



VANUATU INTELLECTUAL PROPERTY OFFICE

Yusum save blong yu blong mekem samting

Ministry of Tourism, Trade, Industry and Commerce
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3rd April 2018

IN THE MATTER of The Trademarks Act No.1 of 2003

IN THE MATTER of an application filed by **Vanuatu Beverage Limited** seeking the registration of Trademark **"Vanuatu Natural"** and opposition filed against registration of such Trademark by **Azure Pure Water Limited**.

DECISION

Introduction

This file concerns an application filed by Vanuatu Beverage Limited, Applicant, seeking registration of a word Trademark known as **"Vanuatu Natural"**. The Applicant has filed her application on 28th September 2017 under class 32 which describe goods as: *Mineral and aerated waters and other non-alcoholic beverages*. On 10th October 2017, details of application were being published on government gazette as requirement under **section 18** of the **Trademarks Act**. On 30th October 2017, Azure Pure Water Limited then filed her opposition against the registration of the word mark **"Vanuatu Natural"**. As such, I am obliged to convene a hearing under **section 31** of the Act. A hearing date was schedule on 12th December 2017 however, due to other engagements by the solicitor representing Vanuatu Beverage Limited, the hearing was being stood over to 29th March 2018.

Present at the hearing was Mr. Mark Hurley of George Vasaries & Co representing Azure Pure Limited with Yael Sakker, and Shaun Gilchrist as owners and directors of the company. Vanuatu Beverage Limited was represented by Mr. John Malcom of Geoffery Gee & Partners, and Manutea Durand as General Manager of the company.

Legal Issue

The legal issue that needs to be decided is, whether or not "**Vanuatu Natural**" is to be registered as a trademark under the proprietorship of Vanuatu Beverage Limited?

Law

Since this is a Trademark Application, the relevant applicable law is the **Trademark Act No.1 of 2003** and its subsequent sections which dictates the manner in which an opposition to a trademark application is to be determined.

Deliberations on Facts

I will now address the issue of opposition that was being raised by Azure Pure Water Limited against the registration of word mark "Vanuatu Natural" in favour of Vanuatu Beverage Limited. The argument put forward by Azure Pure water was under **section 35** of the **Trademarks Act**. This trademark is substantially identical with Azure Pure Water Limited's existing *Vanuatu Natural* trademark, which has been in use by the company for over a decade. Therefore, this trademark has acquired a reputation in Vanuatu before the priority date of the registration of the new trademark.

The products in respect of which Vanuatu Beverage Limited has lodged its trademark application are described by them as "mineral and aerated waters and other non-alcoholic beverages" under Category 32 of the Vanuatu Intellectual Property Office "NICE" classifications.

The products in respect of which Vanuatu Beverage Limited has lodged its trademark application for is "*Vanuatu Natural*". It is effectively identical with Azure Pure Water Limited's products. Azure Pure Water Limited has been using "Vanuatu Natural" for over 10 years. It was urged that the marketing of identical products under the same trademark by different entities will be seen as deceptively similar and will cause deception and confusion.

Given the similarity of this mark, which already has a reputation as a product of Azure Pure Water Limited, the granting of trademark to Vanuatu Beverage Limited would likely deceive or caused confusion amongst consumers in the market.

Azure Pure Water Limited then argued that, under **section 34** of the **Trademark Act**, Vanuatu Beverage Limited had already produced their own well-known brand known as "Vanuatu Waters", and has never used the "Vanuatu Natural" mark. Mr. Hurley then produce, a chronology of events which begins from 1995 till current. Under that, timeline, it stated that, in 17 October 1995, the business name "Azure Pure Water" was registered with the Vanuatu Financial Service Commission by Plantinum Limited, and was owned by Clayton Cross, and his children. On 22nd November 2007, the Company "Azure Pure Water Limited" was registered with Vanuatu Financial Service Commission by Michael and Cecily Piggott, after they purchased the business from Clayton Cross. In 2009, the Azure Pure Water "Vanuatu Natural" flier was displayed as a brand at the World Water Day. Also in 2009, Azure Pure Water started using PVC shrink labels and register the business name known as "Vanuatu Natural Spring Water" with Vanuatu Financial Service Commission. On 17th December 2016, Azure Pure Water Limited was being purchased by Yael Sakker and Shaun Gilchrist from Michael and Cecily Piggott. Azure Pure Water Limited then tender a letter written by an employee of the company known as Yanwa David Leo who stated that, since the business was established in 1995, the word "Vanuatu Natural" was being used as a brand on all sticker labels and other marketing devised that was being used to market their product.

In respond Vanuatu Beverage Limited argued that, she was using a brand word mark known as **Vanuatu Water** for over 30 years, and now wants to register Vanuatu Natural as another brand in promoting her products in the market. She also argued through Mr. Malcom that, the company has registered such name with the registrar of companies in relation to Business name. I have made myself known that, any matters to do with registration of business name does not fall under my jurisdiction. I will only be dealing with trademark matters. Any issue with Business name falls under the jurisdiction of the Registrar of Companies, Vanuatu Financial Service Commission.

I have requested Vanuatu Beverage Limited to tender their graphical design that depicts their brand which includes their mark and how it distinguishes the differences between their products, and other similar products from other rival companies. They then tender this design:

These are the brands that they were using in advertising their different products. Vanuatu water under italics with the splash of water in the background is the brand that they were using in marketing their water products in the market. In terms of advertisement around the commercial district of Port Vila, this is what consumers will see on the billboard signs:



The new proposed trademark that Vanuatu Beverage Limited wishes to use is **Vanuatu Natural**. It is a word mark of which its detail was being published on government gazette.

I then, request Azure Pure Water Limited to tender their current graphical design that depicts their brand which includes their mark and how it distinguishes the differences between, their products and similar products from other rival companies. They then tender these design:



By looking at the branding from these two companies, there is no dispute that in reality, Vanuatu Beverage Limited was actually using the brand "Vanuatu Water" in promoting the image of the water product that she is selling in the market.

In regards to Azure Pure Water Limited, she is using the brand "Vanuatu Natural" in promoting her image in the market.

Both companies claim that, they are in the market for more than 10 years. As such, I bear in mind that branding and marks from these two companies does have a reputation in the market.

Deliberations on Law

The relevant provisions which dictates the manner in which an opposition to the registration of a trademark is **section 30 -32** of the **Trademark Act**. The following sections state as follows:

30.(1) If the Registrar has accepted has accepted an application for the registration of a trademark, a person may oppose the registration by filing a notice of opposition.

(2) The notice of opposition must be in the approved form and must be filed within 28 days after details of the application are published in the Gazette.

(3) The opponent must serve a copy of the notice on the applicant.

(4) The registration of a trademark may be opposed on any of the grounds specified in section 33-37(inclusive) and on no other grounds.

(5) If: (a) after a person has filed a notice of opposition, the right or interest on which the person relied to file the notice of opposition becomes vested in another person; and (b) the other person notifies the Registrar in writing of this, and does not withdraw the opposition; the opposition is to proceed as if the notice of opposition had been filed in that other person's name.

31. The Registrar must give the opponent and the applicant an opportunity of being heard on the opposition.

32. Unless the proceeding are discontinued, the Registrar must decide: (a) to refuse to register the trademark; or (b) to register the trademark (with or without conditions or limitations) for the goods and/or services then specified in the application; having regard to how far any ground of the opposition has been established.

The details of the application filed by Vanuatu Beverage Limited was being published on government gazette under **section 18** of the Act on 10th October 2017. By requirement of **section 30(2)**, opposition must be filed within 28 days and in the required form. The details of the application that was published on 10th October 2017 will lapse on 6th November 2017. Azure Pure Water then launched her opposition by using the approved

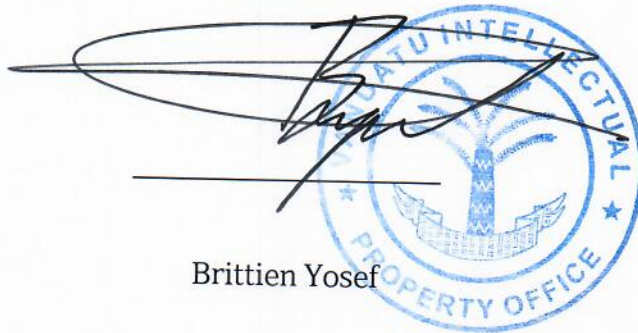
formed on 30th October 2017. A copy of the opposition was being served to Vanuatu Beverage Limited. As such, the statutory requirements of **section 30(1) ;(2); and (3)** were being met by Azure Pure Water Limited.

By reviewing Vanuatu Beverage Limited application, it stated on the required application form that, she seeks to register word mark "**VANUATU NATURAL**". There is no other graphical or fancy design in the background. It's just the word "**VANUATU NATURAL**". As such, I will base my decision based on the content of the information as stated in the approved application formed as prescribed under **section 16 (2) (a) (b) (c)** of the Act. Within this legal framework, it is clear that the proposed mark put forward by Vanuatu Beverage Limited is similar to the mark that is currently being used by Azure Pure Water Limited which, is **VANUATU NATURAL**. I accept arguments put forward by Mr. Mark Hurley Legal Counsel for Azure Pure Water Limited, that the registration and use of **Vanuatu Natural** in favour of Vanuatu Beverage Limited is similar to the mark used by Azure Pure Water Limited. If the said mark is to be registered in favour of Vanuatu Beverage Limited then, it will cause deception in the market. The description of class of goods under this mark is class 32 which, involves the manufacturing of Mineral and aerated waters and other non-alcoholic beverages. It is the same class of activities of which Azure Pure water limited is operating on.

Section 30 (4) of the Act states as follows: *'The registration of a trademark may be opposed on any of the grounds specified in section 33-37 (inclusive) and on no other grounds'*. I took note that, any ground of opposition may be advance from any of the sections commencing from **section 33** to **37**. This is a restrictive clause. Azure Pure Water Limited then stood on **section 35** to raise her opposition. **Section 35** states: *'The registration of a trademark (the "new trademark") for particular goods or services may be opposed on the ground that: (a) it is substantially identical with, or deceptively similar to, a trademark that had acquired a reputation in Vanuatu before the priority date for the registration of the new trademark for those goods or services; and (b) because of the reputation of that other trademark, the use of the new trademark would be likely to deceive or cause confusion.'*

Conclusion

With the above deliberations, I hereby exercise my powers under **section 32 (a)** of the **Trademarks Act** to refuse to register "VANUATU NATURAL" as a Trademark for Vanuatu Beverage Limited.

A handwritten signature in black ink is written over a blue circular official stamp. The stamp contains the text "VANUATU INTELLECTUAL PROPERTY OFFICE" around the perimeter and a central emblem featuring a palm tree and a building. The signature is written in a cursive style, with the first part being particularly large and sweeping.

Brittlen Yosef

Registrar of Trademarks

Vanuatu Intellectual Property Office