

O-161-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 81883  
BY VITASOY INTERNATIONAL HOLDINGS LIMITED  
FOR A DECLARATION OF INVALIDITY IN RESPECT OF  
TRADE MARK No. 1546617 IN THE NAME OF THE SUNRIDER CORPORATION  
TRADING AS SUNRIDER INTERNATIONAL**

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**IN THE MATTER OF an Application under No. 81883  
by Vitasoy International Holdings Limited  
for a Declaration of Invalidity in respect of  
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The Sunrider Corporation trading as Sunrider International**

### BACKGROUND

1. Trade Mark No. 1546617 is for the trade mark VITALITE and is registered in Classes 5, 29 and 32 in respect of the following goods:

- Class 05:** Dietetic substances; herbal beverages; preparations made from herbs all being for health purposes; nutritional supplements; vitamins; dietary fibre supplements; herbal food tablets; mouth drops and lozenges; nutritional syrup; all included in Class 5; but not including oils or fats.
- Class 29:** Food and food products, all containing herbs; herbal food concentrates; snack bars containing herbs; preserved, dried and cooked fruit and vegetables; preserves; all included in Class 29; but not including oils or fats or goods of the same description as oils or fats.
- Class 32:** Syrups, preparations for making beverages, all being nutritional supplements in liquid form; nutritional syrups, herbal drinks, all being for sale on a one to one basis directly to consumers and not through retail outlets; all included in Class 32.

2. On 6 October 2004, Vitasoy International Holdings Limited applied for the registration to be declared invalid. The application is made on the following grounds:

- 1. Under Section 5(2)(b)** because the mark covered by the registration in suit is similar to the applicants' marks and is registered in respect of goods that are identical or similar to the goods covered by the applicants' marks such that there exists a likelihood of confusion.
- 2. Under Section 5(3)** by virtue of the reputation that the applicants' marks have in the UK, use of the registration would take unfair advantage of or be detrimental to their distinctive character or repute.
- 3. Under Section 5(4)(a)** because use of the registration is liable to be prevented by virtue of the law of passing off.

3. The applicants rely on four earlier marks, details of which can be found as an annex to this decision.

4. On 25 November 2004, the registered proprietors filed a Counterstatement in which they deny the grounds on which the application is based. In particular, they put the applicants to proof to show use of the three VITASOY trade marks relied upon, and state that the applicants' marks have been used concurrently with the registration, and being aware of the registered proprietors' use, the applicants have acquiesced for a continuous period of five years.

5. The registered proprietors and the applicants for invalidity both ask for an award of costs in their favour.

6. Both sides filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. The matter came to be heard on 15 December 2005, when the registered proprietors were represented by Mr Simon Malynicz of Counsel, instructed by J A Kemp & Co, their trade mark attorneys. The applicants were not represented.

### **Applicants' evidence**

7. This consists of two Statements. The first is dated 23 February 2005, and comes from Ms Ah Hing Tong, Company Secretary of Vitasoy International Holdings Limited, a position she has held since 1996.

8. Ms Tong gives an account of her company's history, from the first sales of the VITASOY, high protein soyamilk drink in Hong Kong in 1940, expanding in 1975 to encompass a range of fruit juice drinks, and soon after, lemon tea and chrysanthemum tea. Ms Tong refers to the company pushing into the overseas markets, entering the UK in September 1977, and now standing as one of the world's leading manufacturers of health and nutritious foods and beverages. She says that her company has two major brands of products, the VITASOY line of nutritious soybean drinks, and VITA dairy milk products, juice drinks, teas, carbonated drinks and bottled water. Exhibit AHT1 consists of samples of Tetra brik packaging for VITA and VITASOY products, some of which can be seen to bear the name of a UK importer, but being unused there is nothing such as a "best before" date by which to date them.

9. Ms Tong goes on to refer to Exhibit AHT2, which consists of a publication produced by her company entitled "Vision of VITASOY". The publication gives details of the history and development of the VITASOY and VITA products, but apart from a mention of exporting to the UK, gives no information relating to this market such as what, where, when and how much?

10. Ms Tong goes on to refer to her company's trade mark registrations, details of which she provides as Exhibit AHT3. Exhibit AHT4 consists of a table that Ms Tong says details the date of first use of the VITASOY and VITA trade marks in the European Union, listing the UK as "before 1985", the earliest being the Netherlands in 1979. Exhibit AHT6 is described as a schedule of Annual Shipment Sales, Ms Tong stating that the amounts shown are in Hong Kong Dollars, although she does not provide an exchange rate or sterling equivalent. The schedule relates to sales of VITA branded products in the EU in the years 1991/92 to 2003/2004. For the UK the figures range from \$1,020,893, rising almost year on year to a

peak of \$3,781,332, and show that the UK is the largest of the applicants' markets in the EU. Exhibit AHT 6 consists of a similar table relating to shipments of the VITASOY products, showing sales to be in the region of \$2.2 to \$4.4 million, again with the UK constituting the largest of their EU markets.

11. Ms Tong goes on to refer to Exhibit AHT7, which consists of a table showing the amounts spent on advertising and promotion of VITASOY and VITA products in the EU in the years 1996/97 through to 2001/02, which ranges from \$179,573 rising almost year on year to \$328,115, although there is no indication of the proportion spent in the UK.

12. Ms Tong says that it is estimated the VITASOY and VITA brands are among the most popular in the Chinatown markets of the UK and other European countries, but does not give any detail that would give this claim substance. She goes on to refer to her company's websites.

13. Exhibit AHT8 consists of a collection of invoices and bills of lading relating to shipments of VITASOY and VITA products to France, the Netherlands and the UK, in the latter case to the same importer shown on the packaging at exhibit AHT1. The UK documents date from 10 May to December 2000, and list various quantities of VITASOY and VITA products. Exhibit AHT9 consists of examples of advertisements used in the UK and Holland featuring the VITASOY and VITA trade marks. Two show VITA being used for bottled water and a fruit drink; there is no mention of VITASOY. Whilst there is nothing in the advertisements that shows when, or where they were available, they are accompanied by a Declaration from Ng Sze Mui, Exports Manager of the applicants' company, who confirms that they were in use in the UK and Holland "prior to March 1, 2001".

14. The second Witness Statement is dated 24 February 2005, and comes from Leighton John Cassidy, a Legal Assistant employed by Field Fisher Waterhouse, the applicants' representatives in these proceedings.

15. Mr Cassidy refers to exhibit LJC1, which consists of a letter dated 23 February 2005 from Ms Tong, enclosing examples of tetra-brik packaging for VITASOY, some of which can be seen to bear the name of a UK importer, but being unused there is nothing such as a "best before" date by which to date them.

### **Registered proprietors' evidence**

16. This consists of a Witness Statement from Oscar Crispino Philip D'Souza, Regional Finance Manager for Sunrider Europe, Inc, a European licensee of the Sunrider Corporation doing business as Sunrider International. Mr D'Souza says that he has held this post since 8 September 2003.

17. Mr D'Souza says that his company was founded in the US in 1982, as a manufacturer and distributor of dietetic substances, herbal supplements, vitamins and health supplements, herbal food products, snack bars, syrups and beverages, the business being conducted through a network of small distributors selling directly to the public.

18. Mr D'Souza says that the VITALITE trade mark was first used in the UK in 1991 in relation to herbal supplements and herbal food products under the trade marks VITALITE SUNBAR, VITALITE BAR, VITALITE PACK, VITALITE CAPS, VITALITE SPORTCAPS and VITALITE SLIM CAPS. He also mentions the trade marks VITADOPHILUS, FIBERTONE, FORTUNE DELIGHT, and VITATASTE, all of which I consider to be marks differing in their material particulars. Exhibit ODS1 is stated to show how the trade mark VITALITE is applied to the goods. The packaging shows, inter alia, the VITALITE marks being used in connection with dietary supplements, with the mark being shown both in a fancy italicised script and a plain font, in some cases in conjunction with the ® symbol. Whilst some bear a reference to a UK importer, being examples of unused packaging there is nothing such as a "best before" date by which to date them. Mr D'Souza says that his company has made steady sales of its products, going on to refer to a table summarising UK sales of VITALITE products in the period 1995 to 2004, the total sales being stated as £1,154,730, although not all in relation to VITALITE branded products. Mr D'Souza gives details of the regions of the UK in which VITALITE branded products have been sold, which is essentially throughout the UK.

19. Mr D'Souza goes on to refer to Exhibit ODS2, which consists of a collection of invoices. The earliest dates from 16 July 1992. An invoice of 22 July 1992 records the sale, inter alia, of VITADOPHILUS but has no mention of VITALITE. The first mention of VITALITE can be found on an invoice dating from 10 September 1996 relating to the sale of VITALITE PACK 1. Subsequent invoices list VITALITE BARS, VITALITE CAPS, VITALITE SLIMCAPS and VITALITE SUNBAR CHOCOLATE. The invoices also list products sold under VITA brands, such as VITASHAKE and VITATASTE.

20. Mr D'Souza goes on to refer to his company's promotion of its products in the UK, examples of which he shows as Exhibit ODS3. The earliest publication dates from 1997 and runs through to April 2004. Many appear to be produced for company distributors, some for customers, and although they appear to have been available in the UK, and mention VITALITE products, it is not known how many were issued or to whom.

21. Exhibit ODS4 consists of a selection of price lists, headed "United Kingdom", the earliest dating from 1 July 1995, stating the prices to be effective from 1 July 1995. This lists products under brand names including VITALITE PACK, VITAFRUIT, VITADOPHILUS, VITALITE BAR and VITATASTE. More recent lists show entries for products under VITALITE CAPS, VITALITE SUNBAR, VITASHAKE and VITALITE SLIMCAPS. Some entries are shown as coming in packs such as "starter packs" or "introductory packs" which seems to suggest they were intended for merchandisers rather than the public. The later examples lists various items of written and visual media for use by distributors of Sunrider products, but again there is no information that tells me how many lists were issued, who they may have been issued to or whether any were available to the public.

22. Mr D'Souza goes on to give the amounts spent in promoting his company's products in the years 1995 to 2004, which seems to have been exclusively through a monthly newsletter called Sunspot. He says that VITALITE products were regularly featured which indicates that this was not always the case. The amounts spent range from £11,923 to £17,777. Exhibit ODS5 consists of invoices dating from 17 January 2002, 17 December 2003 and 22 October 2004, relating to the printing of Sunspot Newsletters. For the English versions the invoices show that 586 copies of the January 2002, 580 of the December 2003 and 470 of the October 2004 newsletters were printed, each run being at a cost of around £1,000.

23. That concludes my review of the evidence insofar as it is relevant to these proceedings.

## **DECISION**

24. The relevant statutory provision in relation to an application for a declaration of invalidity can be found in Section 47, which are as follows:

“47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground -

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

(2A)\* But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

25. In paragraph 6 of their Counterstatement, the registered proprietors of the mark under attack put the applicants to proof in showing use of trade mark Nos. 539806, 1234113 and 1465316, all being the trade mark VITASOY. All three achieved registration more than five years before the filing of the application for a declaration of invalidity, so the provisions of Section 47(2)(a) et seq apply. For the record, I do not consider that use of the trade mark VITA constitutes “use of a trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”; it is a different mark to VITASOY.

26. The evidence is rather thin, but does contain a number of invoices (Exhibit AHT8) showing that in May and December 2000, a range of soyabean milk drinks bearing the VITASOY brand name was imported into the UK, within the five year period specified in Section (2B). The turnover figures attest to sales for a continuous period from 1991/1992 to 2003/2004. Although these figures are shown in Hong Kong dollars and no exchange rates have been provided, they can be put into some sort of context by the shipping quantities and costs shown in the invoices, from which they appear to show a genuine and commercial trade. The examples of packaging and product literature show how the mark is used, and although it does not conclusively do so in respect of the UK market, I see no reason why it should not be so; the registered proprietors have not seen fit to challenge this. Evidence relating to the promotion of the applicants’ mark is extremely limited, consisting of three examples, two showing use of the VITA trade mark in connection with distilled water and fruit juices; one not showing any mark at all, at least not that I can determine. There is nothing that states how often or where these advertisements would have appeared. The amounts stated to have been spent on promotion are in Hong Kong dollars with no indication of their value in sterling by which to put them into context. Given this uncertainty it is not possible to gauge its impact on the awareness of the mark amongst consumers.

27. As the evidence shows use only in respect of a soyabean milk drink, the provisions of Section 92E) apply, and I must consider their application as though the VITASOY marks are registered only in respect of a specification of goods for which the registered proprietors have proven use. The effect of Section 47(2E) is similar to that of Section 46(5), where, in a revocation based on alleged non-use of a registered trade mark, the evidence show use of the trade mark in respect of some, but not all of the goods or services for which that mark is

registered. In such circumstances the specification is restricted, but not necessarily to an exact description of the goods or services for which use has been shown.

28. When considering partial revocation of a mark, the starting point was for the court to find as a fact what use had been made of the trade mark. In *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 293 it was stated that because of the rights conferred by Section 10(2) of the Trade Marks Act 1994, fairness to the proprietor did not require a wide specification of goods or services. This was approved in *Thomson Holidays Ltd v. Norwegian Cruise Lines Ltd* [2003] RPC 32. In the *Thomson* case Aldous L.J conducted a useful critique of recent case law relating to revocation and referring to the *Decon* case said:

“30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox’s Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox’s Orange Pippins?”

29. This approach was cited with approval in *West (T/A Eastenders) v Fuller Smith & Turner plc* [2003] FSR 44, stating that the aim is to arrive at “a fair description which would be used by the average consumer for the products in which the mark has been used by the proprietor”. He went on to say:

“31 .... In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use ... Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

30. The three trade marks are registered in respect of different ranges of goods. Registration No. 1234113 covers “Soya bean milk” in Class 29. This is an exact description of the goods for which use is shown; it is consistently the way in which the applicants describe the goods on which they use VITASOY. This being the case I see no reason why the scope of this registration should be narrowed; it certainly cannot be widened.

31. Registration No. 1465316 is registered in respect of a range of carbonated and non-carbonated soya-based beverages and soya preparations for making such beverages, albeit in this case in Class 32. This class encompasses beverages with a base of soya beans, but unlike Class 29, not in milk form. There is no evidence that the applicants have used VITASOY in relation to beverages other than those in a milk based form, and consequently, they have no use of the mark in respect of goods in Class 32.

32. The remaining registration, No. 539806 is in respect of “Preparations made from soya beans” in Class 29, and “Flour made from soya beans” in Class 30. In the latter case there is no evidence of use, and is a product quite removed from the goods for which use has been shown. I therefore need only address the Class 29 specification. There is no evidence that shows the applicants to have used VITASOY on anything other than a beverage, which is a definable subset of the goods found in Class 29. Insofar as a beverage can be a “preparation” it would be covered by the scope of the registration. As the statement of goods is limited to those made from soya beans this defines the nature of the beverages. From this I consider that based on the use shown, a fair description of goods would be “beverages made from soya beans; soya bean preparations for making beverages.” Given that Class 29 covers beverages

that are made from milk or substitutes of milk, including soya beans, I do not consider it necessary to restrict the goods to being in milk form.

33. Having determined the breadth of the specifications of the applicants' VITASOY registrations on which I must base my decision, I turn to consider the grounds on which the application is based. I will look first at the ground under Section 5(2)(b), which reads as follows:

“5.-(2) A trade mark shall not be registered if because -

(a) .....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

34. An earlier trade mark is defined in Section 6 of the Act as follows:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

35. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant – but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v. Klijsen Handel B.V.* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

36. Accordingly, I must consider the matter through the eyes of the average consumer of the goods in question, assuming them to be reasonably well informed, circumspect and observant, and on the basis that they will make comparisons of marks based upon an imperfect recollection kept in their mind, not by an analysis of its component parts, but as whole against whole. This must be balanced against the fact that in a comparison of trade marks it is inevitable that reference will be made to the elements of which the marks are composed. Whilst this approach is consistent with the case law which requires that consideration to be given to the distinctiveness and dominance of the component parts, it must be the marks as a whole that are compared.

37. The applicants cite four marks, one consisting of the word VITA, the remaining three being for the word VITASOY. All are represented in a plain script. Insofar as the registration and the applicants' trade marks either consist of, or contain the element VITA, there is inevitably some visual and aural similarity. Adding another textual element must have an effect on the way a word will sound when spoken, and how it looks to the eye, and often more so where the additional element is conjoined rather than represented as a separate element. It is however, generally accepted that it is the beginnings of word marks that have most significance in a comparison, but this in turn may be affected by factors such as the relative strength and significance of the elements.

38. Before looking in detail at the similarity or otherwise of the respective marks, it is appropriate to first consider the question of whether there is a distinctive, dominant component, or does the distinctiveness rest in the marks as a whole? In his submissions relating to the conceptual messages conveyed by the respective marks, Mr Malynicz considered VITA to convey the idea of healthfulness and life-giving properties. Whilst there is no evidence to support this contention, I note that Collins English Dictionary states that it

is the plural of the word VITAE, from the Latin meaning “life”. Whether the consumer would be aware of this I do not know. Nor do I know whether the word is commonly used in trade; there is no evidence one way or the other. Whatever is the case, the word is an allusion, albeit none too covert, to products that lay claim to having health promoting properties.

39. In the mark VITALITE, Mr Malynicz considered the “LITE” element to carry the meaning of being “low-calorie” or “light-weight”. In respect of the goods covered by the subject trade mark, and indeed those for which the applicants’ marks are registered, such characteristics are possible, and potentially desirable. Although there is no evidence to this effect, I am aware that LITE (and/or LIGHT) is frequently used in relation to foods and beverages to describe a variety that are low sugar, low fat, or a healthy option, a usage that I consider the average consumer will be well aware of. This being the case, I consider that if there is a distinctive dominant element in VITALITE, it is more likely to be the VITA prefix, but for the reasons I have given below, it may well be that the distinctiveness rests in the mark in its entirety. The same is not the case in respect of VITASOY; there is nothing to suggest that SOY will be regarded as a reference to soya, and in my view there is no distinctive element, only a distinctive whole.

40. Clearly, VITA and VITALITE are different in sound and how they look. In normal speech, the VITA and SOY elements of VITASOY are likely to be clearly enunciated, VITA being aurally quite a strong feature. In the case of VITALITE, the VITA prefix has a degree of aural prominence, but the addition of LITE has a greater overall effect because the words run through to create a more cohesive sounding whole, and reducing the individual significance of VITA. Because VITA is a short word, the SOY and LITE suffixes have a greater impact on the appearance than would be the case had the prefix been longer. There is no visual feature that acts as a natural break for the eye to distinguish the VITA prefix from the SOY and LITE suffixes. I do not consider VITA or VITASOY to be similar in sound or appearance to VITALITE.

41. As I have already stated, Mr Malynicz considered the VITA mark to convey the primary message of healthy, life-giving properties, whereas VITALITE carries the meaning of low-calorie or light-weight. Taking this argument to its conclusion, Mr Malynicz seems to be accepting that the consumer is able to pick out the “LITE” element and consequently, may well see VITALITE as being composed of two distinct elements, the combination in essence meaning healthy-low calorie foodstuffs. There is no evidence as to the meaning of VITA, or that traders use this word to convey the idea ascribed by Mr Malynicz, but as I have already mentioned, VITA is the plural of the word VITAE, from the Latin meaning “life”, which is presumably the rationale for it being used by traders in relation to goods purported to have health promoting properties. With LITE being known as a description of a variety of goods that are low in sugar, fat, etc. or a “health option”, it is quite possible that the consumer will see VITALITE as the LITE version of VITA. The same is not the case in respect of VITASOY; there is nothing to suggest that SOY will be regarded as a reference to soya.

42. Turning to the respective goods. The applicants’ registration for VITA did not come within the requirements of the proof of use conditions, and stands for its full specification in Class 32, which is as follows:

Carbonated and non-alcoholic beverages; all made from or including sugar cane, guava and mango; all included in Class 32; but not including any drinks made from or including lime flavouring.

43. In looking at the use that the applicants have made of VITASOY in relation to the proof of use requirements, I came to the position that the evidence did not prove use in respect of any goods covered by registration No. 1465316, and that the specifications of the remaining two registrations should be taken as being in relation to the following goods;

1234113 Class 29 Soya bean milk,

539806 Class 29 Beverages made from soya beans; soya bean preparations for making beverages.

44. The registration in suit covers Classes 5, 29 and 32. the specification for Class 5 is as follows:

Dietetic substances; herbal beverages; preparations made from herbs all being for health purposes; nutritional supplements; vitamins; dietary fibre supplements; herbal food tablets; mouth drops and lozenges; nutritional syrup; all included in Class 5; but not including oils or fats.

45. Whilst the description “dietetic” could be said to cover “beverages”, I do not consider that given its usual and ordinary meaning, a beverage would be considered a “substance”. It would therefore follow that “dietetic substances” as a whole would not include beverages although could cover preparations for making into beverages. Quite clearly, “herbal beverages” are of the same nature as the goods for which the applicants’ marks have been used, and the description “preparations made from herbs” and “nutritional syrups” would also encompass preparations in the form of beverages, or for making into beverages. The remainder of the specification does not cover beverages, but may cover preparations for making into beverages.

46. To the extent that the registered proprietors’ Class 5 specification covers beverages and preparations for making into beverages, there is a similarity in the nature with the applicants’ VITASOY soya milk beverages, and the beverages for which their vita mark is registered. The registered proprietors’ beverages are herbal, whereas the applicants’ are not (non-medicinal herbal beverages are proper to Class 30), but this does not make them different in nature. The foodstuffs and beverages covered by Class 5 are for medical purposes, that is they are specifically adapted for consumption by a person with a medical dysfunction, which is not totally dissimilar in purpose to the applicants’ soya milk drinks which is promoted for its health promoting properties, or the beverages generally covered by Class 32. In fact, persons with a medical condition that results in an intolerance to lactose may use the applicants’ soya product in preference to dairy milk. Given this it would seem that it is not so improbable that the respective beverages may meet in the retail chain, such as in pharmacy, and be considered complementary. On balance I would say that the registered proprietors’ beverages and preparations for making the same are similar goods to the applicants’ beverages in Class 29 and 32.

47. Turning to the goods in Class 29 the registration, which reads as follows:

Food and food products, all containing herbs; herbal food concentrates; snack bars containing herbs; preserved, dried and cooked fruit and vegetables; preserves; all included in Class 29; but not including oils or fats or goods of the same description as oils or fats.

48. Insofar as a beverage can be food, it would follow that the descriptions “food and food products, all containing herbs” and “herbal food concentrates” listed in the specification would cover beverages, which in this class would be milk based, be it dairy, soya or whatever, and preparations for making such beverages. The limitation of the foodstuffs to containing herbs, or being herbal does not change this. Accordingly, insofar as Class 29 of the registration would cover beverages and preparations for making beverages, the registration includes goods that are the same or similar to the soya milk beverages and preparations for making such beverages for which the applicants have used their VITASOY marks. The remainder of the registered proprietors’ specification does not contain similar goods.

49. The applicants’ VITA mark is registered in Class 32 for a range of beverages either made from or including sugar cane, guava and mango. From this description it is self evident that these beverages are different in nature to the milk-based drinks in Class 29, such that I consider that if both were to be stocked by a retailer, they would be positioned in distinct areas. Being different it seems less likely that they would be in competition; one is not the alternative choice for the other, but may well be considered complementary products. They may share the same purpose; both are for drinking, but I am not sure that both types would be produced by, or considered to be in the same market sector, or be classified as being similar goods; there is no evidence that they would. I see no reason why the end consumer should not be the same. On balance I would say that the differences outweigh the similarities to the extent that they should not be considered to be similar goods.

50. This leaves Class 32 of the registration, the specification reading as follows:

Syrups, preparations for making beverages, all being nutritional supplements in liquid form; nutritional syrups, herbal drinks, all being for sale on a one to one basis directly to consumers and not through retail outlets; all included in Class 32.

51. I have already stated that I do not consider the beverages found in Class 29 to be similar to those in Class 32, so it must follow that the goods for which the applicants have used their VITASOY marks cannot be similar to the goods in Class 32 of the registration in suit.

52. The applicants’ VITA mark is registered in Class 32 in respect of “beverages made from or including sugar cane, guava and mango”, with the exclusion of those having a lime flavouring, which in the circumstances of this case has no bearing. The registered proprietors’ specification for Class 32 covers “syrups” which would include those for making into beverages, “preparations for making beverages”, and “herbal drinks”, all potentially being or for making up into the same beverages as those covered by the applicants’ registration. Whilst there are qualifications such as “all being nutritional supplements in liquid form” and “all being for sale on a one to one basis directly to consumers and not through retail outlets” attached to the registered proprietors’ goods, as the applicants’ goods are not limited they would notionally encompass beverages being nutritional supplements

sold direct to the consumer. The one grey area here is the “herbal drinks” which, if they are as described, appear to have been accepted in the wrong class. As I have already stated, such drinks are proper to Class 30. However, as they have been registered in Class 32, I must assume that these drinks are proper to that class, and are therefore not herbal per se, but are a beverage proper to that class that has herbs as a minor ingredient, and therefore are potentially similar goods to those of the applicants’ registration.

53. As I have already mentioned, there is nothing in the wording of any of the respective specifications of goods that restricts or makes them specialised in some way, such that they would be separated in their markets or in the course of trade. Accordingly I must notionally assume that they operate in the same sector, and share the same channels of trade, from manufacture to retail. Whilst the “notional” average consumer will depend upon the type of goods, I see no reason why the consumer of the registered proprietors’ goods should be any different to those of the applicants’ goods.

54. Although not inordinately expensive, or sophisticated to the extent that the consumer would indulge in a deal of thought and comparison prior to making the purchase, neither are the goods covered by the applicant’ registrations run-of-the-mill products such as a loaf of bread, lemonade or baked beans that are everyday, inconsequential purchases. They are goods likely to be obtained specifically for their perceived health promoting properties, by consumers who either went looking to obtain such goods, or who encounter them on a shopping trip and after studying their nature and purpose, buy them without any prior thought of doing so. In both cases the purchase will be deliberate and considered, and more likely than not, be by a “clued-up” consumer. In the same way, the registered proprietors’ goods have a degree of adaptation that would make the purchase a more deliberate event, particularly so in relation to the goods listed in Class 5.

55. Where I have found there to be identical goods involved, there seems no reason why they should not be sold alongside one another on the same shelf. Even where the goods are not of themselves similar, that they all are intended for some special dietary purpose makes the likelihood of them reaching into the same retail outlets, such as a pharmacy, more than just a mere possibility.

56. Earlier I stated that the evidence filed by the applicants is thin, but went on to conclude that it did contain enough to satisfy the provisions of Section 47(2)(a), albeit only in relation to some of the goods covered. The question of whether the evidence shows that the applicants have a reputation in their mark is a different matter altogether, and in this respect it is lacking in some important areas. The turnover figures refer to sales for a continuous period from 1991/1992 to 2003/2004, but are shown in Hong Kong dollars with no exchange rates provided. For the purposes of determining whether there had been a genuine trade I put these amounts into context by reference to the unit prices and quantities shown on the invoices. However, in establishing whether the use has been such that it has enhanced the distinctive character of the VITASOY marks, I do not consider this extrapolation to be appropriate or helpful. There is no evidence as to the size, or the applicants’ share of the soya milk beverage market. The information provided in relation to the promotion of the marks is similarly lacking in the detail that assists in assessing the effect on the consumers’ awareness of the mark. On what I have to go on it seems likely that the applicants have established a reputation in their mark VITASOY in the UK in relation to soya milk drinks, but if they wish to claim the benefit of a reputation that has boosted the distinctiveness of that mark the onus is on them to provide the supporting evidence; they have not done so.

57. The evidence of use relating to the VITA trade mark suffers from similar deficiencies, eg. turnover in Hong Kong dollars with no exchange rates, no market details, etc. Whilst it may well be that the applicants have established a reputation in the UK relation to the mark VITA for their fruit juice and bottled water products, I do not know the extent, and whether the trade mark has become any more distinctive by virtue of this use.

58. In their Counterstatement, the registered proprietors say that they have been using the trade mark VITALITE in the UK for some thirteen years concurrently with the applicants' VITASOY and VITA trade marks with no instances of confusion. There is no suggestion that the registered proprietors' use has been anything but honest, but the fact that there has been honest concurrent use is not a defence which in itself will save an application. It is, however, one of the relevant factors which should be taken into account in determining whether there is a likelihood of confusion.

59. The registered proprietors say that they have used VITALITE in the UK since 1991. The evidence shows use of the word on its own, both in plain and an italicised script, and also in conjunction with product descriptions such as BAR, PACK and CAPS, and sub-brands of the like of SUNBAR and VITADOPHILUS, but not from 1991. The earliest use is on an invoice dated from 7 July 1992 forming part of Exhibit ODS2, which lists goods under the trade mark VITADOPHILUS which as I have said is used as a sub-brand of VITALITE on the examples of packaging and some product literature, but this is not always the case, and I do not know whether they were doing so at the date of the invoice. The first use of VITALITE relating to actual sales can be found in an invoice dating from September 1996, also forming part of Exhibit ODS2, which refers to the sale of "VITALITE PACK 1". Given that this shows a cost of £299 it is clearly not just one retail pack of the product. Exhibit ODS4 contains a collection of price lists, the earliest stated as being effective from 1 July 1995. This shows the "VITALITE PACK 2 (bottles)" as containing "NuPlus 6 Flavour combination 42/15g-Action Caps 3/100 caps-Vitalite Bar (3), Fortune Delight 42/3g". The NuPlus, Action Caps and Fortune Delight products are also sold separately. The price list also has a section headed "VITALITE PRODUCTS" under which is listed Action Caps, Vitadophilus, Vitalite Bar, Vita Taste, and Fibretone products. There are also references to VitaFruit. These price lists appear to be for distributors rather than for use by the ultimate end purchaser. There is nothing that shows how many UK distributors received the lists, whether, and if so, when any goods were ordered by a UK distributor, or were actually sold to the public.

60. The applicants in turn claim to have been trading in the UK since 1977. The evidence shows them to have used their VITASOY mark in relation to a soya milk based beverage, and their VITA mark in respect of water and fruit juices. There is no evidence of actual confusion despite the concurrent use. Mr Malynicz referred me to "*Harrods v Harrodian* [1996] RPC697 stating that whilst there is no requirement to demonstrate actual confusion, it is well established that where there has been extensive side-by-side trade without any actual instances of confusion, that can be an indicator that absent some explanation, no confusion is likely. It is also well established that the absence of evidence of actual confusion is not decisive. This is partly because evidence of confusion is notoriously difficult to obtain, and even if there has been relevant confusion, such evidence may not exist because the purchaser is happy with the quality of the goods purchased, they do not complain or may not be even aware that they have been misled as to trade source. See, for example, *Bali v Berlei* [1969] RPC 472 at 492 (lines 12-21) and 498 (lines 1-16 and *Electrux* [1953] 70 RPC 127 at 132. Partly for this reason it has long been held that the assessment of the likelihood of confusion

is a matter for the tribunal to determine. See, for example, *GE trade mark* [1973] RPC 297 and *Neutrogena v Golden* [1996] RPC 473.

61. Given the period that the two parties appear to have been trading in the UK, if there was going to be confusion it has had ample time in which to occur. Whilst the length of time that the parties have been trading concurrently is an important consideration, what matters most is whether the circumstances in which they have used their marks are such, that if there was a potential for confusion it would most likely have arisen.

62. Unlike the comparison of the goods covered by the respective trade marks which is a question of what the descriptions would notionally cover given their usual and ordinary meanings, the determination of whether there has been concurrent use that I should take into account in my assessment of the likelihood of confusion is a matter of fact. As I have highlighted above, the evidence only shows the parties potentially to have been trading concurrently from July 1995, but in my view this still gives a sufficiently long period prior to the application for invalidation for any confusion to manifest itself. I would, however, say that even if I were to accept the registered proprietors' claim to having traded concurrently with the applicants since 1991, I would reach the same conclusions. On my assessment of the evidence it is clear that the parties have been using their respective trade marks in relation to a narrow and different range of goods, and in respect of the registered proprietors, trading through a network of informed distributors rather than retail outlets. Given these differences it is not surprising that there is no evidence of confusion, and in the circumstances of this case I do not consider that I should consider the concurrent use to be a factor relevant to my decision.

63. Taking all of the above and adopting the global approach that I must, I come to the position that even though there are similarities in the factors pertaining to the applicants' VITASOY marks, that these are outweighed by the differences, and that there is no likelihood of the public being led into wrongly believing that the goods for which VITALITE is used come from the applicants or some economically linked undertakings. This being the case, there is no likelihood of confusion. However, the position is different in respect of the applicants' VITA mark where I consider use of VITALITE by the registered proprietors in respect of all goods contained in Class 32, and the following goods in Classes 5 and 29 is likely to cause confusion:

**Class 5:** Herbal beverages; preparations made from herbs all being for health purposes, nutritional syrup (insofar as this includes beverages and preparations for making beverages).

**Class 29:** Food and food products, all containing herbs, herbal food concentrates (insofar as this includes beverages and preparations for making beverages).

64. The application under Section 5(2)(b) succeeds accordingly.

65. Turning next to the ground under Section 5(4)(a). That section reads as follows:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) ....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

66. Mr Geoffrey Hobbs QC, sitting as the Appointed Person set out a summary of the elements of an action for passing off in his decision in the *WILD CHILD* Trade Mark case [1998] RPC 455. Mr Hobbs summarised the requirements as follows:

“(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.”

67. I have accepted that the evidence to establish that the applicants’ marks VITASOY and VITA have a reputation in the UK, albeit I do not know their extent, the former in respect of soya milk beverages, the latter in relation to water and fruit juices. On the facts before me it is not unreasonable to accept that they have achieved a level of goodwill commensurate with this reputation. However, for the reasons that I have given in some detail in my determination of the ground under Section 5(2), the applicants’ VITASOY marks are not similar, and consequently, I do not see that there can be a misrepresentation, or that the opponents will suffer any damage by the applicants’ use of VITALITE in relation to the goods for which it is registered.

68. I did, however, come to the view that the applicants’ VITA mark is similar to VITALITE, and that taking into account all of the surrounding factors, there was a likelihood of confusion in relation to beverages, or preparations for making beverages insofar as such goods were covered by the registration in suit, but not in respect of the remaining goods which I considered to be sufficiently far removed. I am aware that in *Harrods v Harrodian* it was accepted that there is no rule that the respective parties must be operating in the same field of activity, but the more remote the activities, the stronger the evidence needed to establish a real likelihood of damage. Where the fields of activity are different, the burden or proving that the registered proprietor’s use presents a real likelihood of damage to the applicants’ business is a very heavy one (*Stringfellow*s [1984] RPC 546).

69. The applicants have not used their VITA trade mark on a range of goods and services, only water and fruit juices, and I am mindful that they have not in any way provided concrete evidence that shows the extent of their reputation or goodwill in the UK. I do not see there would be any expectation in the minds of the public, that use of VITALITE on health supplements far removed from beverages, would be connected with the applicants. Consequently, I do not see that there is a likelihood of the applicants suffering damage by the registered proprietors’ use of VITALITE in relation to goods other than beverages or for

making beverages. I do not consider that the ground under Section 5(4)(a) takes the applicants' case any further forward than that under Section 5(2)(b).

70. This leaves the ground under Section 5(3). That section reads as follows:

“5.-(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

71. The European Court of Justice in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C-292/00) which was confirmed by its decision in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (C-408/01) determined that Article 5(2) of the Directive granted a right to the proprietor of an earlier trade mark with a reputation, to prevent others from using an identical or similar trade mark in relation to goods or services where such use would, without due cause, take unfair advantage or be detrimental to the distinctive character of the earlier trade mark.

72. Other than a simple recital of the relevant section of the Act, the applicants do not provide any explanation as to the nature of their objection. The first requirement to be met under Section 5(3) is for the earlier trade mark to be identical or similar to the trade mark that is the subject of these proceedings. As I have already stated in my determination of the earlier grounds, I consider the applicants' VITA mark to be similar, but their VITASOY marks not to be so. It is therefore only the VITA mark that I need consider further, and as I have already found for the applicants in relation to the same and similar goods, I shall address the ground on the basis that the goods are not similar.

73. The next requirement is that the opponent's mark possesses a reputation in the UK to the extent set out by the ECJ in *General Motors Corporation v. Yplon SA* [1999] E.T.M.R. 122 (Chevy). The court concluded that the requirement implies a certain degree of knowledge amongst the public, and that the required level would be considered to have been reached when the earlier mark is known by a significant part of the relevant sectors of the public. In deciding whether this requirement is fulfilled all relevant factors should be considered, including, the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking promoting it; the stronger the reputation and distinctive character, the easier it will be to accept that detriment has been caused to it.

74. The table at AHT4 does not give the exact, or even a close approximation of the date of the first shipment of VITA branded goods to the UK, simply stating this to be “before 1985”, but does not say what these goods were, or provide any form of corroborative evidence. The first established use of VITA can be seen in the invoices forming part of Exhibit AHT8, those

relating to the UK being dated 10 May 2000. If I take Ng Sze Mui's Declaration at face value, this would establish the earliest use of VITA as being in relation to distilled water and fruit juices, the use commencing during 1999.

75. Exhibit AHT5 provides figures for the "Annual Shipment Sales Amount (HK\$)", *inter alia*, for the UK, but without providing any information on the sterling value, or that puts these figures into the context of the overall size of the UK market. I do not, therefore, consider that I am in a position to determine, with any degree of certainty, whether the trade has been at a level from which it would be reasonable to infer that at the relevant date, the applicants' VITA trade mark is likely to have become known to a significant part of the relevant public in relation to the product for which it has been used.

76. For arguments sake I shall set aside my concerns and go on to consider the case as though the applicants' mark VITA has become known to a significant part of the public concerned, and to determine whether I can conclude that there will be advantage gained, or detriment caused by the registered proprietors' use of VITALITE in relation to the goods for which it is registered. In the *General Motors Corporation v. Yplon SA* case, the ECJ said the following:

"42. Above all, it is necessary to give full weight to the provisions of Article 5(2) as a whole. Thus the national court must be satisfied in every case that the use of the contested sign is without due cause; and that it takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the mark. These requirements, properly applied, will ensure that marks with a reputation, whether or not the reputation is substantial, will not be given unduly extensive protection.

43. It is to be noted in particular that Article 5(2), in contrast to Article 5(1)(b), does not refer to a mere risk or likelihood of its conditions being fulfilled. The wording is more positive: "takes unfair advantage of, or is detrimental to". [FN14] Moreover, the taking of unfair advantage or the suffering of detriment must be properly substantiated, that is to say, properly established to the satisfaction of the national court: the national court must be satisfied by evidence of actual detriment, or of unfair advantage. The precise method of adducing such proof should in my view be a matter for national rules of evidence and procedure, as in the case of establishing likelihood of confusion: see the tenth recital of the preamble."

77. The words "without due cause" were considered in *Premier Brands UK v Typhoon Europe* [2000] FSR 767. In that case Neuberger J. indicated that the interpretation of these words had to be considered in relation to the general purpose and effect of section 10(3), the purpose of which being to protect the value and goodwill of trade marks, particularly where they are well known, from being unfairly taken advantage of or unfairly harmed. It was not relevant whether the later mark had been innocently adopted. The words have to be read as not merely governing the words "the use of the sign", but also the words "takes unfair advantage of, or is detrimental to", and bearing in mind the overall purpose of Section 10(3) requires the defendant to show not merely that the use of the allegedly infringing sign in connection with the defendant's goods is "with due cause", but also that although the use of the sign might otherwise be said to "take unfair advantage of or is detrimental to" the mark, the advantage or detriment are not "without due cause". He considered this conclusion to be consistent with the view of the Benelux Court in *Lucas Bols* [1976] I.I.C. 420 at 425, where, when discussing the meaning of "without justifiable reason" the Court said.

“What this requires, as a rule, is that he user (of the mark) is under such a compulsion to use this very mark that he cannot honestly be asked to refrain from doing so regardless of the damage the owner of the mark would suffer from such use, or that the user is entitled to the use of the mark in his own right and does not have to yield this right to that of the owner of the mark ....”

78. The registered proprietors do not specifically deny that they will benefit, or that the distinctiveness or reputation of the applicant’s mark will suffer as a result of their use of VITALITE, instead relying on a general denial of all of the grounds. Whilst there is nothing inherently wrong with this, the consequence is that in the event of it being found that advantage will be gained, or detriment suffered, I do not see that I am in a position to conclude that the registered proprietors nonetheless had due cause to use the trade mark.

79. In my determination of the ground under Section 5(2)(b), I found that taking into account all of the relevant circumstances, there was a likelihood of origin confusion in respect of some of the goods covered by the subject registration. Whilst such confusion is not necessary for there to be a finding in favour of the applicants under Section 5(3), that there is potential for confusion must inevitably lead to the possibility of the registered proprietors gaining an unfair advantage, or detriment suffered by the earlier mark.

80. In my view the goods of the subject registration that I did not find to be similar in my consideration of Section 5(2)(b) are quite some way removed from those for which the evidence shows the applicants’ VITA trade mark is distinctive and has a reputation. They are sufficiently different in nature, purpose, and in the absence of evidence to the contrary, trade channels, that even selling them under what I have accepted as being a similar mark is not, in my view, likely to lead the public into believing that there is any economic connection with the applicants. As was stated in the *Premier brands* case, “Section 10(3) is not intended to have the sweeping effect of preventing the use of any sign which is the same or similar to, a registered trade mark with a “reputation” or have the intention of enabling the proprietor of a well known registered mark “... to be able to object as a matter of course to the use of a sign which may remind people of his mark.” As with the ground under Section 5(4)(a), I do not see that the ground under Section 5(3) takes the applicants’ case any further forward than that under Section 5(2)(b).

81. In their Counterstatement, the registered proprietors sought to invoke the defence found in Section 48(1)(a) stating that the applicants had been aware of, and had acquiesced for a continuous period of five years in the registered proprietors’ use of the registered VITALITE trade mark. Section 48, reads as follows:

**48.-(1)** Where the proprietor of an earlier trade mark or other earlier right has acquiesced for continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right-

(a) to apply for a declaration that the registration of the later trade mark is invalid, or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used, unless the registration of the later trade mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark.

82. The provisions of Section 48 apply where the registered trade mark has been in use for at least five years, that is, five years of use as a registered trade mark, not use of the trade mark per se. The VITALITE trade mark was registered on 10 December 1999, which means that for Section 48 to apply the application for a declaration of invalidity must have been made after 10 December 2004. The application was, in fact made on 6 October 2004, within five years of the date of registration. This being the case, the registered proprietors cannot pray in aid Section 48 of the Act, and I do not, therefore, have to go on to determine whether they have made a "...*prima facie* case which has not been rebutted."

83. Given my findings under Section 5(2)(b), if the registered proprietors file a Form TM23 within one month from the end of the appeal period to reduce their registration to Classes 5 and 29, and to a specification in those classes of:

**Class 05:** Dietetic substances; preparations made from herbs all being for health purposes; nutritional supplements; vitamins; dietary fibre supplements; herbal food tablets; mouth drops and lozenges; nutritional syrup; all included in Class 5; but not including oils or fats, and not including any goods being beverages or for making beverages.

**Class 29:** Food and food products, all containing herbs; herbal food concentrates; snack bars containing herbs; preserved, dried and cooked fruit and vegetables; preserves; all included in Class 29; but not including oils or fats or goods of the same description as oils or fats, and not including any goods being beverages or for making beverages.

84. I will, in the event of no appeal, allow this registration to remain on the register. If the applicants fail to file a TM23 within one month from the end of the appeal period the registration will be declared invalid in its entirety.

85. The applicants attacked the registration in its entirety, but they have only been partially successful. The registered proprietors defended the registration in its entirety but also with partial success. In the circumstances I consider it appropriate to take this as a score draw, and as there are no other factors that would warrant an award, make no award of costs.

**Dated this 14<sup>th</sup> day of June 2006**

**Mike Foley  
For the Registrar  
The Comptroller-General**



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## Trade Mark Details as at 14.06.2006

### CASE DETAILS FOR TRADE MARK 1465275

**Mark Text :**

VITA

**Status:** Registered

**Class:** 32

**Licensee details are held:** [for further information please contact our sales team](#)

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#### Relevant Dates

**Filing Date:** 24.05.1991  
**Registration Date:** 17.11.2000  
**Next Renewal Date:** 24.05.2008

#### Publication in Trade Marks Journal

	Journal	Page	Publication Date
<b>First Advert</b>	6074	3143	10.05.1995
<b>Registration</b>	6359		20.12.2000
<b>Expiry</b>	6359		20.12.2000
<b>Restoration</b>	6363		24.01.2001

#### List of goods and/or services

**Class 32:**

Carbonated and non-alcoholic beverages; all made from or including sugar cane, guava and mango; all included in Class 32; but not including any drinks made from or including lime flavouring.

#### Names and Addresses

**Proprietor:** Vitasoy International Holdings Limited  
 1 Kin Wong Street, Tuen Mun, New Territories, Hong Kong

**Incorporated Country:** Hong Kong Special Admin.  
 Region of the People's Rep. of

**Residence Country:** China  
Hong Kong Special Admin.  
Region of the People's Rep. of  
China

**Customer's Ref:** SATURN/VIT

**ADP Number:** [0462627001](#)

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**Agent:** Field Fisher Waterhouse LLP  
35 Vine Street, London, EC3N 2AA

**ADP Number:** 0626972001

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**Service:** Field Fisher Waterhouse LLP  
35 Vine Street, London, EC3N 2AA

**ADP Number:** 0626972001

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#### Other Particulars

**Honest Concurrent Use:**

Use claimed from the year 1978. Section 12(2).

**Previous Acceptance Text:**

Previously accepted on 21 April 1994 and advertised in Journal 6026 page 3191.

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## Trade Mark Details as at 14.06.2006

### CASE DETAILS FOR TRADE MARK 1465316

**Mark Text :**

VITASOY

**Status:** Registered

**Class:** 32

**Licensee details are held:** [for further information please contact our sales team](#)

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#### Relevant Dates

**Filing Date:** 24.05.1991  
**Registration Date:** 02.10.1992  
**Next Renewal Date:** 24.05.2008

#### Publication in Trade Marks Journal

	Journal	Page	Publication Date
<b>First Advert</b>	5933	5481	22.07.1992
<b>Registration</b>	5952		02.12.1992
<b>Renewal</b>	6214		25.02.1998

#### List of goods and/or services

**Class 32:**

Carbonated and non-carbonated beverages; non-alcoholic beverages; syrups and preparations for mixing such beverages; all included in Class 32; all being made from soya beans.

#### Names and Addresses

**Proprietor:** Vitasoy International Holdings Limited  
 1 Kin Wong Street, Tuen Mun, New Territories, Hong Kong

**Incorporated Country:** Hong Kong Special Admin.  
 Region of the People's Rep. of  
 China

**Residence Country:** Hong Kong Special Admin.  
Region of the People's Rep. of  
China  
**Customer's Ref:** SATURN/VIT  
**ADP Number:** 0462627001

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**Agent:** Field Fisher Waterhouse LLP  
35 Vine Street, London, EC3N 2AA

**ADP Number:** 0626972001

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**Service:** Field Fisher Waterhouse LLP  
35 Vine Street, London, EC3N 2AA

**ADP Number:** 0626972001

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## Trade Mark Details as at 14.06.2006

**CASE DETAILS FOR TRADE MARK 1234113**

**Mark Text :**

VITASOY

**Status:** Registered

**Class:** 29

**Licensee details are held:** [for further information please contact our sales team](#)

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### Relevant Dates

**Filing Date:** 23.01.1985  
**Registration Date:** 04.08.1989  
**Next Renewal Date:** 23.01.2016

### Publication in Trade Marks Journal

	Journal	Page	Publication Date
<b>First Advert</b>	5772	2327	10.05.1989
<b>Registration</b>	5794		11.10.1989
<b>Renewal</b>	6614		30.12.2005
<b>Expiry</b>	5917		01.04.1992

### List of goods and/or services

**Class 29:**  
 Soya bean milk.

### Names and Addresses

**Proprietor:** Vitasoy International Holdings Limited  
 1 Kin Wong Street, Tuen Mun, New Territories, Hong Kong

**Incorporated Country:** Hong Kong Special Admin.  
 Region of the People's Rep. of  
 China

**Residence Country:** Hong Kong Special Admin.

Region of the People's Rep. of  
China  
**Customer's Ref:** SATURN/VIT  
**ADP Number:** [0462627001](#)

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**Agent:** Field Fisher Waterhouse LLP  
35 Vine Street, London, EC3N 2AA

**ADP Number:** 0626972001

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**Service:** Field Fisher Waterhouse LLP  
35 Vine Street, London, EC3N 2AA

**ADP Number:** 0626972001

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## Trade Mark Details as at 14.06.2006

### CASE DETAILS FOR TRADE MARK 539806

**Mark Text :**

VITASOY.

**Status:** Registered

**Classes:** 29 30

**Licensee details are held:** [for further information please contact our sales team](#)

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#### Relevant Dates

**Filing Date:** 10.03.1933  
**Next Renewal Date:** 10.03.2013

#### Publication in Trade Marks Journal

	Journal	Page	Publication Date
<b>First Advert</b>	2876	560	10.05.1933
<b>Renewal</b>	6467		07.02.2003

#### List of goods and/or services

**Class 29:**  
Preparations made from soya beans.

**Class 30:**  
Flour made from soya beans.

#### Names and Addresses

**Proprietor:** Vitasoy International Holdings Limited  
1 Kin Wong Street, Tuen Mun, New Territories, Hong Kong

**Incorporated Country:** Hong Kong Special Admin.  
Region of the People's Rep. of  
China

**Residence Country:** Hong Kong Special Admin.

Region of the People's Rep. of  
China

**Customer's Ref:** SATURN/VIT  
**Effective Assignment date:** 17.10.1986  
**Assignment Date:** 17.10.1986  
**ADP Number:** [0462627001](#)

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**Agent:** Field Fisher Waterhouse LLP  
35 Vine Street, London, EC3N 2AA

**ADP Number:** 0626972001

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**Service:** Field Fisher Waterhouse LLP  
35 Vine Street, London, EC3N 2AA

**ADP Number:** 0626972001

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