Application No. 17418 of 1998

IN THE MATTER of the Trade Marks Ordinance (Cap. 43)

AND

IN THE MATTER of an application by Green Spot (Thailand) Limited to register the mark

in Part B of the Register in Class 29

AND

IN THE MATTER of an opposition thereto by Vitasoy International Holdings Limited

DECISION
OF

Ms. Fanny Shuk Fan Pang acting for the Registrar of Trade Marks after a hearing on 20 December 2005.

Appearing : Miss Jennifer Tsang instructed by Messrs. Stephenson Harwood & Lo for the opponent.

Application for Registration

1. On 28 December 1998 ("the application date"), Green Spot (Thailand) Limited ("the applicant") applied to register, pursuant to the provisions of the Trade Marks Ordinance Cap. 43 ("the Ordinance"), in Part A of the register in Class 29, the trade mark, a representation of which appears below :

("the suit mark").

2. The goods intended to be covered by the registration were "soya bean milk" ("the specified goods"). The Registrar of Trade Marks ("the Registrar") accepted the mark for registration in Part B of the register subject to a disclaimer of the word "VITAMILK". The application was advertised in the Government of the Hong Kong Special Administrative Region Gazette on 1 December 2000.

Pleadings and Evidence

3. On 1 February 2001, Vitasoy International Holdings Limited ("the opponent") filed notice of opposition to the application. The grounds of opposition state that the opponent is a company orgainsed and existing under the laws of Hong Kong. It is the proprietor of, inter alia, trade marks "VITA", "VITASOY", "維他" and "維他奶" (the Chinese transliterations of the said "VITA" and "VITA MILK" respectively) and various other marks comprising the same ("the opponent's marks"). The opponent has also registered the opponent's marks in Hong Kong in various classes including 1, 16, 25, 29, 30, 32 and 42. It is pleaded that the opponent's marks have been used continuously and extensively in many countries of the world including Hong Kong. In Hong Kong, the opponent's marks have been used since 1940 in respect of a wide range of products including but not limited to soya bean milk, fruit juice, fruit juice beverage, lemon tea, chrysanthemum tea, honey chrysanthemum tea, soft drinks, carbonated drinks, coffee drinks, cocoa drinks, fresh milk, pure milk, flavoured and reconstituted milk, distilled water and mix syrups.

4. The sales volume of the opponent's goods bearing the opponent's marks in Hong Kong and worldwide is substantial. The opponent's goods enjoy very wide wholesale and retail distribution outlets and are available in almost all food and drinks outlets throughout Hong Kong. The opponent also operates its own vending machines bearing the opponent's

marks in numerous public places in Hong Kong. It is the opponent's case that the opponent's marks especially "VITASOY" and "維他奶" are coined words invented by the opponent which carry no dictionary meaning. They are the trade marks and trade names used by the opponent in its business in relation to the opponent's goods and have become predominantly known in the beverage industry particularly in relation to soya bean milk and products, and throughout the Hong Kong market generally as exclusively connected with the opponent but not otherwise. The opponent further asserts that it has engaged a lot of efforts and incurred substantial expenses in advertising and promoting goods bearing the opponent's marks worldwide especially in Hong Kong. By virtue of the long and substantial use and promotion as aforesaid, the opponent has acquired very substantial worldwide and local reputation in the opponent's marks which have become famous brand names in the minds of the purchasing public that any goods bearing the opponent's marks denote nothing but goods applied, sold, distributed and/or supplied by the opponent.

5. The opponent avers that the suit mark closely resembles the opponent's marks visually, phonetically and conceptually. "VITAMILK" is the most prominent part of the suit mark which is a direct English translation of "維他奶" and at the same time conceptually identical with "VITASOY". The consumers will be misled to think that the suit mark is a new mark adopted by the opponent. The "V" device in the suit mark is relatively insignificant and is likely to be taken to stand for the initial of "VITAMILK" and therefore tainted by the same likelihood of confusion. The likelihood of confusion is further enhanced as the applied for goods of the suit mark are soya bean milk which is the main or only product produced and sold by the opponent under the trade marks "維他奶" and "VITASOY". It follows that both the opponent's goods and the specified goods are the same goods or goods of the same description which are to be sold through the same channels of trade and appeal to the same customers. In view of the aforesaid and the high notoriety of the opponent's marks, use and/or registration of the suit mark will cause confusion or mistaken belief amongst the general unsuspecting public that the applicant's goods and opponent's goods are from the same source or the applicant's goods are associated with the opponent and/or manufactured under licence with its approval and/or otherwise endorsed or approved by the opponent.

6. The opponent further pleads that before filing the application for registration of the suit mark, the applicant knew and/or ought to have known of the existence of the opponent and its established status in the beverage industry, the existence of the opponent's marks and in particular "VITASOY" and "維他奶" as its house marks being applied onto their beverage products especially soya bean milk, the high reputation enjoyed by the opponent in its beverage products bearing the opponent's marks worldwide and the existence and well-accepted uniqueness and distinctiveness of the opponent's marks, in particular "VITASOY" and "維他奶" in relation to the business of the opponent. In the premises, use of the suit mark would be likely to deceive or cause confusion and would be disentitled to protection in a court of justice. The grounds of opposition comprise sections 2, 9, 10, 12, 13(1), 20 and 21 of the Ordinance.

7. In the applicant's counter-statement, the applicant does not admit or denies each and every allegation in the grounds of opposition. The applicant states that it is a limited liability company organised and existing under the laws of Thailand. It strongly denies that the

suit mark is similar to any of the opponent's marks. So far as the opponent's marks "維他" and "維他奶" are concerned, there are no common elements between the suit mark and them. When comparison is to be made with the opponent's marks "VITASOY" and "VITA", one has to bear in mind that the word "VITAMILK" in the suit mark is disclaimed. Further, the suit mark contains a significant and distinctive "V" device. The applicant avers that there are a substantial number of registrations containing "VITA" either as a prefix, suffix or a component of the marks owned by different proprietors. It is thus strongly denied that the suit mark would impress the consumer public as being a variation of the opponent's marks or otherwise associated with the opponent. In addition, the applicant has used the suit mark for a substantial period of time and the suit mark is registered in international classes 29 and 32 or the equivalent local classes in many countries including but not limited to Cambodia, Myanmar, Japan, Korea, Taiwan and Thailand. By virtue of the long and continuous use as well as the numerous registrations throughout the world, the suit mark has become distinctive of and identified with the applicant.

8. The opponent's Trade Marks Rule/s, Cap. 43, Sub. Leg. ("Rule/s") 25 evidence comprises a statutory declaration declared on 27 September 2001 by Tong Ah Hing, the company secretary of the opponent, together with exhibits ("Tong's first statutory declaration"). The applicant's evidence consists of a statutory declaration declared on 24 December 2002 by Yongyut Thavikulwat, the vice chairman of the executive board of the applicant, together with exhibits filed pursuant to Rule 26. Under Rule 27, the opponent filed a statutory declaration declared on 4 July 2003 by the same Tong Ah Hing, together with exhibits ("Tong's second statutory declaration").

Decision

9. Though, by 20 December 2005, the date the matter was heard, the Trade Marks Ordinance Cap. 559 had come into operation, by virtue of sections 10(1) and (2) of schedule 5, oppositions to registrations still pending as of 4 April 2003 are to be determined under the provisions of the repealed Ordinance, Cap. 43.

10. Although a number of grounds were pleaded in the grounds of opposition, Miss Tsang for the opponent indicated at the hearing that she would only rely on the grounds under sections 12(1), 13(1) and 20 of the Ordinance for the present proceedings.

11. By letter dated 15 December 2005, Messrs. Wilkinson and Grist, the agent for the applicant, indicated that the applicant would not attend the opposition hearing fixed to be heard on 20 December 2005.

Under section 12(1)

12. Before an opponent can invoke section 12(1), it must establish a certain degree of reputation in Hong Kong of its marks. As its very highest, it is a question of a substantial

proportion of the interested public being aware of its marks, and at its very lowest, the question relates to the significance of the numbers in relation to the market for particular goods. In any event, the reputation of the opponent must be something more than *de minimis* (*Re Da Vinci Trade Mark* [1980] RPC 237).

13. Miss Tsang submitted that the opponent was incorporated for the purpose of producing soya bean drinks in 1940 under the name of "The Hong Kong Soya Bean Products Company, Ltd (香港荳品有限公司)". Its name was changed to "Vitasoy International Holdings Limited (維他奶國際集團有限公司)" in 1990 (see paragraph 2 and "PT-1" of Tong's first statutory declaration). Since its incorporation, the opponent has, in line with the primary objective for its establishment to promote and develop an alternative but cheaper nutritious drink in substitution for milk for the people of Hong Kong, been carrying on the business of manufacturing and selling soya bean milk drinks (paragraph 3 of Tong's first statutory declaration).

14. My attention was drawn by Miss Tsang to a brief introductory outline of the history of "VITASOY" from its beginning on the eve of the Second World War to its subsequent dominance as the market leader in soya bean milk drinks which is contained in a leaflet published by The Reader's Digest in the exhibit marked "PT-2" to Tong's first statutory declaration. The leaflet is entitled "What's behind the name? Household names that rose to fame and fortune" with a subtitle of "VITASOY-milk from 'the cow of China'". The relevant passages are reproduced below : -

> "As war threatened to engulf Asia in 1940, an energetic young Chinese businessman turned his attention to helping to make people healthier through milk. But Dr. Lo Kwee-seong was not thinking of cow's milk. He was thinking of the soybean, 'the cow of China', that had, for 3,000 years, been a major source of protein for the Chinese. The product that Dr. Lo created, called Vitasoy, was to become a household name in Hong Kong and inspire the spread of soybean milk around the world.
>
> Inspired by a lecture on vegetarianism given by a Seventh Day Adventist doctor in Shanghai in the late 1930s, K.S. Lo pooled his resources and, with a capital of HK$18,000, formed Hong Kong Soya Bean Products. Commercial success and acceptance of Vitasoy was, however, slow in coming. Vitasoy was sold originally in glass bottles and delivered fresh by bicycle and K.S. Lo managed to sell only nine bottles of his new drink on his first day in business. By the end of 1940, the company had sales of less than HK$100,000 and only 20 employees."
>
> "... Since 1979, Hong Kong Soya has maintained its leadership position in Hong Kong, holding over 70 percent of the Tetra Brik carton drinks market."
>
> "...A new plant in Tuen Mun in Hong Kong's New Territories, with 34,000 square metres of space, will begin operations in 1987."
>
> "From a first-day sale of a mere nine bottles of Vitasoy, the company now produces 800,000 product units of 43 different items. These figures are impressive, indeed, as are the many

people, at all levels, within the company. The success of the company has been created by an astute mixture of Western and Eastern styles and systems."

15. In addition, Miss Tsang pointed out that a booklet entitled "厚生與創業 維他奶五十年(一九四O至一九九O)" recording the historical growth of the opponent and outlining the way the opponent's family of beverages had evolved over the period of 50 years is also produced in exhibit "PT-3" to Tong's first statutory declaration. The English mark "Vita Milk" was first used by the opponent together with the Chinese mark "維他奶" in 1940. However, the use of the English mark "Vita Milk" was subsequently objected to by the government as the product was not animal milk (page 18 of "PT-3" to Tong's first statutory declaration and "PT-17" and "PT-18" to Tong's second statutory declaration). As a result, "Vitasoy" was adopted as the English name of "維他奶" in 1953 (paragraph 3 of Tong's first statutory declaration and page 42 of "PT-3"). By the 1960s, "Vitasoy" had become a name in itself (page 10 of "PT-3"). It had become a household brand in Hong Kong by as early as 1968 (page 71 of "PT-3" reproducing an extract from the American "TIME" magazine).

16. It was the contention of Miss Tsang that "Vitasoy" was marketed not only as a milk substitute (hence packaged in the milk bottle) in the early days (page 29 of "PT-3") but was subsequently portrayed after the Second World War as a soft drink substitute (pages 28 and 78 of "PT-3"). Heated "Vitasoy" was launched in 1957 (page 41 of "PT-3"). Tera-brik packages 250 ml "Vitasoy" were introduced in 1975 (page 56 of "PT-3"). In the late 1970s, "VITA" fruit juices, teas and soft drinks were launched (page 78 of "PT-3"). The opponent invested in Shenzhen 光明 farm in 1979 and "VITA" fresh milk products were launched in 1980 (pages 65 and 66 of "PT-3"). Expansion overseas has made "Vitasoy" a health drink in the United States by 1989 (pages 76 to 78 of "PT-3"). Sales figures for the opponent's products from 1941 to 1989 ranging from HK$0.09 million in 1941 to about HK$600 million in 1989 and sales volume from 1941 to 1986 ranging from 0.01 million cartons to 12.1 million cartons per year are stated in the appendixes on page 100 of "PT-3". As for the sales turnover in Hong Kong from 1993 to 1998, it amounted from HK$839,800,000.00 to HK$1,165,967,000.00 on an annual basis (paragraph 17 of Tong's first statutory declaration). Advertising expenditure for Hong Kong for the same period ranging from HK$29,042,000.00 to HK$27,594,000.00 is set out in paragraph 23 of Tong's first statutory declaration as well.

17. As indicated in paragraph 4 and "PT-5" of Tong's first statutory declaration, Ms Tsang submitted that "VITASOY" were the first ever, and for many years the only, soya bean milk drinks marketed and sold in Hong Kong through territory wide retail distribution. Throughout the years, the marketing and sales of "VITASOY" have kept pace with the growth and development of Hong Kong. From the times when the grocery retail network in Hong Kong had in the main comprised neighbourhood grocery stores to the more recent times of dominance by supermarkets and convenience stores, "VITASOY" have continuously maintained a place of prominence on the shelves of such retail outlets. Furthermore, "VITASOY" have been and are also marketed and sold in a great variety of other food retail outlets, ranging from food bars, canteens, tuckshops, bakeries to ice cream vendors and vending machines.

18. Miss Tsang went on to point out that in the latter part of the 1970s, with the growing sophistication and expansion of Hong Kong's food industry, and increasing demand by the Hong Kong public for variety, the opponent began to introduce other drink products, including many varieties of fruit juice drinks, tea drinks, herbal tea drinks, coffee drinks, cocoa drinks, carbonated sodas, mix syrups for carbonated sodas, fresh milk, pure milk, flavoured and reconstituted milk drinks, pure soya bean extracts and fresh fruit juices (paragraph 5 of Tong's first statutory declaration). All new products and services embarked upon by the opponent are invariably labelled and endorsed under the trade marks "VITASOY" and "維他奶" in case of soya bean milk and related drinks or under the trade marks "VITA" and "維他" in respect of other non-alcoholic drinks and beverages and related products. As a result, the public and the industry have come to know and associate immediately the marks "VITASOY", "維他奶", "VITA" and "維他" with the opponent and its products and services and none others (paragraph 16 of Tong's first statutory declaration).

19. To summarise, Miss Tsang said that the opponent's range of products can be divided into two main groups ("PT-9" to Tong's first statutory declaration). The first group is about the products of soya bean milk, natural soya bean milk, calci-plus high calcium soya bean milk (calci-plus being introduced in 1999, which was post-application date) which are sold under and by reference to the mark "VITASOY" in English and the mark "維他奶" in Chinese. The second group relates to the products of milk, juice drinks, teas, soft drinks, water and tofu sold under and by reference to the mark "VITA" in English and the mark "維他" in Chinese which were created as offsprings of "VITASOY" and "維他奶" in 1976. More specifically, "VITA" juice drinks such as orange, mango, guava and lime were introduced in 1976. Subsequently, the juice drinks were expanded to include more flavours such as apple, blackcurrant, pineapple orange, sugar cane and lychee. "VITA" tea drinks such as "VITA" lemon tea was first launched in 1979 which is the world's first ready-to-drink lemon tea. Later on, other tea products include "VITA" chrysanthemum tea, "VITA" honey chrysanthemum tea, "VITA" jasmine tea, "VITA" green tea and "VITA" oolong tea were launched in the market. "VITA" soft drinks were introduced in 1978 including lemon lime, orange, cola and cream soda. Another line of drinks products "VITA" distilled water was launched in 1992 (paragraph 7 and "PT-11" of Tong's first statutory declaration).

20. Miss Tsang concluded it is abundantly clear from the evidence that the opponent has been a manufacturer of soya bean milk and a number of other non-alcoholic beverages in Hong Kong under the marks of "VITASOY", "維他奶", "VITA" and "維他" which have become household names in Hong Kong at the application date.

21. On the whole, I accept Miss Tsang's submissions and find that it is clear, on the evidence presented, that the opponent has acquired a very substantial and long-standing reputation for its marks "VITASOY" and "維他奶" in respect of soya bean milk products and "VITA" and "維他" in relation to a variety of other beverages including milk, juice drinks, teas, soft drinks and distilled water in Hong Kong at the application date. The opponent started off as a company specialised in producing soya bean drinks in Hong Kong in 1940. The Chinese mark "維他奶" has been used by the opponent for their soya bean milk products since the commencement of business in 1940. The English mark "VITASOY" was adopted by the

opponent in 1953 and has since then been used in conjunction with the Chinese mark "維他奶" on the opponent's soya bean milk products.

22. With a view to diversifying its business, the opponent began to branch out into other lines of products from the 1970s. The marks "VITA" and "維他" created as offsprings of "VITASOY" and "維他奶" in 1976 were adopted as the English and Chinese marks respectively for the opponent's other lines of products including milk, juice drinks, teas, soft drinks and distilled water. On the packagings of the opponent's products, the English marks are invariably used together with the Chinese marks, "VITASOY" with "維他奶" and "VITA" with "維他". They sometimes appear on different faces of the package, sometimes on the same face (pages 56, 57 and 78 of "PT-3" to Tong's first statutory declaration).

23. With the growing of business, on 30 March 1994, the opponent was listed on the stock exchange market of Hong Kong. A few years later in 1997, the opponent was awarded one of the "Top 20 Leading Companies in Hong Kong" in an election organised by the Hong Kong Economic Times (see the corporate milestones in "PT-9" to Tong's first statutory declaration). Coupled with the fame and reputation established by widespread advertising and promotion of the opponent's marks in Hong Kong (pages 77 to 88 of "PT-3" and paragraph 23 of Tong's first statutory declaration), there have also been very substantial sales of the opponent's wide range of products through a broad network of distribution outlets in Hong Kong.

24. In the light of all the above, there is no doubt, to my mind, that as at the application date, the opponent's marks "VITASOY", "維他奶", "VITA" and "維他" had become household names in Hong Kong in respect of the opponent's beverage products. Indeed, it appears to me that all of the opponent's marks form a series sharing the common distinctive feature "VITA" in English and "維他" in Chinese ("維他" is also the natural Chinese transliteration for "VITA") which have been in use by the opponent in the Hong Kong market for well a number of decades and thus widely known to the general public.

25. The opponent having overcome the initial threshold to mount an opposition under section 12(1), Miss Tsang rightly submitted that the onus will then shift to the applicant to show that there would be no reasonable likelihood of confusion or deception.

26. To begin with, Miss Tsang made a comparison between the suit mark and the opponent's marks. Miss Tsang pointed out that the suit mark is a composite mark consisting of the word "VITAMILK" together with a pictorial element. It is trite law that words speak louder than devices which are thus more readily recalled by the purchasers. Despite the presence of a prominent "V" device in the suit mark, the word "VITAMILK" appearing in a conspicuous position directly under the pictorial device must be the identifying feature. The purchaser's attention will not be directed to the "V" logo. The suit mark would be referred to as "VITAMILK".

27. Conceptually, Miss Tsang submitted that both "VITAMILK" and the opponent's mark "VITASOY" are invented words comprising the prefix "VITA" co-joined with a meaningful suffix. The suffix of each carries an obvious meaning to the average consumer. "MILK" is generic and descriptive. "SOY" is descriptive of soya bean. The suffix of the respective marks being milk and soy will readily allow the public to infer that the goods are milk products. Both of them share a distinctive prefix "VITA". As a whole, "VITAMILK" cannot be easily distinguished from "VITASOY".

28. Turning to the opponent's Chinese mark "維他奶" which has been used in conjunction with the English mark "VITASOY", Ms Tsang contended that the word "VITAMILK" is just a direct English transliteration of "維他奶" as the predominantly Chinese-speaking population in Hong Kong would know that "milk" is equivalent to "奶". When the public sees the suit mark comprising the identifying feature "VITAMILK", the opponent's mark "維他奶" would bring to the minds of the purchasers as being a Chinese transliteration for "VITAMILK".

29. When comparison is to be made with the other two marks of the opponent "VITA" and "維他", it was the contention of Miss Tsang that there is a wholesale incorporation of them into the suit mark comprising the essential feature "VITAMILK". As "VITA" always appears with "維他" on the opponent's lines of products including milk, teas, juice drinks, soft drinks and distilled water, "VITA" stands for "維他" in the minds of the purchasing public in Hong Kong and vice versa. When the suit mark with the identifying feature "VITAMILK" is applied to the specified goods soya bean milk, the consumers will associate it with the opponent's marks "VITA" and "維他".

30. To strengthen the opponent's case, Miss Tsang argued that the opponent relies on the actual user and reputation of "VITASOY", "維他奶", "VITA" and "維他" being household names to support the contention that confusion is even more likely. Miss Tsang pointed out that the public in Hong Kong was aware that since the 1970s, the opponent has been diversifying its products from soya bean milk products sold under and by reference to the marks "VITASOY" and "維他奶" to milk, juice drinks, teas, soft drinks and water products sold under and by reference to the marks "VITA" and "維他". As at the application date, the opponent had extensively used their marks "VITASOY" and "維他奶" for over 50 years , "VITA" and "維他" for over 20 years in Hong Kong. All of them bear the common feature "VITA" or "維他". They form a series of marks belonging to the opponent which make deception or confusion even more likely. Where there are a series of marks already in use by the opponent and known to the public, the cumulative effect of such is to create an impression in the minds of the average purchaser that "VITAMILK" is but a diversification and/or extension of the existing lines of products of the opponent (*Kerly's Laws of Trade Marks and Trade Names*, 12th edition, paragraph 17-14).

31. Although the word "VITAMILK" in the suit mark is disclaimed meaning that registration of the suit mark shall give no right to the exclusive use of the word, Miss Tsang submitted that this does not assist in reducing the likelihood of confusion or deception. As

disclaimers do not go into the market with the goods sold under individual marks, it would not affect the likelihood of confusion. Therefore it would be improper for the Registrar to register a composite mark, which includes as one feature another person's mark, upon the applicant disclaiming the exclusive right to the use of that feature (*Kerly's*, supra, paragraph 9-04 and *Ace (Fred Mellor)* (1948) 65 RPC 238 at 241). Applying the reasoning to the present case, Miss Tsang contended that even if the word "VITAMILK" in the suit mark is disclaimed, it will not affect the likelihood of confusion or deception. If there is a real likelihood of confusion or deception, it would not be proper for the Registrar to allow registration of the suit mark, upon the applicant disclaiming the exclusive right to the use of the word "VITAMILK".

32. Miss Tsang moved on to make submissions on trade channels and target customers. The goods intended to be covered by the registration were soya bean milk. The opponent has used its "VITASOY" and "維他奶" marks in respect of soya bean milk products and "VITA" and "維他" marks for milk, juice drinks, teas, soft drinks and distilled water. By their nature, the goods of the parties are all consumer goods, specifically beverages of daily consumption. It is reasonable to assume that they will be similarly priced, that is, relatively cheap and affordable and will be sold through the same trade channels, in particularly, on the shelves of supermarkets and convenience stores and coins operated vending machines where self-service is the norm, and to the same customers. The goods are not going to be examined in details and no particular care would be exercised by the purchasers in buying them.

33. Above all, Miss Tsang submitted that the most important consideration is whether potential purchasers would be caused to wonder if the applicant's goods are likely to have emanated from the opponent, that is, whether there will be a likelihood of perception of association between the products. Miss Tsang submitted that the answer must be yes. There is a clear case of likelihood of confusion or deception. If there is a probability of deception, there is no discretion to the Registrar in the application of section 12 and the application for registration must be refused.

34. In my view, it is well established that the test to be used in applying section 12(1) is that stated by Evershed J. in *Smith Hayden & Co's Application* (1946) 63 RPC 97 at 101. The test under section 12(1), adapted to this application, is as follows : -

> "Having regard to the reputation of the opponent's trade marks "VITASOY" and "維他奶" in respect of soya bean milk and "VITA" and "維他" in respect of milk, juice drinks, teas, soft drinks and distilled water, is the Registrar satisfied that the suit mark, if used in a normal and fair manner in respect of soya bean milk will not be reasonably likely to cause deception and confusion amongst a substantial number of persons? May a number of people be caused to wonder whether the goods under the respective marks come from the same source? Is there a real tangible danger of confusion if the applied for mark is put on the Register?"

35. Having considered the very substantial and long-standing reputation built up by the user and advertising of the opponent's family of marks "VITASOY", "維他奶", "VITA" and "維他" for the opponent's wide range of beverage products in Hong Kong, I have found

that the opponent owns a series of marks containing the common feature "VITA" in English or "維他" in Chinese which have been widely known to the general public in paragraph 24 above.

36. It is settled law that where a trader adopts a series of marks with a common element, another mark containing the element could be regarded by purchasers as indicating products from the same trade source (*Australian Law of Trade Marks and Passing Off* by D.R Shanahan, 2nd edition at page 181 and *Beck Koller & Co. Ltd's Application* (1947) 64 RPC 76 (UK Reg.)). The strength of the series objection is strongly felt in this particular case. When the suit mark incorporating the common feature "VITA" is applied to the soya bean milk which is one of the dominant lines of products of the opponent, there is a reasonable likelihood that a number of persons will at least be caused to wonder, if not actually confused, whether the products bearing the suit mark and the opponent's products come from the same source.

37. I have not overlooked the fact that there is the presence of a prominent "V" device in the suit mark. However, given the great extent of the public's familiarity with the opponent's family of marks, the addition of the "V" device above the word "VITAMILK" might well be supposed by customers to have been made by the owner of the trade mark they are already acquainted with, that is, the opponent in the present case to denote a particular line of products within the opponent's "VITA" range. I also see the force of Miss Tsang's proposition that if there is a real likelihood of confusion or deception, it would not be proper for me to allow registration of the suit mark, upon the imposition of a disclaimer on the word "VITAMILK". Simply put, the likelihood of confusion or deception cannot be cured by a disclaimer.

38. In the result, the opponent succeeds under the section 12(1) opposition.

39. Section 12(1) however is subject to section 22 of the Ordinance. Suffice for me to say that as it is not asserted in the pleadings and evidence filed by the applicant that the suit mark has been used in Hong Kong, it is not necessary for me to consider section 22 in the present case.

Under sections 13(1) and 20

40. Having decided the opposition under section 12(1), I do not think it is necessary for me to deal with the opposition under these sections.

Under section 13(2)

41. As the opponent has succeeded in the opposition under section 12(1), the exercise of my discretion under section 13(2) of the Ordinance does not arise.

42. It follows the application to register the suit mark in Class 29 in Part B of the register in respect of the specified goods fails.

Costs

43. The opponent has sought costs and there is nothing in the circumstances or conduct of this case which would warrant a departure from the general rule that the successful party is entitled to his costs. I accordingly order that the applicant pays the costs of these proceedings

44. Subject to any representations as to the amount of costs or calling for special treatment which either party makes within one month from the date of this decision, costs will be calculated with reference to the usual scale in Part 1 of the First Schedule to Order 62 of the Rules of the High Court (Cap. 4) as applied to trade mark matters, with one counsel certified unless otherwise agreed between the parties.

(Original signed)

(Ms Fanny S. F. Pang)
p. Registrar of Trade Marks
28 February 2006