

TRADE MARKS ACT 1994

**IN THE MATTER OF AN APPLICATION
UNDER NUMBER 10159 BY SETON HEALTHCARE GROUP PLC
FOR REVOCATION OF TRADE MARK
NUMBER 1372130 IN THE NAME OF
BIOCARE LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF an application
under number 10159 by Seton Healthcare Group plc
5 for revocation of trade mark number 1372130
in the name of BioCare Limited**

DECISION

10 Trade mark registration No. 1372130 is in respect of the mark VITASORB and is registered in Class 5 for a specification of:

15 Pharmaceutical preparations and substances; vitamin and mineral preparations; all included in Class 5.

The registration currently stands in the name of BioCare Limited.

20 By an application dated 15 June 1998, Seton Healthcare Group plc applied for the registration to be revoked on the grounds that:

25 the mark has not been used in the United Kingdom by the registered proprietor or with his consent for a continuous period of five years up to the date of three months before the date of the application for revocation.

The registered proprietors filed a Counterstatement in which they deny the assertions in the application. The registered proprietors and the applicants for revocation both ask for an award of costs in their favour.

30 Both sides have filed evidence in these proceedings. The matter came to be heard on 23 October 2000, when the applicants were represented by Mr Bruce Marsh of Wilson Gunn M'Caw, their trade mark attorneys, who, by his own request was not present at the hearing, making his submissions via the telephone. The registered proprietors were represented by Mr James St Ville of Counsel, instructed by Swindell & Pearson, their trade mark attorneys.

Registered proprietors' evidence (Rule 31(3))

40 This consists of a Statutory Declaration dated 17 September 1998, and comes from John Stirling, who confirms that he was the registered proprietor of trade mark number 1372130 until 24 March 1998, on which date the rights were transferred to BioCare Limited. Mr Stirling confirms that he has a good knowledge of the trade and records of BioCare Limited.

45 Mr Stirling says that the use made of the mark by BioCare Limited has been with his consent, and has been in respect of pharmaceutical preparations and substances and vitamin and mineral preparations, in particular, liquid vitamin and mineral preparations manufactured from pharmaceutical grade ingredients. He refers to exhibit JS1 which consists of a number of invoices dating from June 1993 to June 1997, sent by BioCare Ltd to various individuals and companies

for the supply of, inter alia VITASORB, and to exhibit JS2 which consists of invoices dating from December 1992 through to July 1997 for labels supplied to BioCare Limited, samples of these labels, and fact sheets. The invoices and labels all bear references to the VITASORB mark, mostly in conjunction with other, plainly descriptive or non-distinctive matter, usually to codify or identify a constituent of VITASORB.

The contents page of the fact sheets refer to VITASORB liquid vitamins, and go on to describe VITASORB A, VITASORB B, VITASORB B12, VITASORB C, VITASORB D, VITASORB E and VITASORB MULTIVITAMINS, the suffix in each case denoting that that version of VITASORB is a micellised liquid preparation incorporating vitamin A, B, C, etc, according to the suffix. The fact sheets refer to VITASORB marked with the letters “™” as an indication that the word is a trade mark. The fact sheets are undated but are said to have been available to customers since about 1990.

Mr Stirling next refers to exhibit JS3 which consists of a number of undated items of printed matter, either promoting the VITASORB products, or factual information about these products extracted from unspecified publications and in the form of a leaflet. All show use of VITASORB as detailed above although in this instance in conjunction with the symbol “®” denoting that the word is a registered trade mark, and from which it is reasonable to assume that they post-date the date of registration, that is, 13 July 1990. Mr Stirling concludes his Declaration by saying that since 1993 approximately £15,000 has been spent promoting VITASORB.

Applicants’ evidence

This consists of a Statutory Declaration dated 13 April 1999, and comes from Bruce Marsh, a registered trade mark agent and partner in Wilson, Gunn M’Caw, the applicants’ representatives in these proceedings.

Mr Marsh refers to paragraph 2 of Mr Stirling’s Declaration, challenging the claim that VITASORB has been used in relation to pharmaceutical preparations and substances. He says that this is not borne out in the registered proprietors’ evidence which only shows use in relation to liquid pharmaceutical preparations, and Mr Marsh draws the conclusion that the registration should be revoked in respect of all but liquid vitamin preparations.

Registered proprietors evidence

This consists of a Statutory Declaration dated 9 July 1999, and is a further Declaration by John Stirling.

Mr Stirling refers to paragraph 3 of Mr Marsh’s Declaration, which he takes to be an acknowledgement that the registered proprietors have used VITASORB in relation to liquid pharmaceutical preparations, drawing the conclusion that this establishes that no distinction can be drawn between pharmaceutical preparations and vitamin preparations. He refutes the suggestion that vitamin preparations are not pharmaceutical preparations and substances and to support his view refers to exhibit JS4 which consists of extracts from medical pharmaceutical and general dictionaries and reference books, highlighting those he considered to be relevant:

Mr Stirling goes on to set out reasons and arguments to support his view that vitamin preparations and supplements are pharmaceutical preparations. He refers to exhibit JS5 which consists of a box in which the multivitamin drops of another trader are sold, noting that the active ingredients are the same as VITASORB products and that the product is sold under a licence issued by the Medicines Control Agency, from which he draws the conclusion that the Agency considers vitamin supplements and preparations to be medicines requiring product licences. Mr Stirling next refers to a product known as VIRASORB which is the subject of trade mark application 2115510, and to exhibit JS6 which consists of an extract from a product catalogue.

10 **Applicants' evidence in reply**

This consists of two Statutory Declarations. The first is dated 5 January 2000 and comes from Jonathon Jowett, the Company Secretary of SSL International plc, who confirms that he is authorised to make the Declaration on behalf of Seton Healthcare Group plc,

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Mr Jowett refers to the Statutory Declaration of John Stirling dated 9 July 1999, confirming that the product VIRASORB referred to by Mr Stirling is a product sold under licence.

The second Statutory Declaration is dated 10 January 2000 and is a second Declaration by Bruce Marsh.

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Mr Marsh also refers to the Statutory Declaration executed by John Stirling on 9 July 1999, and to his own Declaration of 13 April 1999, stating that the reference to liquid pharmaceutical preparations is a typographical error and should have referred to liquid vitamin preparations.

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Registered proprietors evidence

This consists of a Statutory Declaration dated 10 August 1999, and is a third Declaration by John Stirling. Mr Stirling confirms that his two earlier Declarations were made under the Trade Marks Act 1994.

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

Decision

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I now turn to consider the grounds of revocation. Although the Statement of Grounds does not say under which section of the Act the application is made, from the wording it is possible to determine that this is an application which comes under Section 46(1)(a). This is confirmed in the skeleton arguments provided. Section 46(1)(a) of the Act reads as follows:

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46-(1) The registration of a trade mark may be revoked on any of the following grounds:-

- (a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

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Where the registered proprietor claims that there has been use of the trade mark, the provisions of Section 100 of the Act makes it clear that the onus of showing use rests with him.

5 The applicants do not ask for the registration to be revoked in its entirety. They acknowledge that there has been use of the trade mark within the relevant five year period, but only in respect of liquid vitamin preparations. From my review of the evidence I have come to a similar view, differing only to the extent that the evidence shows that the registered proprietors have also used the trade mark in respect of a liquid zinc preparation.

10 The registered proprietors do not lay claim to having used the trade mark on any specific goods beyond these, basing their argument on the proposition that as vitamin preparations and substances are pharmaceutical preparations there has been use in respect of pharmaceutical preparations. Mr St Ville referred me to a number of cases, inter alia, the Mercury trade mark case (1995 FSR at page 850), Typhoo trade mark case (2000 FSR at page 767) and the Minerva trade mark case (2000 FSR at page 734). I do not propose to look at each of these in turn, but to go to the Minerva case in which Mr Justice Jacob considered the two preceding cases.

Commenting on Neuberger J.'s decision in the Typhoon trade mark case, Mr Justice Jacobs said:

20 "Neuberger J.'s attention was not drawn to the decision of Laddie J. in the Mercury Communications Ltd v Mercury Interactive (UK) LtdLaddie J. was concerned with a very wide specification of goods: "computer programs". In rejecting an application for summary judgement, he took the view that the wide specification could be cut down by a non use attack. In other words, that "computer programs" could be limited to computer
25 programs of a particular part.

I have no doubt that what Laddie J. assumed was right and in this respect I differ from Neuberger J. The problem is that some of the language for specifications of goods is apt to be extremely wide. Indeed, "printed matter" in this case is extremely wide. I think it
30 inevitable that at times one would have to "dig deeper". Even taking the specification considered by Neuberger J. for a "domestic container", one can think of quite different sorts of domestic container: a hat box, a snuff box, a jewellery box, a plastic thing you put inside the fridge. Wide words can cover what are commercially quite different sorts of articles. So if one were to show use for just one of that sort, it would be commercially
35 nonsense to maintain the registration for all goods caused by the wide words.

That is not to say the court will cut the registration right down to things like red tea caddies. But if non use in respect of a significant subset of a wide general description is established, then I see no reason why the court should not eliminate that subset from the
40 registration. Thus here I think that, although use in relation to printed stationery is established, stationery is a quite different sort of material from literary publications of the kind put out by Reed and the specification can be cut down."

45 In his submissions, Mr St Ville took the view that where there is non use, the authorities indicated the following approach:

that any narrowing of the specification should be on a rational basis and pay regard to the commercial factors, citing inter alia, the Minerva trade mark case in which Jacob J. said that the court will not cut the registration down to things like red tea caddies.

5 where there is a suitably narrow description, the register should lie as it stands.

when narrowing a wide description, having regard to the public interest and the avoidance of confusion, it must be possible to draw a real distinction between the goods remaining after the narrowing, and those that have been excluded.

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To the extent that it does not envisage a reduction in the specification to reflect the precise nature of the goods for which use has been shown, I accept the first of these points. To adopt any other approach would place a burden upon a proprietor not only to show use in respect of particular items of goods, but also the full range of colours, materials, etc, which cannot have been the intention of the legislation. Translating this to the case in hand. The registered proprietor has shown use in relation to vitamin preparations and zinc preparations, but only in liquid form. Although I have no evidence relating to the trade in such goods, I see no sensible reason why such goods would be considered to be commercially different simply because they may be supplied in liquid, tablet, powder, or whatever form. Accordingly I take the view that to cut the specification back to reflect that the registered proprietors have only used the mark in respect of liquid preparations would not reflect the commercial reality of the trade in such goods, and would be a step too far.

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In the Minerva case, Jacob J. indicated that where a specification contains a description which covers what are commercially the same goods, then use in relation to some (but not all) of the goods falling within that description would be sufficient to warrant the term remaining in the specification. Very wide descriptions covering different sorts of articles may be refined down to one which describes the subset of goods on which use has been shown. That said, I would consider the onus of establishing that there is a term which will adequately describe this subset to be a matter for the proprietor, and may require evidence of how the relevant trade regards, groups or classifies the goods in question.

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The specification in this case consists of “Pharmaceutical preparations and substances; vitamin and mineral preparations”. Mr St Ville conceded that pharmaceutical preparations and substances is not a description covering only goods similar to those for which the proprietors have used the trade mark. The description may well encompass vitamin and zinc preparations but is a very wide term covering a diverse range of goods from simple herbal preparations to sophisticated medicaments, and quite clearly, goods of a very different commercial nature. As such its retention cannot be justified from the use shown.

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From the evidence it seems that the term vitamin preparations covers a definable subset of goods, including the liquid preparations sold by the registered proprietor under the VITASORB mark. They have also used the mark in relation to a zinc preparation which Mr St Ville took to be a mineral preparation, a view not challenged by Mr Marsh. Whilst there must be many different mineral preparations, taking into account that these will all be for use as medicaments or health supplements (by virtue of the registration being in Class 5) it seems reasonable that these should be considered to be the same commercial subset as zinc preparations. I therefore come to the

view that commercial use has been shown in respect of “vitamin and mineral preparations”.

5 The final strand of the approach suggested by Mr St Ville advocated a consideration of public policy, and in particular, whether these descriptions encompass a distinct range of goods so as to avoid the consequences of confusion, which in relation to pharmaceuticals could have quite serious implications. I have already reached the view that the descriptions “vitamin and mineral preparations” encompasses a distinct set of goods. On the question of whether there are other items not covered by these descriptions which could be said to be similar, I do not have any evidence to assist me. That aside, I do not see that a likelihood of confusion with other goods is a consideration in cases such as this. In my view the question is whether the registered proprietors have used the mark in relation to all or any of the goods for which it is registered, and if so, taking into account the above, (and where available information such as how the trade classifies or views such goods), how can this use be described so as to encompass a definable set of such goods.

15 I am satisfied that the evidence shows that the registered proprietors have used VITASORB as a badge of origin for their goods, albeit only in respect of “vitamin and mineral preparations”, and as a consequence, the specification for which the mark is registered must be limited accordingly. I therefore find that the application for revocation is successful, albeit in part, and under the provisions of Section 46(5) order that the registration be revoked in respect of all goods other than “vitamin and mineral preparations”. This to take effect from the date of the application for revocation, that is, 15 June 1998 (Section 46(6)).

20 The application for revocation having been successful, the applicants are entitled to a contribution towards their costs. I therefore order the registered proprietor to pay the applicant the sum of £835 within seven days of the expiry of the period allowed for filing an appeal or, in the event of an unsuccessful appeal, within seven days of this decision becoming final.

30 **Dated this 1 Day of December 2000**

35 **Mike Foley**
For the registrar
The Comptroller-General