

O/825/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003549558

BY BAUER HOLDINGS LIMITED

TO REGISTER:

LSA Legal Steriod Alternative

AS A TRADE MARK IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 422860 BY

SWISS RESEARCH LABS LIMITED

BACKGROUND AND PLEADINGS

1. On 28 October 2020, Bauer Holdings Limited (“the applicant”) applied to register the trade mark shown on the cover of this decision in the UK for the following goods:

Class 5: Pharmaceuticals, medical preparations; dietetic preparations; dietetic food and substances; dietetic food and substances adapted for medical use; dietary supplements for humans; diet capsules; dietary supplements and dietetic preparations; dietary supplements for humans; supplements for use in relation to energy, exercise, health, fitness, beauty, wellbeing, bodybuilding; all of the foregoing in drop form, powder form, capsule form, tablet form, and in liquid form; dietary supplements and dietetic preparations; glucose dietary supplements; powdered nutritional supplement drink mix; powdered fruit-flavored dietary supplement drink mix; protein powder dietary supplements; protein supplement shakes; vitamin and mineral supplements; wheat dietary supplements; nutritional supplements; meal replacement powders; meal replacement bars; meal replacement drink mixes; nutritional energy bars; dietary and nutritional supplement drink mixes; nutraceuticals for use as a nutritional or dietary supplement; nutrition supplements in drop form, powder form, capsule form, tablet form and in liquid form; nutritional powder for use as a food additive for culinary purposes; fruit-based meal replacement powders; nutritional and dietetic food and substances; nutritional and dietary supplements for humans; nutrition and diet related products.

2. The application was published for opposition purposes on 18 December 2020 and, on 8 January 2021, was opposed by Swiss Research Labs Limited (“the opponent”). The oppositions are based on sections 3(1)(b), 3(1)(c), 3(6) and 3(3)(b) of the Trade Marks Act 1994 (“the Act”).

3. In respect of its 3(1)(c) ground, the opponent states:

“LSA Legal Steroid Alternative’ is descriptive. The goods for which registration has been sought are all legal alternatives to steroids. ‘Legal Steroid Alternative’ consists exclusively of signs which designate the kind, quality, intended purpose and other characteristics of the goods, because it tells prospective customers that the goods are legal alternatives to steroids. ‘Legal Steroid Alternative’ is therefore a descriptive word combination. This has been juxtaposed with “LSA”.”

4. In respect of its 3(1)(b) ground, the opponent goes on to state that, for the same reasons and in accordance with the decision in *Strigl*,¹ the applicant’s mark is devoid of distinctive character.
5. Under its 3(6) ground, the opponent claims that the application was made in bad faith as it was “filed with the intention of preventing third parties from using the phrase ‘legal steroid alternative’.” Further, it states that the application is particularly illegitimate because the applicant seeks to prevent the use by third parties of a descriptive term.
6. Finally, the opponent claims that in the event that the applicant’s mark is deemed not descriptive, it is contrary to section 3(3)(b) of the Act. This is also pleaded on the basis that if the applicant argued that its mark will not be used on legal steroid alternatives, then it is deceptive.
7. The applicant filed a counterstatement denying the claims made and set out that the opposition was not brought with clean hands. The applicant also requested an order for security of costs and also that the grounds relied upon be immediately struck out. In the first instance, both requests were denied by the Tribunal and, in respect of the request for security of costs, the applicant was informed that it should attempt to negotiate security of costs with the opponent directly and if that fails, it could refer the matter back to the Tribunal. No such referral was received.

¹ Cases C-90/11 and C-91/11

8. The opponent is represented by Browne Jacobson LLP and the applicant is represented by Cloch Solicitors. Only the opponent filed evidence. During the evidence rounds, both parties filed written submissions. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
9. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

PRELIMINARY ISSUES

10. Firstly, I note that the applicant's mark is applied for the word 'LSA Legal Steriod Alternative' and that there are, instead, many references throughout the documents filed in these proceedings (including those already referred to) to 'LSA Legal Steriod Alternative'. Further, I note that the opponent's submissions stated that:

“We have recently noticed that the Application contains a typographical error; it is for “LSA Legal Steriod Alternative”, not “LSA Legal Steroid Alternative”. However, it is telling that neither party has noticed this to date, and in the circumstances the average consumer would read it as “Steroid”.”

11. I note that both parties have referred to steroids in their evidence and/or submissions but also reproduced the mark in the documents as both “Steroid” and “Steriod”. It is not clear whether the applicant's mark contains a typographical error or whether it was the intention to file the mark as applied for. On this point, I am required to consider the mark as it is applied for. However, the submissions put forth by the opponent on the impression of the average consumer are ones that I must consider at the appropriate point during this decision.

12. In its counterstatement, the applicant notes that “the Application was examined by UKIPO examiner Josie Ash on 16 December 2020 and no absolute objection was raised under s. 3(1) or otherwise.” While this is noted, the fact that a mark was not objected to at the examination stage by this Office does not mean that it is not subject to scrutiny under an opposition (or an application for invalidation, for that matter) reliant upon section 3(1) grounds.

13. In its submissions, the applicant referred to an ‘unanswered preliminary matter’ and stated that:

“The Applicant stated that the Opponent does not have clean hands and does not bring its Opposition in good faith. The Opponent strictly failed to answer. The Applicant reminds the Tribunal that it provided proof with its counterstatement (exhibit BAU-02) showing public statements published by the Opponent’s controlling mind, Mr Slack, in November 2020 (after the date of Application but before the date of Opposition) inciting parties to “stick it” to – what the Opponent refers to as – the ‘Applicant’s group’, by attacking trade marks owned and licensed by the Applicant. We have now witnessed how that statement sets the Opponent’s desperately contrived case in the correct light.”

14. While these submissions are noted, the intention of the opponent in bringing the opposition is not a relevant factor to this decision. This opposition is brought against the applicant’s mark and the opponent’s intentions and pre-action activities are not relevant to the assessment I must make under the relevant grounds relied upon. Further, the proof that the applicant refers to was filed with its counterstatement. This is not evidence that has been filed in the correct manner under a witness statement and it is not appropriate to consider it as such. I note that the applicant had opportunities to file these documents as evidence during the appropriate rounds but elected not to do so. Therefore, the argument put forward will not factor into this decision. Having said that, I will consider such issues when considering costs in the event that the applicant is successful in defending the opposition.

15. The applicant has also taken issue with the accuracy of the opponent's witness evidence and requested that the statements provided be withdrawn. The applicant also reserved its right to request cross-examination of the witnesses regarding the truth of their statements and the construction of their exhibits. No such request was made. On the point as to the accuracy of the opponent's witness evidence, these allegations were made in written submissions during the evidence rounds. The opponent had the opportunity to respond to such by filing evidence in reply. It elected not to do so but did address them in its written submissions in lieu. I note the comments from both parties on this point and I also note the fact that both the challenged statements are accompanied by signed statements of truth. Overall, I do not consider there to be any reasons to disbelieve any of the evidence provided. However, as for the applicant's issues regarding the relevance of the evidence, this is something that I will, of course, take into account when assessing the relevance of the evidence throughout the course of this decision.

EVIDENCE

16. The opponent filed evidence in the form of the witness statements of Mr Andrew Jon Slack and Giles Anthony John Parsons dated 12 June and 14 June 2021, respectively. Mr Slack is the sole director of the opponent and his statement is accompanied by five exhibits. Mr Parsons is a partner of the opponent's representative and his statement is accompanied by 15 exhibits.

17. I do not propose to summarise the parties' evidence or submissions here. However, I have taken them all into consideration in reaching my decision and will refer to them below, where necessary.

DECISION

Section 3(6)

18. I will first consider the opposition reliant upon the section 3(6) ground. Section 3(6) of the Act provides as follows:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith”

19. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker*, Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO*, *Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. It summarised the law as follows:

“68. The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any

possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]".

20. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

21. The opponent has pleaded that by filing the application, the applicant has acted in bad faith on the basis that it had the intention to prevent a third party from using the phrase "Legal Steroid Alternative". While I note that an explanation has been provided in its notice of opposition as to the events leading up to the application being made, I am not convinced that any of the evidence points towards the applicant acting in bad faith.

22. I note that evidence has been filed regarding a commercial relationship between Wolfson Berg Limited and MoreNiche Limited.² I also note that a 'Partner Marketing Agreement' between those same parties, as provided by the opponent,³ was executed on behalf of Wolfson Berg Limited by Georgiou & Prasanna Nominee Services Limited, in its capacity as a director.⁴ Further, the evidence also shows the breakdown of the relationship between those parties by way of correspondence from a Mr Stewart Lochrie,⁵ who the opponent claims to be a part owner of the applicant.⁶ While it is possible for directors to be responsible for the actions of their companies when it comes to determining bad faith,⁷ I have no evidence showing that Mr Lochrie is the sole director of the applicant or whether he has full control over the applicant. While I note the evidence provided, it points to the actions of companies and persons that are not subject to these proceedings. No evidence has been provided to indicate that these parties or persons act for or on behalf of the applicant.

23. Before moving to consider the applicant's comments on this claim, I consider it necessary to point out that simply applying to register a descriptive mark is not normally an act of bad faith. On the contrary, it is legitimate to apply for an exclusive right in a mark intended to be used to distinguish that proprietor's goods and services. Such a purpose necessarily entails seeking a right to prevent all third parties from using the mark without the proprietor's consent. An application on this basis will not be considered as having been filed in bad faith unless it was made for some other reason than protecting the recognised functions of a trade mark. In defence of the claim of bad faith, the applicant submits that its mark has long been used in conjunction with its other registered marks and is, therefore, associated with the applicant. The applicant submits that it was, therefore, entirely proper and commercially sensible for it to make the application. I have no evidence from the opponent to contradict these submissions and show that the application was made for some other reason than to protect the recognised function of a trade mark.

² Exhibits AJS01 to AJS05 of the Witness Statement of Andrew Jon Slack

³ Exhibit AJS01 of the Witness Statement of Andrew Jon Slack

⁴ Page 16 of AJS01 of the Witness Statement of Andrew Jon Slack

⁵ Exhibit AJS02 of the Witness Statement of Andrew Jon Slack

⁶ Paragraph 10 of the Witness Statement of Andrew John Slack

⁷ *Joseph Yu v Liaoning Light Industrial Products Import and Export Corporation* (BL O-013-05)

24. The case law above sets out that an allegation of bad faith must be distinctly proven and an assessment of such a claim must take into account all of the factual circumstances relevant to the case. The opponent has failed to file any evidence that shows the commercially dishonest intention of the applicant in making the application. As a result, the opponent has not made out a prima facie case of bad faith in relation to the application for the contested mark. Therefore, the opposition based upon section 3(6) fails.

Section 3(1)

25. I now move to consider the section 3(1) grounds. Section 3(1) of the Act provides as follows:

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

(a) [...]

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

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

(d) [...].

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

26. The relevant date for determining whether the applicant’s mark is objectionable under sections (3)(1)(b) and 3(1)(c) is the date of the application at issue, being 28 October 2020.

27. I bear in mind that the above 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].

28. The position under the above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect: *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. I have no submissions or evidence from either party as to who the relevant public will be. Given that the applicant's mark's goods are a range of pharmaceutical and dietetic substances, I consider that the relevant public for the majority of the goods will be members of the general public. I consider that the degree of attention being paid for those goods will, for the most part, be medium. In my view, the relevant public will consider different factors such as the ingredients, nutritional content, flavour and health benefits of the goods at issue. However, the same does not necessarily apply to the pharmaceutical and medical goods in the applicant's specification. For these goods, the average consumer will include both the medical professional who prescribes the goods and the end user who uses them. While I do not consider that the end user will pay any higher than a medium degree for these goods on the basis that they are prescribed by a medical professional, I am of the view that a doctor will pay a high degree of attention. This is on the basis that they will need to rely on their expertise in considering the active ingredients, symptoms of the patient and any risk of adverse reactions.

Section 3(1)(c)

29. I will first consider the opposition based on the 3(1)(c) ground. Section 3(1)(c) prevents the registration of marks which are descriptive of the goods, or a characteristic of them. 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. 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 Court of Justice of the European Union (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].”

30. The opponent has claimed that the applicant’s mark consists exclusively of signs which designate the kind, quality, intended purpose and other characteristics of the goods applied for. This is on the basis that it tells the customers that the goods are legal alternatives to steroids. Despite initially pleading that its mark has acquired distinctiveness as a result of the opponent’s use *for the benefit of the applicant*, no evidence that would point to acquired distinctiveness has been filed by either party. Further, I have no explanation as to what was meant by the applicant’s claim that the opponent has used the mark for the benefit of the applicant.

31. The applicant has also taken issue with the bulk of the opponent’s evidence showing that the phrase ‘Legal Steroid Alternative’ is widely used. I note that one of the applicant’s issues is that the evidence provided by the opponent of the phrase ‘Legal Steroid Alternative’ online⁸ is not targeted at the UK public. Also, the applicant states that this same evidence is inconsistent in that the webpages have a copyright date of 2021, indicating that it is evidence from after the relevant date. In response to this, the opponent admits that the evidence may have some US references but states that the evidence shows descriptive use in the English language. On the copyright date point, the opponent sets out that this was automatically generated by the script on the website.

32. Having reviewed the evidence and taking into account the opponent’s explanation, I am content to conclude that the evidence is from prior to the relevant date. However, I am in agreement with the applicant in that the evidence does not

⁸ Exhibits GAJP1 to GAJP15 of the Witness Statement of Giles Parsons

demonstrate a level of awareness of use of the phrase 'Legal Steroid Alternative' by the UK public, despite being in the English language. The websites provided are all '.com' or '.org' websites and some even contain references to products in US dollars. Aside from a reference to one customer in the UK who provided a review of a testosterone booster called 'Prime Male',⁹ there is nothing on these websites to suggest they show use of 'Legal Steroid Alternatives' in the UK. Further, there is no evidence as to how many UK consumers have accessed these websites, if at all. While I do not consider the evidence to be of any assistance to the opponent, the assessment I must make may also take into account the inherent meaning of 'Legal Steroid Alternatives' with regard to the perception of the mark by average consumers in the UK. Therefore, despite the difficulties with the opponent's evidence, the 3(1)(c) claim proceeds.

33. The applicant's mark is made up of an initialism, being 'LSA', that is followed by three words, being 'Legal Steriod Alternative'. Average consumers normally perceive marks as wholes and do not proceed to analyse their various details. While it is wrong to artificially dissect the applicant's mark, it is necessary to take into account its distinctive and dominant components and give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. As a result, it is necessary to assess the impressions of both the initialism and the word element separately before moving to assess their roles within the mark as a whole.

34. Firstly, I consider it necessary to address the use of the word 'Steriod' and its perception amongst the UK average consumer. 'Steriod' has no meaning in the English language and the opponent submits it to be a typographical error. The question as to whether it was a typographical error or an intentional misspelling is irrelevant to the assessment I must make. Instead, I will consider how the word will be seen by the average consumer in the context of the mark as a whole.

35. I note that it is established case law that the human eye has a well-known tendency to see what it expects to see.¹⁰ Therefore, I consider that the misspelling of 'Steriod'

⁹ Page 14 of Exhibit GAJP06 of the Witness Statement of Giles Parsons

¹⁰ See paragraph 48 of *Aveda Corporation v Dabur India Limited* [2013] EWHC 589 (Ch)

would be overlooked and, instead, the average consumer would see it as the word 'Steroid'. This is particularly the case given the context of the goods applied for and when viewed in conjunction with the remaining words in the mark. Even if the misspelling is noticed, I consider that it will simply be seen as an obvious misspelling of the word 'Steroid' and the average consumer will be aware of this.

36. Turning to the phrase 'Legal Steriod Alternative' as a whole, I note that I have submissions from both parties on this point. The applicant has submitted the following:

"20. At that, 'LEGAL STERIOD ALTERNATIVE' has no, or no single, meaning. The Opponent has provided no evidence as regards natural meaning. The Hearing Officer is invited to take judicial notice of the NHS definition:

"Steroids, also called corticosteroids, are anti-inflammatory medicines used to treat a range of conditions. They're different from anabolic steroids, which are often used illegally by some people to increase their muscle mass".

21. Note: it is natural to refer to 'steriods' and 'illegal steriods', not 'legal steriods'. Therefore, the word "STERIOD" is not naturally or commonly associated with the word "LEGAL". Accordingly, the uncommon use of "LEGAL STERIOD" ensures a distinctive character – particularly memorable in the United Kingdom.

22. As stated in the counterstatement the mark contains "juxtaposed" terms i.e. the mark has syntactically unusual combination. The addition of "ALTERNATIVE" is creative, ensuring that 'LEGAL STERIOD ALTERNATIVE' is not descriptive. The average consumer would not immediately understand that mark as conveying any particular message." (original emphasis included)

37. While the above submissions are noted, I disagree with the arguments the applicant is seeking to make. Firstly, I am of the view that the average consumer will understand that some steroids may be used illegally and, therefore, the concept

of a 'legal steroid' would be readily understood. Secondly, I do not consider that the average consumer would view 'Legal Steriod' on its own and then consider the addition of 'Alternative' to be a creative addition. In my view, the average consumer would view the phrase 'Legal Steriod Alternative' as a unit and understand its natural meaning to be a reference to a legal alternative to steroids. I do not consider that evidence is required to allow me to make such a finding.

38. While I appreciate that steroids may be legal in the UK, it is my understanding that this is only the case when they are prescribed by a doctor. Further, it is a common perception of the average consumer that using steroids for the purpose of body building or to gain muscle is, for the most part, illegal. It is my view that to an average consumer, the concept of a legal steroid alternative is clearly something that will be understood in that it is a product that provides body building or muscle gaining benefits, like some types of steroids do, but is legal.

39. Finally, I shall address the initialism. The opponent refers to the case of *Strigl* (cited above) in which the CJEU stated that the mere bringing together of a letter sequence as an abbreviation and a word combination, without introducing any unusual variations is likely to result in a verbal expression that consists exclusively of signs or indications that may serve in trade to designate characteristics of the services concerned. The opponent also referred to the UKIPO's Examination Guide which states that:

“where the mark consists of a letter and word combination and the letter sequence clearly and unambiguously represents the initial letter of each accompanying word in the mark, an objection under section 3(1)(c) will be raised. For example, the sign 'MGS Missile Guidance System', applied for in respect of 'electronic apparatus', would face objection under section 3(1)(c).”

40. The applicant sought to counter this point by distancing 'LSA Legal Steriod Alternative' from 'MGS Missile Guidance System' on the basis that 'Legal Steriod Alternative' is clearly impenetrable or fanciful as opposed to the example given. While this is noted, I see no basis for a finding that 'Legal Steriod Alternative' is

impenetrable or fanciful. In my view, the letters 'LSA', will be seen as an obvious abbreviation of the words that succeed them.

41. Turning to address the mark as a whole, the applicant submits that:

“As a general rule the beginnings of marks tend to make more impact on consumers than the endings (*El Corte Inglés, SA v OHIM, Cases T-183/02 and T-184/02*). 'LSA' is the dominant and highly distinctive element. The mark applied for has clear capacity to individualise.” (original emphasis included)

42. While I accept the principle set out in the case of *El Corte Inglés*, I also note that it is not always the case that average consumers focus on the beginnings of marks. I do not consider that the principle applies here. In my view, the average consumer's eye will, when considering the mark as a whole, be drawn to the phrase 'Legal Steroid Alternative' on the basis that it will be more readily understood. I have set out above that the 'LSA' element will simply be seen as the initials of the words that follow it and it is those words upon which the average consumer will likely focus. As a result of my findings above, the 'LSA' element will, in my view, have a negligible effect on the overall impression of the mark.

43. Taking the applicant's mark as a whole, I am of the view that it will be understood as a reference to a legal alternative to steroids. For those goods that can be said to be consumable legal goods that assist the user in building muscle mass, the applicant's mark is clearly descriptive of their kind or purpose and will, therefore, be objectionable under section 3(1)(c) of the Act. On this basis, it is now necessary to consider the goods for which the applicant's seeks to register its mark for and determine whether they are objectionable.

“Dietetic preparations; dietetic food and substances; dietetic food and substances adapted for medical use; dietary supplements for humans; diet capsules; dietary supplements and dietetic preparations; dietary supplements for humans; supplements for use in relation to energy, exercise, health, fitness, beauty, wellbeing, bodybuilding; all of the foregoing in drop form, powder form, capsule form, tablet form, and in liquid

form; dietary supplements and dietetic preparations; glucose dietary supplements; powdered nutritional supplement drink mix; powdered fruit-flavored dietary supplement drink mix; protein powder dietary supplements; protein supplement shakes; vitamin and mineral supplements; wheat dietary supplements; nutritional supplements; meal replacement powders; meal replacement bars; meal replacement drink mixes; nutritional energy bars; dietary and nutritional supplement drink mixes; nutraceuticals for use as a nutritional or dietary supplement; nutrition supplements in drop form, powder form, capsule form, tablet form and in liquid form; nutritional powder for use as a food additive for culinary purposes; fruit-based meal replacement powders; nutritional and dietetic food and substances; nutritional and dietary supplements for humans; nutrition and diet related products.”

44. The above goods cover a range of different types of dietary substances, food supplements and nutritional products. I am of the view that when the applicant's mark is used on these types of goods, it will be descriptive of their kind, in that they are legal alternatives to steroids, or purpose, in that they are capable of being used to assist the user in building muscle legally. For example, when 'LSA Legal Steriod Alternative' is seen on a diet capsule or a dietary food supplement in the form of a tablet, it will clearly be descriptive of the type of good being sold in that it is a legal alternative to steroids. As for its purpose, I am of the view that the phrase 'LSA Legal Steriod Alternative' gives a clear message to the user that the goods being sold can be used for the purpose of building and maintaining muscles, legally. This is on the basis that the purpose of steroids in this context is clear to the average consumer in that it is an illegal aid to building and/or maintaining muscle. The message of a legal alternative to that will be understood as being something that will assist the user in achieving the same purpose as a steroid, albeit legally.

45. The applicant's mark is, therefore, descriptive of the kind and purpose of the goods at issue. As a result, I consider that these goods are objectionable under section 3(1)(c) of the Act.

“Pharmaceuticals, medical preparations; all of the foregoing in drop form, powder form, capsule form, tablet form, and in liquid form”

46. It is my understanding that these goods include medicines or pharmaceutical that are prescribed by doctors or recommended by pharmacists and also over the counter medications. These goods can include steroids but can also cover a wide range of other types of goods that are capable of being readily understood by the average consumer as legal alternatives to steroids. For example, a doctor can prescribe a range of dietary capsules or dietetic preparations that are not steroids, but alternatives to them. In my view, the average consumer, on the understanding that steroids are, for the most part, illegal, would still consider these goods to be legal alternatives to steroids, regardless of whether they were prescribed or not. I consider that this applies even where the average consumer pays a high degree of attention on the basis that the medical professional would understand that the applicant's mark is still descriptive of the goods, in that they are legal alternatives to steroids. The applicant's mark is, therefore, capable of being descriptive of the kind of goods at issue. As a result, I consider that these goods are objectionable under section 3(1)(c) of the Act.

47. As I have found that the applicant's mark is objectionable in respect of all of the goods in its specification, the opposition reliant upon section 3(1)(c) of the Act succeeds in full.

Section 3(1)(b)

48. I now move to consider the opposition under section 3(1)(b) of the Act. Section 3(1)(b) prevents registration of marks which are devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG (C-265/09 P)* as follows:

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

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

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

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)."

49. The opponent's pleaded case in respect of its section 3(1)(b) ground is that the applicant's mark lacks distinctive character on the basis that it is descriptive. Given that the opponent also pleaded descriptiveness under its section 3(1)(c) ground, my assessment under this ground will not result in a different outcome from the one I have made above. Therefore, for the same reasons set out at paragraphs 30 to 46 above, I consider that the applicant's mark is devoid of distinctive character for all of the goods in its specification on the basis that it will be perceived by average consumers and end users as purely descriptive. The applicant's mark is, therefore, objectionable under section 3(1)(b) of the Act.

50. The opposition based on section 3(1)(b) succeeds in full.

Section 3(3)(b)

51. The opponent has pleaded an alternative claim in that if the applicant's mark is deemed not to be descriptive then it is deceptive and, therefore, falls foul of section 3(3)(b) of the Act. While I have found that the applicant's mark is descriptive of the goods for which it seeks to register, I will proceed to consider this ground in the event that I am incorrect on my finding that the applicant's mark is descriptive under the section 3(1) grounds. Section 3(3)(b) of the Act states:

“A trade mark shall not be registered if it is—

(a) [...]

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

52. In *Elizabeth Florence Emanuel v Continental Shelf 128 Ltd*, Case C-259/04, the CJEU stated:

“47. Nevertheless, the circumstances for refusing registration referred to in Article 3(1)(g) of Directive 89/104 presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived

(Case C-87/97 Consorzio per la tutela del formaggio Gorgonzola [1999] ECR I-1301, paragraph 41)".

53. In the event that the average consumer does not consider the goods in the applicant's specification to be goods that are capable of being legal alternatives to steroids, then I am of the view that the use of 'LSA Legal Steriod Alternative' on those goods is deceptive or poses a sufficiently serious risk that the consumer will be deceived. My reasons follow.

54. Given that the applicant's term of "pharmaceuticals" can be said to include legally prescribed steroids, it is possible that 'LSA Legal Steriod Alternative' is displayed on steroids themselves and potentially prescribed by a doctor. The average consumer will proceed to buy those goods on the assumption that they are not in fact steroids but a legal alternative to the same. In this scenario, the average consumer will have been deceived into buying a product that he/she believed to be a legal alternative to a steroid but was, in fact, a steroid.

55. Further, I consider that the same applies to the remaining goods in the applicant's specification. While they are not capable of covering legally prescribed steroids, I am of the view that the phrase 'LSA Legal Steriod Alternative' will still be deceptive in the event that it is not descriptive. This is on the basis that if the goods are not considered legal alternatives to steroids and are, instead, of another kind or for another purpose, then the reliance on the phrase 'legal steriod alternative' will deceive the average consumer into buying the goods on the basis that they are, in fact, legal alternatives to steroids and fit for the purpose of building muscle.

56. As a result of the above findings, I am of the view that, in the event the applicant's mark is not descriptive under the section 3(1) grounds, the average consumer will either be deceived by it or there is a sufficiently serious risk that they will be. Therefore, the opposition based on on section 3(3)(b) of the Act succeeds.

CONCLUSION

57. The opposition succeeds in its entirety. The application is, therefore, refused.

COSTS

58. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. Given that the evidence was of no assistance to the opponent in these proceedings, I consider it appropriate to reduce the costs award in respect of the evidence filed. In the circumstances, I award the opponent the sum of **£1,000** as a contribution towards its costs. The sum is calculated as follows:

Filing a notice of opposition and considering the counterstatement:	£200
Preparing evidence:	£300
Preparing submissions in lieu of a hearing:	£300
Official fees:	£200
Total	£1,000

59. I therefore order Bauer Holdings Limited to pay Swiss Research Labs Limited the sum of £1,000. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 10th day of November 2021

A COOPER
For the Registrar