on the market which might include bacteriological cultures and the like, the bacterial culture itself will unlikely be available for purchase by the general consumer.

Pharmaceutical preparations; dietetic substances adapted for medical use; food for babies; chewing-gum, lozenges, pastilles and mouthwashes for medical purposes.

26. I find that the above class 5 goods will be purchased by both professionals and general consumers alike. It is my understanding that 'pharmaceutical preparations', put simply, are medicinal products intended to treat or alleviate health conditions. This broad term will encompass a very wide range of goods, including, *inter alia*: over-the-counter medicines (e.g. aspirin); prescription drugs (e.g. antibiotics); and highly specialised drugs exclusively for professionals (e.g. anaesthetics).

Section 3(1)(c)

27. I shall deal with this ground first, given its centrality to the CA's case. The case law relating to this section (which corresponds with Article 7(1)(c) of the EU Trade Mark Regulation, formerly the Community Trade Mark ('CTM') Regulation) was set out by Arnold J (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

'91. The principles to be applied under Article 7(1)(c) of the CTM Regulation were conveniently summarised by the Court of Justice of the European Union ('the CJEU') in Case C-51/10P *Agencja Wydawnicza Technopol sp. z o.o. v OHIM* [2011] ECR I-0000, [2011] ETMR 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, Case C-265/00 *Campina Melkunie* [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94 , see Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 30, and the order in Case C-150/02 P *Streamserve v OHIM* [2004] ECR 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*, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 45, and Case C-48/09 P *Lego Juris v OHIM* [2010] ECR I-0000, 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 Case C-80/09 P *Mergel and Others v OHIM*, 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 58). 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).

...

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 89/10, *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 89/10, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in Article 7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see Case C-191/01 P *OHIM v Wm Wrigley Jr Co* [2003] ECR I-12447 at [32] and Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 at [97].’

28. Whether the contested marks are descriptive must be assessed through the eyes of the relevant parties, as the CJEU held in *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. In paragraph 24 of that decision, it described the relevant parties as in trade or the average consumers of the goods and services in question, ‘*reasonably well-informed and reasonably observant and circumspect*’. The case law quoted above in *Starbucks* makes it clear that a mark will be caught by this section if the relevant parties can easily recognise that it designates a characteristic of the goods and services, such as their geographical origin.

29. I also note the following guidance from the key ‘Practitioner’ text, Kerly’s Law of Trade Marks and Trade Names:²²

‘Although these grounds are “absolute”, this does not mean that the sign in question is considered in a vacuum. Far from it. The tribunal must ensure that it is sufficiently educated about the relevant trade so that it is able properly to assess applicable grounds. This is obvious in the case of s.3(1)(d) of the 1994 Act, but no less important in assessing the grounds in ss. (1)(c), (2) and (3). [...].’

The CA’s evidence

30. The documentary evidence comprises the following materials:

- Extracts from:

²² 17th Ed., at [10-016].

(i) the website of the International Scientific Association for Probiotics and Prebiotics ('ISAPP'), a leading organisation providing guidance in the field of probiotics;²³

(ii) an online repository 'the Probiotic database by Optibac probiotics' ('the Optibac database');²⁴

and

(iii) a document titled 'World Gastroenterology Organisation Global Guidelines: Probiotics and prebiotics' ('the Global Guidelines').²⁵

- A selection of articles and abstracts from scientific journals.²⁶
- Product listings from Amazon.co.uk.²⁷
- Entries from online dictionaries.²⁸

31. Mr Moretti has stated that the CA is an Italian pharmaceutical company founded in 1999, with over 25 years of experience in designing, testing and developing 'high-quality food supplements and medical devices'.²⁹ His narrative on the meaning of the 'LACTOBACILLUS REUTERI' element of the Prodentis and Protectis Marks can be summarised as follows:

- according to the ISAPP, 'Lactobacillus reuteri', is a bacterium from the Lactobacillaceae family, present in 'the gastrointestinal tract of humans and animals';³⁰
- Lactobacillus reuteri is an example of a 'probiotic'. Probiotics are known by their genus, species and strain; with 'lactobacillus' being the genus and

²³ Witness Statement of G. Moretti, [4].

²⁴ Exhibit 1; CA's written submissions of 3 June 2025, [6].

²⁵ Exhibit 1.

²⁶ Exhibits 3 – 10, and 12.

²⁷ Exhibit 11.

²⁸ Exhibit 2.

²⁹ Witness Statement of G. Moretti, [2].

³⁰ As above, [4].

‘reuteri’ being the species.³¹ A ‘descriptive strain’ is then added to indicate the ‘health effect’ of the probiotic in question.³²

32. In support of the aforesaid narrative, Mr Moretti has introduced an excerpt from the ISAPP website, dated 2019,³³ from which I note the following passages:³⁴

‘The term ‘probiotic’ was defined in 2001 by an Expert Consultation of the Food and Agricultural organization of the United Nations and the World Health Organization (FAO/WHO). [...] In 2013, ISAPP convened an Expert Panel to review the term probiotic and literature surrounding it. The net result was a publication reiterating the definition [...]: “Live microorganisms that, when administered in adequate amounts, confer a health benefit on the host.” This is the widely accepted definition of probiotics around the world.

[...]

Probiotics are known by genus, species and strain: for example, *Lactobacillus acidophilus* ABC. The strain designation is important, as different strains of the same species may have different health effects.

[...]

What are probiotics?

Scientists define probiotics as live microorganisms that, when administered in adequate amounts, confer a health benefit on the host. They can help support gut bacteria that live with us, especially when our bacteria are challenged, for example by antibiotics, poor diet or travelling, Probiotics are present in numerous foods and dietary supplements.’

³¹ Witness Statement of G. Moretti, [4] – [5].

³² As above, [5].

³³ According to the copyright notice.

³⁴ Exhibit 1.

33. Exhibit 10 comprises eight scientific abstracts, ranging from 1998 to 2025, concerning studies of *Lactobacillus reuteri*.³⁵ Six are dated prior to or circa the Relevant Date. All refer to *Lactobacillus reuteri*, variously, as a 'probiotic' or a 'lactobacillus species'.

The Global Guidelines document

34. Further, the CA has identified the following passages from the Global Guidelines document, dated February 2017, to describe the 'use of the International strain designation' system:³⁶

'A probiotic strain is identified by the genus, species, subspecies (if applicable) and an alphanumeric designation that identifies a specific strain. In the scientific community, there is an agreed nomenclature for microorganisms—for example, *Lactobacillus casei* DN-114 001 or *Lactobacillus rhamnosus* GG. Marketing and trade names are not controlled by the scientific community. According to WHO/FAO guidelines (<http://www.fao.org/3/a-a0512e.pdf>), probiotic manufacturers should register their strains with an international depository. Depositories will give an additional designation to strains.

[...]

Using strain designations for probiotics is important, since the most robust approach to probiotic evidence is to link benefits (such as the specific gastrointestinal targets discussed in this guideline) to specific strains or strain combinations of probiotics at the effective dose.'

35. There are some references in the documentary evidence to 'LACTOBACILLUS REUTERI PROTECTIS'.³⁷ I address these in the following paragraphs [36] – [41].

The Optibac database

³⁵ Witness Statement of G. Moretti, [15].

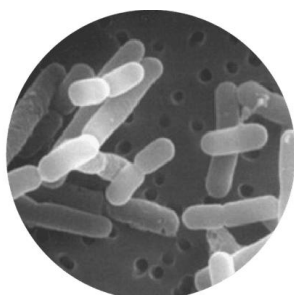
³⁶ CA's written submissions of 3 June 2025, [6]; Exhibit 1.

³⁷ Exhibits 1 and 12.

36. The extract is headed 'PROBIOTICS DATABASE' and comprises a dedicated section for 'Lactobacillus reuteri Protectis'.³⁸ The CA submits that the aforesaid database 'is a non-commercial project and is intended as an informative, educational tool for healthcare professionals, health journalists, and those with a particular interest in probiotics'.³⁹ The URL also indicates that the information is aimed at professionals: 'optibacprobiotics.com/professionals/probiotics-database/lactobacillus/lactobacillus-reuteri/lactobacillus-reuteri-protectis'. The document appears to be dated 7 May 2020.⁴⁰ There are frequent references to 'Lactobacillus reuteri Protectis' throughout, with particular focus on its applications to health. The first page shows the following:

Lactobacillus reuteri Protectis®

Especially trialled in digestive disorders in infants
Shown to help with infantile colic
Also known as *Lactobacillus reuteri* DSM 17938



Lactobacillus reuteri Protectis® under the microscope

I will comment on the presence of the ® superscript on the word 'Protectis' later at [52].

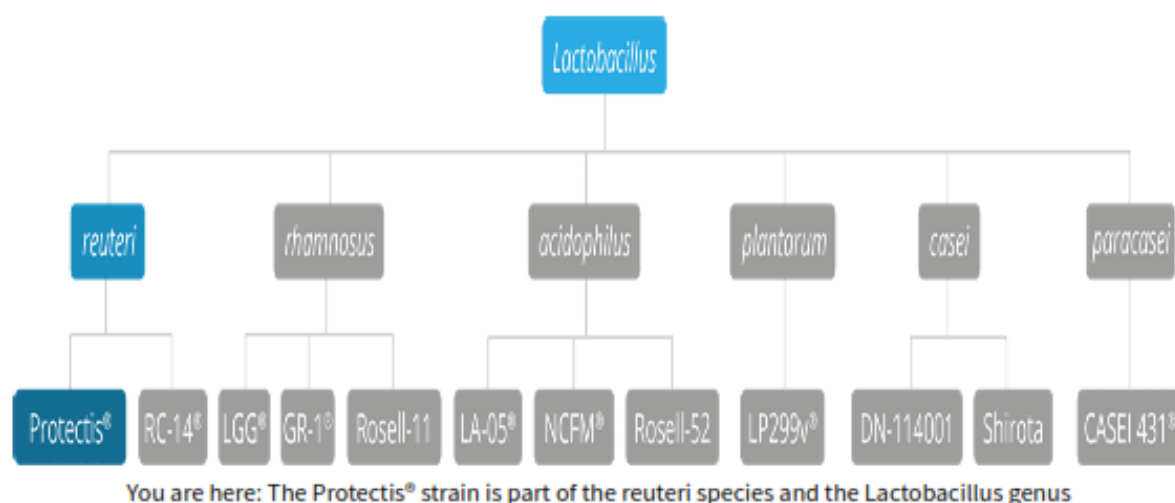
37. The document states that '[t]he Protectis® strain is a member of the ***lactobacillus reuteri*** species; it is also known as *lactobacillus reuteri* DSM 17938. This strain is the daughter strain of *lactobacillus reuteri* ATCC 55730, a bacteria which was originally isolated from the breast milk of a Peruvian mother'. [Original emphasis].

³⁸ Exhibit 1; CA's written submissions of 3 June 2025, [6].

³⁹ CA's written submissions of 3 June 2025, [6].

⁴⁰ A note after the main body of text reads 'Last updated – 7th May, 2020'.

38. The CA has referred to the following graphic, showing the nomenclature of various ‘strains’ of lactobacilli, to support its argument that the Protectis Mark is ‘wholly descriptive’:⁴¹



I note that this graphic shows a somewhat ‘mixed’ practice in the approach to nomenclature of strains under the ‘Lactobacillus’ umbrella; with the majority of strains given alpha-numeric designations. Only two of the strains featured here are designated by a ‘word’ element only. Furthermore, the body of evidence, as a whole, suggests that the use of alpha-numeric designations is the most common system for denoting/cataloguing Lactobacillus strains. Some strains appear to be designated by a word/numeral combination. The use of a mere word element does not appear to be particularly commonplace.

39. I also note the following:



‘Lactobacillus reuteri Protectis’ is referred to in the context of its utility in several areas of health, with information for each health application set out under the following headings:

⁴¹ Exhibit 1; CA’s written submissions of 3 June 2025, [6].

Lactobacillus reuteri **Protectis®** and Infantile Colic

Lactobacillus reuteri **Protectis®** and Functional Abdominal Pain (FAP) in Children

Lactobacillus reuteri **Protectis®** and Diarrhoea in Children

Lactobacillus reuteri **Protectis®** and Constipation

Lactobacillus reuteri **Protectis®** and *Helicobacter pylori* Infection in Children and Adults

Lactobacillus reuteri **Protectis®** and Oral Health

Lactobacillus reuteri **Protectis®** and Immunity

Scientific abstracts concerning LACTOBACILLUS REUTERI PROTECTIS⁴²

40. The CA has provided two abstracts which focus specifically on ‘*Lactobacillus reuteri* protectis’:

- An abstract for an article titled ‘Increasing work-place healthiness with the probiotic *Lactobacillus reuteri*: A randomised, double-blind placebo-controlled study’, published in November 2005, in the journal *Environmental Health*.⁴³ The abstract makes explicit reference to ‘*Lactobacillus reuteri* protectis’ as a probiotic with potential benefits for those suffering from respiratory or gastrointestinal infections. I note that the aforesaid article title has been referenced in the bibliographies of both the 2006 article at exhibit 5 and the 2018 article at exhibit 8, which are addressed later at [43] and [45].
- The second abstract is titled Antiviral activity of *Lactobacillus reuteri* protectis against Coxsackievirus A and Enterovirus 71 infection in human

⁴² Witness Statement of G. Moretti, [17]; Exhibit 12.

⁴³ As above.

skeletal muscle and colon cell lines' is from *Virology Journal*, and it was published in December 2016.⁴⁴

Scientific articles/abstracts referencing 'LACTOBACILLUS REUTERI'

41. Most of the articles and abstracts adduced contain references to 'lactobacillus reuteri', rather than the full wording of which the Protectis mark is comprised. I note that none contain any reference to the wording of which the Prodentis mark is comprised. These articles have been provided in order to demonstrate that 'LACTOBACILLUS REUTERI' was, at the Relevant Date, and continues to be, a scientifically recognised name for a specific bacterium; within the EU, UK and internationally.⁴⁵ I set out my observations on these materials in the following paragraphs [42] – [47].

Material published prior to or circa the Relevant Date:

42. The following articles are dated, respectively, prior to and a year or so post the Relevant Date:

Publication date:	Article title:	Journal title (and Publisher, if applicable)
2006	<u>Lactobacillus reuteri</u> therapy to reduce side-effects during anti- <i>Helicobacter pylori</i> treatment in children: a randomized placebo controlled trial. ^{46,47}	<i>Aliment Pharmacol Ther.</i> ⁴⁸
2008	Inhibition of <i>Helicobacter pylori</i> Infection in Humans by <u>Lactobacillus reuteri</u> ATCC 55730 and Effect on Eradication Therapy: A Pilot Study ⁴⁹	Helicobacter, Blackwell Publishing Ltd

[my underlining]

⁴⁴ Exhibit 12.

⁴⁵ Witness Statement of G Moretti, [7] – [15], [17]; Exhibits 3, 4, 5, 6, 7, 8, 9, 10 and 12.

⁴⁶ Exhibit 5.

⁴⁷ This article is also referenced in the bibliographies of: the 2008 article at Exhibit 4, and the 2018 article at Exhibit 8.

⁴⁸ It is clear from the scientific articles that the convention is to italicise and abbreviate journal titles.

⁴⁹ Exhibit 4.

The 2008 article lists 'Lactobacillus reuteri' under 'Keywords'.

43. I note that the bibliography to the aforesaid 2006 article references several articles whose titles also mention 'Lactobacillus reuteri'. I note the pertinent details in the following table:

Publication date:	Article title:	Journal title (and Publisher, if applicable)
2000	<u>L. reuteri</u> confers broad-spectrum protection against disease in humans and animals.	<i>Microb Ecol Health Dis</i>
2004	Colonization and immunomodulation by <u>Lactobacillus reuteri</u> ATCC 55730 in the human gastrointestinal tract. ⁵⁰	<i>Appl Environ Microbiol.</i>
2005	Increasing workplace healthiness with the probiotic <u>Lactobacillus reuteri</u> : a randomised double-blind placebo-controlled study. ⁵¹	<i>Environ Health</i>

[my underlining]

44. Whilst the 2008 article, noted in the table at [42], was published after the Relevant Date, the bibliography contains references to several articles on 'Lactobacillus reuteri' which *pre-date* the relevant period. I note the pertinent details in the following table:

Publication date:	Article/abstract title:	Journal title (and Publisher, if applicable)
1997	<u>Lactobacillus reuteri</u> as a therapeutic agent in acute diarrhea in young children. ⁵²	<i>J Paediatr Gastroenterol Nutr.</i>

⁵⁰ This is also referenced in the bibliography to the 2018 article at Exhibit 8.

⁵¹ As above.

⁵² This is also referenced in the bibliographies to: the 2006 article at Exhibit 5, and the 2018 article at Exhibit 8.

2004	<u>Lactobacillus reuteri</u> ATCC 55730 in the human gastrointestinal tract.	<i>Apl Envirol Microbiol.</i>
2002	Inhibition of binding of <i>Helicobacter pylori</i> to the glycolipid receptors by probiotic <u>Lactobacillus reuteri</u> . ⁵³	<i>FEMS Immunol Med Microbiol.</i>
1997	Bacteriotherapy with <u>Lactobacillus reuteri</u> in rotavirus gastroenteritis. ⁵⁴	<i>Pediatr Infect Dis J.</i>
1998	Safety and tolerance of <u>Lactobacillus reuteri</u> supplementation to a population infected with the Human Immunodeficiency virus. ⁵⁵	<i>Food Chem Toxicol.</i>
2003	Anti <i>Helicobacter pylori</i> activity among lactic acid bacteria isolated from gastric biopsies and strains of <u>Lactobacillus reuteri</u> (Abstract)	<i>Helicobacter</i>

[my underlining]

Material published after the Relevant Date:

45. Five of the scientific articles provided post-date the Relevant Date; ranging from 2010 to 2025. All five mention ‘Lactobacillus reuteri’ in the title. The following article, published in April 2018, is particularly of note because the bibliography contains several references to articles *pre-dating or circa* the relevant period: ‘Role of Lactobacillus reuteri in Human Health and Diseases’,⁵⁶ in the journal *Frontiers in Microbiology*. [my underlining]. Mr Moretti has stated that the journal in which this article was published is circulated worldwide, including the UK. The article states that Lactobacillus reuteri was first isolated in 1962.⁵⁷ The following articles are referenced in the aforesaid bibliography:

⁵³ This is also referenced in the bibliographies to: the 2006 article at Exhibit 5, and the 2018 article at Exhibit 8.

⁵⁴ This is also referenced in the bibliographies to: the 2006 article at Exhibit 5, and the 2018 article at Exhibit 8.

⁵⁵ This is also referenced in the bibliographies to: the 2006 article at Exhibit 5, and the 2018 article at Exhibit 8.

⁵⁶ Exhibit 8.

⁵⁷ Witness Statement of G. Moretti, [13].

Published:	Article title:	Journal title:
2007	Inhibitory activity spectrum of reuterin produced by <u>Lactobacillus reuteri</u> against intestinal bacteria.	<i>BMC Microbiol</i>
2006	Inhibitory effects of <u>Lactobacillus reuteri</u> on visceral pain induced by colorectal distension in Sprague-Dawley rats.	<i>GUT</i>
2002	A high-molecular-mass cell-surface protein from <u>Lactobacillus reuteri</u> 1063 adheres to mucus components.	<i>Microbiology</i>
2007	<u>Lactobacillus reuteri</u> (American Type Culture Collection Strain 55730) versus simethicone in the treatment of infantile colic: a prospective randomized study.	<i>Pediatrics</i>
1989	Chemical characterization of an antimicrobial substance produced by <u>Lactobacillus reuteri</u>	<i>Antimicrob. Agents Chemother.</i>
2003	<u>Lactobacillus reuteri</u> CRL 1098 produces cobalamin.	<i>J Bacteriol</i>
2005	A high-molecular-mass surface protein (Lsp) and methionine sulfoxide reductase B (MsrB) contribute to the ecological performance of <u>Lactobacillus reuteri</u> in the murine gut.	<i>Appl Environ Microbiol.</i>

[my underlining]

46. Mr Moretti has stated that the following articles were circulated worldwide, including the UK:

Publication date:	Article title:	Journal title
2010	<u>Lactobacillus reuteri</u> (DSM 17938) in Infants with Functional Chronic Constipation: A Double-Blind, Randomized, Placebo-Controlled Study. ⁵⁸	<i>The Journal of Pediatrics</i>

⁵⁸ Exhibit 3.

2018	<u>Lactobacillus reuteri</u> to Treat infant Colic: A meta-analysis. ⁵⁹	<i>American Academy of pediatrics</i>
2022	Polyphenols and <u>Lactobacillus reuteri</u> in oral health. (Abstract) ⁶⁰	<i>Journal of Preventive Medicine and Hygiene</i>
2025	The impact of <u>Lactobacillus reuteri</u> on oral and systemic health: A comprehensive review of recent research. ⁶¹	<i>Microorganisms</i>

[My underlining]

47. Mr Moretti has referred to the following text from the 2025 article:

'Lactobacillus reuteri is a Gram-positive rod-shaped bacterium that exists in various body parts of humans, including the gastrointestinal tract, urinary tract, skin, and so on. This species has a potentially positive impact on oral health and plays an important role in maintaining systemic health'.⁶²

Product listings from Amazon UK⁶³

48. Product listings from Amazon, showing goods held out for sale as at the time of filing the evidence (i.e. 11 June 2025) have been provided.⁶⁴ This evidence is intended to demonstrate that Lactobacillus reuteri 'is commonly used in the course of trade as an ingredient of products by other companies, and is widely used as a product name'.⁶⁵ The following listings show products by the name of 'Lactobacillus reuteri':

⁵⁹ Exhibit 6.

⁶⁰ Exhibit 7.

⁶¹ Exhibit 9.

⁶² Witness Statement of G. Moretti, [14].

⁶³ Exhibit 11.

⁶⁴ Witness Statement of G. Moretti, [16].

⁶⁵ As above.



(i)

'Lactobacillus reuteri' appears vertically at a 180-degree angle on the labelling. The accompanying product description indicates that 'lactobacillus reuteri' is the *good*, sold under the brand name 'Epigenetics':

Lactobacillus Reuteri 15g | 5 Billion CFU
Probiotic + Chicory Root Prebiotic
(Inulin) | Vegan Friendly Powder UK
Made | 1g Daily (15 Servings)

Visit the Epigenetics Store

4.6 ★★★★★ 44 ratings | Search this page

Amazon's Choice for "lactobacillus reuteri"

100+ bought in past month

£15.99 (£106.60 / 100 g)

Brand	Epigenetics
Flavour	Unflavoured
Unit count	15.0 grams
Item form	Powder
Age range (description)	Adult
Package	Bag

(ii) Product descriptions for the following indicate that the goods are 'lactobacillus reuteri' in tablet/capsule form, describing them as probiotics:

	
 Lactobacillus Reuteri 15g 5 Billion CFU Probiotic + Chicory Root Prebiotic (Inulin) Vegan Friendly... Although the resolution is poor, I am able to read 'Lactobacillus reuteri 15g/5 Billion' and 'Probiotic'.	

(iii) The product description for the following, 'Reuflor Drops Probiotic Supplement 5 ml', states that it is a 'Food supplement based on live lactic ferments [...] (Lactobacillus reuteri DSM 17938) useful for promoting the balance of the intestinal bacterial flora'. 'Lactobacillus reuteri' is listed as an ingredient.



Evidence relating to the word 'prodentis'

49. None of the materials addressed thus far contain any reference to the word 'prodentis'. The only 'evidence' provided in this regard is by way of the following:

i) a definition of 'Dens' from an online source 'The Latin Dictionary' which indicates that 'Dentis' is a singular form of the word 'dentium', both words deriving from the word 'dens', meaning 'tooth'.

ii) an entry from the online Oxford Learner's dictionary for the word 'pro'. The only meaning noted for 'pro' is 'a person who works as a professional, especially in a sport'.

50. Mr Moretti's accompanying narrative reads:⁶⁶

'6. Exhibit 2 shows that 'PRO' and 'DENTIS' are words which are understood by the relevant public as suggesting a health benefit or health effects associated with the probiotic strain and pertaining self-evidently to dental health, hence, the combination "PRODENTIS" does not constitute more than the sum of its parts. Together with the LACTOBACILLUS genus in Latin, the species name in Latin, PRODENTIS and PROTECTIS are respectively strains pertaining to this genus and species and are merely descriptive of the health

⁶⁶ Witness Statement of G. Moretti.

benefit as per the norm set out in Annex 1 by ISAPP. Each term being as per the scientific norm derived from Latin and being simply descriptive of the health benefit in question.'

The RP's evidence

51. The RP's evidence can be dealt with swiftly. Mr Bhandal has highlighted the existence of the two trade marks, 'Prodentis'⁶⁷ and 'Protectis'⁶⁸ (both word marks), currently registered at both the EUIPO and the UKIPO in the name of the RP, whose specifications overlap with those of the Protectis/Prodentis Marks. In essence, he has stated that these registrations demonstrate that the words 'Prodentis' and 'Protectis' are 'considered inherently registrable marks which are distinctive and not descriptive'. This argument is circular because it assumes that a mark is distinctive by virtue of the fact that it is registered. To accept such an argument is at odds with the fact that section 47 of the Act makes invalidation based on section 3 available as a cause of action. My assessment in the instant proceedings is concerned only with the marks 'Lactobacillus reuteri Protectis' and 'Lactobacillus reuteri Prodentis'.

52. I refer back to [36] in which I noted the presence of the ® superscript on the word 'Protectis', as it appeared in the extract from the Optibac database. The aforesaid extract is dated 7 May 2020, some 13 years after the Relevant Date. Given that the registration of the RP's mark 'Protectis' was also completed some years after the Relevant Date, but some 8 years prior to the publication of the Optibac database entry, the presence of ® is, to my mind, unremarkable. Instances of 'Protectis®' appearing several years after the Relevant Date have little relevance to the question of whether the contested marks in the instant proceedings fall foul of one of other of sections 3(1)(b), 3(1)(c) or 3(1)(d).

The claims under section 3(1)(c)

⁶⁷ UK00910279735 achieved UK registration on 19 April 2012.

⁶⁸ UK00910279421 achieved UK registration on 21 April 2012.

The Protectis Mark:

53. I remind myself that the general interest underpinning the 3(1)(c) ground of objection is to 'keep free' certain signs which consist of indications which honest traders either currently use or may wish to use without any improper motive.⁶⁹

54. Mentions of the wording LACTOBACILLUS REUTERI PROTECTIS in the evidence are few, although it is clear that these constitute *use* of the term to denote a particular strain of bacterium. The clearest example predating the Relevant Date, noted at [40], appears in an abstract for an article published in November 2005 in the journal *Environmental Health*, titled 'Increasing work-place healthiness with the probiotic Lactobacillus reuteri: A randomised, double-blind placebo-controlled study'.⁷⁰ The abstract makes explicit reference to 'lactobacillus reuteri protectis' and shows that its potential utility to human health was explored at that time. This demonstrates that 'lactobacillus reuteri protectis' was a subject of scientific enquiry for which findings had been published, at least a year and four months prior to the Relevant Date. Furthermore, the appearance of the aforesaid article title as a bibliographic reference in another work, published in 2006 ('Lactobacillus reuteri therapy to reduce side-effects during [...]').⁷¹ constitutes another example of use pre-dating the relevant period. There is further citation of the 2005 article in the bibliography to a work published in April 2018 in the journal *Frontiers in Microbiology*.⁷² Whilst the latter citation post-dates the relevant period by some 11-or-so years, it is clear that there is some level of recognition of 'lactobacillus reuteri protectis', within the scientific community, which has persisted over time.

55. The 2016 abstract titled 'Antiviral activity of Lactobacillus reuteri protectis against Coxsakievirus A and Enterovirus 71 infection in human skeletal muscle and colon cell lines', noted at [41], indicates that 'Lactobacillus reuteri protectis' has continued to be the subject of scientific enquiry in the context of human health. The 2020 extract from the Optibac database, dedicated to 'Lactobacillus reuteri protectis',

⁶⁹ Kerly's Law of Trade Marks and Trade Names, 17th Ed., at 10-103.

⁷⁰ Exhibit 12.

⁷¹ Listed in the table at paragraph [42] of this decision.

⁷² Noted at paragraph [45] of this decision.

noted at [35], sets out, inter alia, further applications of the bacterium to human health.

56. However, to my mind, it is not clear from these references whether ‘Protectis’ is understood as *purely descriptive*, i.e. having a meaning that is understood by the relevant public purely as a *descriptor* for the particular bacterial strain denoted by it. The fact that the term ‘Lactobacillus reuteri Protectis’ has been used amongst a portion of the scientific community for a period of time to *designate* a particular strain of a probiotic bacterium does not say anything about the *nature* of that designation, i.e. whether it is understood as a *pure description* or as an indicator of *trade* origin. The CA itself has, at times, couched its argument in somewhat tentative terms; e.g. by submitting that ‘Protectis’ implies or suggests protective qualities.⁷³ Implication or suggestion alone are not sufficient to substantiate a claim under section 3(1)(c). After all, many trade marks comprise invented words that are allusive or suggestive without impeding their registrability.

57. Much of the evidence features ‘lactobacillus reuteri’, which forms the first two elements of each contested mark. There are 13 clear references to the term ‘lactobacillus reuteri’ spanning the ten-year period 1997 to 2007, in a scientific context, in relation to a bacterium.

58. I find that the totality of evidence demonstrates the following:

- that ‘lactobacillus reuteri’ is a type of bacteria known as a ‘probiotic’, and that probiotics are bacteria deemed to have health benefits; and
- that the naming convention for particular strains of bacteria takes the form Genus-Species-Strain, with many examples in the form of alpha-numeric designations. Some strains are referred to by a pure word element rather than an alpha-numeric designation, albeit the only examples of these in the evidence are ‘Protectis’ and ‘Shirota’. Others take the form of a word/numeral combination.

⁷³ CA’s written submissions of 3 June 2005, [9].

59. I now proceed to consider whether LACTOBACILLUS REUTERI PROTECTIS will be understood, by the relevant consumer, to be descriptive for the goods at stake, or for some characteristic of those goods.

60. I will address the following class 5 goods first:

bacteriological cultures, bacteria and bacterial preparations, and biological and biochemical preparations for medical purposes and healthcare; lactic acid bacteria, lactobacillus

61. I have found that the aforesaid goods are specialised and likely to be purchased by professionals, e.g. for use in a laboratory setting. I consider purchases by ordinary members of the public to be unlikely. The evidence clearly demonstrates that 'lactobacillus reuteri protectis' has been used, on a small number of occasions, in the context of lactobacillus bacteria since several years before the Relevant Date. All of the terms enumerated above either encompass or *are* bacteria. The term '*lactic acid bacteria, lactobacillus*' appears to be the term to which the Protectis Mark might be most obviously applied given its specificity (i.e. as a lactobacillus). The categorisation of probiotics (of which 'Lactobacillus reuteri protectis' is said by the CA to be an example) as 'biological' or 'biochemical' is, in my view, borne out by the evidence: e.g. reference to probiotics as 'live microorganisms',⁷⁴ and the subject areas as indicated by the journal titles. However, I am not satisfied that the *manner* in which the term 'Lactobacillus reuteri Protectis' has been used is purely descriptive. While it seems clear to me that the 'Lactobacillus reuteri' portion of the Protectis Mark is purely descriptive, the evidence does not, in my view, support a finding that the '*Protectis*' element is purely descriptive for the strain in question.

62. None of the remaining goods for which the Protectis Mark stands registered are bacteria, although some terms might encompass products containing bacterial cultures. Following my conclusion that the evidence is not sufficient to support a finding that the Protectis Mark is purely descriptive for the explicitly *bacteria-related*

⁷⁴ Noted at paragraphs [32] and [33] of this decision.

goods (set out at [60]), the section 3(1)(c) claim cannot succeed against the remainder of the registered specification, being goods further removed from bacteria or bacterial cultures themselves.

63. In reaching this conclusion, I have borne in mind that section 3(1)(c) also has a prospective effect in that it is intended to prevent the registration of signs which are *capable of* serving in trade, to designate the kind, quality, quantity, intended purpose etc [...] or other characteristics of goods in the future. In the *Doublemint*⁷⁵ case, the ECJ said that ‘it is clear that a term does not have to be in current descriptive use to be precluded from registration, but that a reasonable apprehension that it may be so used in the future suffices’. It is my view that the very few examples of the ‘lactobacillus reuteri Protectis’ wording being used is insufficient to support a finding that the Protectis Mark is *capable of* designating in trade a particular strain of bacteria.

64. The section 3(1)(c) ground fails.

The Prodentis Mark:

65. Whilst there is significant evidence of the ‘lactobacillus reuteri’ portion of the Prodentis Mark being descriptive, there is not one reference to ‘lactobacillus reuteri prodentis’ in the materials provided. The CA has argued that the word ‘prodentis’ is a descriptive term because it ‘suggests a connection with dental health, potentially alluding to ‘pro’ (Latin for ‘in favour/on behalf of’) and ‘dents’, a Latin word relating to teeth.⁷⁶ The CA seems to treat the Prodentis Mark as analogous to the Protectis Mark in submitting that ‘Prodentis in the same vein as Protectis is simply a descriptive term incapable of distinctiveness serving to qualify the specific health benefit of the strain in this latter case being dental benefits’.⁷⁷ The CA proceeds to argue that ‘both Prodentis and Protectis are merely descriptive adjuncts which are defined according to Exhibit 1 as descriptive strains whose sole

⁷⁵ OHIM v Wm Wrigley Jr Co (“Doublemint”) Case C-191/01 P [2004] 1 W.L.R. 1728, at [33].

⁷⁶ CA’s written submissions of 3 June 2025, [12].

⁷⁷ As above.

purpose is to define the intended use of the genus and species as helpful guide to the relevant market'.⁷⁸

66. There are several difficulties with this argument. Firstly, the CA's account of how the word 'prodentis' will be understood is couched in terms of it being merely allusive or suggestive, rather than descriptive. Section 3(1)(c) is not concerned with mere allusiveness or suggestiveness, but descriptiveness. Secondly, the evidence as to the naming conventions for bacterial strains⁷⁹ does not go as far as the CA claims – whilst the evidence does demonstrate actual use of 'lactobacillus reuteri protectis' in the context of bacterial strains, as already noted, there is no evidence of 'lactobacillus reuteri prodentis' being used at all, whether descriptively or in a trade mark sense. Whilst some average consumers may well perceive the word 'prodentis' as alluding to dental health, this is not sufficient to lead me to infer that 'prodentis', when preceded by the descriptive words 'lactobacillus reuteri', will be perceived by the relevant consumers as denoting a bacterial strain. To make such a finding would, in my view, be overly liberal. Even bearing in mind the prospective scope of section 3(1)(c), in the absence of any evidence whatsoever to indicate that lactobacillus reuteri prodentis' has been used in any context at all, it is difficult to conceive of the Prodentis Mark becoming a descriptive term in the future for the goods at stake or any characteristic of them. In the light of the foregoing, I find that the Prodentis Mark does not fall foul of section 3(1)(c) to any extent.

67. The section 3(1)(c) ground fails.

The section 3(1)(d) claims

The relevant case law:

68. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court ('the GC') summarised the case law of the CJEU under the equivalent of section 3(1)(d) of the Act, as follows:

⁷⁸ CA's written submissions of 3 June 2025, [12].

⁷⁹ The Optibac Database, Exhibit 1.

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

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

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

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

69. I also take note of the comments of Mr Daniel Alexander Q.C. (as he then was), sitting as the Appointed Person, in *Affinity Leasing Limited v Total Motion Limited*, BL O/522/20:

‘26. [...] the case law of the CJEU and the English courts seems to be better understood as requiring the term in question to have already become customary in the trade in question, specifically to designate the goods or services in respect of which registration of the mark is sought and not merely that it has become customary in the trade more generally.

[...]

28. In my view where reliance is placed on section 3(1)(d) and, in particular, where the usage alleged goes back some years (as here) it is ordinarily reasonable to expect some evidence that the term in question has, in fact, been used specifically to denote the goods or services in question at the Relevant Date, not merely an evaluation of what an average consumer may think. [...]

The Protectis Mark:

70. I remind myself of the requirement to assess each of the grounds pleaded independently (whilst being cognisant of the interplay between them). Section 3(1)(d) of the Act has a narrower scope than section 3(1)(c); setting a fairly high bar in that the sign in question must have become customary in the current language or in the bona fide and established practices of the trade at the Relevant Date. The essence of the section 3(1)(d) objection is that the sign has become generic from the perspective of the relevant consumers.⁸⁰ It is immaterial whether the sign in question is descriptive of the goods or some characteristic of them.⁸¹ For an objection to succeed under section 3(1)(d), it is not sufficient that the sign merely *serves/could* serve in trade to describe the goods or a characteristic thereof; it must have become *customary*, in the current language (not confined to the trade),

⁸⁰ Kerly's *Law of Trade Marks and Trade Names*, 17th Ed., at [10-117].

⁸¹ Case C-517/99 *Merz & Krell GmbH & Co.* [2001] ECR I-6959, at [41].

or in the bona fide and establishes practices of the trade. It seems to me that use of the sign must have become *conventional*.

71. Whilst I have found that the evidence does demonstrate that 'lactobacillus reuteri protectis' was, at the Relevant Date, used on a small number of occasions amongst the scientific community, I am not satisfied that this use has been shown to be sufficiently widespread or conventional to amount to customary in the context of the goods at stake.

72. The section 3(1)(d) objection, therefore, fails.

The Prodentis Mark:

73. In the absence of any evidence of the wording 'lactobacillus reuteri prodentis' being used in any context whatsoever, the section 3(1)(d) ground must fail.

The section 3(1)(b) claims

The relevant case law:

74. Section 3(1)(b) of the Act prevents the registration of marks which are devoid of distinctive character. The case law under section 3(1)(b) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

'90. The principles to be applied under Article 7(1)(b) of the CTM Regulation were conveniently summarised by the CJEU in Case C-265/09 P *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* [2010] ECR I-8265 as follows:

"29. ... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific

product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v. OHIM* [2004] ECR I-5089, paragraph 32).

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

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

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

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P and C-474/01 P *Procter & 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).

34. In that regard, the Court has already stated that difficulties in establishing distinctiveness which may be associated with certain categories of marks because of their very nature – difficulties which it is legitimate to take into account – do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law (see *OHIM v. Erpo Möbelwerk*, paragraph 36, and *Audi v. OHIM*, paragraph 38).

...

37. ... it should be pointed out that, even though it is apparent from the case-law cited that the Court has recognised that there are certain categories of signs which are less likely *prima facie* to have distinctive character initially, the Court, nevertheless, has not exempted the trade mark authorities from having to carry out an examination of their distinctive character based on the facts.

...

45. As is clear from the case-law of the Court, the examination of trade mark applications must not be minimal, but must be stringent and full, in order to prevent trade marks from being improperly registered and, for reasons of legal certainty and good administration, to ensure that trade marks whose use could be successfully challenged before the courts are not registered (see, to that effect, *Libertel*, paragraph 59, and *OHIM v. Erpo Möbelwerk*, paragraph 45).”

The Protectis Mark:

75. The CA's section 3(1)(b) pleading is essentially the same as its pleading for section 3(1)(c), with no further basis of 'non-distinctiveness' provided. Accordingly, the section 3(1)(b) objection against the Protectis Mark must also fail.

The Prodentis Mark:

76. The CA's case against the Prodentis Mark under section 3(1)(c) has been argued slightly differently to that against the Protectis Mark. As noted, the CA's arguments were largely framed in terms of the 'Prodentis' element of the mark being allusive or suggestive of the goods at stake, which is not the mischief that section 3(1)(c) is intended to address. This prevents me from making a finding on section 3(1)(b) for the Prodentis Mark on the same basis as that for the Protectis Mark.

77. In the absence of any evidence of the words 'lactobacillus reuteri prodentis' being used in any context whatsoever, I am unable to make a finding that the Prodentis Mark is devoid of distinctive character. Whilst the evidence clearly shows that the 'lactobacillus reuteri' portion of the mark is used descriptively, my view is that the CA's case that the 'prodentis' element will be perceived as alluding to benefits relating to the teeth/dental health is entirely consistent with the mark enjoying some measure of distinctive character. The CA's explicit reference in its pleading to 'the combination 'PRODENTIS' as a sum of the two parts 'PRO' and 'DENTIS', to my mind, points to a measure of inventiveness at odds with a finding that the mark is devoid of distinctive character.

78. In the light of the foregoing, the section 3(1)(b) ground fails against the Prodentis Mark.

Acquired Distinctiveness

79. The proviso in Section 3 of the Act enables a mark to be registrable if, before the date of application for registration (in the instant case, the filing date of 29 August 2007), it has in fact acquired a distinctive character as a result of the use that has been made of it. As noted at [17], the RP elected not to file evidence to demonstrate acquired distinctiveness. I am, therefore, unable to make a finding in this regard.

CONCLUSION

80. Both invalidation actions have failed in their entirety. Subject to any successful appeal, UK00906235873 and UK00906235501 may remain registered in their entireties.

COSTS

81. The RP is the successful party and is, therefore, entitled to a contribution to its costs based upon the scale published in Tribunal Practice Notice 1/2023, calculated as follows:

Preparing statements and considering the other side's statements x2	£350*
Preparing evidence and considering and commenting on the other side's evidence	£600
Preparation of submissions in lieu of a hearing	£350
Total:	£1,300

*I have awarded a sum of £350 for this head of costs (which is below the minimum threshold of £250 per claim) to reflect the fact that there was a great deal of overlap in the respective pleadings.

82. I, therefore, order NOOS SRL to pay to BioGaia AB the sum of £1,300. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of July 2026

N. R. Morris

**For the Registrar,
the Comptroller-General**