TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 10482
BY VITASOY INTERNATIONAL HOLDINGS LTD
FOR REVOCATION OF TRADE MARKS NO 1340627
IN THE NAME OF ELIZABETH BELLHOUSE WIELKOPOLSKA

TRADE MARKS ACT 1994

IN THE MATTER OF application No 10482
by Vitasoy International Holdings Ltd
For revocation of trade mark No 1340627
in the name of Elizabeth Bellhouse Wielkopolska

DECISION

Trade mark number 1340627 is registered in respect of

> Mineral and aerated waters; preparations for making and additives for beverages; all included in Class 32.

The registration is for a series of two trade marks, VITA FLORUM and Vita Florum and currently stand in the name of Elizabeth Bellhouse Wielkopolska.

By an application dated 11 December 1998, Vitasoy International Holdings Ltd applied for these registrations to be revoked under the provisions of Section 46(1) on the grounds that:

Under Section 46(1)(a) the mark has not been put to genuine use in the United Kingdom by the registered proprietor or with its consent within a period of five years following the date of completion of the registration procedure in relation to the goods for which it is registered and there are no proper reasons for non-use.

Under Section 46(1)(b) the use of the registration has been suspended for an uninterrupted period of five years and there are no proper reasons for non-use.

The registered proprietor filed a counterstatement in which they say that they seek to maintain the registration in respect of mineral waters and additives for beverages, and would agree to a partial surrender of all other goods for which the mark is registered, namely, aerated waters and preparations for making beverages. Subject to this, they request that the application for revocation be dismissed.

The registered proprietor and the applicants for revocation both ask for an award of costs in their favour.

Only the registered proprietors have filed evidence in these proceedings. The matter came to be heard on 8 May 2001, when the applicants were represented by Mr J Mitchener of Field Fisher Waterhouse, their trade mark attorneys, the registered proprietors were not represented.

Registered proprietors' evidence

This consists of a Statutory Declaration dated 18 March 1999 by Elizabeth Bellhouse Wielkopolska, the registered proprietor.

Ms Wielkopolska says that she is the sole Director of Vita Fons II Limited, her company, which is located in Somerset. She states that the company has used (and continues to use) the trade mark VITA FLORUM since November 1993 in respect of the goods for which trade mark number 1340627 is registered, and refers to exhibit EBW1 which consists of the following:

- order forms/price lists dated as applicable from 1 November 1993, 1 February 1995 and 1 November 1997 from Vita Fons II Limited. The list of goods and prices is in four sections, three of which have the headings:

  VITA FLORUM FOR PERSONAL USE under which the following goods are listed: Vita Florum water, tablets, ointment, lotion, massage oil, talcum powder and salve.

  VITA FLORUM FOR ANIMALS under which is listed the item "superhealth".

  VITA FLORUM FOR PLANTS AND SOILS under which the following goods are listed: foliar spray and soil conditioner.

  A fourth section under the heading MISCELLANEOUS details various items of printed matter.

- Information sheet headed VITA FLORUM ® giving information and advice on the use of the products shown in the price list, referring to each by the name VITA FLORUM, eg VITA FLORUM WATER, VITA FLORUM TABLET etc. The sheet bears copyright dates for 1989, 1990, 1991 and 1993.

- Information sheet issued by Vita Florum Products Limited headed WHERE VITA FLORUM COMES IN, giving details of the origins and use of VITA FLORUM describing it as "a semiconductor" which can add tissue, or rid the body of excess tissue, change the composition of cells and blood.

- Information sheet from the Association of Reflexologists, dated as March 1995, which refers to VITA FLORUM powder.

- Completed order forms/price lists (as described in A), letters placing orders for VITA FLORUM products and a compliment slip confirming the order/receipt of VITA FLORUM water. These date from 16 March 1994 through to August 1998.

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

Decision

I now turn to consider the grounds of revocation. Although the statement of grounds referred to both subsection (a) and (b) of Section 46, the skeleton arguments filed by Mr Mitchener mentioned subsection (b) alone. Section 46(1)(b) of the Act reads as follows:

> **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;
>
> **(b)** that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

I have included subsection (a) because it tells us what "such use" means.

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

Mr Mitchener submitted that the evidence, and in particular, document D of exhibit EBW1, showed VITA FLORUM to be a generic description for the goods. The exhibit consists of a discussion paper dated March 1995 from the Association of Reflexologists, and considers the question of the use of talcum powder, base oil or cream in reflexology suggesting that practitioners who prefer to use a powder may consider using VITA FLORUM powder or Calendula powder as an alternative to talc. There is no mention of VITA FLORUM being the trade mark of the proprietors, or that they have any connection with the name. Whilst this could be taken to be generic use (as could other instances shown in the exhibits) it is not clear that that is the case, the use shown being just as capable of being use as a trade mark. Mr Mitchener considered the fact that the company name is Vita Fons rather than Vita Florum added to the suspicion that VITA FLORUM is generic, but in my view this is no more than speculation. In any event, document C of exhibit EBW1 shows that at some time the proprietors were trading under the name Vita Florum Limited.

The objection that VITA FLORUM is a generic description for the relevant goods was in no way foreshadowed in the statement of case. The exhibit relied upon by Mr Mitchener was filed with the Counterstatement under Rule 31(3) which means that the applicants could have raised this ground early on in the proceedings or filed evidence to substantiate the allegation, but they did neither, the consequence of which is that the proprietors have not had the opportunity to address this complaint. There is no evidence that VITA FLORUM has any meaning or that it is used in the trade, and in the absence of such evidence I am not prepared to consider an isolated and ambiguous instance as being sufficient to say that all use of VITA FLORUM from March 1995 has been in a generic sense, or that its absence from the company name goes any where near to taking this beyond conjecture, and I dismiss this line of argument. But for the same reasons,

neither can I accept the exhibit as providing any evidence of genuine use of VITA FLORUM as an indication of origin.

Mr Mitchener referred to the limited amount of VITA FLORUM products that the evidence shows to have been sold in the relevant five year period. If the evidence shows the full extent of the registered proprietor's trade, it can only can be described as bordering on insignificant, but I do not think this is of any great importance, for if it is shown that the mark has been used, and the genuineness of the use is not in question (substantiality being but one factor) then a consideration of the extent of the use serves no useful purpose.

What is meant by "genuine use"? In the Crate & Barrel case (2000 All ER (D) 1050), Jacob J considered the matter in the following passages:

> "Assume, however there were these three things, namely the packaging on a few items posted at the US customer's request to the UK, gift registry sales, and a tiny amount of spillover advertisements in what the reader in the UK would know are US journals. Do they individually or collectively amount to "genuine use" of the UK registered mark? Miss Vitoria contends they do. She says the reference to "genuine" is merely in contradistinction to "sham". Small though the use may have been, there was nothing fake about it. The mark appeared in the UK in connection with genuine transactions and that is enough.
>
> I disagree. It seems to me that "genuine use" must involve that which a trader or consumer would regard as a real or genuine trade in this country. This involves quantity as well as the nature of the use. In part it is a question of degree and there may be cases on the borderline. If that were not so, if Miss Vitoria were right, a single advertisement intended for local consumption in just one US city in a journal which happened to have a tiny UK distribution would be enough to save a trade mark monopoly in this country. Yet the advertisement would not be "sham." This to my mind shows that Miss Vitoria's gloss on the meaning of "genuine" is not enough. And the only stopping place after that is real trade in this country. I think all the examples relied upon are examples of trade just in the US."

Evidence of the use of VITA FLORUM by the registered proprietors in the course of trade can be found in document E of exhibit EBW1. This includes copies of order forms/price lists, the earliest dated November 1993, and two hand written letters and a complement slip relating to orders for VITA FLORUM products. Although pre-dating the five year period, two examples of the order form/price list dating from November 1993 record the completion of 3 orders for VITA FLORUM water, ointment salve, detailing the purchasers as being resident in the United Kingdom and endorsed as "sent 16.03.94", "sent 7.6.96" and 27.6.96" which would place the use within the five year period. Three further lists, two dated as being effective from 1 February 1995 and one from 1 November 1997 record the despatch of orders for VITA FLORUM water, tablets, ointment, lotion, massage oil and talcum powder within the relevant five year period (and outside of the 3 month exclusion period of section 46(3)). The price lists show a progressive increase in the prices over a period of some years which I take to be an indication of an ongoing trade, and notwithstanding the apparent low turnover, I take this to be genuine commercial use of the mark.

I note that two of the price lists shown as being effective from 1 November 1993 relate to orders that were completed well over a year after the revision of the prices in February 1995 yet the

orders appear to have been fulfilled at the 1993 prices. In my experience the normal business practice would have been to charge at the new rates but I accept that there may well be perfectly good reasons why the proprietors elected not to do so. The applicants do not suggest that this is an indication that the orders are not genuine and I do not do so either, but given this uncertainty I do not propose to give them any weight.

The letters and complement slip come from customers within the United Kingdom and relate to orders for VITA FLORUM (and VITA FLOURUM) water, lotion, cream, tablets, ointment and talcum powder, in one instance referring to the supplier as Vita Florum Products Limited. The papers show the orders to have been placed and completed within the relevant five years prior to the application being made.

In my view the evidence shows the proprietors to have made genuine use of the trade mark VITA FLORUM within the United Kingdom and in the requisite period, but the question is whether this has been in respect of all, or any of the goods for which the mark is registered.

The proprietors have been using the mark in relation to a range of goods described as VITA FLORUM water, tablets, ointment, lotion, massage oil, talcum powder and salve, all for use by persons, and a number of goods for animals, plants and soil which cannot come within the scope of the goods of their registration in Class 32. Of the goods for use by persons, from the descriptions given by the proprietors, only the water is, in my view, capable of falling in Class 32.

The purpose of VITA FLORUM is not entirely clear, being described in the proprietor's evidence as "an energy which increases spiritual (or if you prefer "inner") awareness, giving the user greater ability to rise above (or overcome) psychological blocks (or problems), and the body greater ability to heal itself.". The products are recommended to maintain well being and also for use in the treatment of a range of physical and psychological conditions, although on their order form/price list dating from November 1997 the proprietors say that VITA FLORUM preparations have no medicinal properties.

The instructions for use of the water say that it is to be used on its own, or added to food or beverages. The fact that it is sold in 55ml quantities and used by the drop indicates that it is not a beverage per se and I do not see that the use justifies the retention of mineral waters at large, Class 32 being for beverages, but as a non-medicinal additive to food or beverages the proprietor's use still falls within the description "mineral water" and is proper to Class 32. The proprietors say that the products should stay active for one year, which to me makes it unlikely that the water is carbonated. With this in mind, I come to the position that the evidence establishes that the proprietors have made genuine use of the mark VITA FLORUM in respect of goods covered by the registration in Class 32, but only:

Mineral water for use as an additive to food or beverages.

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 "Mineral water for use as an additive to food or beverages". This to take effect from the date of the application for revocation, that is, 11 December 1998 (Section 46(6)).

The application for revocation having been successful, the applicants are entitled to a contribution towards their costs. The registered proprietors offered to restrict their registration but still sought to defend it for a wider specification that I found the use to establish and I consider that the applicants are entitled to their full costs. I therefore order the registered proprietor to pay the applicant the sum of £535 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.

Dated this 14 Day of September 2001

Mike Foley
For the registrar
The Comptroller-General