

**IN THE TRIBUNAL OF THE REGISTRAR OF TRADE MARKS**

**TRADE MARKS ACT, ACT 194 OF 1993**

Trade Mark Application No. 1997/16120      VITA CARE

In the matter between:

**JAYMIA CC**      Applicant

and

**KEMPTEK (PTY) LTD**      Respondent

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**JUDGMENT**

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Kemtek (Pty) Ltd, a company incorporated and existing under the company laws of Botswana, and having its principal place of business at Plot No.1, New Industrial Site,

Shashe, Botswana, is the proprietor of trade mark registration number 1997/16120 VITA CARE in class 3 in respect of, “Cosmetics and toilet products including preparations of all kinds for the care of the hair and skin, soaps, perfumery, essential oils, dentrifices”. (hereinafter referred to as “the Respondent”).

The Applicant in this matter is Jaymia CC, a South African close corporation of Shop 15, Riverside Centre, Main Road, Rondebosch, South Africa (herein referred to as “the Applicant”). The Applicant is also the applicant for the registration of trade mark number 2003/20182 VITACARE PHARMACY & SKINCARE CLINIC in class 35 in respect of, “Sale of pharmaceutical & cosmetic allied products, rendering pharmaceutical advice, skincare clinic, nursing clinic and general pharmaceutical services”.

The Applicant brought an application for expungement of the Respondent’s trade mark registration in terms of section 27(1)(b) of the Trade Marks Act, Act 194 of 1993 (“the Act”) on the ground of non-use.

**Section 27. Removal from register on ground of non-use**

- (1) Subject to the provision of section 70 (2), a registered trade mark may, on application to the court, or, at the option of the applicant and subject to the provisions of section 59 and in the prescribed manner, to the Registrar by any interested person, be removed from the register in respect of any goods or services in respect of which it is registered, on the grounds of either-*
- (b) that up to the date three months before the date of the application, a*

*a continuous period of five years or longer has elapsed from the date of issue of the certificate of registration during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof or any person permitted to use the trade mark as contemplated in section 38 during the period concerned*

Mr Chicktay, the deponent to the Applicant's founding affidavit is the manager of the Applicant. He testified that it was only after the Applicant's trade mark application no. 2003/20182 was published for opposition purpose, and a letter was received from the Respondent's attorneys, that he became aware of the existence of Kemtek (Pty) Ltd and trade mark registration no. 97/16120 VITA CARE.

Subsequent to becoming aware of Kemtek's objection, he carried out a general search on the internet for Kemtek's products or brand, and could not find any relevant entries. Furthermore, he contacted all the established wholesalers to find out if they stocked any VITA CARE products. The outcome of his search was that there was only one product under the brand VITA CARE marketed by First Pharm. Investigations carried out in the Western Cape also revealed use of VITA CARE by First Pharm only.

Further investigations were conducted by Dr Samantha Ann Gregory. In her supporting affidavit she stated that the results of the investigation failed to reveal that VITA CARE products were manufactured by Kemtek or stocked by pharmacies. Sphiwe Nzimande

employed by Dr Samantha Ann Gregory also in her supporting affidavit on page 16 paragraph 7 stated that all the acquaintances she interviewed indicated that they had no knowledge of VITA CARE and/or Kemtek products.

In view of the above, the Applicant's contention is that, notwithstanding a diligent search there is no evidence at all to show that the Respondent used the trade mark VITA CARE during the relevant period. It then follows according to the Applicant that the trade mark VITA CARE should be removed from the register.

One of the directors of the Respondent's company, Mr Venkatesh, deposed to the answering affidavit. The Respondent contended that the relevant 5 year period, for purpose of Section 27(1)(b) commenced on 30 July 2002 and expired on 29 July 2007 since the notice of rectification was filed on 29 October 2007.

The Respondent further contended that it had used its registered trade mark VITA CARE since 19 September 2000 and the products bearing its trade mark were sold in South Africa during the relevant 5 year period. As proof of use of the mark VITA CARE, the Respondent referred to invoices as listed on pages 22 – 27 under paragraph 7.1 – 7.26 of the answering affidavit. Also referred to (as **Annexure "BTY"**) for purposes of advertising and promotion is a copy of Jumbo Cash & Carry promotional catalogue, relating to the period 1 September 2004 to 31 October 2004, showing a Kemtek product bearing the trade mark VITA CARE for hair food.

**Annexures “BTV” to “BTV”** on pages 135 – 140 of the records are photographs of Kemtek’s VITA CARE hair food product, promotional T-shirts, bags and pop-up displays reflecting the VITA CARE trade mark for hair food. The Respondent alleges that these promotional material were sent to South Africa to be used in promoting VITA CARE products.

Mr Michau on behalf of the Respondent submitted that the use of the word “may” in Section 27(1) of the Act confers upon the Registrar a discretion not to expunge, even in the case where a trade mark has not been used. He said that this is exactly what happened in the well-known case of **McDonalds Corporation v Joburgers Drive-Inn Restaurant (Pty) Ltd 1997 (1) SA (1) (A)**. I wish to point out that it was further stated in this judgment at page 32 at B

that, *“It goes without saying that a party who has shown himself entitled to relief under the section will not be deprived of such relief by the exercise of a general discretion unless the circumstances are exceptional”*. In the court’s view circumstances in the McDonalds matter were exceptional hence it exercised its discretion to refuse removal of the trade mark from the register. In my opinion nothing exceptional has been shown by the Respondent in this matter as the circumstances differs substantially from the ones in the McDonald’s matter.

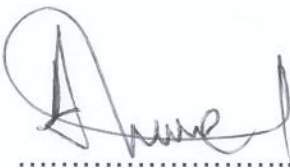
The Respondent contended that the Applicant is not entitled to an order in terms of Section 27(1)(b) of the Trade Marks Act.

Having considered the evidence submitted by the Respondent, evidence of use of the mark VITA CARE was only presented in respect of hair food products. Nothing was shown to support use of the mark in relation to other products in the specification. I find the specification to other items, to extend unduly beyond the items, proved to have been used.

The Applicant therefore has been partially successful in the application for rectification.

In view of the above, the following order is made:

- (1) Trade mark registration number 1997/16120 VITA CARE in class 3 in the name of Kemtek (Proprietary) Limited is rectified by the amendment of the specification to "hair food preparations".
- (2) Costs to be borne by the Respondent.



**TUWE, A N**

**DEPUTY REGISTRAR TRADE MARKS**

10.....DECEMBER 2009