O-0946-23

TRADE MARKS ACT 1994

IN THE MATTER OF

INTERNATIONAL TRADE MARK NO. WO1660578

DESIGNATING THE UNITED KINGDOM

IN THE NAME OF BIODERMIS CORPORATION

TO REGISTER

BIODERMIS
THE SCIENCE OF SKIN

AS A TRADE MARK

IN CLASS 5

AND OPPOSITION THERETO (UNDER NO. 435525)

BY APPLEDENE LIMITED

Background & Pleadings

1. Biodermis Corporation ("the holder") is the holder of International Registration ("IR") no. WO0000001660578 ("the designation") in respect of the trade mark set out on the title page. Protection in the UK was requested on 11 April 2022, based on a priority date of 13 October 2021 (USA) in respect of *Topical gel for medical and therapeutic use for the treatment of scars* in class 5. The IR was published in the UK for opposition purposes on 3 June 2022.

2. Appledene Limited ("the opponent") opposed the designation under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ("the Act"). The opponent's grounds under section 3(1)(b) and (c) are as follows:

> "The combination of the words "BIO" and "DERMIS", when used in respect of the Opposed Goods, would be readily understood by consumers to refer to goods that are biological or natural and that are used for treating the dermis (scars).
>
> The remaining element of the mark, namely, "THE SCIENCE OF SKIN", is a descriptive, commonly used term and/or advertising slogan, as it relates to the science relating to skin and/or the treatment of skin.
>
> The combination of the descriptive elements BIODERMIS and THE SCIENCE OF SKIN is not sufficient to render the mark registrable. Given the above, the applied for mark is descriptive and/or non-distinctive in relation to the Opposed Goods."

3. The holder filed a counterstatement in which it denied both grounds of opposition.

4. The parties have been represented throughout these proceedings. The holder is represented by Barker Brettell LLP and the opponent by Appleyard Lees.

5. Only the opponent filed evidence in these proceedings. A hearing was not requested and neither side filed written submissions in lieu.

6. I make this decision based on a reading of all the material before me.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Opponent's evidence

8. The opponent filed a witness statement in the name of Daniel Bailey, a Chartered Trade Mark Attorney and Solicitor employed by Appleyard Lees, who are the opponent's legal representatives in these proceedings. Mr Bailey appends 7 exhibits. I shall summarise the exhibits below.

9. Exhibit DJB1 comprises dictionary definitions for the term **bio** from Dictionary.com and Collins English dictionary and for **dermis** from the Collins English dictionary. I note that the definition for **dermis** in Collins Dictionary states says it is another word for corium, so Mr Bailey has included the definition for corium from the same dictionary. In addition Mr Bailey exhibits a Google search for the term "dermis definition" and an entry for the word **bio** from the examination chapter of the Manual of Trade Mark Practice used by the IPO.

10. Exhibit DJB2 comprises two screenshots dated March 2021 and January 2022 respectively. The first screenshot is taken from the holder's website, www.biodermis.com, entitled "Biodermis blog: Know the different scar types". The second screenshot is taken from www.webmd.com and is entitled "Scars and your skin".

11. Exhibits DJB3 and 4 comprise screenshots dated 11 January 2023 from the holder's website and other third party websites offering Biodermis scar treatment products for sale as well as other similar goods using derma-formative trade marks. The websites appear to be directed at UK consumers and the goods are priced in pounds sterling.

12. Exhibit DJB5 comprises extracts taken from 3 academic articles, namely from the US Government website (dated 2007), International Journal of Dermatology (dated 1995) and Wiley Online Library (dated 2002) respectively. The articles detail the use and benefits of silicone gel sheeting for skin tissue healing.

13. Exhibit DJB6 comprises a screenshot of an article, dated April 2021, from the holder's website entitled "How Silicone helps scars heal".

14. Exhibit DJB7 comprises copy of a decision from the EUIPO, dated February 2002, refusing the registration of the mark "The Science of Skin Care".

15. That concludes my summary of the evidence.

16. I also note that whilst it was not formally submitted as evidence, the opponent attached another EUIPO decision to its notice of opposition as "Annex 1". The annexed decision, dated February 2007, relates to the refusal of the mark "Biodermis".

Decision

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

"3.— Absolute grounds for refusal of registration

(1) The following shall not be registered—

(a) [...]

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

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

(d) […]

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

18. The relevant date for determining whether the contested mark is objectionable under the above provisions is 11 April 2022.

19. I bear in mind that the present grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b): *SAT.1 SatellitenFernsehen GmbH v OHIM,* Case C-329/02 P at [25]. I shall therefore begin by considering the section 3(1)(c) ground first, then returning to section 3(1)(b).

3(1)(c)

20. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

> "91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:
>
> > "33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. … due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

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

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

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

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

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

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production

of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

21. More recently, Zacaroli J. summarised the key question in *Puma SE v Nike Innovate C.V.*[1] in which he said at paragraph 21,

"Ultimately, as Ms Himsworth QC submitted, the question is whether the mark applied for, when notionally and fairly used, is descriptive of the goods and

[1] [2021] EWHC 1438 (Ch)

services in question within the meaning of section 3(1)(c). A sign can be refused registration 'only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of [the characteristics in section 3(1)(c)]': *Technopol* (above), at [50]. Moreover, a sign will be descriptive 'if there is a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of one of the characteristics of the goods and services in question': Case T-234/06 *Giampetro Torresan* (above) at [25]".

22. The position under the present grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.[2] Neither side has made any submissions in respect of the identity or level of attention of the average consumer. Medicinal goods in class 5 can be obtained "over the counter" or via prescription from a medical professional. As such the relevant consumers in the case of these contested goods can be both general and specialist. Given that the goods are intended for use on the body to treat a health issue, the level of attention from consumers is considered to be higher than average.[3] The purchasing process will be predominately visual with consumers self-selecting the goods from a retail premises or online equivalent, but I do not discount an aural aspect if advice is sought from medical professionals.

23. The opponent maintains in its notice of opposition that both elements making up the designation, namely BIODERMIS and THE SCIENCE OF SKIN, are descriptive. It is not made clear which characteristic under section 3(1)(c) the opponent claims the contested designation is descriptive for. It also maintains that the combination of BIO and DERMIS "would be readily understood to refer to goods that are biological or natural and that are used for treating the dermis". I find that these submissions appear to be a claim that the designation is descriptive of the kind and intended purpose of the goods for which it seeks registration, although the provision in section 3(1)(c) allows for a category of "other" characteristics as well.

[2] *Matratzen Concord AG v Hukla Germany SA,* Case C-421/04
[3] *Olimp Laboratories sp. z o.o. v EUIPO*, Case T-817/19, EU:T:2021:41

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24. The opponent’s evidence makes use of dictionary definitions, in particular Collins, to demonstrate that **bio,** in British English, is a combining form for “indicating life or living organisms” and **dermis,** in British English, is another word for corium. The entry for corium also refers back to dermis and is itself defined as the inner layer of skin. The opponent maintains that the whole will be “readily understood”. I do not find this contention to be so clear cut. I note the extract from the Trade Mark Manual which states that in an examination of a trade mark containing **bio**, it should be treated as if it were the word biological. Even when this is applied to the mark at issue, I find it would still only result in BIODERMIS being considered as biological dermis. I accept that many consumers, particularly specialist consumers, would understand the combining form “derm” as related to skin as they may be familiar with connected words like dermatitis or dermatology. However some consumers will not know this meaning and regard the mark as invented. In either case, it is my view that BIODERMIS will not be viewed as having its own singular meaning. Instead it will, at best, be understood as being something biological to do with skin but it does not describe the kind or intended purpose of the goods, which are targeted for use on scars, in the specific and direct way envisaged by section 3(1)(c). I am also alert to the fact that the BIODERMIS element is not a word mark solus but is stylised with a wavy thin white line being drawn through each of the letters. Moreover the whole mark consists of the BIODERMIS element plus the strapline THE SCIENCE OF SKIN. I note the opponent’s comments in relation to its common nature, which is frequently the case with straplines, but I would point out that it is whilst it may add some notion that the word BIODERMIS is somehow scientific in origin, it also does not refer to the kind and intended purpose of the goods. Overall I find the contested mark to be “more than the sum of its parts”.[4]

25. Taking all these factors into account I do not find the case under section 3(1)(c) has been made out.

[4] *Campina Melkunie BV v Benelux-Merkenbureau* Case C-265/00

3(1)(b)

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

> "29...... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel* v *OHIM* [2004] ECR I-5089, paragraph 32).
>
> 30. Under that provision, marks which are devoid of any distinctive character are not to be registered.
>
> 31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel* v *OHIM*, paragraph 34; Case C-304/06 P *Eurohypo* v *OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi* v *OHIM* [2010] ECR I-0000, paragraph 33).
>
> 32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck* v *OHIM*, paragraph 25; *Henkel* v *OHIM*, paragraph 35; and *Eurohypo* v *OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat* v *OHIM* [2004] ECR I-10107, paragraph 78; *Storck* v *OHIM*, paragraph 26; and *Audi* v *OHIM*, paragraphs 35 and 36).

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

27. In its notice of opposition, the opponent maintains the contested mark is devoid of any distinctive character *per se*, because it is descriptive. There was no separate basis for the objection under section 3(1)(b). Given my previous findings in relation to descriptiveness, it follows that the ground under section 3(1)(b) must also fail.

Conclusion

28. The opposition has failed. Subject to any appeal against this decision, the designation will become protected in the UK.

Costs

29. As the holder has been successful, it is entitled to a contribution to its costs. Awards of costs are ordinarily governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, and noting that the holder did not file any submissions beyond the counterstatement save for an email dated 15 March 2023 stating it would not file evidence and requesting the evidence rounds be closed, I award costs to the holder as follows:

£400 Considering Notice of Opposition and preparing a counterstatement

30. I order Appledene Limited to pay Biodermis Corporation the sum of £400. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of October 2023

June Ralph

For the Registrar

The Comptroller-General