



UNIVERSITY *of the*
WESTERN CAPE

**An analysis of the ‘likelihood of confusion’ test in the South African
trademark law**

By

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A mini-thesis submitted in partial fulfilment for the degree LLM in the Faculty of
Law of the University of the Western Cape.

DECLARATION

I declare that ‘**An analysis of the “likelihood of confusion” test in the South African trademark law**’ is my own work, that it has not been submitted before for any degree or examination in any other university, and that all the sources I have used or quoted have been indicated and acknowledged as complete references.

Student: Kawake Sipelo Vuke

A handwritten signature in black ink, consisting of the letters 'SK' followed by 'Vuke' in a cursive style, all enclosed within a hand-drawn oval.

Signature

Date: 02 December 2021



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DEDICATION

To my God, Lord and Saviour, Jesus Christ

And

To my beloved mother, Fundiswa Cynthia Vuke



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ABBREVIATIONS

CJEU	The Court of Justice of the European Union [formerly: European Court of Justice, (ECJ)]
CTM	Community Trademark(s)
EU	European Union
IP	Intellectual Property
MFN	Most Favoured Nation
RSA	Republic of South Africa
SCA	Supreme Court of Appeal
TRIPS	Trade-Related Aspects of Intellectual Property Rights
UK	The United Kingdom
WIPO	The World Intellectual Property Organisation



KEYWORDS

Trademark protection

Deception

Extended infringement

Identical marks

Intellectual property rights

Likelihood of association

Likelihood of confusion

Primary infringement

Registered trademarks

Similar goods



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CHAPTER ONE: INTRODUCTION

1.1. INTRODUCTION

This section contains an overview of trademarks and the objective is to provide background information to the discussion. Trademark law is a creature of statute except for the law of passing-off which comes from common law.¹ Trademarks are governed by the Trade Marks Act 194 of 1993.² Accordingly, it is imperative to look at this Act to have clarity on the definition of a mark and a trademark. Section 2 of the Trade Marks Act first defines a mark as:

‘[A]ny sign capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour or container for goods or any combination of the aforementioned.’³

Thus, the Trade Marks Act requires a sign to have the ability to be represented graphically for it to be considered a mark. The word ‘graphically’ means that it must be capable of being represented in a form that can be recorded or reproduced such as words.⁴

Secondly, section 2 of the Trade Marks Act defines a trademark as:

‘[A] mark used or proposed to be used by a person in relation to goods or services for the purpose of distinguishing the goods or services in relation to which the mark is used or proposed to be used from the same kind of goods or services connected in the course of trade with any other person.’⁵

It is important to note that the definition of a trademark excludes both certification marks and collective marks. A mark must distinguish goods of one enterprise from another and be something other than the products themselves to qualify as a trademark.⁶ The words ‘used or proposed to be used’ denote that the proprietor must have the intention to use the mark or there should be prior use.⁷

¹ Dean O & Dyer A (eds) *Introduction to Intellectual Property Law* (2014) 93 & 79.

² Mukuka GS *Reap What You have not Sown: Indigenous Knowledge Systems & Intellectual Property Laws in South Africa* (2010) 21.

³ Trade Marks Act 194 of 1993, section 2.

⁴ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 111. See also Dean O & Dyer A (eds) *Introduction to Intellectual Property Law* (2014) 93; Ramsden P *A Guide to Intellectual Property Law* (2011) 108.

⁵ Trade Marks Act 194 of 1993, section 2. This definition is similar to the one in the TRIPS Agreement which also puts emphasis on the distinguishing function.

⁶ Ramsden P *A Guide to Intellectual Property Law* (2011) 108.

⁷ Dean O & Dyer A (eds) *Introduction to Intellectual Property Law* (2014) 97.

Trademarks are protected under international law and the various instruments that govern trademarks such as the Paris Convention for the Protection of Industrial Property⁸ (Paris Convention) as well as the Agreement on Trade-Related Aspects of Intellectual Property Rights⁹ (TRIPS Agreement) are discussed in chapter two. In a consumer-driven society, trademarks are an important marketing tool.¹⁰ They play a prominent role in influencing consumers.¹¹ Four functions make trademarks to be of commercial importance: first, the trademark fundamentally serves as a badge of origin.¹² This means that a trademark links the marked goods or services to the owner of the trademark.¹³ In other words, a trademark identifies the source of the goods and this helps consumers to be able to recognise the goods amongst the products of competitors.¹⁴ A trademark thus prevents similar marks from causing confusion in the marketplace.¹⁵ In *Stable Brands (Pty) Ltd v LA Group (Pty) Ltd*,¹⁶ the court stated that a trademark cannot serve as a badge of origin where the goods or services have not been in the market.¹⁷

Second, a trademark fulfils a distinguishing function. In other words, it helps the consumer to be able to distinguish the goods of the proprietor from those of the competitor.¹⁸ Should consumers be satisfied with a particular good or service, they will want to purchase it again in

⁸ Paris Convention for the Protection of Industrial Property (signed on 20 March 1883 and came into effect on 7 July 1884).

⁹ Agreement on Trade-Related Aspects of Intellectual Property Rights (signed on 15 April 1994 and came into effect on 1 January 1995).

¹⁰ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International* 2005 (8) BCLR 743 (CC), paragraph 78.

¹¹ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International* 2005 (8) BCLR 743 (CC), paragraph 78.

¹² Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 116. See also Papadopoulos S & Snail S (eds) *Cyberlaw @ SA III: The Law of the Internet in South Africa* (2012) 192.

¹³ Shikwambana N *USE OR ABUSE OF: Well-known Trademarks* (unpublished LLM thesis, University of Pretoria, 2012) 14.

¹⁴ Taljaard L 'South Africa: A Badge of Origin' 30 May 2020 available at <https://www.mondaq.com/southafrica/trademark/943938/a-badge-of-origin#:~:text=%22A%20trade%20mark.,Origin.&text=The%20essential%20function%20of%20a,other%20which%20have%20another%20origin>. (accessed on 03 February 2021).

¹⁵ De Beer J, Armstrong C, Oguamanam C & Schonwetter T *Innovation & Intellectual Property: Collaborative Dynamics in Africa* (2015) 17.

¹⁶ [2019] ZAGPPHC 567.

¹⁷ *Stable Brands (Pty) Ltd v LA Group (Pty) Ltd*, paragraph 48.

¹⁸ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 116. See also Department of Trade and Industry: Republic of South Africa 'Making a Mark: An Introduction to Trade Marks for Small and Medium-Sized Enterprises' available at https://www.wipo.int/export/sites/www/sme/en/documents/guides/customization/making_a_mark_sa.pdf (accessed on 03 February 2021).

the future.¹⁹ In *Adidas AG v Pepkor Retail Limited*,²⁰ the court stated that the three stripes of Adidas play a crucial role in helping the consumer identify or distinguish its products from those of others.²¹ Section 2 of the Trade Marks Act defines a trademark in terms of the distinguishing function which shows that distinctiveness is at the heart of trademark protection. The court in *First National Bank v Barclays Banks*²² also reiterated that a trademark should be distinctive to qualify for legal protection.²³

The third important function of a trademark is to guarantee quality.²⁴ In other words, the proprietor can assure consumers of the quality of his products through the trademark.²⁵ Hence, if the consumer has been satisfied with the quality produced by the owner of the trademark in some products, the display of the trademark on other products assures the consumer that this product will conform to his or her expectations.²⁶ In other words, it guarantees quality in terms of production, materials and/or methods.²⁷

The last function relates to advertising. A trademark plays a significant role in advertising and promoting the products of the proprietor.²⁸ A business can attract customers or appeal to loyal consumers through its trademarks.²⁹ The selling power of a trademark is an important attribute

¹⁹ Department of Trade and Industry: Republic of South Africa ‘Making a Mark: An Introduction to Trade Marks for Small and Medium-Sized Enterprises’ available at https://www.wipo.int/export/sites/www/sme/en/documents/guides/customization/making_a_mark_sa.pdf (accessed on 03 February 2021).

²⁰ [2013] ZASCA 3.

²¹ *Adidas AG v Pepkor Retail Ltd*, paragraph 3.

²² 2003 (4) SA 337 (SCA).

²³ *First National Bank v Barclays Banks*, paragraph 15.

²⁴ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 117; Tavares I ‘Protection and use of Certification Trademarks in Africa’ 24 August 2020 available at https://inventa.com/en/news/article/536/protection-and-use-of-certification-trademarks-in-africa?utm_source=Mondaq&utm_medium=syndication&utm_campaign=LinkedIn-integration (accessed on 04 February 2021).

²⁵ Shikwambana N *USE OR ABUSE OF: Well-known Trademarks* (Unpublished LLM thesis, University of Pretoria, 2012) 20.

²⁶ Kruger H *Trademark and Brand Dilution: An Empirical Investigation* (Unpublished PhD thesis, Stellenbosch University, 2014) 33.

²⁷ Tavares I ‘Protection and use of Certification Trademarks in Africa’ 24 August 2020 available at https://inventa.com/en/news/article/536/protection-and-use-of-certification-trademarks-in-africa?utm_source=Mondaq&utm_medium=syndication&utm_campaign=LinkedIn-integration (accessed on 04 February 2021).

²⁸ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 117 and Wegierski D ‘Keyword Advertising and Trademark Infringement’ (2012) *Werksmans Attorneys Legal Brief* 2.

²⁹ Kallis GE *The Legal Protection of Sound, Scent and Colour Marks in South Africa: Lessons from The European Union and The United States of America* (Unpublished LLM thesis, University of the Western Cape, 2018) 10.

that increases sales. The advertising function is particularly protected under the so-called anti-dilution provisions.³⁰

The registration of a trademark grants exclusive rights to the owner of the mark. A trademark is seen as a negative right that can ‘prevent others from using the same or a confusingly similar trademark [on] identical or similar goods or services’.³¹ Companies and manufacturers invest significant amounts of money to create, advance and ensure a unique trademark for their products.³² The Constitutional Court stated in *Laugh It Off Promotions CC v South African Breweries International (Finance) BV*³³ that:

‘From the producer’s side, trademarks promote invention, protect investment and enhance market-share by securely identifying a product or service. From the consumer’s point of view, they facilitate choice by identifying the product and guaranteeing its provenance and presumed quality.’³⁴

Put differently, when goods that are associated with a specific mark fail in terms of quality, this may cause consumers to lose confidence in products that are associated with the trademark. This would result in the market-share dropping or result in the loss of investors. The infringement of a trademark, thus, damages the good name of the owner in the marketplace. Third parties are prohibited from using an identical or similar mark that has been registered by the owner. Section 34(1) of the Trade Marks Act deals with three different types of infringement namely: primary infringement, extended infringement, and dilution.³⁵ An owner of a trademark has remedies available in cases of infringement.

1.2. PROBLEM STATEMENT

There is a clear distinction between section 34(1) (a) of the Trade Marks Act which deals with primary infringement and section 34(1) (b) which deals with extended infringement.³⁶ On one hand, section 34(1) (a) focuses on the use of the registered trademark by an infringer or the use of a mark so nearly resembling the registered mark on the same goods for which the mark is

³⁰ See Trade Marks Act 194 of 1993, section 34 (1).

³¹ Harms L ‘Plain Packaging and its Impact on Trademark Law’ (2013) 26 *De Jure* 392.

³² *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International* 2005 (8) BCLR 743 (CC), paragraph 78.

³³ 2005 (8) BCLR 743 (CC).

³⁴ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International*, paragraph 80.

³⁵ See Trade Marks Act 194 of 1993, section 34(1) (a)-(c). See also Visser C (ed) *The New Law of Trade Marks and Designs* (1995) 23.

³⁶ Dean O & Dyer A (eds) *Introduction to Intellectual Property Law* (2014) 146 and 148.

registered.³⁷ Section 34(1) (b), on the other hand, is not limited to the goods or services covered by the registered mark in question.³⁸ Both primary infringement and extended infringement require, amongst others, the ‘likelihood of confusion or deception’ requirement for an infringement action to succeed. Kelbrick argues that:

‘In paragraph (a), the confusion relates to the similarity of the two marks: if the allegedly infringing mark is not identical, it must be confusingly similar. Paragraph (b) refers to confusing use: the similarity between the marks, coupled with the similarity between the goods must cause confusion when the allegedly infringing mark is used.’³⁹

The application of the ‘likelihood of confusion’ requirement in primary infringement *vis-à-vis* in extended infringement has not been very clear. There seems to be inconsistency when courts apply this requirement.⁴⁰ This results in legal uncertainty and confusion with regards to the two separate types of infringement.⁴¹ The failure to distinguish the requirement of ‘likelihood of confusion’ potentially in the two sections may also lead to the blurring of the lines which separate the primary and extended infringement. Undoubtedly, the interpretation of the ‘likelihood of confusion’ requirement is becoming a cause for concern within trademark law.

1.3. RESEARCH QUESTION(S)

This thesis examines the application of the ‘likelihood of confusion’ requirement in trademark infringement cases. The main question is: Do courts consistently apply the ‘likelihood of confusion’ requirement for primary and secondary infringement in South Africa?

In answering this question, the study will address the following sub-questions:

- What does the concept ‘likelihood of confusion’ mean?
- What is the position regarding the ‘likelihood of confusion’ under the international legal framework that governs trademarks?
- Have the courts collapsed the enquiry of the ‘likelihood of confusion’ under sections 34(1) (a) and (b)? In other words, have courts adopted the same approach to the ‘likelihood of confusion’ with respect to primary and extended infringement?

³⁷ Visser C (ed) *The New Law of Trade Marks and Designs* (1995) 23.

³⁸ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 164.

³⁹ Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 1.

⁴⁰ *New Media Publishing (Pty) Ltd v Eating Out Web Services CC* 2005 (5) SA 388 (C) and *Mettenheimer v Zonquasdrif Vineyards CC* 2014 (2) SA 204 (SCA). Both cases analysed the concept of similar goods but reached contradicting conclusions.

⁴¹ Alberts W ‘Trade Mark Infringement’ *LexisNexis* 1.

- How do other legal systems such as the United Kingdom (UK) apply the ‘likelihood of confusion’ requirement?

1.4. SIGNIFICANCE OF THE STUDY

The Trade Marks Act 194 of 1993 ‘defines a trademark in terms of its distinguishing function rather than its origin function’.⁴² Trademarks play a significant role in a trade because they distinguish the products in connection to which it is used or proposed to be used within the course of business.⁴³ Consequently, this study is significant because it seeks to establish an optimal approach to the application of the ‘likelihood of confusion’ requirement with regards to primary and extended infringement. It seeks to provide clarity to courts, legal practitioners, and legal advisors on the preferred way of consistently applying the ‘likelihood of confusion’ requirement in terms of sections 34(1) (a) and (b). This research makes recommendations about how SA courts’ may do so without blurring the lines between the sections and/or collapsing the enquiries under each subsection. It also recommends lessons from other legal systems which could be useful with regards to the application of the ‘likelihood of confusion’ requirement in different types of infringement claims in SA.

1.6. METHODOLOGY

The study will be conducted mainly through desktop research. The research will focus on primary sources which include international treaties on trademarks, national trademark legislation as well as case law. It will also draw on secondary sources such as books, journal articles, theses, discussion papers, and other relevant sources. The UK will be used as a comparator from which lessons can be drawn. The UK has been selected because section 34(1) (a) of the SA Trade Marks Act is drawn from sections 10(1) and (2) of the UK’s Trade Marks Act 1994 and the English decisions provide persuasive authority in interpreting the corresponding provisions in the SA Trade Marks Act.⁴⁴ Likewise, section 34(1) (b) of the SA Trade Marks Act is derived from section 10(2) of the UK Trade Marks Act.⁴⁵

⁴² Rutherford BR ‘Trade Marks and Comparative Advertising’ (2010) 43(2) *The Comparative and International Law Journal of Southern Africa* 178.

⁴³ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 112.

⁴⁴ Rutherford BR ‘Limiting the Trade-Mark Monopoly: The Nature of Infringing use’ (2007) 40(3) *The Comparative and International Law Journal of Southern Africa* 454.

⁴⁵ Rutherford BR ‘Limiting the Trade-Mark Monopoly: The Nature of Infringing use’ (2007) 40(3) *The Comparative and International Law Journal of Southern Africa* 464.

1.7. CHAPTER OUTLINE

This thesis is made up of five chapters.

CHAPTER ONE: INTRODUCTION

This chapter provides an overview of the entire thesis. It gives a background to the study and explains the problem statement, research question(s), significance of the study, and methodology.

CHAPTER TWO: CONCEPTUAL FRAMEWORK

This chapter focuses on the international framework that addresses the confusion or the ‘likelihood of confusion’ in trademark infringement and examines, *inter alia*, the TRIPS Agreement, the Paris Convention, and the Madrid Agreement. The aim is to have a general understanding of the international legal position regarding the ‘likelihood of confusion’ in infringement cases.

CHAPTER THREE: ‘LIKELIHOOD OF CONFUSION’ REQUIREMENT IN TRADEMARK INFRINGEMENT IN SOUTH AFRICA

In this chapter, primary infringement in terms of section 34(1) (a) and extended infringement in terms of section 34(1) (b) are discussed, with a close look at how the courts have interpreted and applied the ‘likelihood of confusion’ requirement in these two provisions to determine whether or not they were consistent in doing so.

CHAPTER FOUR: ‘LIKELIHOOD OF CONFUSION’ REQUIREMENT IN TRADEMARK INFRINGEMENT IN THE UNITED KINGDOM.

This chapter analyses the application of the ‘likelihood of confusion’ requirement in trademark infringement cases in the UK. The objective is to draw lessons that are relevant and applicable to SA.

CHAPTER FIVE: CONCLUSION

This chapter provides a conclusion and also gives recommendations.

CHAPTER TWO: CONCEPTUAL FRAMEWORK

2.1. INTRODUCTION

The definition of a trademark has already been dealt with in chapter one. This chapter focuses on the legal framework that governs trademarks under international law. The international agreements to be discussed in this chapter includes the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement),⁴⁶ the Paris Convention for the Protection of Industrial Property (Paris Convention),⁴⁷ the Madrid Agreement Concerning the International Registration of Marks (Madrid Agreement),⁴⁸ the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks,⁴⁹ Trademark Law Treaty (TLT)⁵⁰ and Singapore Treaty on the Law of Trademarks (Singapore Treaty).⁵¹ A state may be a signatory of an international agreement but the agreement does not become part of the domestic law of a state unless that state has ratified it.⁵² These international agreements seek to accomplish a ‘degree of standardisation and uniformity’.⁵³

Amid the states that are parties to the Paris Convention, and the TRIPS Agreement are the Republic of South Africa (SA) and the United Kingdom.⁵⁴ The United Kingdom signed both the TLT, the Singapore Treaty, the Madrid Agreement and Madrid Protocol.⁵⁵ However, SA is

⁴⁶ Agreement on Trade-Related Aspects of Intellectual Property Rights (signed on 15 April 1994 and came into effect on 1 January 1995).

⁴⁷ Paris Convention for the Protection of Industrial Property (signed on 20 March 1883 and came into effect on 7 July 1884).

⁴⁸ Madrid Agreement Concerning the International Registration of Marks [concluded in 1891 and revised at Brussels (1900), Washington (1911), The Hague (1925), London (1934), Nice (1957) and Stockholm (1967), and amended in 1979].

⁴⁹ The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (which was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996).

⁵⁰ Trademark Law Treaty of 1994.

⁵¹ Singapore Treaty on the Law of Trademarks concluded in 2006 and came into effect in 2009.

⁵² Nguyen X ‘The Other Famous Marks Doctrine’ (2008) 17(757) *Transnational Law & Contemporary Problems* 758.

⁵³ Lukose LP ‘Non-Traditional Trademarks: A Critique’ (2015) 57(2) *Journal of the Indian Law Institute* 200.

⁵⁴ *Truworhs Ltd v Primark Holdings* 2019 (1) SA 179 (SCA), paragraph 12. See also World Trade Organisation (WTO) ‘United Kingdom and the WTO’ available at https://www.wto.org/english/thewto_e/countries_e/united_kingdom_e.htm#:~:text=The%20United%20Kingdom%20has%20been,Union%20until%2031%20January%202020 (accessed on 13 April 2021). See also Francisco Sá J ‘Challenges of using the Madrid Protocol in Africa’ 28 January 2021 available at <https://www.worldtrademarkreview.com/challenges-of-using-the-madrid-protocol-in-africa> (accessed on 29 May 2021).

⁵⁵ World Intellectual Property Organisation ((WIPO) ‘TLT Notification No. 1 Trademark Law Treaty: Signatories’ available at https://www.wipo.int/treaties/en/notifications/tlt/treaty_tlt_1.html (accessed on 29 May 2021). See also WIPO ‘WIPO-Administered Treaties Contracting Parties Singapore Treaty (Total Contracting Parties: 51)’ available at

only a signatory to the TLT and not the Singapore Treaty.⁵⁶ South Africa is also not a signatory to the Madrid Agreement and Madrid Protocol.⁵⁷ Although South Africa is not a signatory to some of these international agreements, having them all included in this discussion is important because they, together, form an international framework for trade mark law. The discussion under this chapter also lays a foundation for the discussion of the ‘likelihood of confusion’ which will be dealt with under chapters three and four of this thesis. In the following sections of this chapter, the focus will be on these agreements and how they address the concept of the ‘likelihood of confusion’ in the provisions dealing with trademark infringement.

2.2. WHAT IS THE ‘LIKELIHOOD OF CONFUSION’?

A confusingly similar mark is any mark that resembles another, whether registered or not, to a point that it is ‘likely to confuse’ the targeted consumers in the marketplace.⁵⁸ The ‘likelihood of confusion’ occurs where the marks are either similar or identical to each other and they are being used on similar or identical goods or services.⁵⁹ Hence, the ‘likelihood of confusion’ is used as a requirement to prove trademark infringement.⁶⁰ In *Plascon-Evans Paints (TVL) Ltd v Van Riebeck Paints (Pty) Ltd*,⁶¹ the court held that:

‘In an infringement action the onus is on the plaintiff to show the probability or likelihood of deception or confusion. It is not incumbent upon the plaintiff to show that every person interested or concerned (usually as customer) in the class of goods for which his trade mark has been registered would probably be deceived or confused. It is sufficient if the probabilities establish that a substantial number of such persons will be deceived or confused. The concept of deception or confusion is not limited to inducing

https://wipolex.wipo.int/en/treaties/ShowResults?start_year=ANY&end_year=ANY&search_what=C&code=ALL&treaty_id=30 (accessed on 29 May 2021).

⁵⁶ World Intellectual Property Organisation ((WIPO) ‘TLT Notification No. 1 Trademark Law Treaty: Signatories’ available at https://www.wipo.int/treaties/en/notifications/tlt/treaty_tlt_1.html (accessed on 29 May 2021). See also WIPO ‘WIPO-Administered Treaties Contracting Parties Singapore Treaty (Total Contracting Parties: 51)’ available at

https://wipolex.wipo.int/en/treaties/ShowResults?start_year=ANY&end_year=ANY&search_what=C&code=ALL&treaty_id=30 (accessed on 29 May 2021).

⁵⁷ See ‘Membership- Agreement Concerning the International Registration of Marks and Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks’ available at https://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf (accessed 08 August 2022). See also World Trademark Review (WTR) ‘Challenges of using the Madrid Protocol in Africa’ available at <https://www.worldtrademarkreview.com/article/challenges-of-using-the-madrid-protocol-in-africa> (accessed 04 August 2022).

⁵⁸ Stephen E & Stim R *Patent Copyright & Trademark* 6 ed (2003) 1039.

⁵⁹ UpCounsel Attorneys ‘Likelihood of Confusion: Everything You Need to Know’ available at <https://www.upcounsel.com/likelihood-of-confusion> (accessed 07 January 2022).

⁶⁰ UpCounsel Attorneys ‘Likelihood of Confusion: Everything You Need to Know’ available at <https://www.upcounsel.com/likelihood-of-confusion> (accessed 07 January 2022).

⁶¹ [1984] ZASCA 51.

in the minds of interested persons the erroneous belief or impression that the goods in relation to which the defendant's mark is used are the goods of the proprietor of the registered mark, ...'⁶²

The burden of proof is on the plaintiff to show on the balance of probabilities that deception or confusion is likely to occur.⁶³ The plaintiff has to satisfy the court that consumers will be confused or misled in the marketplace. The plaintiff must show that a substantial number of persons, most likely those who are interested in the product, are likely to be confused. If the plaintiff succeeds in showing that the commercial use of the mark of the defendant will result in the 'likelihood of confusion', then the defendant will be deemed to have acted dishonestly.⁶⁴

The requirement of the 'likelihood of confusion' is objective.⁶⁵ When determining the 'likelihood of confusion', one must consider the features of the mark as a whole.⁶⁶ Due regard must be held to the phonetical, visual, and conceptual features of the marks.⁶⁷ It is key to the analysis of the 'likelihood of confusion' to take into account 'the appearance, pronunciation, meaning, and commercial impression' of the mark.⁶⁸ Subsequently, one must hypothetically determine how an average consumer perceives the mark in the marketplace with regards to the products concerned.⁶⁹ Should the pronunciation, spelling, or appearance of the marks be similar, then there exists a probability of the 'likelihood of confusion'.⁷⁰ This was also confirmed by the Court of Justice of the European Union (CJEU) in *LTJ Diffusion SA v Sadas Vertbaudet SA*⁷¹ where it held that:

'..., the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind.'⁷²

⁶² *Plascon-Evans Paints (TVL) Ltd v Van Riebeck Paints (Pty) Ltd*, at 680G to 641A.

⁶³ Ramsden P *A Guide to Intellectual Property Law* (2011) 162.

⁶⁴ *Cochrane Steel Products (Pty) Ltd v M-Systems Group (Pty) Ltd* 2016 (6) SA 1 (SCA), paragraph 22.

⁶⁵ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 162. For further understanding, see the discussion of the *Albion Chemical Company (Pty) Ltd v FAM Products CC* [2004] 1 All SA 194 (C) under part 3.3.2. of chapter 3.

⁶⁶ Ramsden P *A Guide to Intellectual Property Law* (2011) 163.

⁶⁷ Dean O & Dyer A (eds) *Introduction to Intellectual Property Law* (2014) 178. Also see *Brown v Edcon Ltd* [2014] ZAGPPHC 371, paragraph 7.

⁶⁸ Radack DV 'Likelihood of Confusion— The Basis for Trademark Infringement' (2002) *The Journal of the Minerals, Metals & Materials Society* 80.

⁶⁹ *Brown v Edcon Ltd* (39873/2013) [2014] ZAGPPHC 371, paragraph 7.

⁷⁰ Radack DV 'Likelihood of Confusion— The Basis for Trademark Infringement' (2002) *The Journal of the Minerals, Metals & Materials Society* 80.

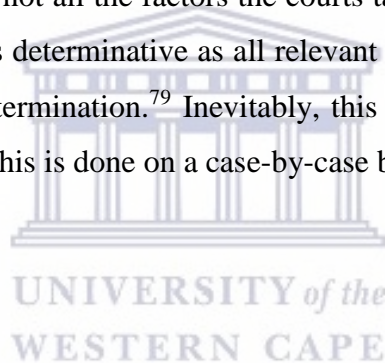
⁷¹ [2003] FSR 608.

⁷² *LTJ Diffusion SA v Sadas Vertbaudet SA*, paragraph 52.

In determining infringement, the judges have to place themselves in the shoes of the consumer in the marketplace. The CJEU confirmed that the consumer must always be part of the analysis since he is the person who is likely to be misled by the confusingly similar mark.⁷³

Another factor to consider is the intention of the defendant. In *Century City Apartments Property Services CC v Century City Property Owners Association*,⁷⁴ the court stated that the ‘likelihood of confusion’ can result from negligence on the part of the defendant.⁷⁵ It must be proven that the defendant’s intention for using a confusingly similar trademark was to create confusion. Circumstantial evidence suffices to prove the intention of the defendant since direct evidence is not always available to the plaintiff.⁷⁶ Whether or not the intention of the defendant was to deceive or cause confusion is not an essential factor for the analysis of the ‘likelihood of confusion’ but a beneficial one if it can be proven.⁷⁷

The factors discussed above are not all the factors the courts take into consideration. There is no closed list.⁷⁸ No one factor is determinative as all relevant factors must be considered and weighed before making that determination.⁷⁹ Inevitably, this means the court considers and weighs all the relevant facts.⁸⁰ This is done on a case-by-case basis.⁸¹



⁷³ Stim R ‘Likelihood of Confusion: How do You Determine if a Trademark is Infringing?’ available at <https://www.nolo.com/legal-encyclopedia/likelihood-confusion-how-do-you-determine-trademark-infringing.html> (accessed 30 May 2021).

⁷⁴ 2010 (3) SA 1 (SCA).

⁷⁵ *Century City Apartments Property Services CC v Century City Property Owners Association*, paragraph 14.

⁷⁶ Stim R ‘Likelihood of Confusion: How do You Determine if a Trademark is Infringing?: Are You Concerned that a Competitor is Unfairly Using the Same or a Similar trademark as Your Business?’ available at <https://www.nolo.com/legal-encyclopedia/likelihood-confusion-how-do-you-determine-trademark-infringing.html> (accessed 20 May 2021).

⁷⁷ Stim R ‘Likelihood of Confusion: How do You Determine if a Trademark is Infringing?: Are You Concerned that a Competitor is Unfairly Using the Same or a Similar trademark as Your Business?’ available at <https://www.nolo.com/legal-encyclopedia/likelihood-confusion-how-do-you-determine-trademark-infringing.html> (accessed 20 May 2021).

⁷⁸ Radack DV ‘Likelihood of Confusion— The Basis for Trademark Infringement’ (2002) *The Journal of the Minerals, Metals & Materials Society* 80.

⁷⁹ Radack DV ‘Likelihood of Confusion— The Basis for Trademark Infringement’ (2002) *The Journal of the Minerals, Metals & Materials Society* 80.

⁸⁰ Radack DV ‘Likelihood of Confusion— The Basis for Trademark Infringement’ (2002) *The Journal of the Minerals, Metals & Materials Society* 80.

⁸¹ Radack DV ‘Likelihood of Confusion— The Basis for Trademark Infringement’ (2002) *The Journal of the Minerals, Metals & Materials Society* 80.

2.3. TRIPS AGREEMENT

2.3.1 Background and Scope of the TRIPS Agreement

The TRIPS Agreement which was adopted by the World Trade Organisation (WTO) came into full operation in 1995.⁸² It is the most comprehensive multilateral agreement on intellectual property.⁸³ Trademarks are included in the scope of intellectual property (IP) that the TRIPS Agreement extends to.⁸⁴ Moreover, it makes provision for the requirements for ‘substantive legal standards’ for the national law (such as compulsory licenses and meeting minimum standards).⁸⁵ Thus, in its scope for trademarks, it includes the national treatment principle and the Most Favoured Nation (MFN) principle.⁸⁶ It is the first agreement of the WTO to include such requirements.⁸⁷

The TRIPS Agreement prescribes minimum standards for member states. It is a minimum standards agreement that grants the discretion of protecting trademarks to member states.⁸⁸ This discretion allows member states such as SA to determine how to implement the provisions of the TRIPS Agreement within their legal systems.⁸⁹ It only requires member states to meet the minimum standards when they are adopting legislation that deals with trademarks.⁹⁰ Further, the TRIPS Agreement introduces a universal legal definition for trademarks.⁹¹ It vests the owners of the registered trademarks with an exclusive right against third parties with marks

⁸² WTO ‘Overview: The TRIPS Agreement’ available at https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm (accessed on 14 April 2021).

⁸³ WTO ‘Overview: The TRIPS Agreement’ available at https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm (accessed on 14 April 2021).

⁸⁴ WTO ‘Overview: The TRIPS Agreement’ available at https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm (accessed on 28 May 2021).

⁸⁵ Law A *Patents and Public Health: Legalising the Policy Thoughts in the Doha TRIPS Declaration of 14 November 2001* (2008) 43. See also Abbott F ‘Dispute Settlement: World Trade Organisation’ (2003) *United Nations Conference on Trade and Development* 1.

⁸⁶ Japan Patent Office ‘Introduction to TRIPs Agreement’ page 11 available at https://www.jpo.go.jp/e/news/kokusai/developing/training/textbook/document/index/TRIPs_Agreement.pdf (accessed on 28 May 2021).

⁸⁷ Abbott F ‘Dispute Settlement: World Trade Organisation’ (2003) *United Nations Conference on Trade and Development* 1.

⁸⁸ WTO ‘Overview: The TRIPS Agreement’ available at https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm#:~:text=The%20TRIPS%20Agreement%20is%20a,own%20legal%20system%20and%20practice. (accessed 02 June 2021).

⁸⁹ WTO ‘Overview: The TRIPS Agreement’ available at https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm#:~:text=The%20TRIPS%20Agreement%20is%20a,own%20legal%20system%20and%20practice. (accessed 02 June 2021).

⁹⁰ Fukunaga Y ‘Enforcing TRIPS: Challenges of Adjudicating Minimum Standards Agreements’ (2008) 23(8) *Berkeley Technology Law Journal* 869.

⁹¹ Reichman JH ‘Universal Minimum Standards of Intellectual Property Protection under the TRIPS Component of the WTO Agreement’ (1995) 20(2) *The International Lawyer* 362.

that amount to a ‘likelihood of confusion’.⁹² The minimum standards are aimed at protecting IP rights internationally without removing the territoriality principle.⁹³

Article 3 of the TRIPS Agreement provides for national treatment. It provides that the protection of IP a country provides to its nationals must also be extended to the foreign nationals who are currently in that country.⁹⁴ The national treatment protects the ‘economic interests’ of foreign nationals by giving them the same treatment as one’s own nationals.⁹⁵ The scope of the national treatment of the TRIPS Agreement is limited to the classes of IP rights provided for in the TRIPS Agreement (which includes trademarks), and ‘matters affecting the availability, acquisition, scope, maintenance, and enforcement of intellectual property right’.⁹⁶ By the same token, the national treatment does not extend to the exceptions that are already provided for by the other international agreements on IP such as the Paris Convention.⁹⁷ This means SA cannot provide different treatment to its nationals, for example, when it comes to the trademark infringement proceedings that relate to the ‘likelihood of confusion’.

Article 4 of the TRIPS Agreement deals with the Most Favoured Nation (MFN) principle. The main purpose of the MFN principle is to ensure equal protection and enforcement of IP rights of both the nationals of a member state and foreign nationals of another member state.⁹⁸ This means SA must implement the same standard of protection for both its nationals and proprietors from other member states. The MFN principle’s scope does not prohibit beneficial treatment and immunity for IP rights arising out of the provisions of other international agreements such as those that are derived from the Berne Convention⁹⁹ or the Rome Convention.¹⁰⁰ Its scope

⁹² Reichman JH ‘Universal Minimum Standards of Intellectual Property Protection under the TRIPS Component of the WTO Agreement’ (1995) 20(2) *The International Lawyer* 362.

⁹³ Kunisawa VYM *The TRIPS Agreement Implementation in Brazil* (2015) 31.

⁹⁴ TRIPS Agreement, Article 3.

⁹⁵ Carr I, Alam S & Bhuiyan JH *International Trade Law and WTO* (2013) 143.

⁹⁶ Sanders AK (ed) *The Principle of National Treatment in International Economic Law: Trade, Investment and Intellectual Property Law* (2014) 287.

⁹⁷ Sanders AK (ed) *The Principle of National Treatment in International Economic Law: Trade, Investment and Intellectual Property Law* (2014) 287.

⁹⁸ Carr I, Alam S & Bhuiyan JH *International Trade Law and WTO* (2013) 103.

⁹⁹ Berne Convention for the Protection of Literary and Artistic Works of 9 September 1886 (completed at Paris on 4 May 1896, revised at Berlin on 13 November 1908, completed at Berne on 20 March 1914, revised at Rome on 2 June 1928, at Brussels on 26 June 1948, at Stockholm on 14 July 1967, and at Paris on 24 July 1971, and amended on 28 September 1979).

¹⁰⁰ The Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations of 26 October 1961.

also does not prohibit the ‘rights of performers, producers of phonograms and broadcasting organisations’ which are not included in the TRIPS Agreement.¹⁰¹

2.3.2. ‘Likelihood of confusion’ under the TRIPS Agreement

The TRIPS Agreement is the first international agreement to include consumer confusion for trademark infringements.¹⁰² Article 16(1) of the TRIPS Agreement deals with trademark infringements. It states that:

‘The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered *where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed...*’¹⁰³

Article 16(1) protects a proprietor where an identical or a similar mark has been used on products identical or similar to those of the owner without their consent.¹⁰⁴ For an infringement to exist, the proprietor does not have to prove that the marks are identical, but may show that the mark is similar to the registered mark.¹⁰⁵ He must also prove that there is a likelihood that an average consumer in the marketplace will be confused.¹⁰⁶ According to Article 15(1) of the TRIPS Agreement, a trademark should distinguish the products of the proprietor from those of other competitors. The consumer may be deceived into believing that the products in question are manufactured by or economically linked to the trademark owner.¹⁰⁷ Article 15(1) should consequently serve as a bedrock for understanding ‘confusion’ within the context of trademark infringement under Article 16(1).¹⁰⁸ Article 15(1) is of paramount importance in determining trademark infringement and it should, therefore, be read together with Article 16.

¹⁰¹ Roffe P ‘Bilateral agreements and a TRIPS-plus world: the Chile-USA Free Trade Agreement’ available at <https://quino.org/sites/default/files/resources/Bilateral-Agreements-and-TRIPS-plus-English.pdf> (accessed 21 May 2021).

¹⁰² Farley CH & Calboli I ‘The Trademark Provisions in the TRIPS Agreement’ in Correa CM & Yusuf AA (eds) *Intellectual Property and International Trade: TRIPS Agreement* 3 ed (2016) 157-192.

¹⁰³ TRIPS Agreement, Article 16(1): emphasis added. This section is similar to section 10(2) of the United Kingdom Trade Marks Act; see part 4.3.2 under chapter 4. The section 34(1) South African Trade Mark Act has this Article as two different sections, see the discussion in 3.2. of chapter 3.

¹⁰⁴ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 186. See part 2.2 above on the discussion of intention above.

¹⁰⁵ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 186. See also Article 3 of the TRIPS Agreement which provides the ‘advantage, favour, privilege or immunity accorded by a [m]ember’ that limits the scope of the MFN principle as contained in the TRIPS Agreement.

¹⁰⁶ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 186.

¹⁰⁷ Zixin S *Confusion or Likelihood of Confusion: Trademark Infringement in China and EU* (Unpublished LLM thesis, Uppsala Universitet, 2018) 40.

¹⁰⁸ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 186.

The 'likelihood of confusion' is generally a prerequisite for a claim for trademark infringement. Article 16 of the TRIPS Agreement prohibits the use of a mark identical or similar to that of the proprietor in a way that would result in a 'likelihood of confusion'. Further, it states that where there is a use of an identical mark, there is a presumption that the 'likelihood of confusion' exists. In other words, the 'likelihood of confusion' will be automatically presumed where there is a use of an identical mark on identical products.¹⁰⁹

This means that the infringing party has to rebut the presumption by adducing evidence that shows that the use of an identical mark did not result in confusion. The extent of the evidence required depends on the trademark laws of the member state concerned. It is important to note that the TRIPS Agreement does not explain the term 'likelihood of confusion'. The right contained in Article 16(1) is also known as an exclusive right of the proprietor against marks that are 'likely to confuse' in the marketplace.¹¹⁰ This exclusive right vests on the owner with the power to prevent third parties from making use of identical or similar marks where such is 'likely to confuse'.¹¹¹ The 'likelihood of confusion' is deemed as an appropriate requirement because it prevents the use of confusingly similar marks that affects the purpose of trademarks as a distinguishing factor of products.¹¹²

The European Union (EU) Trade Mark Directives¹¹³ which were adopted before the TRIPS Agreement is most likely to have influenced the language of Article 16(1).¹¹⁴ It is also worth noting that the EU Trade Mark Directives do not require the 'likelihood of confusion' when dealing with identical marks used on identical products.¹¹⁵ The proprietor is only required to show double identity.¹¹⁶ Conversely, what is key is that the proprietor must show that the third

¹⁰⁹ Brinkerhoff EB 'International Protection of the United States Trademarks: A Survey of Major International Treaties' (2001) 2(1) *Richmond Journal of Global Law & Business* 119.

¹¹⁰ Gervais D *The TRIPS Agreement: Drafting History and Analysis* 3 ed (2008) 275.

¹¹¹ Reichman JH 'Universal Minimum Standards of Intellectual Property Protection under the TRIPS Component of the WTO Agreement' (1995) 20(2) *The International Lawyer* 362.

¹¹² Gervais D *The TRIPS Agreement: Drafting History and Analysis* 3 ed (2008) 275.

¹¹³ First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p.1).

¹¹⁴ Farley CH & Calboli I 'The Trademark Provisions in the TRIPS Agreement' in Correa CM & Yusuf AA (eds) *Intellectual Property and International Trade: TRIPS Agreement* 3 ed (2016) 157-192.

¹¹⁵ Farley CH & Calboli I 'The Trademark Provisions in the TRIPS Agreement' in Correa CM & Yusuf AA (eds) *Intellectual Property and International Trade: TRIPS Agreement* 3 ed (2016) 157-192.

¹¹⁶ The requirement of double identity for trademark infringements will be dealt with under chapter 4 when doing analysis of the 'likelihood of confusion' under the United Kingdom.

party seeks to derive a benefit from the ‘power of attraction’ which arises from the reputation and prestige attached to the mark of the proprietor.¹¹⁷ In other words, he must show that the third party seeks to exploit the reputation of the mark without paying compensation for it.¹¹⁸

2.4. PARIS CONVENTION

2.4.1. Background and Scope of the Paris Convention

The Paris Convention came into effect in 1884. Member states of the Paris Convention are required to comply with the provisions that were finalised in the revised version of the Convention in 1967.¹¹⁹ Article 1 of the Paris Convention sets out the scope of protection of the agreement. The Paris Convention does not provide regulations for the filing and registration of marks but rather it leaves that to be dealt with under the domestic trademark law of each member state.¹²⁰ An owner of a trademark who desires to have their mark protected in a foreign country must ensure that they comply with the domestic trademark requirements of that country.¹²¹

The Paris Convention provides only the national treatment principle and it makes no provision regarding the MFN principle or the minimum standards.¹²² The national treatment of the Paris Convention requires member states to accept trademarks that have been registered in their home countries.¹²³ It obligates member states to create equal enjoyment of the IP right both for its nationals and nationals of other member states by prescribing the same protection for IP rights and legal remedies against the infringement of such rights.¹²⁴ This is subject to the requirement that ‘the conditions and formalities imposed upon nationals are complied with’.¹²⁵ Accordingly, SA must ensure equal treatment between its nationals and those of other member

¹¹⁷ *L’Oréal SA v Bellure NV* (2009) Case C-487/07, paragraph 50.

¹¹⁸ *L’Oréal SA v Bellure NV* (2009) Case C-487/07, paragraph 50.

¹¹⁹ World Intellectual Property Organisation ‘Summary of the Paris Convention for the Protection of Industrial Property (1883)’ available at https://www.wipo.int/treaties/en/ip/paris/summary_paris.html (accessed on 23 April 2021).

¹²⁰ World Intellectual Property Organisation ‘Summary of the Paris Convention for the Protection of Industrial Property (1883)’ available at https://www.wipo.int/treaties/en/ip/paris/summary_paris.html (accessed on 23 April 2021).

¹²¹ Nguyen X ‘The Other Famous Marks Doctrine’ (2008) 17(757) *Transnational Law & Contemporary Problems* 759.

¹²² Trebilcock MJ *Advanced Introduction to International Trade Law* (2015) 139.

¹²³ Trebilcock MJ *Advanced Introduction to International Trade Law* (2015) 139.

¹²⁴ Paris Convention, Article 2.

¹²⁵ Paris Convention, Article 2.

states of the Paris Convention in terms of protecting trademarks from infringement (such as those that would cause confusion) and providing legal remedies in the cases of infringement.

2.4.2. ‘Confusion’ under the Paris Convention

Article 6bis of the Paris Convention deals with infringement. It provides that:

‘The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, *liable to create confusion*, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods.’¹²⁶

This means member states must disallow — either by cancellation or prohibition — a registration or use of marks that are liable to confuse or deceive consumers in the marketplace. This Article speaks directly to well-known marks. Unlike the TRIPS Agreement, the Paris Convention does not use the phrase ‘likelihood of confusion’ but rather uses the words ‘liable to create confusion’. However, the concept bears the same meaning because the issue here is to determine whether or not the average relevant consumer would be misled with regards to the origin of the product.¹²⁷ For well-known marks to be protected from infringement, Article 6bis places a duty upon the state to make laws protecting the well-known marks from marks that are creating confusion.¹²⁸

The infringement under Article 6bis is directed at identical marks that are used on identical goods or services.¹²⁹ Accordingly, the Panel in *Australia – Certain Measures Concerning Trademarks*¹³⁰ concluded that Article 6bis contains a negative right because it requires member states to refuse or cancel the registration of an infringing mark.¹³¹ Article 6bis is considered justifiable because it prevents unfair competition that would result if an identical mark is

¹²⁶ Paris Convention, Article 6bis (1): emphasis added.

¹²⁷ Panel Report, *Australia – Certain Measures Concerning Trademarks, Geographical Indications and Other Plain Packaging Requirements Applicable to Tobacco Products and Packaging*, WT/DS458/R, WT/DS467/R, 28 June 2018, paragraph 7.2794.

¹²⁸ *Arbiter Di Marciano Alfonso & C.S.N.C. v Adamo Exclusive Mens Wear CC t/a Papoutsi* (55428/2015) [2017] ZAGPPHC 7, paragraph 8.

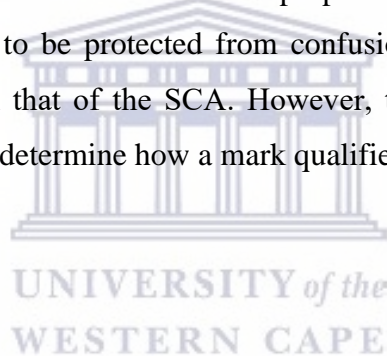
¹²⁹ Kelbrick R ‘The Term “Well-known” in South African Trade-mark Legislation: Some Comparative Interpretations’ (2005) 38(3) *The Comparative and International Law Journal of Southern Africa* 438.

¹³⁰ Panel Report, *Australia – Certain Measures Concerning Trademarks, Geographical Indications and Other Plain Packaging Requirements Applicable to Tobacco Products and Packaging*, WT/DS458/R, WT/DS467/R, 28 June 2018.

¹³¹ *Australia – Certain Measures Concerning Trademarks*, paragraph 7.2098.

registered or granted permission to be used.¹³² Thus, a mark may still be considered to be well-known in a country even if it is not registered or when the infringing identical mark is used in a manner that the proprietor has never used.¹³³

SA did not include Article 6bis as part of its trademark law until the Trade Marks Act 194 of 1993.¹³⁴ The Trade Marks Act dedicates section 35 to deal with well-known marks as provided for under the Paris Convention. Consequently, one may conclude that a well-known mark is entitled to protection under the Convention, and registration of the mark under the domestic trademark law is not a requirement.¹³⁵ A mark that is registered in another country is protected in SA by the virtue of section 35 despite not being registered in SA. This was also affirmed by the Supreme Court of Appeal (SCA) in *McDonald's Corporation v Joburgers Drive-Inn Restaurant (Pty) Ltd*¹³⁶ that the intention of the legislature to include section 35 was to cater for Article 6bis.¹³⁷ It was even further confirmed by the High Court in *Arbiter Di Marciano Alfonso v Adamo Exclusive Mens Wear*¹³⁸ that the proprietor need not be conducting his business in the Republic for it to be protected from confusion arising in SA.¹³⁹ The High Court's decision is in line with that of the SCA. However, the Paris Convention does not provide a standard to be used to determine how a mark qualifies as a well-known mark.¹⁴⁰



¹³² Bodenhausen GCH *Guide to the Application of the Paris Convention or the Protection of Industrial Property as revised at Stockholm in 1967* (1968) 90.

¹³³ Gervais D *The TRIPS Agreement: Drafting History and Analysis* 3 ed (2008) 275; Oloko TO *Impact of the World Trade Organisation TRIPS Agreement on the Intellectual Property Laws of Nigeria* (Unpublished LLD thesis, University of Pretoria, 2014) 83.

¹³⁴ *McDonald's Corporation v Joburgers Drive-Inn Restaurant (Pty) Ltd; McDonald's Corporation v Dax Prop CC; McDonald's Corporation v Joburgers Drive-Inn Restaurant (Pty) Ltd* (547/95) [1996] ZASCA 82; 1997 (1) SA 1 (SCA).

¹³⁵ Kelbrick R 'The Term "Well-known" in South African Trade-mark Legislation: Some Comparative Interpretations' (2005) 38(3) *The Comparative and International Law Journal of Southern Africa* 438.

¹³⁶ (547/95) [1996] ZASCA 82; 1997 (1) SA 1 (SCA).

¹³⁷ *McDonald's Corporation v Joburgers Drive-Inn Restaurant (Pty) Ltd; McDonald's Corporation v Dax Prop CC; McDonald's Corporation v Joburgers Drive-Inn Restaurant (Pty) Ltd*, at 19D-F.

¹³⁸ [2017] ZAGPPHC 7.

¹³⁹ *Arbiter Di Marciano Alfonso & C.S.N.C. v Adamo Exclusive Mens Wear CC t/a Papoutsi*, paragraph 11.

¹⁴⁰ Gervais D *The TRIPS Agreement: Drafting History and Analysis* 3 ed (2008) 275.

2.5. MADRID SYSTEM

2.5.1. The Madrid Agreement

The conclusion of the Madrid Agreement happened in 1891 and it became effective in 1892.¹⁴¹ It has been revised many times including in 1967 and amended in 1979.¹⁴² The Agreement seeks to achieve a single international registration system for trademarks.¹⁴³ Proprietors from member states can, therefore, have their trademarks protected in other countries through a single filing system.¹⁴⁴ The proprietor can file an international registration with a trademark office in his home country.¹⁴⁵ The office sends the application to World Intellectual Property Organisation (WIPO) which publishes the application in *Les Marques International*.¹⁴⁶ The proprietor must indicate in the application the member states in which protection is sought.¹⁴⁷ The proprietor must either be a citizen or be operating his business in the country of registration.¹⁴⁸ Once the trademark rights holder is successfully registered nationally, he must file another application with WIPO in Geneva.¹⁴⁹ WIPO sends this to its member states who are given 12 months to oppose or refuse the registration.¹⁵⁰ Failure to oppose the registration within 12 months is deemed as acceptance of the mark.

The Madrid Agreement makes use of neither the trademark confusion phrases (such as the ‘likelihood of confusion’, ‘risk of confusion’, the ‘likelihood of association’ etc.) nor does it deal with trademark infringements. Conversely, the Agreement subjects the mark seeking

¹⁴¹ WIPO ‘Objectives, Main Features, Advantages of the Madrid System’ available at <https://www.wipo.int/madrid/en/general/> (accessed on 29 May 2021).

¹⁴² Schmidt-Szalewski J ‘The International Protection of Trademarks after the TRIPS Agreement (1998)’ 9(189) *Duke Journal of Comparative & International Law* 202.

¹⁴³ Blakely TE ‘Beyond the International Harmonization of Trademark Law: The Community Trade Mark as a Model of Unitary Transnational Trademark Protection’ (2000) 149(1) *University of Pennsylvania Law Review* 316.

¹⁴⁴ Brinkerhoff EB ‘International Protection of the United States Trademarks: A Survey of Major International Treaties’ (2001) 2(1) *Richmond Journal of Global Law & Business* 114.

¹⁴⁵ Brinkerhoff EB ‘International Protection of the United States Trademarks: A Survey of Major International Treaties’ (2001) 2(1) *Richmond Journal of Global Law & Business* 114.

¹⁴⁶ Brinkerhoff EB ‘International Protection of the United States Trademarks: A Survey of Major International Treaties’ (2001) 2(1) *Richmond Journal of Global Law & Business* 114.

¹⁴⁷ Brinkerhoff EB ‘International Protection of the United States Trademarks: A Survey of Major International Treaties’ (2001) 2(1) *Richmond Journal of Global Law & Business* 114.

¹⁴⁸ Klopper HB, Pistorius T & Rutherford et al *Law of Intellectual Property in South Africa* (2011) 108.

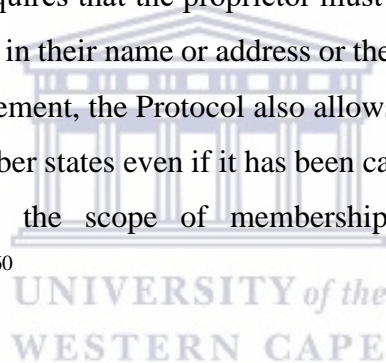
¹⁴⁹ Pacini P ‘*Likelihood of Confusion*’ in the Judgements of the European Courts and in the Decisions of the OHIM (Unpublished Master of European Affairs programme, Law thesis, University of Lund, 2005) 9.

¹⁵⁰ Pacini P ‘*Likelihood of Confusion*’ in the Judgements of the European Courts and in the Decisions of the OHIM (Unpublished Master of European Affairs programme, Law thesis, University of Lund, 2005) 9.

registration in foreign countries to the domestic law of that country.¹⁵¹ Upon the approval of the application or the expiration of the 12 months thereof, the domestic trademark law of the foreign country defines the scope of protection.¹⁵² This means that issues relating to the ‘likelihood of confusion, descriptiveness, and distinctiveness’ of the goods or services will be determined using the scope provided by the domestic trademark law of that nation.¹⁵³

2.5.2. Madrid Protocol

The Madrid Protocol was adopted in 1989, became effective in 1995, and started operating in 1996.¹⁵⁴ The Madrid Protocol which revised the Madrid Agreement was introduced to meet the Agreement’s shortcomings.¹⁵⁵ Unlike the Madrid Agreement, the Protocol only requires the proprietor to have made an application in his home country before he can make an international application to the WIPO’s International Bureau.¹⁵⁶ The Protocol extends the 12 months of the Madrid Agreement within which objections to the registration of a mark may be made to 18 months.¹⁵⁷ The Protocol also requires that the proprietor must report to WIPO’s International Bureau should there be a change in their name or address or there is a transfer of ownership.¹⁵⁸ Different from the Madrid Agreement, the Protocol also allows for the mark to continue to be in commercial use in other member states even if it has been cancelled in the home country.¹⁵⁹ Further, the Protocol extends the scope of membership to allow intergovernmental organisations to be signatories.¹⁶⁰



¹⁵¹ Walters CE ‘The Madrid Protocol’ (1993) 4(1) *Fordham Intellectual Property, Media and Entertainment Law Journal* 410.

¹⁵² Blakely TE ‘Beyond the International Harmonization of Trademark Law: The Community Trade Mark as a Model of Unitary Transnational Trademark Protection’ (2000) 149(1) *University of Pennsylvania Law Review* 317.

¹⁵³ Walters CE ‘The Madrid Protocol’ (1993) 4(1) *Fordham Intellectual Property, Media and Entertainment Law Journal* 410.

¹⁵⁴ WIPO ‘Objectives, Main Features, Advantages of the Madrid System’ available at <https://www.wipo.int/madrid/en/general/> (accessed on 29 May 2021).

¹⁵⁵ Bogsch A *Introduction to Trademark Law & Practice the Basic Concepts: A WIPO Training Manual* (1993) 109.

¹⁵⁶ Mupangavanhu Y *The Regional Integration of African Trade Mark Laws: Challenges and Possibilities* (Unpublished LLD thesis, University of the Western Cape, 2013) 133.

¹⁵⁷ Klein T ‘Madrid Trademark Agreement vs. Madrid Protocol’ (2001) 12(1) *Journal of Contemporary Legal Issues* 486.

¹⁵⁸ The United States Patent and Trademark Office ‘Madrid Protocol’ 26 February 2021 available at <https://www.uspto.gov/trademarks/laws/madrid-protocol> (accessed on 29 May 2021).

¹⁵⁹ Klein T ‘Madrid Trademark Agreement vs. Madrid Protocol’ (2001) 12(1) *Journal of Contemporary Legal Issues* 487.

¹⁶⁰ Madrid Protocol, Article 14(2).

In terms of similarities, the Protocol also does not make use of the word infringement nor does it use trademark confusion-related phrases. Article 2 of the Protocol allows the person making an application in a member country to also seek the protection of his mark in that country.¹⁶¹ In other words, the proprietor can, with rights provided under the Protocol, protect his mark from confusingly similar marks. In addition, the Protocol grants the proprietor the right to choose member countries from which he can have his mark protected especially from infringements by confusingly similar marks.¹⁶² Although the Protocol does not entail provisions that address trademark infringement, it allows the trademark legal system of the member countries to protect the mark of the proprietor who has made an application.

2.6. TRADEMARK LAW TREATY AND SINGAPORE TREATY

2.6.1. Trademark Law Treaty

The TLT came into effect in 1994.¹⁶³ The TLT seeks to systematise the registration procedures for trademarks at a national and regional level.¹⁶⁴ The TLT aims for a system of registration for trademarks that will create simplicity, reliability, and uniformity that will benefit the proprietors and their consumers.¹⁶⁵ The TLT simplifies the system of filing documents that

¹⁶¹ Madrid Protocol, Article 2(1). This subsection provides that:

‘Where an application for the registration of a mark has been filed with the Office of a Contracting Party, or where a mark has been registered in the register of the Office of a Contracting Party, the person in whose name that application (hereinafter referred to as “the basic application”) or that registration (hereinafter referred to as “the basic registration”) stands may, subject to the provisions of this Protocol, secure protection for his mark in the territory of the Contracting Parties, by obtaining the registration of that mark in the register of the International Bureau of the World Intellectual Property Organisation (hereinafter referred to as “the international registration,” “the International Register,” “the International Bureau” and “the Organisation,” respectively), provided that,

- i. where the basic application has been filed with the Office of a Contracting State or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of that Contracting State, or is domiciled, or has a real and effective industrial or commercial establishment, in the said Contracting State,
- ii. where the basic application has been filed with the Office of a Contracting Organization or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of a State member of that Contracting Organization, or is domiciled, or has a real and effective industrial or commercial establishment, in the territory of the said Contracting Organization.’

¹⁶² Cara-Carson F & Chisholm L ‘Australia: Protection of Your Trade Mark Internationally under the Madrid Protocol’ available at <https://www.mondaq.com/australia/trademark/631834/protection-of-your-trade-mark-internationally-under-the-madrid-protocol> (accessed on 29 May 2021).

¹⁶³ WIPO ‘Trademark Law Treaty (TLT)’ available at <https://www.wipo.int/publications/en/details.jsp?id=335&plang=EN> (accessed on 28 May 2021).

¹⁶⁴ WIPO ‘Trademark Law Treaty (TLT)’ available at <https://www.wipo.int/treaties/en/ip/ilt/> (accessed on 28 May 2021).

¹⁶⁵ Cheung R ‘Pros and Cons of the Trademark Law Treaty’ (2001) 1(12) *Journal of Contemporary Legal Issues* 480.

exist in different jurisdictions and the procedures thereof.¹⁶⁶ It also does away with the requirement that the documents must be certified.¹⁶⁷ Additionally, the procedures that the TLT seeks to regulate consist of ‘applications, renewals, and assignments’ for registration.¹⁶⁸ It also abolishes the requirement of trade use for a mark and/or that it must be registered in another country.¹⁶⁹ It also regulates electronic communication between member states and prescribes a requirement for a power of attorney.¹⁷⁰ The scope of the TLT is limited to two-dimensional marks with limited inclusion of some three-dimensional marks.¹⁷¹

The TLT does not provide much direction on how trademark infringements should be dealt with nor does it contain provisions on trademark confusion. Article 15 of the TLT only requires contracting parties to comply with provisions of the Paris Convention which regulates trademarks.¹⁷² This would mean that in infringement cases of the ‘likelihood of confusion’ the contracting state would be required to implement Article 6bis (1) of the Paris Convention. Article 6bis (1) provides that the registration of a mark that is ‘liable to create confusion’ must either be cancelled or prohibited.¹⁷³ The Model International Form No. 6 (Form 6) of the TLT and Regulations¹⁷⁴ also gives the proprietor the power to transfer to a third party the right to sue in cases of past infringements.¹⁷⁵ Form 6 presupposes a proprietor’s right to sue for past infringements. Since the TLT nor its Regulations contain provisions on infringement or its proceedings, a conclusion can be drawn that the existence of such presupposition in Form 6 is owed to Article 15 of the TLT. Article 15 vests the power to deal with infringements including cases of the ‘likelihood of confusion’ to the Paris Convention.

¹⁶⁶ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 144.

¹⁶⁷ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 144.

¹⁶⁸ Browning MG ‘International Trademark Law: A Pathfinder and Selected Bibliography’ (1994) 4(339) *Indiana International & Comparative Law Review* 352.

¹⁶⁹ Brinkerhoff EB ‘International Protection of the United States Trademarks: A Survey of Major International Treaties’ (2001) 2(1) *Richmond Journal of Global Law & Business* 117.

¹⁷⁰ Browning MG ‘International Trademark Law: A Pathfinder and Selected Bibliography’ (1994) 4(339) *Indiana International & Comparative Law Review* 352.

¹⁷¹ Gheewala S ‘Singapore Sling: WIPO Passes the Buck on Meaningful Reform of International Trademark Law’ (2007) 17(2) *DePaul-LCA Journal of Art and Entertainment Law* 310.

¹⁷² Trademark Law Treaty, Article 15.

¹⁷³ See the discussion of Article 6bis (1) under 2.4.2.

¹⁷⁴ Trademark Law Treaty and Regulations done at Geneva on October 27, 1994.

¹⁷⁵ Trademark Law Treaty and Regulations, The Model International Form No. 6.

2.6.2. Singapore Treaty

The Singapore Treaty — which is a revision for the TLT — was concluded in 2006 and came into effect in 2009.¹⁷⁶ The Singapore Treaty seeks ‘to create a modern and dynamic international framework for the harmonisation of administrative trademark registration procedures’.¹⁷⁷ The scope of the Singapore Treaty extends to the newly developed forms of trademarks such as ‘motion marks, colour marks, and non-divisible signs such as sound and taste marks’.¹⁷⁸

Section 19 abolishes any requirement that may exist under the trademark law of a member state which requires the proprietor or an interested party to produce evidence of registration of his license under the law of that state in order to participate in infringement proceedings initiated by the proprietor or obtaining damages through infringement proceedings.¹⁷⁹ The proprietor cannot be denied the right to initiate proceedings in a member state because their license is not registered in that state.¹⁸⁰ Article 19 allows the proprietor to also initiate proceedings regarding infringements emerging from confusingly similar marks. Article 29(4) of the Singapore Treaty allows for the condition prohibited by Article 19(2) to be included in the trademark law of a member state through reservation. Spain and Uruguay have made reservations with regards to Article 19(2).¹⁸¹ These two nations are not bound by the provisions of Article 19(2).

2.7. CONCLUSION

This chapter focused on different international agreements on trademarks. The aim was to analyse how these agreements deal with the ‘likelihood of confusion’ requirement. The chapter begins by defining the ‘likelihood of confusion’. It does this by evaluating three factors of the ‘likelihood of confusion’ namely that the burden to prove the ‘likelihood of confusion’ is on

¹⁷⁶ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 144.

¹⁷⁷ WIPO ‘Singapore Treaty on the Law of Trademarks’ available at <https://www.wipo.int/treaties/en/ip/singapore/#:~:text=The%20objective%20of%20the%20Singapore,of%20Administrative%20trademark%20registration%20procedures>. (accessed on 21 May 2021).

¹⁷⁸ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 144.

¹⁷⁹ Singapore Treaty, Article 19(2).

¹⁸⁰ Gheewala S ‘Singapore Sling: WIPO Passes the Buck on Meaningful Reform of International Trademark Law’ (2007) 17(2) *DePaul-LCA Journal of Art and Entertainment Law* 321.

¹⁸¹ For Spain, the reservation was made in 18 February 2009 it states that ‘[i]n accordance with Article 29(4) of the Treaty, Article 19(2) of the said Treaty will not be applicable in Spanish Law’. For Uruguay, the reservation was made on 29 January 2020 and it states that ‘[t]he Eastern Republic of Uruguay makes a reservation with regard to Article 19(2), Certain Rights of the Licensee, on the grounds that its content is in conflict with existing provisions on the subject in its national legislation’. Treaty Database Overheid.nl ‘Singapore Treaty on the Law of Trademarks: Parties with reservations, declarations and objections’ available at https://treatydatabase.overheid.nl/en/Verdrag/Details/010658_b (accessed on 29 May 2021).

the plaintiff, the ‘likelihood of confusion’ requirement is objective, and the intention of the defendant is not essential. One of the observations under this chapter was that the TRIPS Agreement is the first international agreement to use the phrase ‘likelihood of confusion’ under Article 16(1). It was also noted that the TRIPS Agreement is commended for including substantive legal standards such as the minimum standard, national treatment, and the MFN principle. The chapter also looked at the Paris Convention. Unlike the TRIPS Agreement, the Paris Convention only contains the national treatment principle but it does not impose minimum standards or contain the MFN principle. The Paris Convention is the oldest of the international agreements on trademarks and the first agreement to address trademark confusion. The analysis of this shows that under Article 6*bis* (1), the Paris Convention uses the phrase ‘liable to create confusion’ which is synonymous with ‘likelihood of confusion’.

The Madrid Agreement and its Protocol do not address trademark infringement. They both subject the proprietor seeking to register its mark in a foreign country to be protected by the trademark law of that country. This would include having infringement proceedings of the ‘likelihood of confusion’ dealt with in terms of the domestic law of that country. The TLT also does not address trademark infringement or confusion. The discoveries made show that Article 15 of the TLT requires the contracting state to comply with the Paris Convention provisions that deal with trademarks. This means that Article 6*bis* (1) becomes applicable if there are forms of infringement that require the ‘likelihood of confusion’. Form 6 of the TLT and Regulations grants the proprietor the right to sue in cases of past infringements. The Singapore Treaty has a scope that extends to the modern forms of electronic communications and also covers the recently developed forms of trademarks such as motion marks, colour marks, etc. Article 19(2) allows the proprietor or an interested party to initiate infringement proceedings without producing license documentation. However, Article 29(4) allows member states to make reservations with regards to Article 19(2).

This chapter has demonstrated how the concept of the ‘likelihood of confusion’ is dealt with under international law. The next chapter seeks to discuss the interpretation and application of the ‘likelihood of confusion’ requirement found under sections 34(1) (a) and (b) of the Trade Marks Act 194 of 1993.

CHAPTER THREE: ‘LIKELIHOOD OF CONFUSION’ REQUIREMENT IN TRADEMARK INFRINGEMENT IN SOUTH AFRICA

3.1. INTRODUCTION

Chapter two dealt with the international legal framework that governs trademark law, examining some of the international agreements that regulate trademark infringements. This chapter focuses on confusion-based forms of trademark infringement under the South African (SA) Trade Marks Act.¹⁸² In *Century City Apartments Property Services CC v Century City Property Owners Association*,¹⁸³ the court acknowledged that the Trade Marks Act recognises three forms of trademark infringements, namely primary infringement (section 34(1) (a)), extended infringement (section 34(1) (b)) and infringement by dilution (under section 34(1) (c)).¹⁸⁴ Infringement by dilution falls outside the scope of this research and will, therefore, not be considered in this discussion.

The ‘likelihood of confusion’ as a requirement for both primary and extended infringements will be discussed separately. In summary, this chapter seeks to answer the following question:

- Have the courts collapsed the enquiry of the ‘likelihood of confusion’ under sections 34(1) (a) and (b)? In other words, have courts adopted the same approach to the ‘likelihood of confusion’ with respect to primary and extended infringement?

Hence, this chapter will determine whether or not the courts are collapsing the enquiry into the ‘likelihood of confusion’ under s34(a) and (b). The judgements that are discussed in this chapter are aimed at demonstrating how courts in their application of the ‘likelihood of confusion’ test ‘collapse’ the enquiries.

3.2. TYPES OF INFRINGEMENT UNDER THE TRADE MARKS ACT

It is important to note that the provisions on infringement have to be read in conjunction with provisions defining a trademark and its functions.¹⁸⁵ This is because infringement occurs whenever there is an attempt to ‘sabotage’ any of the functions of the trademark, for example,

¹⁸² 194 of 1993.

¹⁸³ 2010 (3) SA 1 (SCA).

¹⁸⁴ *Century City Apartments Property Services CC v Century City Property Owners Association*, paragraph 7.

¹⁸⁵ Muhlberg H *The Law of the Brand: A Practical Guide to Branding Law in South Africa* (2005) 42.

the origin function.¹⁸⁶ As indicated above this part examines the confusion-based forms of trademark infringements namely, primary and extended infringement.

3.2.1. Primary Infringement

Section 34(1) (a) of the Trade Marks Act sets out the requirements for primary infringement and provides that:

‘The rights acquired by registration of a trade mark shall be infringed by the unauthorised use in the course of trade in relation to goods or services in respect of which the trade mark is registered, of an identical mark or of a mark so nearly resembling it as to be likely to deceive or cause confusion.’¹⁸⁷

The plaintiff bears the onus to prove that the infringement of his trademark has taken place under section 34(1) (a) and that there is a probability that confusion will also occur. Therefore, to succeed with an infringement claim under section 34(1) (a), the plaintiff must prove the following factors:

- unauthorised use;
- in the course of trade;
- of a trademark which is identical or confusingly similar to the registered trademark;
- and in connection with the same goods or services as those covered by the registered trademark.¹⁸⁸

a) UNAUTHORISED USE

Trademark infringement under section 34 is only concerned with infringement that occurred through use that was unauthorised.¹⁸⁹ Lack of consent results in unauthorised use of the trademark which could result in the gradual disassociation with the products of the proprietor on the part of consumers.¹⁹⁰ It is important to note that no infringement occurs where the proprietor expressly consented to the use even if the products have undergone alteration, rebranding, or repackaging.¹⁹¹

¹⁸⁶ See the discussion under part 1.1. for the discussion of all the functions of a trademark.

¹⁸⁷ Trade Marks Act 194 of 1993, section 34(1) (a). See also part 2.3.2 of chapter 2 and part 4.3.2 of chapter 4.

¹⁸⁸ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 162.

¹⁸⁹ Webster CE & Page NS *South African Law of Trade Marks, Unlawful Competition, Company Names and Trading Styles* 5 ed (2008) 12-23.

¹⁹⁰ B R Rutherford, ‘Misappropriation of the Advertising Value of Trade Marks, Trade Names and Service Marks’ (1990) 2(2) *South African Mercantile Law Journal* 155.

¹⁹¹ Webster CE & Page NS *South African Law of Trade Marks, Unlawful Competition, Company Names and Trading Styles* 5 ed (2008) 12-23; See also Claassens M ‘Parallel Imports: Intellectual Property’ (2015) 15(6)

In *Abbott Laboratories v UAP Crop Care (Pty) Ltd*,¹⁹² the applicant, who was a proprietor of two trademarks: PROMALIN and ABBOTT, had brought an infringement application in terms of section 34(1) (a).¹⁹³ The respondent, who was an owner of the trademark PERLAN, had used the applicant's trademarks in his brochure and also declared the PERLAN to be a better farming product than the PROMALIN.¹⁹⁴ Both the applicant and the respondent conducted their businesses in agricultural chemicals and were thus direct competitors.¹⁹⁵ The applicant argued that the 'use' of the marks PROMALIN and ABBOTT by the respondent in his brochure constituted unauthorised use since he did not give the respondent permission to use the marks.¹⁹⁶ The respondent argued that the brochure was created for internal purposes and was never meant for distribution.

Notwithstanding the lack of consent, the court found that the brochure showed PROMALIN as a trademark that belonged to the applicant.¹⁹⁷ However, the court also discovered that the brochure featured the mark ABBOTT on many pages without ever pointing out that it was owned by the applicant.¹⁹⁸ The court stated that the 'unauthorised use' can result in consumers disassociating from the products of the applicant. The more the mark is used on the products of the infringer the more the consumer's attention will also be shifted from the products of the proprietor.¹⁹⁹ The court concluded that the use of the applicant's marks by the respondent was unauthorised.²⁰⁰ The court, in this case, confirmed that 'unauthorised use' may have adverse effects on the trademark of the proprietor such as drawing away consumers from the products of the proprietor to those of the infringer.

Without Prejudice 52: 'Express authority may be in the form of a contract authorising the use of the trademark, the most common being distributor or licence agreements'.

¹⁹² 1999 (3) SA 624 (C): this case concerned comparative advertising and the court also confirmed this in the case.

¹⁹³ *Abbott Laboratories v UAP Crop Care (Pty) Ltd*, 626H-I.

¹⁹⁴ *Abbott Laboratories v UAP Crop Care (Pty) Ltd*, 626E-G.

¹⁹⁵ *Abbott Laboratories v UAP Crop Care (Pty) Ltd*, 626F-H.

¹⁹⁶ *Abbott Laboratories v UAP Crop Care (Pty) Ltd*, 630A-C.

¹⁹⁷ *Abbott Laboratories v UAP Crop Care (Pty) Ltd*, 628C-D.

¹⁹⁸ *Abbott Laboratories v UAP Crop Care (Pty) Ltd*, 628D-E.

¹⁹⁹ *Abbott Laboratories v UAP Crop Care (Pty) Ltd*, 631B-C.

²⁰⁰ *Abbott Laboratories v UAP Crop Care (Pty) Ltd*, 636E-H.

b) IN THE COURSE OF TRADE

‘In the course of trade’ means that use of the proprietor’s mark must take place in activities that are commercial in nature and must be considered to be normal for those types of goods or services.²⁰¹ This was confirmed in *Beecham Group Plc v Southern Transvaal Pharmaceutical Pricing Bureau*,²⁰² where the court refused to accept the argument that ‘in the course of trade’ means ‘in the course of any trade’.²⁰³ The court reasoned that the application of the phrase was confined to commercial use of the mark in the trade within which the goods or services belonged.²⁰⁴ By implications, no infringement would arise where the mark was used in a trade within which it is not ordinarily used. In other words, for use to be ‘in the course of trade’ it must cover the same class (or similar for subsection 1(b)) or a class so associated thereof with goods or services of the registered mark.²⁰⁵

c) AN IDENTICAL MARK OR A MARK NEARLY RESEMBLING THE REGISTERED TRADEMARK

The infringing mark must be identical or it should nearly resemble that of the proprietor.²⁰⁶ The word ‘resemble’ means either to look alike or be similar to something either in visual nature or quality.²⁰⁷ The infringing trademark is expected to reproduce all the elements of the plaintiff’s mark without modifying it or at least reproducing the distinctive or dominant parts without modification.²⁰⁸ The ‘likelihood of confusion or deception’ is also a *sine qua non* for primary infringements. The use of an ‘identical or resembling mark’ should be ‘likely to confuse or deceive’ consumers into believing that the goods originate from the same

²⁰¹ Khan S ‘Trade Mark Infringement’ available at https://www.adams.africa/trade-marks/trade-mark-infringement/?utm_source=Mondaq&utm_medium=syndication&utm_campaign=LinkedIn-integration (accessed on 21 June 2021).

²⁰² 1993 (1) SA 546 (AD).

²⁰³ *Beecham Group Plc v Southern Transvaal Pharmaceutical Pricing Bureau (Pty) Ltd*, paragraph 21: emphasis added.

²⁰⁴ *Beecham Group Plc v Southern Transvaal Pharmaceutical Pricing Bureau (Pty) Ltd*, paragraph 22.

²⁰⁵ Webster CE & Page NS *S South African Law of Trade Marks, Unlawful Competition, Company Names and Trading Styles* 5 ed (2008) 12-23. See also *Verimark (Pty) Ltd v Bayerische Motoren Werke AktienGesellschaft*; *Bayerische Motoren Werke AktienGesellschaft v Verimark* 2007 (6) SA 263 (SCA), paragraph 6.

²⁰⁶ *Yuppichef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd* [2016] ZASCA 118, paragraph 14. See also *Impala Platinum Holdings Limited v Impala Warehousing And Logistics Africa (Proprietary) Limited* [2014] ZAGPJHC 410, paragraph 49; and Karjiker S ‘The Role of Reputation in Trade Mark Infringement’ (2018) 2018(4) *Journal of South African* 731.

²⁰⁷ Soanes C & Hawker S *Compact Oxford English Dictionary: For University and College Students* 3 ed (2005) 874.

²⁰⁸ Muhlberg H *The Law of the Brand: A Practical Guide to Branding Law in South Africa* (2005) 43.

proprietor.²⁰⁹ Trademark use is deemed as use that indicates the source of the goods or services.²¹⁰ The analysis of the ‘likelihood of confusion’ is limited to comparing the two marks that resemble each other.²¹¹ If the plaintiff can prove on a balance of probabilities that the marks are identical or nearly resemble each other and that the infringement has occurred in terms of section 34(1) (a), no enquiry into the nature of goods is required since the goods are expected to be the same goods in the trade of the proprietor.

d) IN RELATION TO THE SAME GOODS OR SERVICES

‘In relation to the same goods or services’ means that the mark should be affixed upon goods or services of the ‘same class or classification’ as found in schedule three of the Trade Marks Regulations²¹² (the Regulations). For example, class 13 of Schedule three lists ‘firearms; ammunition and projectiles; explosives; fireworks’. Assuming the plaintiff’s mark is registered for ‘firearms’ and the defendant’s mark for ‘explosives’, the goods would be deemed identical if the defendant’s mark is identical or similar to that of the plaintiff since the goods appear under the same class.

Section 4 of the Regulations states that the classification of goods or services under schedule three and the interpretation thereof shall be made in terms of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks²¹³ (the Nice Agreement).²¹⁴ A dictionary meaning for the word ‘class’ or ‘classification’ is to group or categorise things based on their common characteristics or traits.²¹⁵ The Trade Marks Act and the Regulations do not provide a definition for the terms. The Nice Agreement defines ‘classification’ to mean two things:

- first, a listing of classes combined, at times, with explanatory notes;

²⁰⁹ Arens WF *Contemporary Advertising* 5 ed (2006) 116.

²¹⁰ Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 16.

²¹¹ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 162.

²¹² Trade Marks Regulation GN R578/95 (Trade Marks Act 194 of 1993).

²¹³ (of June 15, 1957, as revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977, and amended on September 28, 1979).

²¹⁴ Trade Marks Regulation, section 4.

²¹⁵ Soanes C & Hawker S *Compact Oxford English Dictionary: For University and College Students* 3 ed (2005) 176.

- second, a listing of goods and/or services in an alphabetical order where the class under which these goods or services fall is also indicated.²¹⁶

‘In relation to’ requires that there must be a correlation or relationship between the mark and the goods or services.²¹⁷ The Trade Marks Act defines ‘in relation to goods’ as referring ‘to the use thereof upon, or in physical or other relation to, such goods’.²¹⁸ The use of the mark that is identical or similar must be visible, clearly seen, or manifested. Furthermore, it defines ‘in relation to services’ as alluding to ‘the use thereof in any relation to the performance of such services’.²¹⁹ In other words, any performance rendered through the power of attraction of the trademark of the proprietor will be deemed as qualifying to be use ‘in relation to services’. Webster and Page opine that video recorded tapes that result in the projection of the mark of the proprietor can be deemed as use in relation to goods or services.²²⁰

3.2.2. Extended Infringement

Section 34(1) (b) contains the extended infringement which provides that:

‘The rights acquired by registration of a trade mark shall be infringed by the unauthorised use of a mark which is identical or similar to the trade mark registered, in the course of trade in relation to goods or services which are so similar to the goods or services in respect of which the trade mark is registered, that in such use there exists the likelihood of deception or confusion.’²²¹

The plaintiff must prove the following factors to succeed with an infringement claim under section 34(1) (b):

- Unauthorised use;
- In the course of trade;
- Of a mark which is identical or similar to the registered trademark;
- On goods or services which are so similar to the goods or services in respect of which the trademark is registered.²²²

²¹⁶ The Nice Agreement, Article 1(2).

²¹⁷ Soanes C & Hawker S *Compact Oxford English Dictionary: For University and College Students* 3 ed (2005) 176.

²¹⁸ Trade Marks Act, section 2(3) (a).

²¹⁹ Trade Marks Act, section 2(3) (b).

²²⁰ Webster CE & Page NS *South African Law of Trade Marks, Unlawful Competition, Company Names and Trading Styles* (2008) 12-21.

²²¹ Trade Marks Act, section 34(1) (b).

²²² Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 164.

The first two requirements have already been discussed under 3.2.1. and they apply in a similar fashion under subsection (b).²²³

(a) CONFUSINGLY SIMILAR MARK

The similarity of marks is interlinked to the similarity of goods and/or services.²²⁴ The similarity of marks combined with the similarity of goods or services must create the impression that goods or services have the same source as those of the proprietor or somehow are associated.²²⁵ Although the ‘similarity of marks’ is required under this section, it has no effect without the similarity of goods or services. The similarity of marks alone cannot under section 34(1) (b) result in the ‘likelihood of confusion’. The word ‘similar’ is not defined in the Trade Marks Act but in terms of the Oxford dictionary, the term means something that is like another in its appearance but it is not exactly it.²²⁶

The interdependence between the question ‘similarity of marks’ and ‘similarity of goods or services’ was also confirmed in *New Media Publishing v Eating Out Web Services*.²²⁷ In this case, the applicant was a publisher of an annual magazine called ‘Eat Out’ which was a guide to restaurants.²²⁸ It contained information such as addresses as well as trading days and hours of restaurants.²²⁹ The applicant was an owner of a website www.eat-out.co.za and was a proprietor of two marks ‘Eat Out’ and ‘Eat Out Guide’.²³⁰ The respondent was not publishing magazines but was an owner of two websites www.eating-out.co.za and www.eatingout.co.za which provided services to restaurants nationwide.²³¹ The applicant alleged that the respondent was infringing his mark ‘Eat Out’ by using the mark ‘Eating Out’ and, therefore, it is likely that confusion will occur.²³² The court stated that:

‘The enquiry in this matter consists of two separate but closely interrelated questions: first, are the two marks identical or sufficiently similar to one another; and secondly, is the respondent's mark being used

²²³ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 164.

²²⁴ Mupangavanhu Y ‘Towards the Harmonisation of Trade Mark Laws in Africa: A Comparative Analysis of Selected Infringement Provisions’ (2015) 2(2) *Journal of Comparative Law in Africa* 109.

²²⁵ Webster CE & Page NS *South African Law of Trade Marks, Unlawful Competition, Company Names and Trading Styles* 5 ed (2008) 12-37.

²²⁶ Soanes C & Hawker S *Compact Oxford English Dictionary: For University and College Students* 3 ed (2005) 964.

²²⁷ 2005 (5) SA 388 (C).

²²⁸ *New Media Publishing v Eating Out Web Services* 2005 (5) SA 388 (C), 391H-J.

²²⁹ *New Media Publishing v Eating Out Web Services* 2005 (5) SA 388 (C), 391H-J.

²³⁰ *New Media Publishing v Eating Out Web Services* 2005 (5) SA 388 (C), 391H-I and 392E-G.

²³¹ *New Media Publishing v Eating Out Web Services* 2005 (5) SA 388 (C), 392H to 393B.

²³² *New Media Publishing v Eating Out Web Services* 2005 (5) SA 388 (C), 393I-J.

unauthorisedly in the course of trade in relation to services which are so similar to the applicant's goods in respect of which its mark is registered that in such use there exists the likelihood of deception or confusion? There is, it seems to me, an interdependence between the two legs of the inquiry: the less the similarity between the respective goods or services of the parties, the greater will be the degree of resemblance required between their respective marks before it can be said that there is a likelihood of deception or confusion in the use of the allegedly offending mark, and *vice versa*.²³³

It follows that interdependence means that both marks and the goods or services must contribute equally to the similarity that is likely to result in confusion. This is confirmed in the judgement where it is stated that for the lesser similarity between the marks to have an effect that contributes to the 'likelihood of confusion', there must be a greater similarity between the goods or services.

Furthermore, the absence of similarity between the marks cannot be substituted with a greater similarity between the goods or services.²³⁴ If the degree of similarity cannot be established between the marks in step one, the enquiry cannot proceed to the second step. Consequently, if it is concluded that there is no 'likelihood of confusion', there can be no infringement in terms of section 34(1) (b). The burden of proof rests on the plaintiff to prove that the two confusingly similar marks are likely to create confusion when they are used on similar goods or services.²³⁵

(b) IN RELATION TO SIMILAR GOODS OR SERVICES

The discussion under 3.2.1. (b) applies in the same fashion under this section with the exception that the requirement under section 34(1) (b) is that the goods must be of 'similar classes or classification'. In relation to section 34 (1) (b), the court in *Chantelle v Designer Group (Pty) Ltd*,²³⁶ held that 'the issue of similarity and the 'likelihood of confusion' must be determined from the combined effect of the similarity between the marks and similarity between the goods'.²³⁷ This means that an infringement is likely to be established where there is a similarity in both the marks and the goods or services. To determine the similarity of goods or services under extended infringements, the following factors must be taken into consideration:

- the nature and comparison of the goods;

²³³ *New Media Publishing v Eating Out Web Services* 2005 (5) SA 388 (C), 394B-E.

²³⁴ *New Media Publishing v Eating Out Web Services* 2005 (5) SA 388 (C), 394E-G.

²³⁵ Kelbrick R 'Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?' (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 3.

²³⁶ [2015] ZAGPPHC 222.

²³⁷ *Chantelle v Designer Group (Pty) Ltd*, paragraph 61.

- their respective use or functions of the services;
- the trade channels through which the goods can be notionally be retailed or the services offered;
- and the classes of likely customers.²³⁸

3.3. THE ‘LIKELIHOOD OF CONFUSION OR DECEPTION’ REQUIREMENT

The risk of confusion is at the centre of trademark infringement, particularly primary and extended infringement. This section deals first with an overview of the ‘likelihood of confusion or deception’ followed by an analysis of the application and interpretation of the ‘likelihood of confusion or deception’ in various judgements. Ordinarily, the words ‘confusion’ and ‘deception’ are not treated as synonyms. The Oxford dictionary defines them differently. Confusion is defined as ‘being in a state of uncertainty about the occurring event, the meaning of something or expected reaction or response’.²³⁹ Applying this definition, the average consumer must be induced into a state of being uncertain regarding the question of whether or not the products he is confronted with belong to the proprietor.²⁴⁰ The Oxford dictionary further defines deception to mean ‘intentionally making a person believe a state of events that is not true’.²⁴¹ In other words, the average consumer must, to some degree, believe with little doubt that the products they are confronted with belong to the proprietor.²⁴²

As we will see below, the courts have outlined that a difference exists between deception and confusion. In *Brown v Edcon Ltd*,²⁴³ the court stated that deception exists when one persuades the other into believing in falsehood.²⁴⁴ On the contrary, confusion is when one creates a situation that leads another person into ‘bewilderment, doubt, or uncertainty’.²⁴⁵ The court

²³⁸ Dean O & Dyer A (eds) *Introduction to Intellectual Property Law* (2014) 140. See also *Danco Clothing (Pty) Ltd v Nu-Care Marketing Sales and Promotions (Pty) Ltd* 1991 (4) SA 850 (A), 852E-F; and Mupangavanhu Y ‘Towards the Harmonisation of Trade Mark Laws in Africa: A Comparative Analysis of Selected Infringement Provisions’ (2015) 2(2) *Journal of Comparative Law in Africa* 109.

²³⁹ Turnbull J, Lea D & Parkinson D et al *Oxford Advanced Learner’s Dictionary of Current English* 8 ed (2010) 305.

²⁴⁰ Belch GE & Belch MA *Advertising and Promotion: An Integrated Marketing Communications Perspective* 6 ed (1999) 120.

²⁴¹ Turnbull J, Lea D & Parkinson D et al *Oxford Advanced Learner’s Dictionary of Current English* 8 ed (2010) 377.

²⁴² O’Connor J & Galvin E *Marketing in the Digital Age* (2001) 55.

²⁴³ [2014] ZAGPPHC 371.

²⁴⁴ *Brown v Edcon Ltd*, paragraph 7. See also *McDonald’s International Property Co Ltd v Gianni* [2007] ZAGPPHC 226, paragraph 21.

²⁴⁵ *Brown v Edcon Ltd*, paragraph 7. See also *McDonald’s International Property Co Ltd v Gianni* [2007] ZAGPPHC 226, paragraph 21.

affirmed that when determining deception one must examine if the consumer was given a false impression. With confusion, one determines if there was hesitation on the part of the consumer.

In *McDonald's International Property Co Ltd v Gianni*,²⁴⁶ the court added that the words 'likely' or 'likelihood' are deemed to mean 'proof of a probability of deception or confusion'.²⁴⁷ The court confirmed that one determines the prospects of confusion or deception occurring rather than looking for actual confusion. Furthermore, the court held that deception or confusion must be with regards to the origin of the goods or services and whether or not an economic link exists.²⁴⁸ The consumer must be led to think that the goods or services originate from the same producer and that they are economically linked to those of the proprietor.

In *Roodezandt Ko-Operatiewe Wynmakery Ltd v Robertson Winery (Pty) Ltd*,²⁴⁹ the court stated that:

'The concept of deception or confusion is not limited to inducing in the minds of these interested persons the erroneous belief or impression that the two competing products are those of the objector or that there is a connection between these two products. A likelihood of confusion is also established when it is shown that a substantial number of persons will probably be confused as to the origin of the products or the existence or non-existence of such a connection.'²⁵⁰

It follows, therefore, that confusion or deception is not deemed to be likely to arise only with regards to the target market or regular consumers but also with regards to other consumers present in the marketplace. In *Jordan Winery (Pty) Ltd v Pritchard*,²⁵¹ the court held that deception in most instances is intentional while confusion occurs by accident.²⁵² The court further stated that confusion and deception are usually used interchangeably or as if they are synonyms because it is unlikely that one of these would not lead to the other.²⁵³

3.3.1. General Test for Confusion and Deception

The 'likelihood of confusion' is the cornerstone of trademark infringements.²⁵⁴ The SA courts have emphasised that the 'likelihood of confusion' must also 'be appreciated globally', and

²⁴⁶ [2007] ZAGPHC 226.

²⁴⁷ *McDonald's International Property Co Ltd v Gianni*, paragraph 21.

²⁴⁸ *McDonald's International Property Co Ltd v Gianni*, paragraph 21.

²⁴⁹ [2014] ZASCA 173.

²⁵⁰ *Roodezandt Ko-Operatiewe Wynmakery Ltd v Robertson Winery (Pty) Ltd*, paragraph 6(b).

²⁵¹ [2013] ZAWCHC 191.

²⁵² *Jordan Winery (Pty) Ltd v Pritchard*, paragraph 60.

²⁵³ *Jordan Winery (Pty) Ltd v Pritchard*, paragraph 60.

²⁵⁴ Schwabach *A Internet and the Law: Technology, Society, and compromises* 2 ed (2014) 233.

that the ‘global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components’.²⁵⁵ In a practical sense, the combination of both similarities and differences on a mark plays a significant role in the analysis of the ‘likelihood of confusion’. Confusion need not occur for a very long time or continuously and it is also not required to confuse everyone in the market but only a substantial number of people.²⁵⁶ Two important elements of confusion or deception are:

- First, whether or not the ordinary consumer is ‘likely to be deceived or confused’;
- Second, whether or not on a balance of probabilities confusion or deception is likely to ensue.²⁵⁷

This means that actual confusion is not necessarily required. It suffices to show a reasonable probability that a substantial number of persons would be deceived or confused as to the origin of the goods or services. Whether there is a ‘likelihood of deception or confusion’ is a question of fact. This means that it has to be determined based on the facts of the case. The two elements of confusion or deception are interrelated. The ‘likelihood of confusion’ is proven on a balance of probabilities. The standard is that an ordinary or average person should have been confused or deceived by use of the infringing mark. The onus is thus on the plaintiff to show the probability of deception or confusion.²⁵⁸ The plaintiff should adduce evidence that the two marks are sufficiently similar such that a consumer would be confused about the origin of the defendant’s goods. Therefore, the plaintiff only has to prove that confusion is likely or probable.²⁵⁹

An Average Consumer

At the heart of the ‘likelihood of confusion or deception’, is the average or ordinary consumer.²⁶⁰ A consumer is deemed as someone who is purchasing goods or paying for

²⁵⁵ *Adidas AG v Pepkor Retail Ltd* [2013] ZASCA 3, paragraph 21; *Distell Ltd v KZN Wines and Spirits CC* [2013] ZAKZDHC 25, paragraph 10; *Adcock Ingram Ltd v Suresh Patel t/a Dolly Lou* [2005] JOL 15298 (T), paragraph 33; *Cowbell v ICS H Holdings Ltd* [2001] JOL 8098 (A), paragraph 10; *Klimax Manufacturing Ltd v Van Rensburg* [2004] 2 All SA 301 (O), paragraph 27.

²⁵⁶ Webster CE & Page NS *South African Law of Trade Marks, Unlawful Competition, Company Names and Trading Styles* 5 ed (2008) 7-4.

²⁵⁷ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 64.

²⁵⁸ *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* 640G – 641E. See also Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 2.

²⁵⁹ Webster CE & Page NS *South African Law of Trade Marks, Unlawful Competition, Company Names and Trading Styles* 7-19.

²⁶⁰ Haupt P ‘Prescription Medicines and Generics’ (2013) 13(1) *Without Prejudice* 37.

services.²⁶¹ When one is testing the distinctiveness of a mark, one must determine whether or not the ordinary consumer ‘who is reasonably observant, but who is neither conducting an analytical examination nor paying particular attention, will be able to distinguish the goods by seeing the mark’.²⁶² In the *Quad Africa Energy (Pty) Ltd v the Sugarless Co (Pty) Ltd*,²⁶³ the court stated that:

‘This is a matter for the judgment of the court, but in making it the court has regard to the type and class of customers who will buy the products and the circumstances in which such goods will be displayed for sale. The average customer is to be taken as someone of average intelligence, eyesight, observation and recollection. Allowance must be made for *imperfect recollection* on the part of the consumer.’²⁶⁴

In other words, the consumer must be seen as someone who cannot call to mind exactly how the mark of the proprietor looks like when he sees that of the defendant.²⁶⁵ The consumer must, at the time of seeing a confusingly similar mark of the defendant, be induced to think that it is that of the plaintiff.²⁶⁶ The average consumer must be seen as someone of average care and understanding who would have an idea of how the mark of the proprietor looks but without ‘an exact and accurate representation of it’.²⁶⁷ This practically means that the consumer must be perceived as someone who will not have an opportunity to observe cautiously the confusingly similar mark before them.²⁶⁸

3.3.2. ‘Likelihood of Confusion or Deception’ under Primary Infringement

Comparison of the two marks

As indicated above, section 34(1) (a) requires that the infringing mark must be identical or nearly resemble the mark of the proprietor to be ‘likely to confuse or deceive’ consumers in the marketplace.²⁶⁹ The similarity of marks is determined by doing a comparison of the two

²⁶¹ Turnbull J, Lea D & Parkinson D et al *Oxford Advanced Learner’s Dictionary of Current English* 8 ed (2010) 312.

²⁶² Hobson-Jones S and Katjiker S ‘Is South African Trademark Law out of Shape: A Comparative Analysis of Shape Marks, in Light of the Recent SCA and CJEU Kit Kat Decisions’ (2016) 27(3) *Stellenbosch Law Review* 589.

²⁶³ 2020 (6) SA 90 (SCA).

²⁶⁴ *Quad Africa Energy (Pty) Ltd V the Sugarless Co (Pty) Ltd*, paragraph 37. See also *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd*, at 641: emphasis added.

²⁶⁵ Jansson-Boyd CV *Consumer Psychology* (2010) 131.

²⁶⁶ Kotler P & Keller K *Marketing Management* 15 ed (2016) 322.

²⁶⁷ *Adidas AG v Pepkor Retail Ltd*, paragraph 30.

²⁶⁸ Stim R ‘Likelihood of Confusion: How do You Determine if a Trademark is Infringing?’ available at <https://www.nolo.com/legal-encyclopedia/likelihood-confusion-how-do-you-determine-trademark-infringing.html> (accessed on 22 June 2021).

²⁶⁹ Kopel S *Guide to Business Law* 2 ed (1998) 332.

marks, where one is alleged to have infringed or is infringing the mark of the proprietor.²⁷⁰ Both marks and all their features must be considered in their entirety.²⁷¹ This is because such features send a message as a mark when they are composite rather than separate elements.

To answer the question of whether or not the marks are similar, the court in *Plascon-Evans Paints (TVL) Ltd v Van Riebeck Paints (Pty) Ltd*,²⁷² held that the analysis of the ‘likelihood of confusion’ under subsection 1(a) involves due consideration of the similarities and differences between the two conflicting marks in terms of sense, sound, and appearance.²⁷³ It would seem that the presence of similarities would persuade the court to find that there is a ‘likelihood of confusion’, while clearly visible differences would sway the court into concluding that there is no ‘likelihood of confusion’.

The argument of similarities and differences was brought up in *Albion Chemical Company (Pty) Ltd v FAM Products CC*²⁷⁴ in terms of sense, appearance, and sound. In this case, the applicant was manufacturing and distributing household bleach under the trademark ‘Albex’ which was popular in Cape Town.²⁷⁵ The respondent also started to manufacture and distribute bleach under the trademark ‘All Blax’.²⁷⁶ The issue before the court was whether or not these two trademarks were similar to an extent that the confusion was likely to ensue in terms of section 34(1) (a). The court found that:

‘At the outset it is important to emphasise that although, generally speaking, the comparison which is to be made must be made with reference to sense, sound and appearance (*Plascon Evans* (supra)), an applicant need not show a similarity in respect of all three the components. The similarity of any one of sense, sound or appearance may suffice to give rise to deception or confusion [or] sufficient to constitute an infringement of the trade mark.’²⁷⁷

While the comparison of the two marks draws attention to the similarities and differences, the enquiry into the similarities and the differences touches on the sense, sound, and appearance. No other extra factors existing outside the marks may be taken into consideration.²⁷⁸

²⁷⁰ *Adidas AG v Pepkor Retail Ltd* [2013] ZASCA 3, paragraph 23.

²⁷¹ Ramsden P A *Guide to Intellectual Property Law* (2011) 163.

²⁷² [1984] ZASCA 51.

²⁷³ *Plascon-Evans Paints (TVL) Ltd v Van Riebeck Paints (Pty) Ltd*, at 641.

²⁷⁴ [2004] 1 All SA 194 (C).

²⁷⁵ *Albion Chemical Company (Pty) Ltd v FAM Products CC*, paragraphs 1 and 8.

²⁷⁶ *Albion Chemical Company (Pty) Ltd v FAM Products CC*, paragraphs 1 and 10.

²⁷⁷ *Albion Chemical Company (Pty) Ltd v FAM Products CC*, paragraph 18: emphasis added.

²⁷⁸ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 162.

First, the court relied on the appearance (visual) similarities and found that both trademarks began with ‘Al’, ended with ‘X’ and that ‘B’ was a central consonant.²⁷⁹ The Court, therefore, rejected the respondent’s argument that the average consumer would not have time to consider that difference if the trademarks are not visually identical.²⁸⁰ Secondly, the court shifted its focus to the sound (pronunciation, aural or phonetic) of the marks and held that SA is a multicultural country with different languages that bear different accents, and when dealing with pronunciation due regard must be given to that.²⁸¹

Lastly, the court addressed the issue of the sense (conceptual or meaning) of the marks. The respondent argued that their mark was taken from the English word ‘All Blacks’ and it was different from the applicant’s mark in terms of meaning.²⁸² The court rejected this argument and stated that the respondent had the opportunity to use their mark as ‘All Blacks’.²⁸³ However, they decided to use ‘All Blax’ which is confusingly similar to ‘Albex’ of the applicant.²⁸⁴ The court concluded that both visually and phonetically the mark ‘All Blax’ was confusingly similar to the trademark ‘Albex’ and that the respondent intended to mislead consumers into believing that the respondent’s products were those of the applicant.²⁸⁵ When determining the ‘likelihood of confusion’ by examining sense, sound, and appearance, one must take into account the impression left by the resemblance in the mind of the one who is comparing them.²⁸⁶ The enquiry takes into account dominant features of the marks and the impression created by them in the market.²⁸⁷ There is a greater ‘likelihood of confusion’ where there is a dominant feature.²⁸⁸

²⁷⁹ *Albion Chemical Company (Pty) Ltd v FAM Products CC*, paragraph 21.

²⁸⁰ *Albion Chemical Company (Pty) Ltd v FAM Products CC*, paragraph 21.

²⁸¹ *Albion Chemical Company (Pty) Ltd v FAM Products CC*, paragraph 22.

²⁸² *Albion Chemical Company (Pty) Ltd v FAM Products CC*, paragraph 2.

²⁸³ *Albion Chemical Company (Pty) Ltd v FAM Products CC*, paragraph 23.

²⁸⁴ *Albion Chemical Company (Pty) Ltd v FAM Products CC*, paragraph 23.

²⁸⁵ *Albion Chemical Company (Pty) Ltd v FAM Products CC*, paragraph 24.

²⁸⁶ TrademarksNow ‘7 Factors for Identifying Trademark Likelihood of Confusion’ 28 November 2018 available at <https://www.trademarknow.com/blog/7-factors-for-identifying-trademark-likelihood-of-confusion> (accessed on 22 June 2021).

²⁸⁷ *Lucky Star Ltd v Lucky Brands (Pty) Ltd* [2000] ZASCA 192, paragraph 6.

²⁸⁸ *PepsiCo v Atlantic Industries*, paragraph 20.

The distinctiveness of marks

The distinctiveness of a mark is a fundamental requirement for a trademark to come into existence.²⁸⁹ A mark must be able to avoid the ‘likelihood of confusion’ by having distinctiveness in terms of conceptual, visual, and phonetic elements of the mark.

The question of distinctiveness of marks was considered in *PepsiCo Inc. v Atlantic Industries*²⁹⁰ which concerned a composite mark. Atlantic Industries, the owner of the trademark ‘Twist’, opposed the registration of the mark ‘Pepsi-Twist’.²⁹¹ In dealing with the opposition procedure in terms of section 10(14) of the Trade Marks Act, the court discussed the ‘likelihood of confusion’.²⁹² The court was asked to determine whether or not the insertion of the word ‘Pepsi’ before ‘Twist’ was done in such a manner that ‘sufficient similarity’ was eliminated and confusion was unlikely to result.²⁹³ PepsiCo drew the courts’ attention to a definition of ‘Twist’ in a dictionary that meant a ‘piece of lemon’ and asserted that the mark ‘Twist’ was incapable of distinguishing the products of Atlantic Industries.²⁹⁴ The court found that the goods upon which the mark Pepsi-Twist was going to be applied would be sold to the same consumers in the same market, ‘supermarkets, cafes, convenience stores, retail outlets, bars and restaurants’ and usually shelved side-by-side.²⁹⁵

In determining the ‘likelihood of confusion’, the court gave due regard to the fact that the mark ‘Twist’ has been used on millions of cans and bottles of soft drinks.²⁹⁶ The court found that the word ‘Twist’ was not descriptive of Atlantic Industries’ products but served a sole distinctive purpose.²⁹⁷ The court also stated that PepsiCo had inserted the word ‘Twist’ in its mark without

²⁸⁹ Ramabele-Thamae K ‘Trademarks and Loss of Distinctiveness - *Lotte V Orion*’ (2015) 23(1) *Lesotho Law Journal* 165; Mupangavanhu Y *The Regional Integration of African Trade Mark Laws: Challenges and Possibilities* (Unpublished LLD thesis, University of the Western Cape, 2013) 199.

²⁹⁰ [2017] ZASCA 109.

²⁹¹ *PepsiCo Inc. v Atlantic Industries*, paragraph 14.

²⁹² Trade Marks Act, section 10(14) provides that:

‘subject to the provisions of section 14, a mark which is identical to a registered trade mark belonging to a different proprietor or so similar thereto that the use thereof in relation to goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in respect of which such trade mark is registered, would be likely to deceive or cause confusion, unless the proprietor of such trade mark consents to the registration of such mark’. *PepsiCo Inc. v Atlantic Industries*, paragraph 14.

²⁹³ *PepsiCo Inc. v Atlantic Industries*, paragraphs 17 and 24.

²⁹⁴ *PepsiCo Inc. v Atlantic Industries*, paragraph 6. See also Alberts W “‘Come On Twist and Shout Now!’” – A Perspective on Composite Trade Marks’ (2019) 10 *Without Prejudice* 6.

²⁹⁵ *PepsiCo Inc. v Atlantic Industries*, Paragraph 22.

²⁹⁶ *PepsiCo Inc. v Atlantic Industries*, paragraph 26.

²⁹⁷ *PepsiCo Inc. v Atlantic Industries*, paragraph 27.

any less visual prominence from Pepsi.²⁹⁸ Furthermore, the court stated that the confusion spoken of under section 34(1) (a) was not required to be a ‘settled belief’.²⁹⁹ Expressed differently, the consumers do not have to be convinced but rather be uncertain whether or not all products bearing ‘Twist’ had the same source of origin. It would suffice to show that there would be uncertainty as to whether or not all these products belong to the same owner.³⁰⁰ Therefore, the court held that ‘Pepsi-Twist’ was ‘likely to confuse’ consumers.³⁰¹ It was also likely that the consumers could drop the word Pepsi and simply ask for a ‘Twist’ when making a purchase.³⁰²

In *Adidas AG v Pepkor Retail Ltd*,³⁰³ the dispute was brought in terms of section 34(1) (a) and passing-off.³⁰⁴ The appellant is a proprietor of the well-known Adidas three parallel stripes trademark of sports footwear.³⁰⁵ The respondent started selling training and soccer boots that had two or four parallel stripes.³⁰⁶ The court stated that the ‘likelihood of confusion’ must be appreciated globally and the purchaser be deemed as someone who will not have the opportunity of comparing the goods side-by-side.³⁰⁷ The court further stated that due to imperfect recollection, consumers who are familiar with the appellant’s ‘three parallel stripes’ mark are likely to conclude the mark of the respondent is that of the appellant or there is an association.³⁰⁸ In addressing the ‘likelihood of confusion’ with regards to the ‘LDS Sports’ shoes and the ‘Mens’ ATH Leisure’ shoes which bore the ‘four parallel stripes’ mark, the court stated that the mark of the appellant was famous and its reputation was greater.³⁰⁹ Subsequently, this increased the ‘likelihood of confusion or deception’ since the mark of the respondent was being used on competitive goods.³¹⁰ The court then found that the configuration

²⁹⁸ *PepsiCo Inc. v Atlantic Industries*, paragraph 27; see also Alberts W “‘Come On Twist and Shout Now!’” – A Perspective on Composite Trade Marks’ (2019) 10 *Without Prejudice* 6.

²⁹⁹ *PepsiCo Inc. v Atlantic Industries*, paragraph 30.

³⁰⁰ *PepsiCo Inc. v Atlantic Industries*, paragraph 30.

³⁰¹ *PepsiCo Inc. v Atlantic Industries*, paragraph 28.

³⁰² *PepsiCo Inc. v Atlantic Industries*, paragraph 28. See also Thompson K & Modibedi D ‘An SA Twist in The ‘Cola Wars’ | Court Ruling’ 27 September 2018 available at <https://www.adams.africa/intellectual-property/twist-cola-wars-trade-mark-dispute/> (accessed on 05 September 2021).

³⁰³ [2013] ZASCA 3.

³⁰⁴ *Adidas AG v Pepkor Retail Ltd*, paragraph 23. Passing-off is not relevant to this discussion.

³⁰⁵ *Adidas AG v Pepkor Retail Ltd*, paragraph 6.

³⁰⁶ *Adidas AG v Pepkor Retail Ltd*, paragraph 7.

³⁰⁷ *Adidas AG v Pepkor Retail Ltd*, paragraph 22.

³⁰⁸ *Adidas AG v Pepkor Retail Ltd*, paragraph 24.

³⁰⁹ *Adidas AG v Pepkor Retail Ltd*, paragraph 24.

³¹⁰ *Adidas AG v Pepkor Retail Ltd*, paragraph 24.

of the ‘four parallel stripes’ of the respondent were similar to those of the ‘three parallel stripes’.³¹¹

Therefore, the court placed emphasis on the visual similarities and concluded there was a likelihood that the average consumer would be confused.³¹² The Supreme Court of Appeal (SCA) upheld the appeal.³¹³ The respondent was ‘interdicted and restrained’ from using an identical mark which is infringing the trademark of the appellant in terms of section 34(1) (a).³¹⁴ Under this judgement, it would seem that the ‘likelihood of confusion’ is assumed based on the similarity of marks and no deep analysis is conducted to determine the ‘likelihood of confusion’ as a separate enquiry from that of the similarity of marks.

Similarly, in *Bata Ltd v Face Fashion CC*,³¹⁵ the court was called to determine whether or not the respondent’s mark ‘Power House’ was confusingly similar to the applicant’s trademark ‘Power’ in terms of section 34(1) (a).³¹⁶ Both marks were being used on clothes.³¹⁷ The court observed that the word ‘Power’ was not an invented word but an ordinary word used daily and confusion was unlikely if the word was used with another word.³¹⁸ It also found that other companies also made use of the word ‘Power’ in their trademarks and no confusion occurred.³¹⁹ It further stated that the common element was of less importance when one is looking at the mark as a whole.³²⁰ This is because the notional consumer would not disregard the word ‘House’ and look at the word ‘Power’ and therefore the applicant was unsuccessful.³²¹ Here the court said the mark must be considered as a whole and not only isolate the word ‘Power’ from the rest of the mark.

Lastly, trademarks that contain words that are in common use in a language (in this case the English language) were also covered in *Lucky Star Ltd v Lucky Brands (Pty)*.³²² The court had

³¹¹ *Adidas AG v Pepkor Retail Ltd*, paragraph 26.

³¹² *Adidas AG v Pepkor Retail Ltd*, paragraph 27.

³¹³ *Adidas AG v Pepkor Retail Ltd*, paragraph 39.1.

³¹⁴ *Adidas AG v Pepkor Retail Ltd*, paragraph 39.2 (a).

³¹⁵ [2000] ZASCA 192.

³¹⁶ *Bata Ltd v Face Fashion CC*, paragraph 5.

³¹⁷ *Bata Ltd v Face Fashion CC*, paragraph 3.

³¹⁸ *Bata Ltd v Face Fashion CC*, paragraph 10.

³¹⁹ *Bata Ltd v Face Fashion CC*, paragraph 10.

³²⁰ *Bata Ltd v Face Fashion CC*, paragraph 11.

³²¹ *Bata Ltd v Face Fashion CC*, paragraph 11.

³²² 2017 (2) SA 588 (SCA).

to determine whether or not the respondent's trademarks which were 'Lucky Fish, Lucky Fish and Chips and Lucky Fish & Chips' were likely to be confused with the applicant's trademark 'Lucky Star' in terms of section 34(1) (a).³²³ While the matter related to similar trademarks being used on similar goods, the court allowed the applicant to bring the matter under sections 34(1) (a) and (b).³²⁴ Therefore, this case will be discussed under both primary and extended infringement. The court held that when determining the similarity of marks, the marks must be compared side-by-side, with due consideration to whether or not the average consumer in the market is 'likely to be deceived or confused' by their similarity.³²⁵

The court concluded that these marks would not lead to a 'likelihood of confusion' by holding that the word 'Lucky' as the common element of both marks was of less significance and due regard would be given to the word 'Star' and 'Fish'.³²⁶ Furthermore, the court stated that the overall impression created was that the marks did not resemble each other closely.³²⁷ An average consumer would, therefore, not be confused or deceived into believing that the respondents' restaurants bearing the mark 'Lucky Fish' were associated in any way with the appellant business. This is because the consumer would not only look at the word 'Lucky' since the words 'Star' and 'Fish' were also equally prominent as the word 'Lucky'.³²⁸

These judgements show that the assessment of the 'likelihood of confusion or deception' has been collapsed into the test for assessing whether the relevant marks are similar'.³²⁹ *Lucky Star Ltd v Lucky Brands (Pty) Ltd* is instructive in that it shows that courts do not distinguish the two distinct requirements namely: first, that the defendant's mark is similar to the plaintiff's registered trademark; secondly, that the use of the defendant's mark creates the 'likelihood of confusion or deception'.³³⁰ The two distinct requirements are now included in an enquiry of

³²³ *Lucky Star Ltd v Lucky Brands (Pty) Ltd*, paragraph 1. See also Muhlberg H 'Invented Words, Why the Fuss?' (2015) *Without Prejudice* 71. See also Pillay U 'As Luck Would Have It | Trade Mark Litigation Case Study' available at <https://www.adams.africa/intellectual-property/luck-trade-mark-litigation-case-study/> (accessed on 06 July 2021).

³²⁴ See *Lucky Star Ltd v Lucky Brands (Pty) Ltd*, paragraph 2.

³²⁵ *Lucky Star Ltd v Lucky Brands (Pty) Ltd*, paragraph 6. See also *Distell Ltd v KZN Wines and Spirits CC*, paragraph 11.

³²⁶ *Lucky Star Ltd v Lucky Brands (Pty) Ltd*, paragraph 10.

³²⁷ *Lucky Star Ltd v Lucky Brands (Pty) Ltd*, paragraph 10.

³²⁸ *Lucky Star Ltd v Lucky Brands (Pty) Ltd*, paragraph 10.

³²⁹ Karjiker S 'The Role of Reputation in Trade Mark Infringement' (2018) 2018(4) *Journal of South African Law* 732.

³³⁰ *Lucky Star Ltd v Lucky Brands (Pty) Ltd*, paragraph 11.

assessing whether the defendant's mark is confusingly similar to the plaintiff's mark. Karjiker correctly notes that there is no reason why the assessment of 'likelihood of confusion' should be collapsed into the test for assessing whether marks are similar.³³¹ The cases discussed under subsection (a) confirm this position.³³²

A court determines the distinctiveness of a mark by looking at three elements of a mark: conceptual, visual and phonetic. It is, however, not readily evident in the case law as to which one of the three elements carries more weight when one is doing the analysis of the 'likelihood of confusion'. Karjiker seems to argue that the lack of dominance of either of these elements in the context of a composite mark will not translate to the absence of the 'likelihood of confusion' if the sub-brand is still distinctive within the mark of the defendant.³³³ Alberts appears to be satisfied that trademark infringements relating to composite marks are determined on a case-by-case basis.³³⁴ Karjiker opines that the SCA in *PepsiCo Inc. v Atlantic Industries* was in error for relying on the dominance of 'Twist' in the composite mark since a sub-brand can remain distinctive even though it is not the dominant part of the trademark.³³⁵ Unfortunately, the SCA did not expressly clarify that a composite mark can create the impression to the average consumer that the products of the defendant are economically linked to that of the plaintiff.³³⁶

3.3.3. 'Likelihood of Confusion' under Extended Infringement

Section 34(1) (b) requires that the identical or similar mark be used in an unauthorised manner on similar (but not identical) goods or services such that confusion or deception is likely to arise. Similar goods or services would mean that there must be some 'marked resemblance or likeness' which makes it easier for the consumer to recognise the goods or services.³³⁷ If there

³³¹ Karjiker S 'The Role of Reputation in Trade Mark Infringement' (2018) 2018(4) *Journal of South African Law* 732.

³³² See *Lucky Star Ltd v Lucky Brands (Pty) Ltd*, paragraph 10; *Bata Ltd v Face Fashion CC*, paragraph 10.

³³³ Karjiker S 'The Role of Reputation in Trade Mark Infringement' (2018) 2018(4) *Journal of South African Law* 727.

³³⁴ Alberts W "'Come On Twist and Shout Now!'" – A Perspective on Composite Trade Marks' (2019) 10 *Without Prejudice* 6.

³³⁵ Karjiker S 'The Role of Reputation in Trade Mark Infringement' (2018) 2018(4) *Journal of South African Law* 727.

³³⁶ Karjiker S 'The Role of Reputation in Trade Mark Infringement' (2018) 2018(4) *Journal of South African Law* 727.

³³⁷ *McDonald's International Property Co Ltd v Gianni* [2007] ZAGPHC 226, paragraph 38: although the court said this, it refused to consider the meaning of 'similar' as used with similar goods. In paragraph 40, the court stated that '[i]n the light of my conclusion that the application cannot, in any event, succeed, it is not necessary

is less similarity between the goods or services, then a greater degree of resemblances will be required between the two marks so as to determine whether or not there is a ‘likelihood of confusion’.³³⁸ In *Impala Platinum Holdings Limited v Impala Warehousing And Logistics Africa (Proprietary) Limited*,³³⁹ the court held that the plaintiff had the burden to provide the court with evidence that the average consumer would, by only looking at the defendant’s infringing mark on the similar goods, conclude that such goods had the same origin with those of the proprietor.³⁴⁰ The court emphasised that it is an important component of the similarity assessment to show how the consumer will be misled. In the *Foschini Retail Group (Pty) Ltd v Coetzee*,³⁴¹ the court accepted that:

‘The starting point for an assessment of similarity must therefore be with reference to the classification system itself. The fact that the goods/services are in different classes would indicate, at least prima facie, that the goods and services are not similar.’³⁴²

It would follow, therefore, that the reference to the class of goods or services to determine similarity would be a step that comes after determining whether or not the marks themselves are similar. Moreover, the court accepted that this exists to confine trademark monopoly.³⁴³ ‘[A] court “cannot lightly find similarity”’ because it is not impermissible in trademark law to use a mark that resembles another if they are on dissimilar goods or services and it is unlikely for the consumer to assume that there is an economic link.³⁴⁴ The criteria for determining the similarity of goods or services are discussed under 3.2.2 (a) above.

The similarity in the nature of the goods in question is one of the main factors that the court takes into account when determining the ‘likelihood of confusion or deception’. The question of whether or not material goods can be considered similar to processed products was left open

to consider what the precise meaning of the word “similar” in the context of section 10(14) of the Trade Marks Act is’.

³³⁸ Job C ‘Interrogating Trade Mark Protection for ‘Similar’ Goods or Services: A Case for Alternatives? (2018) 6(1) *South African Intellectual Property Journal* 94.

³³⁹ [2014] ZAGPJHC 410.

³⁴⁰ *Impala Platinum Holdings Limited v Impala Warehousing and Logistics Africa (Proprietary) Limited*, paragraph 58.

³⁴¹ [2013] ZAGPPHC 8.

³⁴² *Foschini Retail Group (Pty) Ltd v Coetzee*, paragraph 27. See also *Impala Platinum Holdings Limited v Impala Warehousing and Logistics Africa (Proprietary) Limited*, paragraph 9.

³⁴³ Dean O & Dyer A (eds) *Introduction to Intellectual Property Law* (2014) 151.

³⁴⁴ *Impala Platinum Holdings Limited v Impala Warehousing and Logistics Africa (Proprietary) Limited* [2014] ZAGPJHC 410, paragraph 9. See also *Foschini Retail Group (Pty) Ltd v Coetzee* (A1/11) [2013] NGHC, paragraph 27; and Alberts W ‘Trade Marks: The Reach of a Retail Services Registration’ (2015) 132(1) *South African Law Journal* 31-40.

in the case of *Mettenheimer v Zonquasdrijf Vineyard CC*.³⁴⁵ Mr Mettenheimer and his wife (first appellant) owned Zonquasdrijf Estates (Pty) Ltd (second appellant) which traded in alcoholic beverages including wine (but not wine grapes or beer).³⁴⁶ The respondent was Zonquasdrijf Vineyards CC who traded wine grapes and had their farm located one kilometre away from Zonquasdrijf Estates' farm.³⁴⁷ The name 'Zonquasdrijf' of the defendant was alleged to be infringing 'Zonquasdrijf' of the appellant.

The court had to determine whether or not an average consumer would be led into thinking that the wine and the wine grapes had the same source of origin which would result in the 'likelihood of confusion'.³⁴⁸ The court stated that:

'Unlike s34(1) (a), the provisions of s34(1) (b) do not require that the offending mark be used in relation to goods in the class for which the trade mark had been registered. *It contemplates two elements, namely, (a) a mark identical or similar to the trade mark used in relation (b) to goods which are so similar to those for which it had been registered, that it gives rise to a likelihood of deception or confusion.*'³⁴⁹

The similarity between the respective goods or services of the parties is central to the determination of the 'likelihood of confusion or deception'. The court held that, even though 'wine grapes' were not suitably consumable as a fruit, they were nonetheless still a fruit.³⁵⁰ Therefore, they are different from wine in nature since wine is an alcoholic beverage.³⁵¹ It further held that the missing 't' on the respondent's mark was of no significance but that the dominant part of the mark namely 'Zonquasdrijf' was going to have a huge impact on the imperfect recollection of the consumer.³⁵² The marks were thus found to be virtually identical. The question of whether or not there is a 'likelihood of confusion or deception' thus boils down to the similarity of the goods, namely: wine and wine grapes. The court held that there were distinct differences between the two products and the chances of consumers confusing the respondent's wine grapes as the source of the appellants' wine were non-existent.³⁵³

³⁴⁵ 2014 (2) SA 204 (SCA).

³⁴⁶ *Mettenheimer v Zonquasdrijf Vineyard CC*, paragraph 1.

³⁴⁷ *Mettenheimer v Zonquasdrijf Vineyard CC*, paragraph 2.

³⁴⁸ *Mettenheimer v Zonquasdrijf Vineyard CC*, Paragraph 11.

³⁴⁹ *Mettenheimer v Zonquasdrijf Vineyard CC*, paragraph 11: emphasis added.

³⁵⁰ *Mettenheimer v Zonquasdrijf Vineyard CC*, paragraph 8.

³⁵¹ *Mettenheimer v Zonquasdrijf Vineyard CC*, paragraphs 8 and 14.

³⁵² *Mettenheimer v Zonquasdrijf Vineyard CC*, paragraph 12.

³⁵³ *Mettenheimer v Zonquasdrijf Vineyard CC*, paragraph 16.

The court made reference to considerations that assist in determining the ‘likelihood of confusion’ which include, *inter alia*, the uses of the respective goods; the users of the respective goods; the physical nature of the good as well the respective trade channels through which the goods reach the market.³⁵⁴ The list of what courts consider in the enquiry as to the ‘likelihood of confusion or deception’ is not exhaustive. Therefore, the court reasoned that:

‘The nature of the two products is entirely different. The one is a fruit – albeit inedible – and the other is an alcoholic beverage. As are their uses, their users and the trade channels through which they are marketed. Since wine grapes are not suitable for consumption as a fruit, they are not sold to the public and they are therefore not to be found in any retail outlets. Wine, on the other hand, is marketed, advertised and sold directly to the public in supermarkets, liquor stores and other retail outlets. The prospects of Zonquasdrijf wine and Zonquasdrijf grapes ever being marketed or sold in close proximity can therefore safely be excluded as non-existent.’³⁵⁵

In its application of the considerations, the court concluded that the ‘likelihood of confusion or deception’ was in the circumstances slim.

Similarly, in *Lucky Star Ltd v Lucky Brands (Pty) Ltd*,³⁵⁶ the court was tasked with the question of whether or not there was a similarity between the marks ‘Lucky Star’ and ‘Lucky Fish’ in terms section 34(1) (b).³⁵⁷ It was also confronted with the issue of similarity in the nature of the goods in question namely: canned fish and cooked fish. The court held that where marks are sufficiently dissimilar, no amount of similarity between the goods will suffice for a court to conclude that there is a ‘likelihood of confusion’ under extended infringement.³⁵⁸ Accordingly, the enquiry under section 34(1) (b) failed because the marks were already found to be sufficiently dissimilar under section 34(1) (a). An enquiry into the similarity of goods was, therefore, unnecessary.³⁵⁹ In other words, the court found that there was no ‘likelihood of confusion or deception’.

³⁵⁴ *Mettenheimer v Zonquasdrijf Vineyard CC*, paragraph 16: These considerations were proposed in cases such as *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (Ch.) at 296-297; *Danco Clothing (Pty) Ltd v Nu-Care Marketing Sales and Promotions (Pty) Ltd* 1991 (4) SA 850 (A) at 860-861.

³⁵⁵ *Mettenheimer v Zonquasdrijf Vineyard CC*, paragraph 14.

³⁵⁶ 2017 (2) SA 588 (SCA).

³⁵⁷ *Lucky Star Ltd v Lucky Brands (Pty) Ltd*, paragraph 11.

³⁵⁸ *Lucky Star Ltd v Lucky Brands (Pty) Ltd*, paragraph 12.

³⁵⁹ *Lucky Star Ltd v Lucky Brands (Pty) Ltd*, paragraph 12 and 10; See also Spere J ‘Comparison Creep and The Conflation of Trade Mark Infringement and Passing Off’ (2015) 3 *South African Intellectual Property Law Journal* 92.

The question of whether or not services can be similar to goods was dealt with in *New Media Publishing v Eating Out Web Services*.³⁶⁰ The court was tasked with determining whether the two websites of the respondent (www.eating-out.co.za and www.eatingout.co.za) combined with his goods were confusingly similar to the trademarks of the applicant which are ‘Eat Out’ and ‘Eat Out Guide’.³⁶¹ The court stated that the goods of the applicant and the services of the respondent were similar in physical nature since they were both publishing restaurant guides.³⁶² Their uses were the same since they both provided information about these restaurants and they would often contain information about the same restaurants.³⁶³ The targeted consumers were also likely to be the same ‘fairly affluent urban or suburban dwellers who frequently dine out at smart restaurants with their families or friends’.³⁶⁴ The court concluded that based on these factors that there was a ‘likelihood of confusion’.³⁶⁵ In this judgement, the court confirmed that goods can be similar to services even in nature.

The question of whether or not goods should be construed as similar to services in the ‘likelihood of confusion or deception’ enquiry was once more considered in *Yuppichef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd*.³⁶⁶ The claim was based on all the forms of infringement including the primary and extended infringement which are the focus of this study. The court had to determine whether or not the applicant’s trademark, ‘Yuppichef’ which is registered for kitchen and household equipment, was confusingly similar to the respondent’s mark ‘Yuppie Gadgets’.³⁶⁷ The court reaffirmed the position that when determining the existence of the ‘likelihood of confusion and deception’, the value judgment should be ‘based on a global appreciation of the two marks and the overall impression that they leave in the context of the underlying purpose of a trademark, which is that it is a badge of origin’.³⁶⁸

³⁶⁰ See 3.2.2. (a) where the facts of this case are discussed.

³⁶¹ *New Media Publishing v Eating Out Web Services*, 391H-I, 392E-G and 392H to 393B.

³⁶² *New Media Publishing v Eating Out Web Services*, 398B-D.

³⁶³ *New Media Publishing v Eating Out Web Services*, 398B-D.

³⁶⁴ *New Media Publishing v Eating Out Web Services*, 398B-D.

³⁶⁵ *New Media Publishing v Eating Out Web Services*, 399H-J.

³⁶⁶ [2016] ZASCA 118.

³⁶⁷ *Yuppichef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd*, paragraph 1 and 41.

³⁶⁸ *Yuppichef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd*, paragraph 26.

The court held that the word ‘Yuppie’ is an ordinary word that was commonly used and that it was not the purpose of trademarks to secure monopolies.³⁶⁹ It added that the word ‘Chef’ and ‘Gadget’ form part of the mark and they should not be easily disregarded and the court found the marks to be sufficiently dissimilar.³⁷⁰ Moving to deal with the similarity of goods and services, the court held that:

‘It is unclear to me that those, or any other, services could ever be ‘similar’ to goods. The intrinsic nature of goods is wholly different from the intrinsic nature of services and vice versa. It may be that similarity in this section, when dealing with a services mark, refers only to similar services and, when dealing with a goods mark, refers only to similar goods. However, the question was not fully explored in argument before us and the matter can be resolved without reaching any conclusion on this issue, so it is better to refrain from deciding the point.’³⁷¹

The court casted doubt on the notion that goods can be similar to services. It concluded that there was no ‘likelihood of confusion’ since there was not sufficient similarity between the marks.³⁷² The court concluded that the claim based on subsection (b) should fail because the marks were not similar and that their use would likely cause deception or confusion.³⁷³

The discussion of the cases above appears to prove what Karjiker refers to as a ‘collapsed’ requirement or enquiry. He argues that the SCA has collapsed the requirements under extended infringement into an enquiry about ‘confusingly-similar goods or services’.³⁷⁴ The enquiry into the ‘likelihood of confusion or deception’ has been made part of the enquiry as to whether the infringing goods or services are similar to those for which the plaintiff’s trademark is registered. The assessment of the similarity of the goods or services has, therefore, become an integral part of the requirement of whether there is a ‘likelihood of deception or confusion’.³⁷⁵ The *Mettenheimer v Zonquasdrif Vineyard CC* case discussed above also shows that the determination of the similarity of goods and services was central to the enquiry of the ‘likelihood of confusion or deception’.

³⁶⁹ *Yuppichef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd*, paragraph 33. Scott G ‘Yuppies – Do They Confuse You?’ 02 February 2017 available at <https://www.golegal.co.za/yuppies-do-they-confuse-you/> (accessed 07 August 2021).

³⁷⁰ *Yuppichef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd*, paragraphs 27 and 39.

³⁷¹ *Yuppichef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd*, paragraph 42.

³⁷² *Yuppichef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd*, paragraph 43.

³⁷³ *Yuppichef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd*, paragraph 42.

³⁷⁴ Karjiker S ‘The Role of Reputation in Trade Mark Infringement’ (2018) 2018(4) *Journal of South African Law* 732.

³⁷⁵ *Lucky Star Ltd v Lucky Brands (Pty) Ltd*, paragraph 11.

The question of similarity of goods is also at the heart of determination of the ‘likelihood of confusion’ under section 34(1) (b). Therefore, it is imperative that the court answers the question of whether or not goods or services and whether processed goods and unprocessed goods may be similar, to the extent of creating confusion or deception. Failure to do so leaves questions like the following open, for example, whether or not cooked fish and canned fish are similar in ‘physical nature’? Kelbrick correctly points out that the court in *Mettenheimer v Zonquasdrif Vineyard CC*³⁷⁶ was wrong to state that there was no infringement under section 34(1) (b) because sufficient justification was not made before the court.³⁷⁷ Therefore, the court dodged to unequivocally state whether or not grapes and wine are similar goods.³⁷⁸

3.3.4. Comparative Analysis of the ‘Likelihood of Confusion and Deception’ Under Both Sections

Sections 34(1) (a) and (b) are regarded as confusion-based trademark infringement provisions. This is because both provisions require confusion or deception on a substantial number of persons as to the origin of the goods or services. Ascertaining the ‘likelihood of confusion and deception’ entails an objective test or rather a value judgement.³⁷⁹ The global appreciation assessment is at the heart of the ‘likelihood of confusion or deception’.³⁸⁰ The assessment takes into consideration the visual appearance, sense, and sound (aural) similarities and also gives due regard to their dominant and distinctive components.³⁸¹ The courts have accepted in several cases that this assessment applies to both section 34(1) (a) and (b) in the ‘likelihood of confusion and deception’ infringement.³⁸² Webster and Page also stated that the ‘likelihood of confusion or deception’ is entirely dependent on the global appreciation assessment of the marks.³⁸³ The assessment must be done through the eyes of a notional consumer who buys with ordinary caution. The ‘likelihood of confusion’ arises if the association between the marks

³⁷⁶ 2014 (2) SA 204 (SCA).

³⁷⁷ Kelbrick R ‘Is Due South the True North? Recent South African Interpretations of ‘Similar Goods’ in the Trade Marks Act: Analyses’ (2013) 25(1) *South African Mercantile Law Journal* 65.

³⁷⁸ Kelbrick R ‘Is Due South the True North? Recent South African Interpretations of ‘Similar Goods’ in the Trade Marks Act: Analyses’ (2013) 25(1) *South African Mercantile Law Journal* 65.

³⁷⁹ *Yair Shimansky v Browns the Diamond Store Proprietary Limited* [2014] ZASCA 214, paragraph 9.

³⁸⁰ Webster CE & Page NS *South African Law of Trade Marks, Unlawful Competition, Company Names and Trading Styles* 5 ed (2008) 7-4.

³⁸¹ *Yair Shimansky v Browns the Diamond Store Proprietary Limited* [2014] ZASCA 214, paragraph 10.

³⁸² *Bata Ltd v Face Fashions CC* 2001 (1) SA 844 (SCA), paragraph 9; *Adidas AG v Pepkor Retail Ltd*, paragraph 21; *Yuppichef Holdings (Pty) Ltd v Yuppief Gadgets Holdings*, paragraph 26.

³⁸³ Webster CE & Page NS *South African Law of Trade Marks, Unlawful Competition, Company Names and Trading Styles* 5 ed (2008) 7-4.

causes the public to wrongly believe that the respective goods or services originate from the same source.

Under primary infringement, the two marks should either be identical or ‘so nearly resembling’ the registered mark.³⁸⁴ Kelbrick argues that the confusion or deception relates to the similarity of the two marks.³⁸⁵ Under extended infringement section 34(1) (b) refers to an identical mark or a mark ‘similar to’ the registered mark which is used on ‘similar’ goods or services’.³⁸⁶ This means that the similarity of the marks as well as the similarity between the goods should cause confusion when the infringing mark is used.³⁸⁷ The interpretation of the ‘likelihood of confusion’ requirement brings to the fore the question of whether it is necessary to have this requirement for both primary and extended infringement. Alternatively, the question is whether or not ‘confusingly similarity’ should be reserved for only section 34(1) (b) while section 34(1) (a) strictly deals with the identity between marks and goods/services without the requirement of the ‘likelihood of confusion’.

As explained above, a clear distinction exists between primary and extended infringement. The latter requires that the confusingly similar mark be used on the same (or identical) goods or services and the former replaced ‘same goods or services’ with ‘similar goods or services’. Conversely, the unambiguity arises in terms of whether or not the legislature intended that the same test for confusion be applied in the same way under both subsections.

Kelbrick opines that ‘there has been no consideration of the distinctions between the requirements for primary and extended infringement’.³⁸⁸ The same applies to the distinction between ‘trademark use’ and ‘confusing use’ which he regards as ‘not apparent’.³⁸⁹ Kelbrick suggests that:

³⁸⁴ Trade Marks Act, section 34(1) (a).

³⁸⁵ Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 1.

³⁸⁶ Trade Marks Act, section 34 (1) (b).

³⁸⁷ Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 1.

³⁸⁸ Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 15.

³⁸⁹ Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 15.

‘[A] trade mark use [happens] where the infringer uses the mark to (erroneously) indicate that the goods originate from a particular undertaking, [while] confusing use [occurs] where the defendant causes confusion relating to the origin of the goods’.³⁹⁰

Use of a trademark thus generally refers to ‘use’ that indicates the badge of origin. As it will be shown below, the SCA has stated that under both sections the ‘likelihood of confusion’ relates to the origin of goods.³⁹¹

In *Verimark (Pty) Ltd v Bayerische Motoren Werke AktienGesellschaft; Bayerische Motoren Werke AktienGesellschaft v Verimark*,³⁹² the SCA was confronted with a case of comparative advertising in terms of section 34(1) (a). Verimark used the ‘BMW’ logo to advertise its products called Diamond Guard car care kit and Diamond Guard car polish.³⁹³ The court had to determine whether the public would perceive the BMW logo as identifying the source of the goods. Verimark argued that ‘use’ of the mark must amount to ‘trademark use’ which means it must indicate the origin of goods.³⁹⁴ The court held that one could not simply isolate the logo on the bonnet of the car and ignore the context of use. It found that the use of the BMW logo did not fulfil the function of a source identifier and Verimark’s appeal was thus upheld.³⁹⁵

Similarly, In *Mettenheimer v Zonquasdrijf Vineyard CC*,³⁹⁶ the court stated that confusion under section 34(1) (b) should relate to the origin of the goods or services.³⁹⁷ Kelbrick rightly highlights that there seems to be no significant difference in the interpretation and application of the ‘likelihood of confusion’ between the two subsections.³⁹⁸ This is because both sections 34(1) (a) and (b) seem to require the plaintiff to establish that there is a ‘likelihood of confusion or deception’ in respect of the same (or similar) goods or services as those for which the

³⁹⁰ Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 15.

³⁹¹ Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 3 and 16.

³⁹² 2007 (6) SA 263 (SCA).

³⁹³ *Verimark (Pty) Ltd v Bayerische Motoren Werke AktienGesellschaft; Bayerische Motoren Werke AktienGesellschaft v Verimark*, paragraph 1.

³⁹⁴ *Verimark (Pty) Ltd v Bayerische Motoren Werke AktienGesellschaft; Bayerische Motoren Werke AktienGesellschaft v Verimark*, paragraph 4.

³⁹⁵ *Verimark (Pty) Ltd v Bayerische Motoren Werke AktienGesellschaft; Bayerische Motoren Werke AktienGesellschaft v Verimark*, paragraphs 12 -13.

³⁹⁶ 2014 (2) SA 204 (SCA).

³⁹⁷ *Mettenheimer v Zonquasdrijf Vineyard CC*, paragraph 12.

³⁹⁸ Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 3.

trademark is registered.³⁹⁹ Karjiker clarifies that the only difference between section 34(1) (a) and (b) is that subsection (a), on one hand, deals with the use of the allegedly infringing mark on goods identical with those for which the mark is registered.⁴⁰⁰ On the other hand, subsection (b) focuses on the use of the allegedly infringing mark on similar goods or services in respect of which the plaintiff's mark is registered. The use of the mark should create the possibility of confusion or deception. It has been argued that there cannot be a simultaneous infringement on both sections.⁴⁰¹

Such treatment appears to be evident in at least two judgements of the SCA which are *Yuppichef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd*,⁴⁰² and *Lucky Star Ltd v Lucky Brands (Pty) Ltd*.⁴⁰³ In both cases, the matters have been brought under both sections 34(1) (a) and (b). In the former judgement, the SCA stated that since it was already discovered under section 34(1) (a) that the marks were not similar, it was unnecessary to have a discussion of whether or not the goods were similar.⁴⁰⁴ Comparably, in the latter judgement, the SCA stated that the enquiry under section 34(1) (b) failed because the marks were found to be 'sufficiently dissimilar' under subsection 1(a) to the point that no similarity of goods was ever going to warrant a 'likelihood of confusion or deception'.⁴⁰⁵

The fundamental and the only major differences between the two subsections relate to the goods or services. In section 34(1) (a), goods or services are required to be of the same class or identical.⁴⁰⁶ Under section 34(1) (b), the goods or services are expected to be of similar classes.⁴⁰⁷ This means that under section 34(1) (a) there is no enquiry into the similarity of

³⁹⁹ Karjiker S 'The Role of Reputation in Trade Mark Infringement' (2018) 2018(4) *Journal of South African Law* 730.

⁴⁰⁰ Karjiker S 'The Role of Reputation in Trade Mark Infringement' (2018) 2018(4) *Journal of South African Law* 731.

⁴⁰¹ Karjiker S 'The Role of Reputation in Trade Mark Infringement' (2018) 2018(4) *Journal of South African Law* 731; See also *Commercial Auto Glass (Pty) Ltd v Bayerische Motoren Werke Aktiengesellschaft* 2007 (6) SA 637 (SCA), paragraph 17.

⁴⁰² [2016] ZASCA 118.

⁴⁰³ 2017 (2) SA 588 (SCA).

⁴⁰⁴ *Yuppichef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd*, paragraph 43.

⁴⁰⁵ *Lucky Star Ltd v Lucky Brands (Pty) Ltd*, paragraph 12.

⁴⁰⁶ Salmon O 'Statutory Trade Mark Infringement and Questions about Confusion' (2019) 7(1) *South African Intellectual Property Law Journal* 166.

⁴⁰⁷ Salmon O 'Statutory Trade Mark Infringement and Questions about Confusion' (2019) 7(1) *South African Intellectual Property Law Journal* 176.

goods or services.⁴⁰⁸ Section 34(1) (b) requires the court to determine the ‘likelihood of confusion’ by looking into the similarity of goods or services.⁴⁰⁹ The approach to primary infringement, therefore, shows that the assessment of the ‘likelihood of confusion or deception’ is on whether the relevant marks are similar or not. For extended infringement, the assessment is on whether the relevant goods or services are similar to cause the ‘likelihood of confusion or deception’. The similarity of the marks in question does not feature prominently in the assessment of the ‘likelihood of confusion or deception’. The approach to the ‘likelihood of confusion and deception’ under primary and extended infringement is thus different. The latter focuses on the similarity of goods or services whilst the assessment under primary infringement is on the similarity of the trademarks in question. This also shows that courts are not treating the ‘likelihood of confusion and deception’ as a distinct requirement. There is a ‘collapsed enquiry’ with more emphasis being placed on either the similarity of the marks concerning section 34(1) (a) or the similarity of the relevant goods and services for section 34(1) (b).⁴¹⁰

3.4. CONCLUSION

This chapter reflected on primary and extended infringement under the SA Trade Marks Act with particular attention to the requirement of the ‘likelihood of confusion and deception’. It was found that the analysis of the ‘likelihood of confusion and deception’ under primary infringement is a two-step approach. First, one must determine whether or not the marks are similar. Second, if there is a similarity of marks, one must determine whether or not it amounts to the ‘likelihood of confusion and deception’. The goods or services must be strictly identical (same class). However, it has been proven that under section 34(1) (a) the requirement of the ‘likelihood of confusion and deception’ has been collapsed by the courts into an enquiry of similarity of the marks. It is discernible that the courts do not distinguish between the two requirements of section 34(1) (a). The collapse was confirmed in the discussion of the cases for section 34(1) (a).

Comparably, the requirement of the ‘likelihood of confusion and deception’ has also been collapsed into the similarity goods or services enquiry. The enquiry under section 34(1) (b)

⁴⁰⁸ Salmon O ‘Statutory Trade Mark Infringement and Questions about Confusion’ (2019) 7(1) *South African Intellectual Property Law Journal* 180.

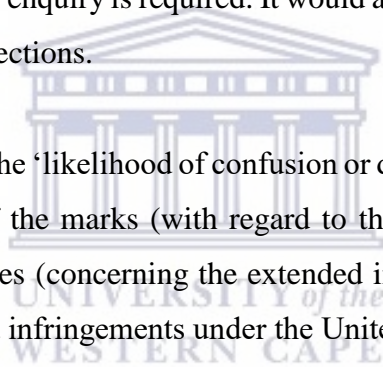
⁴⁰⁹ Salmon O ‘Statutory Trade Mark Infringement and Questions about Confusion’ (2019) 7(1) *South African Intellectual Property Law Journal* 180.

⁴¹⁰ Karjiker S ‘The Role of Reputation in Trade Mark Infringement’ (2018) 2018(4) *Journal of South African Law* 733. See cases discussed above under 3.3.2. and part 3.3.3.

consists of three steps. The first step seeks to determine whether or not the marks are similar. Secondly, whether the goods or services are similar. Lastly, if the similarity exists, the court has to determine whether or not it leads to the ‘likelihood of confusion or deception’. However, it was shown that the court has integrated the requirement of similarity of goods or services with the requirement of the ‘likelihood of confusion and deception’. Therefore, the collapse results in section 34(1) (b) not being applied consistently and uniformly.

It was also observed that the ‘likelihood of confusion’ requirement applies in the same way under both sections 34(1) (a) and (b). The similarity between these subsections relates to the fact that they both protect the function of a trademark which is a badge of origin; the degree of similarity required for marks is the same; they follow the same approach to global appreciation assessment. The only major difference between the sections relates to the goods and/or services since under primary infringement there is no enquiry to the identity of goods or services while under extended infringement this enquiry is required. It would appear to be unnecessary to have the requirement under both subsections.

In summary, the requirement of the ‘likelihood of confusion or deception’ appears blurred since the focus is on the similarity of the marks (with regard to the primary infringement) or the similarity of the goods or services (concerning the extended infringement). The next chapter deals with primary and extended infringements under the United Kingdom’s trademark law.



CHAPTER FOUR: THE ‘LIKELIHOOD OF CONFUSION’ REQUIREMENT IN TRADEMARK INFRINGEMENT IN THE UNITED KINGDOM

4.1. INTRODUCTION

Chapter three examined the requirements for confusion-based infringement, namely primary and extended infringement under sections 34(1) (a) and (b) of the South African (SA) Trade Marks Act 194 of 1993 with particular emphasis on the ‘likelihood of confusion’. It was concluded that SA courts’ approach to the application of the ‘likelihood of confusion’ requirement is problematic. This chapter analyses primary and extended infringement under sections 10(1) and 10(2) of the United Kingdom’s (UK) Trade Marks Act⁴¹¹ and how courts apply the ‘likelihood of confusion’ requirement. The ‘likelihood of confusion’ will be discussed separately from the discussion of the types of infringement. This chapter will also do a comparative analysis of the position concerning primary and extended infringement in SA and the UK trademark law. Similarities and differences between these two jurisdictions will be explored.

Judgements by the Court of Justice of the European Union (CJEU) [formerly known as the European Court of Justice, (ECJ)] will also be discussed. This is because, before Brexit, the UK judiciary and legislature deemed the decisions of the CJEU as guidance in the process of their interpretation and application of the law and also in their process of making UK laws.⁴¹² The UK Trade Marks Act had implemented the European Union (EU) Trade Mark Directive 2015/2436⁴¹³ (Directive 2015/2436) and Regulation (EU) 2015/2424.⁴¹⁴ In *Premier Brands UK Ltd v Typhoon Europe Ltd*,⁴¹⁵ it was specifically stated that the CJEU judgements were guiding the UK courts.⁴¹⁶ Discussions of CJEU judgements will also include reference to Article 10(2)

⁴¹¹ Of 1994 (incorporating amendments up to and including 1 January 2021). See part 1.6. under chapter 1 where it is discussed why UK has been chosen for the comparative part of the analysis.

⁴¹² The UK left the European Union (EU) on 31 January 2020. Most of its laws, however, still reflect the EU law. See Generally UK Parliament ‘Brexit Timeline: Events Leading to the UK’s Exit from the European Union’ available at <https://commonslibrary.parliament.uk/research-briefings/cbp-7960/> (accessed on 16 November 2021).

⁴¹³ Directive (EU) 2015/2436 of The European Parliament and of The Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks.

⁴¹⁴ Regulation (EU) 2015/2424 of the European Parliament and of The Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs).

⁴¹⁵ [2000] EWHC 1557 (Ch.).

⁴¹⁶ *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1091.

(a) and (b) of the Directive 2015/2436 and Article 9(2) (a) and (b) Regulation (EU) 2015/2424. Therefore, this chapter seeks to determine how the UK apply the ‘likelihood of confusion’ requirement.

4.2. OVERVIEW OF THE PROTECTION OF TRADEMARKS IN THE UK

The Trade Marks Act defines a trademark as:

‘[A]ny sign which is capable-

(a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and

(b) of distinguishing goods or services of one undertaking from those of other undertakings.’⁴¹⁷

Saliently, the definition contains requirements that are necessary for registration. First, it must be capable of graphic representation.⁴¹⁸ Lack of graphic representation makes it hard to have it recorded on the trademark register and people may not know when they are infringing it since the scope of protection cannot be easily determined in such cases.⁴¹⁹ The relevant competent authorities must be able to discern the contents of the sign clearly to fulfil their obligations such as ‘examination, publication and maintaining the register’.⁴²⁰ Secondly, it must also be distinctive.⁴²¹ One of the fundamental functions of a trademark is to indicate the origin of goods or services.⁴²² Distinctiveness means it must be capable of differentiating the goods or services of the proprietor.⁴²³ It must also be capable of communicating to the public the origin of goods or services.⁴²⁴ A trademark that is not distinctive does not qualify for registration and cannot, therefore, enjoy protection. This means that only registered trademarks qualify for protection against infringement.⁴²⁵ The next part deals with infringement.

⁴¹⁷ Trade Marks Act, section 1(1).

⁴¹⁸ Bainbridge DI *Intellectual Property* 9 ed (2012) 705.

⁴¹⁹ Bond C ‘UK: The Basics of Trade Mark Law’ 20 November 2017 available at <https://www.mondaq.com/uk/trademark/648042/the-basics-of-trade-mark-law> (accessed on 18 November 2021).

⁴²⁰ Bainbridge DI *Intellectual Property* 9 ed (2012) 705.

⁴²¹ Bainbridge DI *Intellectual Property* 9 ed (2012) 703.

⁴²² Bond C ‘UK: The Basics of Trade Mark Law’ 20 November 2017 available at <https://www.mondaq.com/uk/trademark/648042/the-basics-of-trade-mark-law> (accessed on 18 November 2021).

⁴²³ Bainbridge DI *Intellectual Property* 9 ed (2012) 703.

⁴²⁴ Bainbridge DI *Intellectual Property* 9 ed (2012) 703.

⁴²⁵ UK Trade Marks Act, section 2(1): this section provides that:

‘[a] registered trade mark is a property right obtained by the registration of the trade mark under this Act and the proprietor of a registered trade mark has the rights and remedies provided by this Act’.

4.3. TYPES OF INFRINGEMENTS

4.3.1. Primary Infringement

The first type of infringement is called primary infringement. Section 10(1) of the UK Trade Marks Act provides that:

‘A person infringes a registered trade mark if he uses in the course of trade a sign which *is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.*’⁴²⁶

Article 10(2) (a) of the Directive 2015/2436 and Article 9(2) (a) of the Regulation (EU) 2015/2424 are counterparts of section 10(1) of the UK Trade Marks Act.⁴²⁷ On one hand, Article 10(2) (a) of the Directive 2015/2436 and Article 9(2) (a) of the Regulation (EU) 2015/2424 are identically worded.⁴²⁸ On the other hand, section 10(1) of the UK Trade Marks Act contains similar wording to the abovementioned provisions. The following four requirements are at the heart of the infringement claim under this subsection:

- Use of an identical sign;
- In the course of trade;
- Use must be in relation to identical goods or services;
- Use must be in conflict with the registered mark.⁴²⁹

a) USE OF AN IDENTICAL SIGN

The ‘use of a sign’ must be an unauthorised commercial use that infringes the trademark of the owner.⁴³⁰ Section 10(4) provides four kinds of acts that can be deemed as ‘use of a sign’: first, placing the sign on goods or their packaging.⁴³¹ Secondly, preparing the goods for sale or selling them by putting them on the market or stock under the sign, or rendering/offering

⁴²⁶ UK Trade Marks Act, section 10(1): emphasis added.

⁴²⁷ See Article 10(2) (a) of the Directive 2015/2436 provides that:

‘[w]ithout prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the proprietor of that registered trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where: the sign is identical with the trade mark and is used in relation to goods or services which are identical with those for which the trade mark is registered’. See also Article 9(2) (a) of the Regulation (EU) 2015/2424 which contains a similar provision.

⁴²⁸ Pila J & Torremans P *European Intellectual Property Law* (2016) 402.

⁴²⁹ Colston C *Principles of Intellectual Property Law* (1999) 381.

⁴³⁰ Wasson BD, Underhill AM & Rossow AL ‘Trademark Law and the Right of Publicity in Augment Reality’ in Barfield W & Blitz MJ (eds) *Research Handbook on the Law of Virtual and Augment Reality* (2018) 194; Baker PB & Cordell N ‘United Kingdom’ in Cordell N (ed) *Intellectual Property and the Internet: A Global Guide to Protecting Intellectual Property Online* (2014) 428.

⁴³¹ UK Trade Marks Act, section 10(4) (a).

services under the sign.⁴³² Attachment of the sign to the goods is not necessary to constitute the ‘use of a sign’; it suffices that the sign is used in connection to the goods.⁴³³ The goods must be either sold or packaged under the registered sign, be in close range with the sign or they can be sold in a store that bears the sign.⁴³⁴

Thirdly, the defendant must import and export goods under the sign.⁴³⁵ To ‘import’ goods is to transport them into the UK while to export is to transport the goods out of the country.⁴³⁶ This, therefore, allows the claimant to be able to block the importation of goods from entering the country even if the goods are legitimate.⁴³⁷ Fourthly, it means to make use of the sign either as a company or trade name including where it is added to the company or trade name.⁴³⁸ This would include having the sign used ‘on letterheads, envelopes, invoices,’ business cards, and/or email signatures.⁴³⁹

b) IN THE COURSE OF TRADE

The section stipulates that the infringing sign must be used ‘in the course of trade’. This phrase has been interpreted to mean that a sign must have been used in activities that are economically driven and should be non-private.⁴⁴⁰ It means such use must create an impression that there is a material link between the goods or services of the defendant and those of the proprietor.⁴⁴¹ Making communications such as orders or invoices to suppliers and wholesales can be deemed as activities involving trade’.⁴⁴² Furthermore, the placing of a sign on the website of a foreign business that targets people in the UK also constitutes use ‘in the course of trade’.⁴⁴³ Use of an identical sign in a jurisdiction in the EU other than the UK can also be deemed as use ‘in the

⁴³² UK Trade Marks Act, section 10(4) (b).

⁴³³ Michaels A & Norris A *A Practical Guide to Trade Mark Law* 5 ed (2014) 172.

⁴³⁴ Bently L & Sherman B *Intellectual Property Law* 4 ed (2014) 1044.

⁴³⁵ UK Trade Marks Act., section 10(4) (c).

⁴³⁶ Johnson TE & Blade DL *Export/Import Procedures and Documentation* 4 ed (2010) 3.

⁴³⁷ Caddick N, Longstaff B, Wood JM & Duly C *A User's Guide to Trade Marks and Passing Off* 5 ed (2021) 237.

⁴³⁸ UK Trade Marks Act, section 10(4).

⁴³⁹ Bently L & Sherman B *Intellectual Property Law* 4 ed (2014) 1046.

⁴⁴⁰ Bently L & Sherman B *Intellectual Property Law* 4 ed (2014) 1045.

⁴⁴¹ *Arsenal Football Club PLC v Reed* [2002] ECR I-7945, paragraph 56.

⁴⁴² Mellor J, Llewelyn D & Moody-Stuart T et al *Kerly's Law of Trade Marks and Trade Names* 16 ed (2018) 573.

⁴⁴³ Mellor J, Llewelyn D & Moody-Stuart T et al *Kerly's Law of Trade Marks and Trade Names* 16 ed (2018) 573.

course of trade'.⁴⁴⁴ Without the evidence that shows that the use was in a course of trade, it would be difficult to establish infringement.⁴⁴⁵

The question of what constitutes 'in the course of trade' was addressed by the court in *Merck KgaA v Merck Sharp and Dohme Corp.*⁴⁴⁶ The matter concerned the use of 'Merck' as a domain name on websites that could be accessed globally including in the UK.⁴⁴⁷ Both 'Merck' Global (claimant), which was a German company, and its former subsidiary based in the United States of America (USA or US), 'Merck' US, were conducting their businesses in pharmaceuticals.⁴⁴⁸ In 1955, the parties agreed that the defendant would only operate their business in the USA and Canada.⁴⁴⁹ The claimant would then conduct their business in other parts of the world.⁴⁵⁰ The dispute between the parties arose with the dawn of the internet when the defendant started using domains such as 'merck.com', 'merckformothers.com' etc.⁴⁵¹ Since the 'Merck' US was not based in the UK, the court had to determine if the use of 'Merck' by the defendant was a use 'in the course of trade'.

The court held that the mere fact that 'Merck' US' websites are accessible in the UK does not mean that the goods or services offered are aimed at consumers in the UK.⁴⁵² The court stated that the question to be asked is: would the average consumer in the UK deem the goods on the website as directed or intended for him or her?⁴⁵³ It further held that all material circumstances should be considered.⁴⁵⁴ The court concluded that the defendant's websites were commercial

⁴⁴⁴ *Lifestyle Equities C.V., Lifestyle Licensing B.V. v Amazon UK Services Limited, Amazon Export Sales LLC, Amazon.com Inc, Amazon Europe Core Sarl, Amazon Eu Sarl* [2021] EWHC 721 (Ch.), paragraph 113; see also Mellor J, Llewelyn D & Moody-Stuart T et al *Kerly's Law of Trade Marks and Trade Names* 16 ed (2018) 574.

⁴⁴⁵ Wong M 'Trademark Infringement under the 1994 UK Trademarks Act in the Singapore Context' (1998) 10(1) *Singapore Academy of Law Journal* 155.

⁴⁴⁶ [2016] ETMR 19.

⁴⁴⁷ *Merck KgaA v Merck Sharp and Dohme Corp*, paragraph 16.

⁴⁴⁸ *Merck KgaA v Merck Sharp and Dohme Corp*, paragraph 2.

⁴⁴⁹ *Merck KgaA v Merck Sharp and Dohme Corp*, paragraph 2.

⁴⁵⁰ *Merck KgaA v Merck Sharp and Dohme Corp*, paragraph 2.

⁴⁵¹ *Merck KgaA v Merck Sharp and Dohme Corp*, paragraph 16. In fact, these websites were in four 'domain names "merck.com", "merckformothers.com, "merckresponsibility.com" and "merckmanuals.com". These are accessible globally and employ numerous uses of the word "Merck" alone.'

⁴⁵² *Merck KgaA v Merck Sharp and Dohme Corp*, paragraph 156.

⁴⁵³ *Merck KgaA v Merck Sharp and Dohme Corp*, paragraph 157.

⁴⁵⁴ *Merck KgaA v Merck Sharp and Dohme Corp*, paragraph 157: Quoting from the judgement in *Dearlove (t/a Diddy) v Combs (t/a Sean Puffy Combs, Puffy and P Diddy)* [2007] EWHC 375 (Ch.), the court stated that material circumstances '... include the nature of the goods and services, the appearance of the website, whether it is possible to buy goods or services from the website, whether or not the advertiser has in fact sold

activities directed at consumers in the UK.⁴⁵⁵ This is because they had ‘UK-specific content’ which was directed to consumers seeking ‘information about corporate responsibility and enquirers about [‘Merck’ US] products generally and specifically’.⁴⁵⁶ This judgement confirmed that the use ‘in the course of trade’ requirement may be met even where there are no actual sales within the UK territory.⁴⁵⁷

c) IN RELATION TO IDENTICAL GOODS OR SERVICES

The third requirement states that the identical mark must be used ‘in relation to goods or services’ that are identical to those of the claimant. The goods must be of the same specification or class as those of the registered trademark.⁴⁵⁸ Classifications or classes are done in terms of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks⁴⁵⁹ (the Nice Agreement). Section 60A of the UK Trade Marks Act defines the ‘Nice Classification’ for purposes of UK trademark law to mean the ‘system of classifications’ as found in the Nice Agreement.⁴⁶⁰ The UK just like SA adopts the definition of classification as contained in the Nice Agreement and the classes embodied in the Nice Agreement.

For example, class 25 of the Nice Agreement provides for ‘[c]lothing, footwear, [and] headgear’. Infringement would be probable in terms of section 10(1) where the defendant uses an identical sign on ‘clothing’ and the plaintiff conducts its business in ‘footwear’. Another example relates to the use of a trademark on hotels by the plaintiff while the defendant uses the same mark on guest houses. Both hotels and guest houses fall under class 43 which covers temporary accommodation.⁴⁶¹ Such use can only be deemed as infringing if it is being used for

goods or services in the UK through the website or otherwise, and any other evidence of the advertiser’s intention’.

⁴⁵⁵ *Merck KgaA v Merck Sharp and Dohme Corp*, paragraph 158.

⁴⁵⁶ *Merck KgaA v Merck Sharp and Dohme Corp*, paragraph 158.

⁴⁵⁷ Stobbs J, Zhou Y & Bain WA ‘Overview of United Kingdom Trade Mark and Designs Cases 2020’ (2021) 52(3) *International Review of Intellectual Property and Competition Law* 336.

⁴⁵⁸ Pila J & Torremans P *European Intellectual Property Law* (2016) 405.

⁴⁵⁹ (of June 15, 1957, as revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977, and amended on September 28, 1979): the classifications in terms of the Nice Agreement has already been discussed under chapter 3 of this thesis. It is not necessary to repeat it under this chapter since both nations refer to the Nice Agreement for their classifications. See chapter 3 part 3.2.1 (d).

⁴⁶⁰ Trade Marks Act, section 60A (2).

⁴⁶¹ The explanatory notes under class 43 provides that:

‘Class 43 includes mainly services provided by persons or establishments whose aim is to prepare food and drink for consumption and services provided to obtain bed and board in hotels, boarding houses or

distinguishing the services or serves as a source of origin.⁴⁶² The use of a sign for purely descriptive purposes is not a use in ‘relation to goods or services’ in terms of section 10.⁴⁶³

‘In relation to’ requires that the use be ‘incidental or ephemeral’.⁴⁶⁴ The sign is not required to be affixed on the goods physically.⁴⁶⁵ For this requirement to be met, the sign need not appear on the products themselves.⁴⁶⁶ Use ‘in relation to goods or services’ must be a use to distinguish the goods or services as coming from a specific undertaking.⁴⁶⁷ The court has to determine whether or not the average consumer would understand the use of the sign ‘in relation to goods or services’ as indicating the origin of goods or services.⁴⁶⁸ If the average consumer is likely to see the use of the sign ‘in relation to’ as distinguishing the goods or services, there will be infringement.⁴⁶⁹

4.3.2. Extended Infringement

Extended infringement is the second type of infringement that is considered under this section. This type of infringement is provided for under section 10(2) where it is stated that:

‘A person infringes a registered trade mark if he uses in the course of trade a sign where because—

(a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered, or

(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

there exists *a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.*⁴⁷⁰

other establishments providing temporary accommodation.’ Hence, ‘other establishments’ include guest houses.

⁴⁶² Bently L & Sherman B *Intellectual Property Law* 4 ed (2014) 1049.

⁴⁶³ *Fox International Group Ltd v Folly* [2012] ECC 30, paragraph 21.

⁴⁶⁴ Caddick N, Longstaff B, Wood JM & Duly C *A User's Guide to Trade Marks and Passing Off* 5 ed (2021) 239.

⁴⁶⁵ Caddick N, Longstaff B, Wood JM & Duly C *A User's Guide to Trade Marks and Passing Off* 5 ed (2021) 239.

⁴⁶⁶ Caddick N, Longstaff B, Wood JM & Duly C *A User's Guide to Trade Marks and Passing Off* ed (2021) 239.

⁴⁶⁷ Mellor J, Llewelyn D & Moody-Stuart T et al *Kerly's Law of Trade Marks and Trade Names* 16 ed (2018) 574.

⁴⁶⁸ Mellor J, Llewelyn D & Moody-Stuart T et al *Kerly's Law of Trade Marks and Trade Names* 16 ed (2018) 576.

⁴⁶⁹ Bently L & Sherman B *Intellectual Property Law* 4 ed (2014) 1049.

⁴⁷⁰ UK Trade Marks Act, section 10(2): emphasis added. This section has similar wording to the Article 16(1) of the TRIPS Agreement, see also the discussion under part 2.3.2 under chapter 2.

Both Article 10(2) (b) of the Directive 2015/2436 and Article 9(2) (b) of the Regulation (EU) 2015/2424 contain provisions on extended infringement.⁴⁷¹ The wording in section 10(2) (b) of the Directive 2015/2436 is identical to Article 9(2) (b) of the Regulation (EU) 2015/2424.⁴⁷² The aforementioned provisions bear some resemblance to the wording in section 10(2). Kelbrick states that Article 10(2) (b) contains the same wording as section 10(2) of the UK Trade Marks Act.⁴⁷³ He believes that the only difference is that the Directive 2015/2436 combines the provisions under sections 10(2) (a) and (b) of the UK Trade Marks Act into one provision of Article 10(2) (b).⁴⁷⁴ The claimant who claims that his mark has been infringed in terms of section 10(2) must show:

- use of an identical or similar sign;
- in the course of trade;
- in relation to identical or similar goods or services;
- the ‘likelihood of confusion’ on the part of the public.⁴⁷⁵

The second requirement of ‘in the course trade’ has already been dealt with under 4.2.1. and it is applied in the same way under extended infringement.

a) USE OF AN IDENTICAL OR SIMILAR SIGN

This subsection extends the scope to include the similarity of marks. ‘Similarity’ is not defined in the UK Trade Marks Act. The dictionary meaning of ‘similar’ is to be ‘like something else in appearance or character but not exactly the same’.⁴⁷⁶ Hence, similarity means it must be indistinguishable. A degree of similarity is allowed where confusing similarity is absent.⁴⁷⁷

⁴⁷¹ See Article 10(2) (a) of the Directive 2015/2436 which provides that:

‘[w]ithout prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the proprietor of that registered trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where: the sign is identical with, or similar to, the trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark’. See also Article 9(2) (b) of the Regulation (EU) 2015/2424 which contains a similar provision.

⁴⁷² Pila J & Torremans P *European Intellectual Property Law* (2016) 408.

⁴⁷³ Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 4.

⁴⁷⁴ Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 4.

⁴⁷⁵ *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] EWHC 1557 (Ch.), at 1081.

⁴⁷⁶ Soanes C & Hawker S *Compact Oxford English Dictionary: For University and College Students* 3 ed (2005) 964.

⁴⁷⁷ Bainbridge DI *Intellectual Property* 9 ed (2012) 785.

Mere similarity does not suffice to find infringement under section 10(2).⁴⁷⁸ The similarity must amount to the ‘likelihood of confusion’.⁴⁷⁹ Whether or not a sign could still be deemed to be infringing if it has not been used in a descriptive or a trademark sense was not answered by the court in *British Sugar plc v James Robertson and Sons*.⁴⁸⁰ The judgement concerned the use of the word ‘Treat’ on the products of the respondent which were jams and preserves with a flavour of Toffee calling it ‘Toffee Treat’.⁴⁸¹ The court left the question open since the defendant had not registered its mark.⁴⁸²

b) IN RELATION TO IDENTICAL OR SIMILAR GOODS OR SERVICES

Section 60A of the UK Trade Marks Act defines ‘similarity’ of goods and services to mean that:

- the similarity of goods or services should not be based on the fact that the goods or services appear on the same class under the Nice Agreement classification; and
- the dissimilarity should also not be based on the fact that the goods appear in different classes within the Nice Agreement classification.⁴⁸³

It follows that the enquiry into the similarity of goods or services is not determined with reference to the class they fall in. Pila and Torremans submit that when determining the similarity of goods or services, due regard must be given to the underlying factors of the relationship between the respective goods or services.⁴⁸⁴ The following are the six factors the court must take into consideration to determine whether or not the goods or services are similar:

- the ‘uses’ of the respective goods or services;
- ‘users’ of the respective goods or services;
- the physical ‘nature’ of the goods or acts of service;
- the respective ‘trade channels’ through which the goods or services reach the market;
- whether the goods and/or services are offered through some customer self-services, taking into account whether or not they can be found in the same market, and whether shelved side-by-side or separately;

⁴⁷⁸ Bainbridge DI *Intellectual Property* 9 ed (2012) 785.

⁴⁷⁹ Bainbridge DI *Intellectual Property* 9 ed (2012) 785.

⁴⁸⁰ [1996] EWHC 387 (Ch.).

⁴⁸¹ *British Sugar PLC v James Robertson & Sons Ltd* [1996] EWHC 387 (Ch.) at 287.

⁴⁸² Davis J ‘How The Trade Marks Act Shapes up to Perpetual Monopolies’ (1998) 57(2) *The Cambridge Law Journal* 265.

⁴⁸³ UK Trade Marks of 1994, section 60A (1).

⁴⁸⁴ Pila J & Torremans P *European Intellectual Property Law* (2016) 409.

- the extent of ‘competition’ between the respective goods or services.⁴⁸⁵

4.4. THE ‘LIKELIHOOD OF CONFUSION’ REQUIREMENT

The ‘likelihood of confusion’ has also been dealt with by the UK courts.⁴⁸⁶ This section determines how the UK courts have applied the ‘likelihood of confusion’ and whether or not they are being consistent as compared to South Africa. This section deals first with an overview of the ‘likelihood of confusion’ followed by an analysis of the application and interpretation of the ‘likelihood of confusion’ in various judgements.⁴⁸⁷

Section 10(2) of the UK Trade Marks Act provides that there should ‘*exist... a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark*’. The question of the ‘likelihood of confusion’ includes ‘association’ instead of ‘deception’. For the purposes of this discussion, the ‘likelihood of association’ is treated as a species of the ‘likelihood of confusion’.⁴⁸⁸ Confusion refers to the inability to distinguish goods due to a lack of accurate knowledge required in those circumstances.⁴⁸⁹ It is induced by the possession of incomplete or false knowledge or an impact on recollection of facts which results in uncertainty or doubt about the existing situation.⁴⁹⁰ Confusion means that the consumer is confronted with a different product that he did not intend to buy.⁴⁹¹ For example, the consumer comes into a store looking for ‘Bokomo’ Weet-Bix but when they get there they are confronted with ‘Tokomo’ Weet-Bix. They would be confronted with something that they did not intend to purchase when they got into the shop. Likelihood means that there is a probability that confusion will occur.⁴⁹² This does not mean that confusion has happened or will happen but that an average consumer will likely be confused.⁴⁹³

⁴⁸⁵ Colston C *Principles of Intellectual Property Law* (1999) 385; Hart T, Fazzani L & Clark S *Intellectual Property Law* 4 ed (2006) 118; Cornish W & Llewelyn D *Intellectual Property: Patents, Copyright, Trade Mark and Allied Rights* 5 ed (2003) 704.

⁴⁸⁶ See part 3.3 of chapter 3 for the discussion on how the South African courts have dealt with ‘likelihood of confusion’.

⁴⁸⁷ Please see part 2.2. under chapter 2 for the discussion of important factors of the ‘likelihood of confusion under international law.

⁴⁸⁸ Annand RE ‘Lookalikes under the New United Kingdom Trade Marks Act 1994’ (1996) 86(2) *The Trademark Reporter* 157. See also Hart T, Fazzani L & Clark S *Intellectual Property Law* 4 ed (2006) 112.

⁴⁸⁹ Dent C ‘Confusion in a Legal Regime Built on Deception: The Case of Trade Marks’ (2015) 5(1) *Queen Mary Journal of Intellectual Property* 26.

⁴⁹⁰ Dent C ‘Confusion in a Legal Regime Built on Deception: The Case of Trade Marks’ (2015) 5(1) *Queen Mary Journal of Intellectual Property* 26.

⁴⁹¹ Elias S & Stim R *Trademarks: Legal Care for Your Business & Product Name* 9 ed (2010) 155.

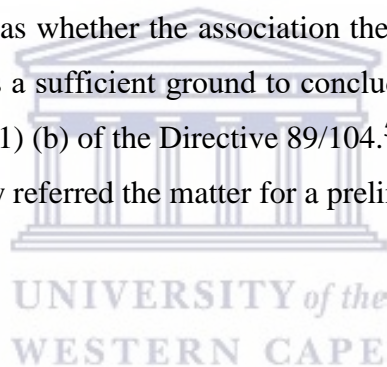
⁴⁹² Elias S & Stim R *Trademarks: Legal Care for Your Business & Product Name* 9 ed (2010) 155.

⁴⁹³ Elias S & Stim R *Trademarks: Legal Care for Your Business & Product Name* 9 ed (2010) 155.

In the dictionary, the word ‘associate’ means to ‘connect [something] in one’s mind’.⁴⁹⁴ The ‘likelihood of association’ is when a possibility exists that the consumer would be led to think of the proprietor’s goods when they see those of the infringer.⁴⁹⁵ The goods or services must convey to the consumer an impression that the goods or services before them are connected to those of the proprietor. The consumer may not think the goods or services have the same source but rather that there is a link or connection.⁴⁹⁶ The phrase ‘likelihood of association’ was also dealt with in *Sabel BV v Puma AG, Rudolf Dassler Sport*.⁴⁹⁷ Sabel wanted to register ‘Sabel’ with a bouncing cheater device as its trademark.⁴⁹⁸ Puma opposed this registration on the grounds that it was similar to its leaping panther or cougar (a puma).⁴⁹⁹ The goods were identical as they are:

‘goods in classes 18 “[l]eather and imitation leather, products made therefrom not included in other classes; bags and handbags” and 25 “[c]lothing, including tights, hosiery, belts, scarves, ties/cravats and braces; footwear; hats”.’⁵⁰⁰

The question before the court was whether the association the public may make between the marks as a result of similarity is a sufficient ground to conclude that there is a ‘likelihood of confusion’ in terms of Article 4(1) (b) of the Directive 89/104.⁵⁰¹ The Federal Court of Justice (Bundesgerichtshof) in Germany referred the matter for a preliminary ruling to the CJEU.



⁴⁹⁴ Soanes C & Hawker S *Compact Oxford English Dictionary: For University and College Students* 3 ed (2005) 51.

⁴⁹⁵ Hart T, Fazzani L & Clark S *Intellectual Property Law* 4 ed (2006) 112.

⁴⁹⁶ Hart T, Fazzani L & Clark S *Intellectual Property Law* 4 ed (2006) 112.

⁴⁹⁷ [1998] RPC 199.

⁴⁹⁸ *Sabel BV v Puma AG, Rudolf Dassler Sport*, paragraph 2. See also ‘Likelihood of Confusion and Trade Marks’ 15 June 2015 available at <https://trademarkroom.com/blog/item/likelihood-of-confusion-and-trademarks/> (accessed 18 November 2021).

⁴⁹⁹ *Sabel BV v Puma AG, Rudolf Dassler Sport*, paragraph 3. See also ‘Likelihood of confusion and trade marks’ 15 June 2015 available at <https://trademarkroom.com/blog/item/likelihood-of-confusion-and-trademarks/> (accessed 18 November 2021).

⁵⁰⁰ *Sabel BV v Puma AG, Rudolf Dassler Sport*, paragraph 2.

⁵⁰¹ First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p.1). Article 4(1) (b) deals with refusal of registering sign similar to an earlier registered trademark. Article 4(1) (b) was replaced with Article 5(1) (b) of the Directive 2015/2436. Article 4(1) (b) provides that: ‘[a] trade mark shall not be registered or, if registered, shall be liable to be declared invalid: (b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark’; *Sabel BV v Puma AG, Rudolf Dassler Sport*, paragraphs 10-11.

The CJEU held that the ‘likelihood of association’ was not included as an alternative to the ‘likelihood of confusion’.⁵⁰² The inclusion of the phrase was for defining the scope of the ‘likelihood of confusion’.⁵⁰³ It further stated that the ‘likelihood of association’ would not be applicable where it does not lead to the ‘likelihood of confusion’. It concluded that mere association made by the public was not sufficient to conclude that there was a ‘likelihood of confusion’. Therefore, the court confirmed that the ‘likelihood of association’ is included for defining the scope of the ‘likelihood of confusion’.

4.4.1. General Test for Confusion under UK Law

The global appreciation assessment is at the core of the ‘likelihood of confusion’ requirement. This means that the court must consider the visual, aural and conceptual similarities between the sign and the trademark.⁵⁰⁴ This must be done by giving due regard to the impression created by the sign and the trademark and also taking into consideration their distinctive and dominant elements.⁵⁰⁵ The existence of the ‘likelihood of confusion’ is the touchstone for liability because trademark infringement interferes with the trademark function of being a source of origin.⁵⁰⁶ The Directive 2015/2436 explains the ‘likelihood of confusion’ in this manner:

‘It is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion. The likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified, should constitute the specific condition for such protection.’⁵⁰⁷

In essence, the ‘likelihood of confusion’ does not wholly rest on the similarity between the infringing sign and the registered trademark and between the goods and/or services.⁵⁰⁸ However, other factors are also taken into account such as the ‘the level of attention of the consumer’, nature of the goods, the use and users of the goods, channels used for the goods to reach the market, and the level of competitiveness between the respective goods.⁵⁰⁹

⁵⁰² *Sabel BV v Puma AG, Rudolf Dassler Sport*, paragraph 18.

⁵⁰³ *Sabel BV v Puma AG, Rudolf Dassler Sport*, paragraph 18.

⁵⁰⁴ *Sabel BV v Puma AG, Rudolf Dassler Sport*, paragraph 22.

⁵⁰⁵ *Sabel BV v Puma AG, Rudolf Dassler Sport* [1998] RPC 199, paragraph 22.

⁵⁰⁶ Wasson BD, Underhill AM & Rossow AL ‘Trademark Law and the Right of Publicity in Augment Reality’ in Barfield W & Blitz MJ (eds) *Research Handbook on the Law of Virtual and Augment Reality* (2018) 195.

⁵⁰⁷ Directive (EU) 2015/2436 of The European Parliament and of The Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, recital 16.

⁵⁰⁸ Directive (EU) 2015/2436 of The European Parliament and of The Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, recital 16.

⁵⁰⁹ Mellor J, Llewelyn D & Moody-Stuart T et al *Kerly's Law of Trade Marks and Trade Names* 16 ed (2018) 591.

The ‘likelihood of confusion’ is the standard that courts use to determine whether or not infringement has occurred.⁵¹⁰ The ‘likelihood of confusion’ is concerned with two elements:

- That the similarity is likely to confuse the average consumer;
- The claimant must prove on a balance of probabilities that confusion is likely.⁵¹¹

The burden of proof is on the plaintiff to prove that there is a ‘likelihood of confusion’. Such evidence may be in the form of surveys.⁵¹² It is important to note that the claimant is only required to show that because of the use of the sign by the defendant there exists a ‘likelihood of confusion’ on the part of the public or that there is a ‘likelihood of association’ in the minds of the consumers.⁵¹³ Actual confusion can be ‘powerful evidence’ of the existence of confusion.⁵¹⁴ However, evidence of actual confusion is not required but such evidence can be led in a court.⁵¹⁵ Depending on the facts of the case, the lack of actual confusion can also be a sign that there is no sufficient similarity that amounts to confusion.⁵¹⁶ The fact that a competitor was careful by trying to avoid creating confusion between the marks does not mean that the ‘likelihood of confusion’ would not later arise.⁵¹⁷

The global appreciation assessment is central to the ‘likelihood of confusion’.⁵¹⁸ The court in *Sabel BV v Puma AG, Rudolf Dassler Sport*,⁵¹⁹ stated as follows regarding the average consumer:

‘That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive — “... there exists a likelihood of confusion on the part of the public ...”’

⁵¹⁰ Wasson BD, Underhill AM & Rossow AL ‘Trademark Law and the Right of Publicity in Augment Reality’ in Barfield W & Blitz MJ (eds) *Research Handbook on the Law of Virtual and Augment Reality* (2018) 195.

⁵¹¹ Hart T, Fazzani L & Clark S *Intellectual Property Law* 4 ed (2006) 114.

⁵¹² Colston C *Principles of Intellectual Property Law* (1999) 385.

⁵¹³ *Martin Lewis v Client Connection Ltd* [2011] EWHC 1627 (Ch.), paragraph 25.

⁵¹⁴ *Roger Maier and Assos of Switzerland SA v ASOS plc and ASOS.com Limited* [2015] EWCA Civ 220, paragraph 80.

⁵¹⁵ Colston C *Principles of Intellectual Property Law* (1999) 385.

⁵¹⁶ *Roger Maier and Assos of Switzerland SA v ASOS plc and ASOS.com Limited* [2015] EWCA Civ 220, paragraph 80.

⁵¹⁷ Hayes E ‘In the Name of Cultured UK Ltd. for the Trade Mark’ available at <https://www.ipo.gov.uk/t-challenge-decision-results/o23821.pdf> (accessed on 16 August 2021).

⁵¹⁸ Mellor J, Llewelyn D & Moody-Stuart T et al *Kerly's Law of Trade Marks and Trade Names* 16 ed (2018).

⁵¹⁹ [1998] RPC 199.

Consequently, when dealing with the analysis of the ‘likelihood of confusion’, the following three factors must be considered:

- the visual, aural, and conceptual similarity between the trademark of the proprietor and the infringing mark. Due regard should be given to the overall impression given by the registered sign *vis-à-vis* the infringing mark taking also into account their respective and dominant components;
- the distinctiveness of the mark (whether inherent distinctiveness or it was attained through its reputation with the public): the more a mark is distinctive, the greater is the ‘likelihood of confusion’;
- the degree of similarity of the goods for which the mark is registered and the goods in respect of which the sign is being used.⁵²⁰

These are the fundamental principles for the global appreciation assessment which is at the heart of the ‘likelihood of confusion’.

a) AVERAGE CONSUMER

The average consumer’s perception of the impugned sign is pivotal to the global appreciation assessment for the ‘likelihood of confusion’.⁵²¹ The average consumer must be deemed as someone who has an imperfect recollection of the claimant’s trademark.⁵²² She must also be ‘deemed to be reasonably well-informed and reasonably observant and [circumspect]’.⁵²³

The view with regard to the ‘likelihood of confusion’ is that:

‘... the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.’⁵²⁴

Therefore, the average consumer perceives the overall impression of the sign or mark and does not individually analyse the details of it.⁵²⁵ This means that the court must consider the

⁵²⁰ *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] EWHC 1557 (Ch.), at 1083. See also Blythe A ‘Misrepresentation, Confusion and the Average Consumer: To What Extent are the Tests for Passing Off and a Likelihood of Confusion Within Trade Mark Law’ (2015) 37(8) *European Intellectual Property Review* 488.

⁵²¹ *Laboratorios RTB, SL v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* [2003] EUECJ T-156/01, paragraph 33.

⁵²² See *Gap (ITM) Inc v. Gap 360 Ltd* [2019] EWHC 1161 (Ch.), paragraph 9. See also *Gut Springenheide GmbH v Oberkreisdirektor des Kreises* [1998] ECR I-4657, Paragraph 31.

⁵²³ *London Taxi Corp Ltd (t/a London Taxi Co) v Fraser-Nash Research Ltd* [2016] EWHC 52 (Ch.), paragraph 159 and 166.

⁵²⁴ *Sabel BV v Puma AG, Rudolf Dassler Sport*, paragraph 23: emphasis added.

⁵²⁵ *Lifestyle Equities CV v The Copyrights Group Ltd* [2021] F.S.R. 32, at 1021.

impression the infringing sign is likely to make to the average consumer since he will not always have the marks side-by-side to make a direct comparison.⁵²⁶

The CJEU has stated in several cases that one of the main functions of a trademark is to guarantee to the average consumer the ‘origin’ of the goods.⁵²⁷ Hence, the trademark serves as a product-identifying factor when consumers search for the proprietor’s products in the marketplace.⁵²⁸ The notional consumer becomes central to the analysis of the ‘likelihood of confusion’ when courts determine whether or not there is a probability that the average consumer is going to be confused by the new sign of the defendant and think it is the trademark of the claimant.⁵²⁹ The average consumer is perceived as someone who is reasonably careful, and who will reasonably expect the goods or services with the identical or similar signs to be economically linked to those of the claimant.⁵³⁰ The average consumer is a legal construct used by the courts as part of the ‘likelihood of confusion’ analysis to determine how actual consumers behave so as to be able to protect them against probable confusion.⁵³¹

4.4.2. Infringement under Primary Infringement

Dual Identity

Dual or double identity is when both the claimant’s and the defendant’s trademark, as well as the respective goods or services, are identical.⁵³² This leaves no room for mere similarity since both marks and the goods are the same.⁵³³ In such cases, it is relatively easy to prove infringement since there is no requirement to show the ‘likelihood of confusion’.⁵³⁴ What is important is to establish whether or not a trademark infringement involves identical or similar marks.⁵³⁵ Kelbrick believes that it is a general assumption if the marks are identical and the

⁵²⁶ *Lifestyle Equities CV v The Copyrights Group Ltd* [2021] F.S.R. 32, at 1025. Coteanu C *Cyber Consumer Law and Unfair Trading Practices* (2005) 138.

⁵²⁷ Lautsen RD *The Average Consumer in Confusion-based Disputes in European Trademark Law and Similar Fictions* (2020) 8. See also *Mitsubishi v Duma Forklifts* [2018] EUECJ, paragraph 35.

⁵²⁸ Lautsen RD *The Average Consumer in Confusion-based Disputes in European Trademark Law and Similar Fictions* (2020) 8.

⁵²⁹ Wilson L *Trademarks Guide: A Friendly Handbook to Protecting and Profiting from Trademarks* 2 ed (2004) 17.

⁵³⁰ *Lifestyle Equities CV v The Copyrights Group Ltd* [2021] F.S.R. 32, at 1024. Schulze R, Schulte-Nölke H & Jones J A *Casebook on European Consumer Law* (2002) 9.

⁵³¹ Austin GW ‘Tolerating Confusion about Confusion: Trademark Policies and Fair Use’ in Dinwoodie GB & Janis MD (eds) *Trademark Law and Theory: A Handbook of Contemporary Research* (2008) 381.

⁵³² ‘Infringement’ (2015) 105(2) *Trademark Reporter* 633.

⁵³³ ‘Infringement’ (2015) 105(2) *Trademark Reporter* 633.

⁵³⁴ ‘Infringement’ (2015) 105(2) *Trademark Reporter* 633.

⁵³⁵ Bainbridge D & Howell C *Law Express: Intellectual Property Law* 5 ed (2017) 140.

defendant's sign has been used on identical goods or services, that infringement will occur.⁵³⁶ He further states that, because of this, the 'likelihood of confusion' is not a requirement.⁵³⁷ As seen under 4.2.1., section 10(1) of the UK Trade Marks Act, Article 9(2) (a) of the Regulation (EU) 2015/2424 and Article 10(2) (a) of the Directive 2015/2436 only deal with identical marks. The word 'identical' is not defined in the UK Trade Marks Act but it is possible that the meaning of being 'exactly alike, equal or agreeing' would be attributed to the word.⁵³⁸ The plaintiff bears the burden to prove that there is a double identity. Kelbrick states that where the claimant alleges that there is a primary infringement, he must show that one of the trademark functions has been affected by the defendant's use of an identical sign.⁵³⁹ For example, the claimant can allege that the function of a trademark as the source of origin has been affected.⁵⁴⁰

In *LTJ Diffusion SA v Sadas Vertbaudet SA*,⁵⁴¹ the CJEU had to answer a question on the interpretation of the phrase 'sign which is identical with the trade mark' within the framework of Article 5(1) (a) of the Directive 89/104^{542, 543}. The matter was referred for a preliminary ruling by the Regional Court of Paris.⁵⁴⁴ The CJEU was confronted with the trademark ARTHUR that belonged to the LTJ Diffusion which, allegedly, was being infringed by ARTHUR ET FÉLICIE and they were both being used on clothes.⁵⁴⁵ The CJEU held that a 'strict interpretation' must be rendered for the standard by which identity is determined and the comparison must require that the elements be the same in all respects.⁵⁴⁶ The CJEU correctly pointed out that the protection provided under Article 5(1) (a) should not go beyond what the

⁵³⁶ Kelbrick R 'Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?' (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 3.

⁵³⁷ Kelbrick R 'Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?' (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 3.

⁵³⁸ Colston C *Principles of Intellectual Property Law* (1999) 383.

⁵³⁹ Kelbrick R 'Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?' (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 15.

⁵⁴⁰ Kelbrick R 'Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?' (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 15.

⁵⁴¹ [2003] FSR 608.

⁵⁴² First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p.1). Article 5(1) (a) of the Directive 89/104 became Article 10(1) (a) of the Directive 2015/2436. Article 5(1) (a) provides that '[t]he registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered'.

⁵⁴³ *LTJ Diffusion SA v Sadas Vertbaudet SA*, paragraph 23.

⁵⁴⁴ *LTJ Diffusion SA v Sadas Vertbaudet SA*, paragraph 23.

⁵⁴⁵ *LTJ Diffusion SA v Sadas Vertbaudet SA*, paragraphs 11 and 14.

⁵⁴⁶ *LTJ Diffusion SA v Sadas Vertbaudet SA*, paragraph 50.

section requires into the sphere of protection provided by Article 5(1) (b).⁵⁴⁷ The CJEU stated that a correct interpretation of Article 5(1) (a) would be to define identity to involve a situation where:

‘a sign is identical to a trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.’⁵⁴⁸

Adopting a mark as it is without alterations or improvements to the components of the trademark of the proprietor renders that mark identical.⁵⁴⁹ The alterations or the improvements that have been applied to the mark must be in such a manner that it would not be easy for the average consumer to overlook them.⁵⁵⁰ The mere similarity would not suffice to prove that infringement has taken place in terms of section 10(1).⁵⁵¹

In *Reed Executive PLC v Reed Business Information Ltd*,⁵⁵² the court gave further clarity on what CJEU meant by ‘strict interpretation of identity’ in *LTJ Diffusion SA v Sadas Vertbaudet SA*. The respondent was a service provider for employment agencies and it was responsible for advertising employment posts on their website and they were operating their business under the trademark REED.⁵⁵³ The appellant, who was conducting trade in online magazines, had a section that was dedicated to employment advertisement under the trademark ‘Read Business Information’ (RBI).⁵⁵⁴ Dealing with the identity of marks, the court stated that the addition of ‘Business Information’ to the claimant’s trademark REED resulted in the sign falling outside identity infringement.⁵⁵⁵ It further stated that there was no need to ‘soften the edges of strict identity’ since if a mark falls outside section 10(1), it may still be found similar and ‘likely to confuse’ under section 10(2).⁵⁵⁶ The court held that ‘Read Business Information’ was one name and the use of capital letters gave the consumer the impression that ‘Business Information’ was part of the name and, therefore, played a visual significance.⁵⁵⁷ It further stated that REED is a

⁵⁴⁷ *LTJ Diffusion SA v Sadas Vertbaudet SA*, paragraph 50.

⁵⁴⁸ *LTJ Diffusion SA v Sadas Vertbaudet SA*, paragraph 53.

⁵⁴⁹ Twigg-Flesner C *Research Handbook On EU Consumer and Contract Law* (2016) 302.

⁵⁵⁰ Benöhr I *EU Consumer Law and Human Rights* (2013) 15.

⁵⁵¹ Bainbridge D & Howell C *Law Express: Intellectual Property Law* 5 ed (2017) 140.

⁵⁵² [2004] EWCA Civ 159.

⁵⁵³ *Reed Executive PLC v Reed Business Information Ltd*, paragraph 4.

⁵⁵⁴ *Reed Executive PLC v Reed Business Information Ltd*, paragraph 8.

⁵⁵⁵ *Reed Executive PLC v Reed Business Information Ltd*, paragraph 26.

⁵⁵⁶ *Reed Executive PLC v Reed Business Information Ltd*, paragraph 27.

⁵⁵⁷ *Reed Executive PLC v Reed Business Information Ltd*, paragraph 37.

common surname and that the words ‘Business Information’ would not be overlooked by the average consumer.⁵⁵⁸ Therefore, there was no identity of mark and sign.⁵⁵⁹

Moving to answer the question of identical services, the court stated that this requires one to enquire into the elements of an employment agency. The question that arises is: what sets apart the employment agent from other service providers who are also in the recruitment industry?⁵⁶⁰ Alternatively, the court stated that one must also ask whether or not the appellant is offering the services of an employment agency.⁵⁶¹ The court found that the remuneration of employment agencies was dependent on placement, and the identity of the employer remains a secret until the agency has connected the employee with the employer.⁵⁶² Conversely, the court noted that RBI would be paid regardless of whether or not the employee makes contact with the employer.⁵⁶³ The court concluded, therefore, that their services were also not identical.⁵⁶⁴ The court confirmed that the word REED as used in ‘Reed Business Information’ was not being used ‘in relation to identical services’. Therefore, was no infringement under section 10(1).

In another case of *Fox International Group Ltd v Folly*,⁵⁶⁵ the court had to determine if the use of the sign STALKER by the defendant amounted to infringement of the claimant’s marks STALKER and FOX STALKER which were affixed on identical goods: clothing.⁵⁶⁶ The defendant used his sign on domains of two websites which were *stalkertackle.co.uk* and *stalkerclothing.co.uk*.⁵⁶⁷ The defendant argued that it was not using the sign STALKER alone but as either STALKER TACKLE or STALKER CLOTHING.⁵⁶⁸ The defendant added that if there was a use of the word STALKER alone it would be for descriptive purposes.⁵⁶⁹

⁵⁵⁸ *Reed Executive PLC v Reed Business Information Ltd*, paragraph 38. See also paragraphs 30-41.

⁵⁵⁹ *Reed Executive PLC v Reed Business Information Ltd*, paragraphs 41.

⁵⁶⁰ *Reed Executive PLC v Reed Business Information Ltd*, paragraph 53.

⁵⁶¹ *Reed Executive PLC v Reed Business Information Ltd*, paragraph 52.

⁵⁶² *Reed Executive PLC v Reed Business Information Ltd*, paragraph 62.

⁵⁶³ *Reed Executive PLC v Reed Business Information Ltd*, paragraph 62.

⁵⁶⁴ *Reed Executive PLC v Reed Business Information Ltd*, paragraph 77.

⁵⁶⁵ [2012] ECC 30.

⁵⁶⁶ *Fox International Group Ltd v Folly*, paragraphs 1, 3, and 11.

⁵⁶⁷ *Fox International Group Ltd v Folly*, paragraph 10.

⁵⁶⁸ *Fox International Group Ltd v Folly*, paragraph 45.

⁵⁶⁹ *Fox International Group Ltd v Folly*, paragraphs 39-40.

The claimant also drew the court's attention to goods bought from the website of the defendant which were marked with the word STALKER alone without CLOTHING or TACKLE.⁵⁷⁰ The court also looked at the two websites and found that they had the phrase 'Welcome to the Stalker website'.⁵⁷¹ It concluded that STALKER, in this case, was being used to refer to the source or origin of the goods.⁵⁷² The court stated that the word was capable of being used as a descriptive word for someone who is searching for goods.⁵⁷³ The defendant was using it in that sense but also as a badge of origin for the goods.⁵⁷⁴ Therefore, it was infringing the trademark in terms of Article 9(1) (a) of the Regulation (EU) 2015/2424.⁵⁷⁵

In *Student Union Lettings Ltd v Essex Student Lets Ltd*,⁵⁷⁶ the court dealt with infringement in terms of section 10(1) of the UK Trade Marks Act.⁵⁷⁷ The claimant was a proprietor of the trademark SULETS and the defendant owned the sign SU LETS (SU is an abbreviation for Student Union).⁵⁷⁸ They both conducted their businesses by providing accommodation services for university students.⁵⁷⁹ The court had to determine whether or not SU LETS was identical to SULETS.⁵⁸⁰ The court stated that aurally the marks were identical because people would pronounce both of them either 'SOO LETS' or SU LETS.⁵⁸¹ It further stated that 'the space between SU and LETS' did not play a significant role in distinguishing the sign since the average consumer would not notice it when it is in plain word form.⁵⁸² The court also held that the defendant used the sign as one word in the email address (such as 'essex.su/sulets') which features prominently in promotional material (such as posters).⁵⁸³ Therefore, the sign and the trademark were conceptually and visually similar.⁵⁸⁴ The court concluded that the defendant

⁵⁷⁰ *Fox International Group Ltd v Folly*, paragraph 44.

⁵⁷¹ *Fox International Group Ltd v Folly*, paragraph 53. See also *Reed Executive PLC v Reed Business Information Ltd*, paragraph 37.

⁵⁷² *Fox International Group Ltd v Folly*, paragraph 53.

⁵⁷³ *Fox International Group Ltd v Folly*, paragraph 53.

⁵⁷⁴ *Fox International Group Ltd v Folly*, paragraph 53.

⁵⁷⁵ *Fox International Group Ltd v Folly*, paragraph 53.

⁵⁷⁶ [2018] EWHC 419 (IPEC).

⁵⁷⁷ *Student Union Lettings Ltd v Essex Student Lets Ltd*, paragraph 12.

⁵⁷⁸ *Student Union Lettings Ltd v Essex Student Lets Ltd*, paragraph 1.

⁵⁷⁹ *Student Union Lettings Ltd v Essex Student Lets Ltd*, paragraph 1.

⁵⁸⁰ *Student Union Lettings Ltd v Essex Student Lets Ltd*, paragraph 13.

⁵⁸¹ *Student Union Lettings Ltd v Essex Student Lets Ltd*, paragraph 18.

⁵⁸² *Student Union Lettings Ltd v Essex Student Lets Ltd*, paragraph 19.

⁵⁸³ *Student Union Lettings Ltd v Essex Student Lets Ltd*, paragraph 19.

⁵⁸⁴ *Student Union Lettings Ltd v Essex Student Lets Ltd*, paragraph 19.

has infringed the trademark of the claimant in terms of section 10(1) of the UK Trade Marks Act.⁵⁸⁵

The above judgements reveal that section 10(1) of the UK Trade Marks Act is purely about determining identity and not the ‘likelihood of confusion’. This is because section 10(1) deals only with identical marks. It is clear from these cases that the courts are not prepared to compromise on the requirement of strict identity or as the court has stated: courts should not ‘soften the edges of strict identity’.⁵⁸⁶ The UK courts primarily emphasise the strict interpretation of the requirement of identity of the sign and the trademark.⁵⁸⁷ The word ‘strict’ is defined to mean something ‘must be obeyed exactly’.⁵⁸⁸ For identity to exist, the infringing sign must be the exact imprint of the trademark such as in the sense of a reflection of an object in a mirror. Additionally, for identity infringement to exist, the emphasis must be with regards to replication and reconstruction of the trademark in the sign without any modification or addition. For example, in *Fox International Group Ltd v Folly*, the use of the word STALKER was deemed to be infringing FOX STALKER. This appears to indicate that the addition or removal of elements from the registered trademark also amounts to infringement through identity under section 10(1).

4.4.3. ‘Likelihood of Confusion’ under Extended Infringements

In the Absence of Dual Identity

Where dual identity is not complete or absent this is substituted with similarity. A mark will be infringing if it is identical or similar to the trademark of the proprietor.⁵⁸⁹ It must also be used on goods or services that are identical or similar to those of the registered trademark of the proprietor.⁵⁹⁰ Unlike section 10(1), section 10(2) of the UK Trade Marks Act,⁵⁹¹ expressly includes the phrase ‘likelihood of confusion’ which is expected to be on the part of the

⁵⁸⁵ *Student Union Lettings Ltd v Essex Student Lets Ltd*, paragraph 20.

⁵⁸⁶ *Reed Executive PLC v Reed Business Information Ltd*, paragraph 27.

⁵⁸⁷ ‘Description of Mark, Specification of Goods and Services, and Seniority’ (2014) 104(2) *The Trademark Reporter* 479.

⁵⁸⁸ Soanes C & Hawker S *Compact Oxford English Dictionary: For University and College Students* 3 ed (2005) 1026.

⁵⁸⁹ Stokes R & Kipping M *Trademarks, Brands, and Competitiveness* (2010) 122.

⁵⁹⁰ Stokes R & Kipping M *Trademarks, Brands, and Competitiveness* (2010) 122.

⁵⁹¹ Regulation (EU) 2015/2424, Article 9(2) (b); and 2015 Directive, Article 10(2) (b).

public.⁵⁹² The ‘likelihood of confusion’ also covers the ‘likelihood of association’.⁵⁹³ The degree of similarity becomes a determining factor and the greater the similarity between the infringing sign and the registered trademark and also between the respective goods or services there simpler and easier the analysis for the ‘likelihood of confusion’ will be.⁵⁹⁴

The similarity is not the main infringing factor. The question is whether or not that similarity causes confusion on the part of the public.⁵⁹⁵ The similarity between the marks is determined as a matter of first impression.⁵⁹⁶ The enquiry tries to determine consumers’ perception of the sign when they initially set their eyes for the first time on it.⁵⁹⁷ The dissimilarity between the goods or services does not mean there is no ‘likelihood of confusion’ but that it will be harder to prove the ‘likelihood of confusion’.⁵⁹⁸ The ‘likelihood of confusion’ is a question of fact that calls for the consideration of all the relevant factors and not to overlook the differences between the classes.⁵⁹⁹

The important purpose of registration is to protect the trademark function as a source of origin. Thus, the ‘likelihood of confusion’ must negatively impact this function.⁶⁰⁰ The UK courts have stated that the claimant must show that there is a risk that the average consumer would be misled into thinking the goods or services of the defendant are economically linked to those of the claimant.⁶⁰¹ Kelbrick alludes that the claimant must show that the ‘likelihood of confusion’ which exists on the part of the public affects the function of a trademark as the badge of origin.⁶⁰² The consumer must be led to think there is a commercial relationship that exists between the goods or services of the claimant and those of the defendant.

⁵⁹² Litman J ‘Breakfast with Batman: The Public Interest in the Advertising Age’ (1999) 108 *The Yale Law Journal* 1720.

⁵⁹³ Litman J ‘Breakfast with Batman: The Public Interest in the Advertising Age’ (1999) 108 *The Yale Law Journal* 1720.

⁵⁹⁴ Bainbridge DI *Intellectual Property* 9 ed (2012) 783.

⁵⁹⁵ *Natural Instinct Ltd v Natures Menu Ltd* [2020] EWHC 617 (IPEC), paragraph 60(k).

⁵⁹⁶ Michaels A & Norris A A *Practical Guide to Trade Mark Law* 5 ed (2014) 46.

⁵⁹⁷ Devenney J & Kenny M *European Consumer Protection: Theory and Practice* (2012) 24.

⁵⁹⁸ *Pfizer Ltd v Eurofood Link (UK) Ltd* [2000] ETMR 896, paragraph 29.

⁵⁹⁹ Maniatis SM ‘Dilution in Europe’ (2002) 7 *International Intellectual Property Law & Policy* 43-11.

⁶⁰⁰ Stokes R & Kipping M *Trademarks, Brands, and Competitiveness* (2010) 122.

⁶⁰¹ *Sazerac Brands LLC v Liverpool Gin Distillery Ltd* [2020] EWHC 2424 (Ch.), paragraph 74.; *APT Training and Consultancy Ltd v Birmingham and Solihull Mental Health NHS Trust* [2019] EWHC 19 (IPEC), paragraph 140. *Beauty Bay Ltd v Benefit Cosmetics Ltd* [2019] EWHC 1150 (Ch.), paragraph 39; *Red Bull GmbH v Big Horn UK Ltd* [2020] EWHC 124 (Ch.), paragraph 43.

⁶⁰² Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 16.

The *British Sugar PLC v James Robertson & Sons Ltd*⁶⁰³ is instructive. The court in this case dealt with the use of the word ‘Treat’ on the products. The respondent’s goods were jams and preserves with a flavour of Toffee calling it ‘Toffee Treat’.⁶⁰⁴ The plaintiff used the word ‘Treat’ to advertise its dessert sauces and syrup.⁶⁰⁵ The court held that the question of similarity was a distinct question from that of the ‘likelihood of confusion’.⁶⁰⁶ It stated that three questions must also be added to the enquiry under section 10(2) which are as follows:

- Whether or not the mark is being used in the course of trade;
- Whether or not it is being used on goods similar to those covered by the registration;
- Whether or not a ‘likelihood of confusion’ arises due to the similarity.⁶⁰⁷

Furthermore, it stated that determining the similarity between goods or services of the two parties was a matter of principle. The court found that the word ‘Treat’ also appears with a trademark every time the word was used either by the respondent or the plaintiff.⁶⁰⁸ Therefore, since it was not used as a trademark by either party, the use by the respondent did not cause any commercial harm to the plaintiff.⁶⁰⁹

The court turned to the question of whether or not dessert sauces and syrup; and jams and preserves were ‘similar’ goods. The court looked at the factors that are used to determine the similarity of goods or services for the analysis of the ‘likelihood of confusion’.⁶¹⁰ The court stated that:

‘[T]he two products to some extent have the same use, but broadly in practice have different uses. They are hardly in direct competition and consumers will find them in different places in supermarkets. Their physical nature is somewhat different, the Robertson produce being hardly pourable and really needing spooning out of the jar whereas the British Sugar product is meant to be poured out of the small hole in the plastic top... *Taking all these things together, I think the spread is not [being] regarded as similar to the dessert sauces and syrups of the registration.* I therefore think there is no infringement.’⁶¹¹

⁶⁰³ [1996] EWHC 387 (Ch.).

⁶⁰⁴ *British Sugar PLC v James Robertson & Sons Ltd*, at 287.

⁶⁰⁵ *British Sugar PLC v James Robertson & Sons Ltd*, at 285.

⁶⁰⁶ *British Sugar PLC v James Robertson & Sons Ltd*, at 295.

⁶⁰⁷ *British Sugar PLC v James Robertson & Sons Ltd*, at 294.

⁶⁰⁸ *British Sugar PLC v James Robertson & Sons Ltd*, at 288.

⁶⁰⁹ *British Sugar PLC v James Robertson & Sons Ltd*, at 288.

⁶¹⁰ These factors are: the uses of the respective goods or services; their respective users; their physical nature; the channels used to get them to the market; whether or not they are likely to be found on the same supermarkets and also likely to be shelved side-by-side; and the extent of their competitiveness: *British Sugar PLC v James Robertson & Sons Ltd*, at 296.

⁶¹¹ *British Sugar PLC v James Robertson & Sons Ltd*, at 297: emphasis added.

The court pointed out that similarity between these products is eliminated by the fact that they would usually be placed on different shelves in the store. Moreover, how the average consumer would use them indicates that they needed to be treated as dissimilar goods. Therefore, the court found there was no ‘likelihood of confusion’ and infringement in terms of section 10(2) of the UK Trade Marks Act.⁶¹²

Comparably, in *Premier Brands UK Ltd v Typhoon Europe Ltd*,⁶¹³ the court confirmed that the similarity question was distinct from the question of the ‘likelihood of confusion’.⁶¹⁴ The matter was decided in terms of section 10(2).⁶¹⁵ The court had to deal with the sign ‘Typhoon’ which was affixed on kitchen houseware.⁶¹⁶ The sign was deemed to be infringing the mark ‘Ty.Phoo’ which was registered for ‘hand tools and hand implements for domestic use (found in class 8); cutlery for domestic utensils and containers, combs, brushes, sponges, and cleaning materials’ (which are in class 21).⁶¹⁷ The court stated that the four following questions must be answered with regards to infringement under section 10(2):

- whether ‘Typhoon’ is a sign used in the course of trade;
- whether the sign ‘Typhoon’ is similar to the trademark ‘Ty.Phoo’;
- whether the sign is being used in relation to goods that are either identical with or similar to the goods of the registered trademark;
- whether there exists a ‘likelihood of confusion’ on the part of the public which includes the ‘likelihood of association’.⁶¹⁸

The court stated that it was not disputed that ‘Typhoon’ was a sign and that it was being used in the course of trade.⁶¹⁹ It further stated that it was plain that ‘Typhoon’ is a sign similar to the

⁶¹² *British Sugar PLC v James Robertson & Sons Ltd*, at 300.

⁶¹³ [2000] EWHC 1557 (Ch.).

⁶¹⁴ *Premier Brands UK Ltd v Typhoon Europe Ltd* at 1081.

⁶¹⁵ *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1072.

⁶¹⁶ *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1072.

⁶¹⁷ *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1071: in terms of the classification of the Nice Agreement class 8 consists of ‘[h]and tools and implements (hand-operated); cutlery; side arms; razors’; class 21 embodies ‘[h]ousehold or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes’.

⁶¹⁸ *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1081.

⁶¹⁹ *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1081.

trademark 'Ty.Phoo'.⁶²⁰ The court moved to answer the question of identity or similarity of goods. The court stated as follows:

'... I consider that pestles & mortars, cleavers, chopsticks and sushi sticks and bamboo utensils are identical or similar to the category of goods to which the [trademark 'Ty.Phoo'] was registered; I am unpersuaded that any of the other items relied on by Premier could be said to fall within "and tools and hand implements" whether for domestic use or otherwise, and they cannot seriously be said to be within "cutlery, forks and spoons", with the possible exception of some ancillary items, for instance the forks included in fondue sets.'⁶²¹

In addition, the court accepted that mug trees are also goods that are similar to those of the claimant's registered trademark.⁶²²

Turning to address the question of the 'likelihood of confusion', the court went on to apply the principles of global appreciation assessment.⁶²³ The court stated that there was considerable aural similarity between the two marks but it was hardly greater.⁶²⁴ It further stated that the visual similarity was blurred by the presence of 'N' in the sign 'Typhoon' and the existence of the 'full stop' in the middle of 'Ty.phoo'.⁶²⁵ With regards to the conceptual similarity, the court stated the word 'Typhoon' was an ordinary dictionary word in common use while the word 'Ty.phoo' was invented with no meaning but just a fancy word.⁶²⁶ Concerning the second factor, the court stated that 'Ty.phoo' enjoyed inherent distinctiveness.⁶²⁷

Lastly, they had to determine the degree of similarity between the goods and whether or not the average consumer would be confused. The court acknowledged that there was a similarity between the plaintiff's and the defendant's goods.⁶²⁸ However, it stated that the average reasonable consumer would not confuse 'Typhoon' as used in kitchenware with goods for which 'Ty.phoo' is registered.⁶²⁹ The court concluded that despite the similarity between the trademark 'Ty.phoo' and the sign 'Typhoon', there was no 'likelihood of confusion' on the part

⁶²⁰ *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1081.

⁶²¹ *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1082.

⁶²² *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1082.

⁶²³ *Premier Brands UK Ltd v Typhoon Europe Ltd & Another*, at 1083: See the discussion in this chapter under part 4.3.1.

⁶²⁴ *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1086.

⁶²⁵ *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1086.

⁶²⁶ *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1086.

⁶²⁷ *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1086.

⁶²⁸ *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1086.

⁶²⁹ *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1086.

of the public.⁶³⁰ In this judgement, the court did not only state the distinction between the question of similarity and that of the ‘likelihood of confusion’ but made that evident in its application of section 10(2). It treated the analysis of the ‘likelihood of confusion’ as a three-step approach: first by determining whether the sign and the trademark are similar or identical; secondly, whether the respective goods or services are similar; thirdly, if there is similarity, whether it leads to the ‘likelihood of confusion’ of the part of the public.

In *Pfizer Ltd v Eurofood Link (UK) Ltd*,⁶³¹ the court clarified the three-step approach to the assessment of ‘likelihood of confusion’ in its application. In this case, the court had to determine whether or not the defendant’s sign VIAGRENE was similar to VIAGRA the trademark of the claimant in terms of section 10(2). The trademark VIAGRA was being used on pharmaceutical products to treat a form of impotence called erectile dysfunction which was common among men.⁶³² The sign VIAGRENE was used on beverages that were meant to stimulate libido.⁶³³ Enquiring into the similarity of marks, the court found that the trademark VIAGRENE contained five letters from VIAGRA and this would make consumers call into mind the trademark of the claimant.⁶³⁴ The court concluded that VIAGRENE was a sign similar to VIAGRA.⁶³⁵

With regards to the question of whether or not the goods or services were identical or similar, the court stated that the comparison must not be conducted because VIAGRA is a pharmaceutical product and VIAGRENE is a non-alcoholic beverage.⁶³⁶ However, it should be done by taking into consideration that VIAGRA products are used for impotence; VIAGRENE is a product used for stimulating libido.⁶³⁷ They are both used on reproductive organs.⁶³⁸ It further stated that the defendant intended to market VIAGRENE as a kind of aphrodisiac aimed at ‘enhancing the body’s natural response to sexual stimulation’.⁶³⁹ In determining the ‘likelihood of confusion’, the court held that there was a substantial similarity between

⁶³⁰ *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1091.

⁶³¹ [2000] ETMR 896.

⁶³² *Pfizer Ltd v Eurofood Link (UK) Ltd*, paragraph 3.

⁶³³ *Pfizer Ltd v Eurofood Link (UK) Ltd*, paragraph 3.

⁶³⁴ *Pfizer Ltd v Eurofood Link (UK) Ltd*, paragraph 50.

⁶³⁵ *Pfizer Ltd v Eurofood Link (UK) Ltd*, paragraph 52.

⁶³⁶ *Pfizer Ltd v Eurofood Link (UK) Ltd*, paragraph 48.

⁶³⁷ *Pfizer Ltd v Eurofood Link (UK) Ltd*, paragraph 48.

⁶³⁸ *Pfizer Ltd v Eurofood Link (UK) Ltd*, paragraph 48.

⁶³⁹ *Pfizer Ltd v Eurofood Link (UK) Ltd*, paragraph 49.

VIAGRENE and VIAGRA.⁶⁴⁰ The court concluded that the ‘likelihood of confusion’ was inherent between VIAGRENE and VIAGRA because both marks were being used on similar goods.⁶⁴¹ The court also concluded that the goods were different in nature but were similar in use because they were intended for ‘use’ against the problem of importance.⁶⁴² It substantiated these conclusions by stating that the ‘likelihood of confusion’ was so real that when the public sees the VIAGRENE products it would conclude that the products were originating from the same source.⁶⁴³

In *Sky Plc v SkyKick UK Ltd*,⁶⁴⁴ the court dealt with an extended infringement under Article 9(2) (b) of the Regulation (EU) 2017/1001⁶⁴⁵ and Article 10(2)(b) of the Directive 2015/2436.⁶⁴⁶ The trademark of the claimant is SKY (with sub-brands trademarks such as SKYSCANNER and SKY BROADBAND).⁶⁴⁷ The defendant was a proprietor of the sign SKYKICK.⁶⁴⁸ The marks were both being used on computer software and telecommunication services.⁶⁴⁹ The court held that the first part of SKYKICK was aurally, visually, and conceptually identical to the trademarks of the claimant while the last part was not even similar.⁶⁵⁰ It also held that the marks of the claimant had a moderately high degree of distinctiveness and use by third parties was not enough to lower this.⁶⁵¹ The court ruled on the goods and services of both parties as being identical.⁶⁵² The court dealt with the ‘likelihood of confusion’ and stated that the average consumer was likely to deem SKYKICK as a sub-brand of SKY.⁶⁵³ It stated that confusion was likely because the average consumer exercises lower degrees of care and attention.⁶⁵⁴ In its finding, the court concluded that the defendant had

⁶⁴⁰ *Pfizer Ltd v Eurofood Link (UK) Ltd*, paragraph 52.

⁶⁴¹ *Pfizer Ltd v Eurofood Link (UK) Ltd*, paragraph 52.

⁶⁴² *Pfizer Ltd v Eurofood Link (UK) Ltd*, paragraph 52.

⁶⁴³ *Pfizer Ltd v Eurofood Link (UK) Ltd*, paragraph 53.

⁶⁴⁴ [2018] EWHC 155 (Ch.).

⁶⁴⁵ Regulation (EU) 2017/1001 of The European Parliament and of The Council of 14 June 2017 on the European Union trade mark.

⁶⁴⁶ *Sky Plc v SkyKick UK Ltd*, paragraph 284.

⁶⁴⁷ *Sky Plc v SkyKick UK Ltd*, paragraph 2.

⁶⁴⁸ *Sky Plc v SkyKick UK Ltd*, paragraph 8.

⁶⁴⁹ *Sky Plc v SkyKick UK Ltd*, paragraph 6.

⁶⁵⁰ *Sky Plc v SkyKick UK Ltd*, paragraph 299.

⁶⁵¹ *Sky Plc v SkyKick UK Ltd*, paragraph 293.

⁶⁵² *Sky Plc v SkyKick UK Ltd*, paragraph 298.

⁶⁵³ *Sky Plc v SkyKick UK Ltd*, paragraph 302.

⁶⁵⁴ *Sky Plc v SkyKick UK Ltd*, paragraph 302.

infringed the trademarks of the claimant in terms of Article 9(2) (b) of the Regulation (EU) 2017/1001 and Article 10(2) (b) of the Directive 2015/2436.⁶⁵⁵

The court in *Frank Industries Pty Ltd v Nike Retail BV*⁶⁵⁶ also dealt with extended infringement in terms of Article 9(2) (b) of the Regulation (EU) 2017/1001 and Article 10(2) (b) of the Directive Directive 2015/2436.⁶⁵⁷ The claimant (Frank) was the proprietor of the trademark LNDR (in uppercase letters) registered for clothing including sportswear.⁶⁵⁸ Nike (the defendant) started a new advertising campaign in which it made use of the sign LDNR (also in uppercase letters) on clothing.⁶⁵⁹ Central to the issue was the question regarding how the average consumer was going to perceive the signs of LNDR and LDNR in context.⁶⁶⁰ With regards to the similarity of marks, the court stated that there was a high degree of both aural and visual similarity despite the transposition of the middle letters.⁶⁶¹ There was also a high degree of conceptual similarity because some consumers ‘perceive LNDR as meaning Londoner’ are also likely to attribute that meaning to LDNR.⁶⁶² The court stated that there was no doubt that the clothes on which Nike made use of the sign were identical to those of the claimant.⁶⁶³ The court turned to the question of the ‘likelihood of confusion’ and stated that:

‘The distinctive character of the Trade Marks, the close and confusing similarity between the Trade Marks and LDNR, the identity of the goods and the moderate degree of attention paid by the average consumer all points towards a likelihood of confusion.’⁶⁶⁴

It was, therefore, held that there was a ‘likelihood of confusion’.⁶⁶⁵ The court concluded that the defendant had infringed the trademark of the claimant in terms of Article 9(2) (b) of the EU CTM Regulation and Article 10(2) (b) of the Directive 2015/2436.⁶⁶⁶

The discussion of the judgements above appear to show the preservation of the ‘distinction’ between the question of similarity and that of the ‘likelihood of confusion’. It is evident that

⁶⁵⁵ *Sky Plc v SkyKick UK Ltd*, paragraph 303.

⁶⁵⁶ [2018] EWHC 1893 (Ch.).

⁶⁵⁷ *Frank Industries Pty Ltd v Nike Retail BV* [2018] EWHC 1893 (Ch.), paragraph 88.

⁶⁵⁸ *Frank Industries Pty Ltd v Nike Retail BV*, paragraph 1.

⁶⁵⁹ *Frank Industries Pty Ltd v Nike Retail BV*, paragraph 1.

⁶⁶⁰ *Frank Industries Pty Ltd v Nike Retail BV*, paragraph 2.

⁶⁶¹ *Frank Industries Pty Ltd v Nike Retail BV*, paragraph 95.

⁶⁶² *Frank Industries Pty Ltd v Nike Retail BV*, paragraph 95.

⁶⁶³ *Frank Industries Pty Ltd v Nike Retail BV*, paragraph 97.

⁶⁶⁴ *Frank Industries Pty Ltd v Nike Retail BV*, paragraph 117.

⁶⁶⁵ *Frank Industries Pty Ltd v Nike Retail BV*, paragraph 119.

⁶⁶⁶ *Frank Industries Pty Ltd v Nike Retail BV*, paragraph 119.

the question of whether or not there is a similarity between the sign and the trademark and also between the goods or services must be determined first. The assessment of the ‘likelihood of confusion’ becomes an enquiry separate from that of similarity. The UK judgements such as *Pfizer Ltd v Eurofood Link (UK) Ltd*,⁶⁶⁷ and *Premier Brands UK Ltd v Typhoon Europe Ltd*,⁶⁶⁸ provide a clear guide on how the enquiries into infringement under section 10(2) should be conducted. It can be deduced from these judgements that the outcome of the ‘likelihood of confusion’ enquiry is dependent on the outcome of similarity or partial identity (e.g. identical goods or services with similar marks).⁶⁶⁹ However, the presence of similarity between the sign and the trademark and the goods themselves does not mean that there is a ‘likelihood of confusion’.⁶⁷⁰ Therefore, the UK courts have succeeded in separating the enquiry into similarity from the enquiry into the ‘likelihood of confusion’.

4.4.4. Comparative Analysis between the Two Subsections

Differences

The first difference between section 10(1) and section 10(2) under the UK Trade Marks Act relates to the marks. Under section 10(1), it’s a prerequisite that the ‘same’ mark must be used by the defendant whilst under section 10(2), the marks can be identical or ‘similar’.⁶⁷¹ Under section 10(1), the sign becomes identical if it reproduces all the elements of the trademark without modifying or adding to them.⁶⁷² All the elements of the claimant’s trademark must be transferred to the sign of the defendant without making any alterations. Under section 10(2), the defendant is only expected to have transferred at least the dominant and/or the distinctive elements of the registered trademark.⁶⁷³ Therefore, under section 10(1) marks must be strictly identical while under section 10(2) they can be similar.

The second difference between the two subsections relates to the specification of goods or services. Section 10(1) requires that goods or services be of the same specification or class as those of the registered trademark.⁶⁷⁴ The approach is different under section 10(2), the

⁶⁶⁷ [2000] ETMR 896.

⁶⁶⁸ [2000] EWHC 1557 (Ch.).

⁶⁶⁹ See *Frank Industries Pty Ltd v Nike Retail BV*, paragraph 97; and *Sky Plc v SkyKick UK Ltd*, paragraph 298.

⁶⁷⁰ *Premier Brands UK Ltd v Typhoon Europe Ltd*, at 1091.

⁶⁷¹ Cothill C ‘Shape Trade Marks – Lindt Fails to Pull a Rabbit out of the Hat’ (2013) 13(3) *Without Prejudice* 16.

⁶⁷² Torremans P & Pila J *European Intellectual Property Law* (2016) 404.

⁶⁷³ Dutfield G & Suthersanen U *Global Intellectual Property Law* (2008) 139.

⁶⁷⁴ Torremans P & Pila J *European Intellectual Property Law* (2016) 405.

similarity of goods or services is not determined based on specification or class but on six factors which are: the respective uses of the respective goods or services; users of the respective goods or services; the physical nature of the goods or acts of service; the respective trade channels through which the goods or services reach the market; whether the goods and/or services are offered through some customer self-services, taking into account whether or not they can be found in the same market, and whether shelved side-by-side or separately.⁶⁷⁵ Therefore, for section 10(1) the goods or services must be of the same classes while under section 10(2) this is not a requirement.

Global appreciation assessment was declared as one of the dividing lines between sections 10(1) and (2). In *Pfizer Ltd v Eurofood Link (UK) Ltd*,⁶⁷⁶ the court stated that global appreciation assessment is only reserved for cases where dual identity is absent.⁶⁷⁷ Remarkably, global appreciation assessment goes hand in hand with similarity. It focuses on the interdependence between the similarity of the signs and the similarity of the goods/services.⁶⁷⁸ If there is a lesser degree of similarity between the trademark, it can be counterbalanced by the similarity between the goods or services and *vice versa*.⁶⁷⁹ This is known as the ‘interdependence principle’. Practically, more weight will be given to the degree of similarity between the goods or services, the level of attention the public will give to these goods or services, the degree of similarity between the trademark and the sign, and whether or not this creates an important impression.⁶⁸⁰

Section 10(1) also differs from section 10(2) with regards to the requirement of the ‘likelihood of confusion’. Section 10(1) requires that for infringement to occur, there must be double identity. This means the sign and the trademark must be identical and the respective goods or services must be of the same class. The section does not include ‘likelihood of confusion’

⁶⁷⁵ *British Sugar PLC v James Robertson & Sons Ltd*, at 296.

⁶⁷⁶ [2000] ETMR 896.

⁶⁷⁷ *Pfizer Ltd v Eurofood Link (UK) Ltd*, paragraph 19.

⁶⁷⁸ ‘Questions of Translation and Dilution –the CJEU Rules on Similarity between GOLDEN BALLS and BALLON D’OR’ available at <http://eprints.bournemouth.ac.uk/23204/1/EIPR%20case%20comment%20Golden%20Balls%20%20final.pdf> (accessed on 13 October 2021).

⁶⁷⁹ ‘Questions of Translation and Dilution –the CJEU Rules on Similarity between GOLDEN BALLS and BALLON D’OR’ available at <http://eprints.bournemouth.ac.uk/23204/1/EIPR%20case%20comment%20Golden%20Balls%20%20final.pdf> (accessed on 13 October 2021).

⁶⁸⁰ EUIPO ‘Trade Mark Guidelines’ available at <https://guidelines.euipo.europa.eu/1803468/1789458/trade-mark-guidelines/2-interdependence-principle> (accessed 13 October 2021).

which means it is not a requirement for primary infringement.⁶⁸¹ An infringement can never ensue under section 10(1) without dual identity. Under section 10(2), the standard required for infringement is lower. It only requires either double similarity or one to be identical (e.g. the sign) while the other is similar (e.g. the goods or services can be similar) but combined they must result in the ‘likelihood of confusion’. Therefore, the ‘likelihood of confusion’ is only a requirement for section 10(2).

Similarities

UK courts seem to emphasise that both types of infringements will only occur if there is an aural and visual identity or similarity. This was first confirmed in *Reed Executive PLC v Reed Business Information Ltd* for section 10(1) where courts stated that one can still conclude that there is identity infringement if there is both aural and visual identity.⁶⁸² The UK courts have also hinted that a section 10(2) infringement will occur where people can hear (aural similarity) what they want to hear or see what they want to see (visual similarity).⁶⁸³ People must hear the sign of the defendant sounding similar to the trademark of the plaintiff and visually appearing to be similar to the trademark. It would be appropriate to emphasise the two since they affect two senses of the human body which are sight and hearing. This would also perfectly fit the concept of the imperfect recollection of the average consumer. This is because for the consumer to have the claimant’s mark in his memory, he must have either seen it or heard someone pronouncing it. Furthermore, since initial confusion is a part of the analysis of the ‘likelihood of confusion’, it would be difficult to show how conceptual similarity or identity has resulted in initial confusion. Therefore, the courts on the overall impression created by the mark place emphasis on visual and aural identity or similarities.

Both for sections 10(1) and (2), the UK courts provide an answer to the question of whether goods or services are identical which is central to finding infringement. In *Reed Executive PLC v Reed Business Information Ltd*,⁶⁸⁴ the court stated that the provision of services such as an employment agency was not the same as featuring employment advertisements on the website

⁶⁸¹ Cornish W & Llewelyn D *Intellectual Property: Patents, Copyright, Trade Mark and Allied Rights* 5 ed (2003) 701.

⁶⁸² *Reed Executive PLC v Reed Business Information Ltd*, paragraph 32.

⁶⁸³ See cases *Avada Corporation v Dubur India Ltd* [2013] EWHC 589 (Ch.), paragraph 48; and *Sky Plc v SkyKick UK Ltd* [2018] EWHC 155 (Ch.), paragraph 293. See also *Frank Industries Pty Ltd v Nike Retail BV* [2018] EWHC 1893 (Ch.), paragraph 95: where the court placed emphasis on aural and visual similarity before turning to deal with conceptual similarity.

⁶⁸⁴ [2004] EWCA Civ 159.

or in a magazine.⁶⁸⁵ Comparably, in *British Sugar PLC v James Robertson & Sons Ltd*,⁶⁸⁶ despite the court discovering that ‘Treat’ was being used as a trademark by either party — and therefore, could not amount to use as a sign as required by section 10(2) — the court still answered the question of whether or not dessert sauces and syrup (which were the products of the claimant) were similar to jams and preserves (the goods of the defendant).⁶⁸⁷ In summary, the court stated that they were not similar goods.⁶⁸⁸ Therefore, it would appear that answering the question of whether or not goods are identical is vital to avoid legal uncertainty. It is also important for establishing a clear precedent to create consistency in the application of the ‘likelihood of confusion’ under section 10(2) and for dual identity under section 10(1).

UK courts have introduced definitions and guiding factors or principles for determining whether or not there is an infringement in terms of sections 10(1) and 10(2). Under section 10(1), the courts have adopted the definition of ‘identity’ for Article 10(2) (a) of the Directive 2015/2436 provided by the CJEU in *LTJ Diffusion SA v Sadas Vertbaudet SA*.⁶⁸⁹ Secondly, in *Reed Executive PLC v Reed Business Information Ltd*, the court set the two questions to be asked in dual identity cases under section 10(1).⁶⁹⁰ Thirdly, in *Premier Brands UK Ltd v Typhoon Europe Ltd*,⁶⁹¹ the court introduced three principles for the ‘global appreciation’ assessment.⁶⁹² Lastly, in *British Sugar PLC v James Robertson & Sons Ltd*, the court introduced three questions for infringements under section 10(2).⁶⁹³ The UK needs to be commended for creating tests and criteria for determining infringements. This sets good guidelines for courts and creates certainty and consistency in terms of what is necessary for the enquiry.

It is clear that the approach to primary infringement is different from the approach for extended infringement. The courts in the UK have ensured that they do not blur the line separating section 10(1) from section 10(2). The UK courts apply these two subsections consistently and uniformly without confusing them.

⁶⁸⁵ *Reed Executive PLC v Reed Business Information Ltd*, paragraphs 62 and 77.

⁶⁸⁶ [1996] EWHC 387 (Ch.).

⁶⁸⁷ *British Sugar PLC v James Robertson & Sons Ltd*, at 285 & 287.

⁶⁸⁸ *British Sugar PLC v James Robertson & Sons Ltd*, at 289.

⁶⁸⁹ [2003] FSR 608, ECJ.

⁶⁹⁰ See the discussion under 4.3.2.

⁶⁹¹ [2000] EWHC 1557 (Ch.).

⁶⁹² See the discussion under 4.3.1(a).

⁶⁹³ See the discussion under 4.3.3.

4.5. COMPARATIVE ANALYSIS OF SA AND THE UK TRADEMARK LAW RELATING TO PRIMARY AND EXTENDED INFRINGEMENT

The tables below illustrate the differences between primary and extended infringement in the UK and SA.

4.5.1. Primary Infringement

Primary Infringement	SA Approach (section 34(1) (a) of the SA Trade Marks Act). ⁶⁹⁴	UK Approach (section 10(1) of the UK Trade Marks Act). ⁶⁹⁵
Registered and infringing trademark	<p>Similarities:</p> <ul style="list-style-type: none"> • The trademarks must be identical. <p>Differences:</p> <ul style="list-style-type: none"> • The trademarks can also be similar (resemble each other). 	<p>Similarities:</p> <ul style="list-style-type: none"> • The trademarks are required to be identical. <p>Differences:</p> <ul style="list-style-type: none"> • Same trademarks must be used by both parties.
Goods and/or services	<p>Similarities:</p> <ul style="list-style-type: none"> • The goods or services are expected to be of the same class or classification. • The classification is made in terms of the Nice Agreement. • No enquiry is made when the goods or 	<p>Similarities:</p> <ul style="list-style-type: none"> • The goods or services are expected to be of the same specification or class. • The UK also uses the Nice Agreement classification. • No enquiry is made when goods or services fall into the same class.

⁶⁹⁴ SA Trade Marks Act 194 of 1993.

⁶⁹⁵ UK Trade Marks Act of 1994 (incorporating amendments up to and including 1 January 2021).

	services are of the same classification.	
‘Likelihood of confusion and deception’ as a requirement	Differences: <ul style="list-style-type: none"> • The ‘likelihood of confusion and deception’ is required for both primary and extended infringement. 	Differences: <ul style="list-style-type: none"> • There is no requirement of the ‘likelihood of confusion’.

Both the SA Trade Marks Act and UK Trade Marks Act provide the requirements that must be satisfied for primary infringement. The UK law requires that the sign and the trademark must be identical.⁶⁹⁶ The CJEU has stated in *LTJ Diffusion SA v Sodas Vertbaudet SA*⁶⁹⁷ that the identity requirement must be interpreted strictly. The UK courts have understood this to mean no compromise must be made in terms of the requirement of identity under section 10(1).⁶⁹⁸ No room should be created to have the requirement relaxed to accommodate similarity. However, the SA Trade Marks Act’s approach is different in that it requires that the marks to be either identical or nearly resemble each other.⁶⁹⁹ Where the marks are identical, infringement immediately follows.⁷⁰⁰ On the contrary, where marks are similar, the enquiry must be conducted by the court to determine whether or not they are confusingly similar.⁷⁰¹ Therefore, UK courts are strict on the identity requirement while the SA law accommodates confusing marks.

The approach to goods or services is the same under both SA and UK law. In both countries, the infringing mark is strictly expected to be used on goods or services that are the same as

⁶⁹⁶ UK Trade Marks Act, section 10(1).

⁶⁹⁷ [2003] FSR 608, ECJ.

⁶⁹⁸ *Fox International Group Ltd v Folly* [2012] ECC 30, paragraph 53; *Reed Executive PLC v Reed Business Information Ltd* [2004] EWCA 2772 (Ch.), paragraph 37; *PlanetArt LLC v Photobox Ltd* [2020] EWHC 713 (Ch.), paragraph 154; *Student Union Lettings Ltd v Essex Student Lets Ltd*, [2018] EWHC 419 (IPEC), paragraph 14.

⁶⁹⁹ SA Trade Marks Act, section 34(1) (a).

⁷⁰⁰ Dean O & Dyer A (eds) *Introduction to Intellectual Property Law* (2014) 146. See also chapter 3 part 3.3.2.

⁷⁰¹ Dean O & Dyer A (eds) *Introduction to Intellectual Property Law* (2014) 146.

those of the registered trademark.⁷⁰² The goods or services of the sign and those of the registered trademark must be of the same class. Under both the UK and the SA law, the classification of goods and services is made in terms of the Nice Agreement. Under the SA law, the Nice classification is provided for in terms of Trade Marks Regulations.⁷⁰³ Under UK law, Nice Classification is provided for in terms of section 60A of the UK Trade Marks Act.⁷⁰⁴

The second major difference is with regards to the ‘likelihood of confusion’. The SA Trade Marks Act requires the infringing mark being used on goods or services of the same class to be ‘likely to deceive or cause confusion’.⁷⁰⁵ In *Lucky Star Ltd v Lucky Brands (Pty) Ltd*,⁷⁰⁶ Swain JA stated that section 34(1) (a) requires the plaintiff to show that the defendant has made ‘use of a mark so nearly resembling its trade marks as to be likely to deceive or cause confusion’.⁷⁰⁷ This reveals that the ‘likelihood of confusion’ is central to section 34(1) (a) of the SA Trade Marks Act. On the contrary, section 10(1) of the UK Trade Marks Act requires double identity. In *Reed Executive PLC v Reed Business Information Ltd*,⁷⁰⁸ Jacob J outlined what the proprietor is expected to do under section 10(1) infringements. He stated that:

‘To bring a case within [section 10(1)] the proprietor must show two things, (i) use of a sign which is identical to his registered mark, and (ii) use for goods or services which are identical to those which his mark is registered.’⁷⁰⁹

This statement shows that the ‘likelihood of confusion’ is not a prerequisite under primary infringement in the UK trademark law since section 10(1) only deals with identical marks on identical goods.

There are similarities and differences in how primary infringement is interpreted and applied in both jurisdictions. Kelbrick alludes that primary infringement in the UK occurs when the average consumer cannot determine the source of origin of the goods or services.⁷¹⁰ In other

⁷⁰² See Cornish W & Llewelyn D *Intellectual Property: Patents, Copyright, Trade Mark and Allied Rights* 5 ed (2003) 701. See also Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 162.

⁷⁰³ SA Trade Marks Regulation GN R578/95 (Trade Marks Act 194 of 1993).

⁷⁰⁴ UK Trade Marks Act, section 60A (3).

⁷⁰⁵ SA Trade Marks Act, section 34(1) (a).

⁷⁰⁶ 2017 (2) SA 588 (SCA): see 3.3.4 under chapter 3 where the facts of this case are discussed.

⁷⁰⁷ *Lucky Star Ltd v Lucky Brands (Pty) Ltd*, paragraph 6.

⁷⁰⁸ [2004] EWCA 2772 (Ch.).

⁷⁰⁹ *Reed Executive PLC v Reed Business Information Ltd*, paragraph 20.

⁷¹⁰ Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 9.

words, it must affect the essential function of the trademark as a badge of origin. However, Kelbrick suggests that SA has shifted from this and now only require that the plaintiff must show a ‘trademark use’.⁷¹¹ He asserts that in SA the plaintiff is no longer required to show a ‘likelihood of confusion or deception’ but only ‘trademark use’.⁷¹²

4.5.2. Extended Infringement

Extended Infringement	SA Approach (section 34(1) (b) of the SA Trade Marks Act).	UK Approach (section 10(2) of the UK Trade Marks Act).
Trademarks	<p>Similarities:</p> <ul style="list-style-type: none"> • Trademarks can be similar or identical. <p>Differences:</p> <ul style="list-style-type: none"> • The standard used for the enquiry is the same as for primary infringement. 	<p>Similarities:</p> <ul style="list-style-type: none"> • The trademarks can also be identical or similar. <p>Differences:</p> <ul style="list-style-type: none"> • Requires a lower standard from that of primary infringement.
Goods and/or services	<p>Similarities:</p> <ul style="list-style-type: none"> • Goods or services are expected to be only similar. • The similarity is not determined in terms of classification under the Nice Agreement. 	<p>Similarities:</p> <ul style="list-style-type: none"> • Goods or services can also be similar. • The similarity is also not determined in terms of the specification under the Nice Agreement.

⁷¹¹ Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 10.

⁷¹² Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 10. To support this argument in his analysis, Kelbrick relies on cases such as *Commercial Auto Glass (Pty) Ltd v Bayerische Motoren Werke Aktiengesellschaft* [2007] 4 All SA 1331 (SCA); *Verimark (Pty) Ltd v Bayerische Motoren Werke Aktiengesellschaft*; *Bayerische Motoren Werke Aktiengesellschaft v Verimark* 2007 (6) SA 263 (SCA).

	<p>Differences:</p> <ul style="list-style-type: none"> • No provision is made for identical goods or services. 	<p>Differences:</p> <ul style="list-style-type: none"> • Goods or services can also be identical given that the marks are not.
<p>‘Likelihood of confusion and deception’ as a requirement</p>	<p>Similarities:</p> <ul style="list-style-type: none"> • SA requires that there must be a ‘likelihood of confusion or deception’ for extended infringement to ensue. <p>Differences:</p> <ul style="list-style-type: none"> • The section does not refer to ‘likelihood of association’. 	<p>Similarities:</p> <ul style="list-style-type: none"> • The UK Trade Marks Act specifically includes the requirement of the ‘likelihood of confusion’ only for extended infringement. <p>Differences:</p> <ul style="list-style-type: none"> • The UK Trade Marks Act specifically includes the ‘likelihood of association’ as a species of the ‘likelihood of confusion’.⁷¹³

The same approach is followed for extended infringement both under UK and SA concerning the marks. Section 34(1) (b) of the SA Trade Marks Act requires that the infringing mark be ‘identical or similar to the registered’ trademark.⁷¹⁴ Similarity requires that the ‘degree of similarity between the marks must be likely to result in confusion and/or deception’.⁷¹⁵ Section 10(2) of the UK Trade Marks Act provides that the infringing sign must be identical or similar

⁷¹³ Annand RE ‘Lookalikes under the New United Kingdom Trade Marks Act 1994’ (1996) 86(2) *The Trademark Reporter* 157.

⁷¹⁴ SA Trade Marks Act, section 34(1) (b).

⁷¹⁵ Webster CE & Page NS *South African Law of Trade Marks, Unlawful Competition, Company Names and Trading Styles* 5 ed (2008) 12-38.

to the trademark.⁷¹⁶ These extend to the area where the marks are not required to be identical.⁷¹⁷ Therefore, both SA and UK allow the infringing mark to be either identical or similar.

The similarity of goods or services becomes the second step of the enquiry of similarity under extended infringement for both countries. In *British Sugar PLC v James Robertson & Sons Ltd*,⁷¹⁸ Jacob J wrestled with the question of similarity. The learned judge was attempting to determine how courts should approach it.⁷¹⁹ Addressing the issue of similar goods and/or services, he stated:

‘... In effect a registration covers the goods of the specification plus similar goods. No one may use the registered mark or a similar mark for any of those goods unless he has some other defence. This suggests caution otherwise, however narrow a specification, the actual protection will be wide.’⁷²⁰

The concept of ‘similar goods or services’ was introduced to widen the scope of protection. Both SA and UK law aim to cover goods or services falling outside the classification of goods or services of the registered trademark. The degree of similarity cannot be applied to the goods or services without an application on the marks and *vice versa*.⁷²¹

Under both SA and UK Trade Marks Act, there is a requirement of the ‘likelihood of confusion’ for extended infringement. The enquiry into the ‘likelihood of confusion’ involves the similarity between the trademarks, the goods or services and other factors such as ‘the level of attention of the consumer’ and the nature of the goods.⁷²² It requires that the global appreciation assessment be conducted which investigates the aural (sound), phonetic (pronunciation), and visual (appearance) similarities.⁷²³

⁷¹⁶ UK Trade Marks Act, section 10(1).

⁷¹⁷ Mellor J, Llewelyn D & Moody-Stuart T et al *Kerly's Law of Trade Marks and Trade Names* 16 ed (2018) 589.

⁷¹⁸ [1996] EWHC 387 (Ch.).

⁷¹⁹ *British Sugar PLC v James Robertson & Sons Ltd*, at 295.

⁷²⁰ *British Sugar PLC v James Robertson & Sons Ltd*, at 295. See the discussion of the case in this chapter under part 4.4.3. The *British Sugar PLC v James Robertson & Sons Ltd* has been referenced in a number of SA cases. See cases such as *Mettenheimer v Zonquasdrijf Vineyards CC* 2014 (2) SA 204 (SCA), paragraph 13; *Verimark (Pty) Ltd v Bayerische Motoren Werke AktienGesellschaft ; Bayerische Motoren Werke AktienGesellschaft v Verimark* 2007 (6) SA 637 (SCA), paragraph 4; *Chantelle v Designer Group (Pty) Ltd* [2015] ZAGPPHC 222, paragraph 61; *Impala Platinum Holdings Limited v Impala Warehousing And Logistics Africa (Proprietary) Limited* [2014] ZAGPJHC 410, paragraphs 66 and 47.

⁷²¹ Webster CE & Page NS *South African Law of Trade Marks, Unlawful Competition, Company Names and Trading Styles* 5 ed (2008) 12-41.

⁷²² Mellor J, Llewelyn D & Moody-Stuart T et al *Kerly's Law of Trade Marks and Trade Names* 16 ed (2018) 592.

⁷²³ Mellor J, Llewelyn D & Moody-Stuart T et al *Kerly's Law of Trade Marks and Trade Names* 16 ed (2018) 592.

Furthermore, the enquiry requires that one should not overlook the distinctive and/or dominant elements of the marks.⁷²⁴ This assists in determining the impression created by the mark to the average consumer.⁷²⁵ Both the SA courts and the UK courts have stated that lesser similarity between the marks can be supplemented with a greater similarity between the goods or services and *vice versa*.⁷²⁶ It has also been confirmed that the ‘likelihood of confusion’ must be the outcome of the combined effect of similarity between the marks and between the respective goods or services.⁷²⁷ What distinguishes the UK is that their section includes the ‘likelihood of association’ while SA included ‘deception’. The SA provision on extended infringement does not cover the ‘likelihood of association’. Furthermore, the approach to the global appreciation assessment is the same since both UK and SA allow for a low degree of similarity between the marks to be offset by a high degree of similarity between the goods and/or services.⁷²⁸ Therefore, both SA and the UK adopt the same approach when they conduct the enquiry of the ‘likelihood of confusion’.⁷²⁹

The approach to extended infringement under both jurisdictions resemble each other more. Kelbrick correctly argues that under the UK Trade Marks Act, the claimant is required to show that there exists a ‘likelihood of confusion’ on the part of the public.⁷³⁰ Similarly, in SA, the plaintiff has to show that the ‘trademark use’ by the defendant leads to a ‘likelihood of

⁷²⁴ Mellor J, Llewelyn D & Moody-Stuart T et al *Kerly's Law of Trade Marks and Trade Names* 16 ed (2018) 592.

⁷²⁵ Mellor J, Llewelyn D & Moody-Stuart T et al *Kerly's Law of Trade Marks and Trade Names* 16 ed (2018) 592.

⁷²⁶ See *New Media Publishing v Eating Out Web Services* 2005 (5) SA 388 (C), 394B-E; *Lucky Star Ltd v Lucky Brands (Pty) Ltd* [2014] ZAWCHC 197, paragraph 23; *Kalypso Media Group GmbH v EUIPO / Wizards of the Coast LLC* [2019] EUECJ T-700/18, paragraph 71; *Dairyglen Products Ltd v Razneck Ltd* [2015] ETMR 22, at 546. *CCHG Ltd t/a Vaporized v Vapouriz Ltd* [2017] ETMR 35, at 837; *Cable Logic Europe Ltd v Wagamama Ltd* [2019] ETMR 20, paragraph 21(g).

⁷²⁷ See *Chantelle v Designer Group (Pty) Ltd* [2015] ZAGPPHC 222, paragraph 61; Caddick N, Longstaff B, Wood JM & Duly C A *User's Guide to Trade Marks and Passing Off* 5 ed (2021) 244.

⁷²⁸ See ‘Questions of Translation and Dilution –the CJEU rules on Similarity between GOLDEN BALLS and BALLON D’OR’ available at <http://eprints.bournemouth.ac.uk/23204/1/EIPR%20case%20comment%20Golden%20Balls%20%20final.pdf> (accessed on 13 October 2021; *New Media Publishing v Eating Out Web Services* 2005 (5) SA 388 (C), 394B-E.

⁷²⁹ The enquiry under extended infringement requires that one must determine first whether or not there is similarity between the marks. secondly, to determine the similarity between the goods or services of the defendant and the goods or services of the registered trademark. If there is similarity between the marks and similarity between the goods or services, on the third step one has determine if the combined effect of the similarity leads to the ‘likelihood of confusion’.

⁷³⁰ Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 16.

confusion’.⁷³¹ He further asserts that under both jurisdictions the ‘likelihood of confusion’ must affect the essential function of the trademark as the badge of origin.⁷³²

4.6. CONCLUSION

This chapter focused on primary and extended infringement under the UK and SA Trade Marks Act. The purpose was to analyse the application of the ‘likelihood of confusion’ requirement under the UK and use it as a backdrop to SA’s position. The chapter has revealed that the UK’s approach to the types of infringement is far more different from that of SA. Primary infringement under the UK does not include the ‘likelihood of confusion’ as a requirement. It focuses on double identity with an emphasis on the lack of modification and addition for infringement to ensue. For extended infringement, the UK preserved the application of section 10(2) without collapsing it. It uses three–steps enquiry to determine infringement. The first step determines the similarity of marks; the second step focuses on the similarity of goods and services; and if there is a similarity in steps one and two, the third step determines if that similarity leads to the ‘likelihood of confusion’. The average consumer is also at the centre of the enquiry. The lack of the requirement of the ‘likelihood of confusion’ under section 10(1) has aided the UK courts in keeping the two subsections apart. Kelbrick suggests that the UK has also preserved the need for the plaintiff to prove that the function of origin has been affected under primary infringement. However, he points out that SA has shifted from this to only proving trademark use. For extended infringement, both UK and SA require the plaintiff to show that there is a ‘likelihood of confusion’.

Under this chapter, it has been shown that the UK has a better approach to the ‘likelihood of confusion’. The following chapter, which is chapter five, assist in drawing lessons for SA from the UK. It helps to determine how the ‘likelihood of confusion’ requirement can be applied without being collapsed and/or the lines blurred between the two sections.

⁷³¹ Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 16.

⁷³² Kelbrick R ‘Confused about Confusion: is there still a Distinction between Primary and Extended Trade Mark Infringement?’ (2017) 50(1) *The Comparative and International Law Journal of Southern Africa* 16.

CHAPTER FIVE: CONCLUSION AND RECOMMENDATIONS

5.1. INTRODUCTION

The thesis aimed to provide a comprehensive analysis of the interpretation and application of the ‘likelihood of confusion’ requirement in infringement claims by the South African (SA) courts. Its goal was to determine whether or not the courts are being consistent and uniform in their application of the ‘likelihood of confusion’ requirement. To fulfil this aim, sub-questions needed to be addressed to answer the foundational question of this thesis. First, what does the concept ‘likelihood of confusion’ mean? Secondly, what is the position regarding this requirement under the international legal framework that governs trademarks? Thirdly, how have SA courts interpreted the ‘likelihood of confusion’ requirement in relation to section 34(1) (a) of the Trade Marks Act when dealing with primary infringement? Fourthly, have SA courts adopted the same approach to the ‘likelihood of confusion’ concerning extended infringement in terms of section 34(1) (b)? Fifthly, how do other legal systems such as the United Kingdom (UK) apply the ‘likelihood of confusion’ requirement under its Trade Marks Act of 1994?

Chapter one analysed the definition of a mark and a trademark as they are provided for under the SA Trade Marks Act.⁷³³ It discussed the four functions of a trademark namely: the badge of origin; distinguishing function; function of guaranteeing quality; and function of advertising.⁷³⁴ The chapter also discussed the problem statement, the existing literature as well the significance of the study. The main objective of this research was to identify the problem with the application of the ‘likelihood of confusion and deception’ requirement in SA and what can be done to remedy the situation.

Chapter two examined several international agreements which govern trademarks. The chapter discussed the various instruments such as the Agreement on Trade-Related Aspects of

⁷³³ 194 of 1993.

⁷³⁴ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 116. See also Department of Trade and Industry: Republic of South Africa ‘Making a Mark: An Introduction to Trade Marks for Small and Medium-Sized Enterprises’ available at https://www.wipo.int/export/sites/www/sme/en/documents/guides/customization/making_a_mark_sa.pdf (accessed on 11 November 2021).

Intellectual Property Rights (TRIPS Agreement),⁷³⁵ the Paris Convention for the Protection of Industrial Property (Paris Convention),⁷³⁶ the Madrid Agreement Concerning the International Registration of Marks (Madrid Agreement),⁷³⁷ the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol),⁷³⁸ Trademark Law Treaty (TLT)⁷³⁹ and Singapore Treaty on the Law of Trademarks (Singapore Treaty).⁷⁴⁰ The Paris Convention also includes trademark confusion.⁷⁴¹ Article 6*bis* (1) requires member states of the Paris agreement to put in place measures that will prevent or prohibit the registration of marks that are ‘liable to create confusion’. The phrase ‘liable to create confusion’ has the same meaning as the phrase ‘likelihood of confusion’.

The Madrid Agreement makes no mention of the ‘likelihood of confusion’ nor does it speak on trademark infringement.⁷⁴² Comparably, the Madrid Protocol is also silent on the ‘likelihood of confusion’ and trademark infringement.⁷⁴³ Both the Madrid Agreement and the Protocol leave it to the domestic law of the member states to protect the trademark of the proprietor seeking registration.⁷⁴⁴ Similarly, the TLT does not contain a trademark confusion provision. It does not provide for the types of infringement nor does it speak about the ‘likelihood of confusion’ or similar phrases (such as ‘risk of confusion’).⁷⁴⁵ Article 15 of the TLT contains a requirement that the contracting state must comply with the Paris Convention provisions that deal with trademarks. This means that Article 6*bis* (1) becomes applicable if there are infringements of the ‘likelihood of confusion’. The Model International Form No. 6 of the TLT and Regulations⁷⁴⁶ also grants the proprietor a right to institute an action in cases of trademark

⁷³⁵ Agreement on Trade-Related Aspects of Intellectual Property Rights (signed on 15 April 1994 and came into effect on 1 January 1995).

⁷³⁶ Paris Convention for the Protection of Industrial Property (signed on 20 March 1883 and came into effect on 7 July 1884).

⁷³⁷ Madrid Agreement Concerning the International Registration of Marks [concluded in 1891 and revised at Brussels (1900), Washington (1911), The Hague (1925), London (1934), Nice (1957) and Stockholm (1967), and amended in 1979].

⁷³⁸ The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (which was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996).

⁷³⁹ Trademark Law Treaty of 1994.

⁷⁴⁰ Singapore Treaty on the Law of Trademarks concluded in 2006 and came into effect in 2009.

⁷⁴¹ See chapter 2 part 2.4.2.

⁷⁴² See chapter 2 part 2.5.1.

⁷⁴³ See chapter 2 part 2.5.2.

⁷⁴⁴ See chapter 2 part 2.5.1. and part 2.5.2.

⁷⁴⁵ See chapter 2 part 2.6.1.

⁷⁴⁶ Trademark Law Treaty and Regulations done at Geneva on October 27, 1994.

infringement. This means that the proprietor would have a right to institute action of infringements that include the ‘likelihood of confusion’.⁷⁴⁷

The chapter showed that the TRIPS Agreement is the first international agreement to speak on consumer confusion as a requirement for trademark infringement.⁷⁴⁸ First, Article 16(1) of the TRIPS Agreement prohibits the use of a mark that is identical with or similar to the trademark of the proprietor from being used on goods or services which are identical or similar to those of the owner in a way that will likely cause confusion.⁷⁴⁹

The Singapore Treaty makes provision for trademark infringement. Article 19(2) of the Singapore Treaty requires the trademark owner to show evidence of registration to be able to have a claim of infringement. The Singapore Treaty also does not provide for the types of infringement. Although it does speak about a claim of infringement, it does not distinguish between the different types of infringement or address infringements of the ‘likelihood of confusion’. Conversely, the claim of infringement addressed under Article 19(2) includes types of infringement of the ‘likelihood of confusion’. Article 29(4) of the Singapore Treaty allows member states to make reservations for Article 19(2).⁷⁵⁰ This means that nations that have reservations under Article 29(4) can require evidence of registration from the proprietor in claims of infringements of the ‘likelihood of confusion’.

Chapter three dealt with the ‘likelihood of confusion’ requirement in confusion-based infringement in SA. The chapter outlined the two types of confusion-based infringements namely: primary infringement under section 34(1) (a) and extended infringement found under section 34(1) (b).⁷⁵¹ Requirements of each type were discussed. For primary infringement the requirements are unauthorised +use; in the course of trade; of a trademark which is identical or confusingly similar to the registered trademark; and in connection with the same goods or

⁷⁴⁷ See chapter 2 part 2.6.1.

⁷⁴⁸ See chapter 2 part 2.3.2.

⁷⁴⁹ See chapter 2 part 2.3.2. See also TRIPS Agreement, Article 16(1).

⁷⁵⁰ See chapter 2 part 2.6.1.

⁷⁵¹ See chapter 3 part 3.2.

services as those covered by the registered trademark.⁷⁵² Requirements for extended infringement are unauthorised use; in the course of trade; of a mark which is identical or similar to the registered trademark; on goods or services which are so similar to the goods or services in respect of which the trademark is registered.⁷⁵³

Both section 34(1) (a) and section 34(1) (b) contain the ‘likelihood of confusion’ as a central requirement. It was revealed that section 34(1) (a) focuses on the comparison of the two marks to determine similarity.⁷⁵⁴ If there is similarity, the next step is to determine if there is a ‘likelihood of confusion or deception’.⁷⁵⁵ Goods and/or services are required to be of the same class (identical). No enquiry is made into the identity of the goods or services.⁷⁵⁶ Inversely, section 34(1) (b) focuses on determining similarity first between the marks and similarity between goods and/or services.⁷⁵⁷ If there is similarity, the next step is to determine whether or not there is a ‘likelihood of confusion’.⁷⁵⁸

In chapter three, it was found that the courts in SA have collapsed the enquiry under section 34(1) (a) to an assessment of confusingly similar marks.⁷⁵⁹ The discussion of case law under chapter three revealed that courts do not distinguish the two distinct requirements of section 34(1) (a) which are: first, comparing the marks to determine similarity; second, to enquire whether there is a ‘likelihood of confusion and deception’.⁷⁶⁰ Comparably, the collapse has also occurred under section 34(1) (b) to an assessment of the confusingly similar goods or services.⁷⁶¹ The assessment of whether or not there is a ‘likelihood of confusion’ has been

⁷⁵² Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 162. See also chapter 3 part 3.2.1.

⁷⁵³ Geyer S, Kelbrick RA & Klopper HB et al *Law of Intellectual Property in South Africa* 2 ed (2016) 164. See also chapter 3 part 3.2.1.

⁷⁵⁴ See chapter 3 part 3.3.2.

⁷⁵⁵ See chapter 3 part 3.3.2.

⁷⁵⁶ See chapter 3 part 3.3.2.

⁷⁵⁷ See chapter 3 part 3.3.3.

⁷⁵⁸ See chapter 3 part 3.3.3.

⁷⁵⁹ See chapter 3 part 3.3.2.

⁷⁶⁰ See chapter 3 part 3.3.2.

⁷⁶¹ See chapter 3 part 3.3.3.

integrated with the enquiry of whether or not the goods or services of the defendant are similar to those of the registered mark of the plaintiff.⁷⁶²

Chapter four examined the ‘likelihood of confusion’ under the UK’s trademark law. The findings made under this chapter show that section 10(1) of the UK Trade Marks Act⁷⁶³ does not require the ‘likelihood of confusion’ for primary infringement.⁷⁶⁴ The requirements for primary infringement under section 10(1) are as follows: the defendant must be using an identical sign; in the course of trade; in relation to identical goods or services; and the use must conflict with the registered mark.⁷⁶⁵ It was also established that the ‘likelihood of confusion’ is reserved only for extended infringement under section 10(2) of the UK Trade Marks Act. This section is the only section that expressly contains the phrase: ‘likelihood of confusion’. The requirements for extended infringement are: there must be a use of an identical or similar sign; in the course of trade; in relation to identical or similar goods or services; there is an existence of the ‘likelihood of confusion’.⁷⁶⁶

The ‘likelihood of confusion’ is not a requirement for primary infringement under the UK Trade Marks Act. On one hand, primary infringement requires that there must be a double identity.⁷⁶⁷ The defendant’s sign and the registered trademark must be identical and the respective goods or services must be also identical.⁷⁶⁸ The identity of goods or services is determined in terms of the classification or class to which goods or services belong to.⁷⁶⁹ There is no room for marks to be similar.⁷⁷⁰ On the other hand, extended infringement requires the defendant’s sign and the registered trademark to be similar and also the respective goods or services to be similar.⁷⁷¹ The similarity or dissimilarity of goods or services is not determined based on classes contained in the Nice Agreement Concerning the International Classification

⁷⁶² See chapter 3 part 3.3.3.

⁷⁶³ UK Trade Marks Act of 1994.

⁷⁶⁴ See chapter 4 part 4.3.1.

⁷⁶⁵ Colston C *Principles of Intellectual Property Law* (1999) 381.

⁷⁶⁶ *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] EWHC 1557 (Ch.), at 1081.

⁷⁶⁷ See chapter 4 part 4.4.2.

⁷⁶⁸ See chapter 4 part 4.4.2.

⁷⁶⁹ See chapter 4 part 4.3.1. (c).

⁷⁷⁰ See chapter 4 part 4.4.3.

⁷⁷¹ See chapter 4 part 4.4.3.

of Goods and Services for the Purposes of the Registration of Marks.⁷⁷² (the Nice Agreement).⁷⁷³ Section 10(2) also specifically states that there must be ‘*a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.*’⁷⁷⁴ The sign and the trademark, and the respective goods or services must have a similarity that leads to the ‘likelihood of confusion’.⁷⁷⁵ The ‘likelihood of association’ appears sub-category of the ‘likelihood of confusion’.⁷⁷⁶

The findings made under chapter four were that the UK courts have maintained the distinction between primary infringement (under section 10(1) infringement) and extended infringement (section 10(2) infringement). For primary infringement, the UK courts maintain a strict interpretation that requires the marks to be the same. This means that there must be a lack of modification or addition to the proprietor’s trademark for infringement to exist under section 10(1).⁷⁷⁷ Deletion of some elements of the trademark has also been ruled by the court in the UK as amounting to double identity.⁷⁷⁸ Concerning extended infringement, the UK courts have maintained the distinction between the enquiry into similarity and the ‘likelihood of confusion’.⁷⁷⁹ The courts first determine whether or not the defendant’s sign and the registered trademark are similar. It is then followed by an enquiry into the similarity of goods or services. If there is a similarity between the marks and the respective goods or services, the court moves to determine whether or not there is a ‘likelihood of confusion’. Therefore, it is a three-step enquiry.

Chapter four also undertook a comparative study of SA’s and the UK’s approach to the primary and extended infringement. In terms of primary infringement, both jurisdictions require goods or services to be of the same class in terms of the Nice Agreement. However, the UK requires an identical mark to be used on identical goods or services while SA trademark law allows the

⁷⁷² (of June 15, 1957, as revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977, and amended on September 28, 1979). The discussion of classifications in terms of Nice Agreement has already been had under chapter 3 of this research and it is, therefore, not necessary to repeat it under this chapter since both nations refer to the Nice agreement for their classifications. See also chapter 4 part 4.3.2. (b).

⁷⁷³ See chapter 4 part 4.3.2. (b).

⁷⁷⁴ UK Trade Marks Act, section 10(2).

⁷⁷⁵ See chapter 4 part 4.4.3.

⁷⁷⁶ See chapter 4 part 4.4.3.

⁷⁷⁷ *LTJ Diffusion SA v Sadas Verbaudet SA* [2003] FSR 608, paragraph 53.

⁷⁷⁸ *Fox International Group Ltd v Folly*, [2012] ECC 30, paragraph 53.

⁷⁷⁹ See chapter 4 part 4.4.3.

marks to be either identical to or ‘nearly resembling’ each other.⁷⁸⁰ In the SA Trade Marks Act the ‘likelihood of confusion’ is a prerequisite for primary infringement while the UK Trade Marks Act does not require ‘likelihood of confusion’.⁷⁸¹

In terms of the extended infringement, both jurisdictions allow the marks to be either identical or similar.⁷⁸² The UK Trade Marks Act requires the goods or services to be identical or similar to those for which the trademark is registered. In comparison, SA requires the goods or services to be similar concerning a claim for extended infringement.⁷⁸³ Both systems incorporate the requirement of the ‘likelihood of confusion’.⁷⁸⁴ Lastly, the UK Trade Marks Act includes the ‘likelihood of association’ in its provision for extended infringement. However, the SA Trade Marks Act makes no mention of the ‘likelihood of association’ but rather the ‘likelihood of confusion and deception’.⁷⁸⁵

5.2. RECOMMENDATIONS

It has been shown that the ‘likelihood of confusion’ requirement, both under primary and extended infringement, has been collapsed by the SA courts. On one hand, under primary infringement, it has been collapsed into determining whether or not the marks are similar. On the other hand, under extended infringement, it has been collapsed into determining whether or not the goods or services are similar. Therefore, it is necessary to make recommendations to resolve the problem. Under this section of chapter five, recommendations are made on how the confusion-based infringements may be amended and also how courts may avoid collapsing the requirement of the ‘likelihood of confusion’.

5.2.1. Adoption of a Better Approach to the Application of Section 34(1) (a)

The plaintiff is required to show that on a balance of probabilities that the average consumer is likely to be confused or deceived by the identical or similar mark of the defendant. A similar mark must be used on identical goods or services. The courts have collapsed the enquiry into

⁷⁸⁰ See chapter 4 part 4.6.1.

⁷⁸¹ See chapter 4 part 4.6.1.

⁷⁸² See chapter 4 part 4.6.2.

⁷⁸³ See chapter 4 part 4.6.2.

⁷⁸⁴ See chapter 4 part 4.6.2.

⁷⁸⁵ See chapter 4 part 4.6.2.

assessing whether the two marks are similar.⁷⁸⁶ The Supreme Court of Appeal (SCA) in the *Verimark (Pty) Ltd v Bayerische Motoren Werke AktienGesellschaft*⁷⁸⁷ that:

‘... What is, accordingly, required is an interpretation of the mark through the eyes of the consumer as used by the alleged infringer. If the use creates an impression of a material link between the product and the owner of the mark there is infringement; otherwise there is not. The use of a mark for purely descriptive purposes will not create that impression but it is also clear that this is not necessarily the definitive test.’⁷⁸⁸

Subsequently, the ‘likelihood of confusion and deception’ is assessed through the eyes of the average consumer. A proper application of section 34(1) (a) is required to ensure the protection of the trademark’s function as a badge of origin. Therefore, where there is a mark allegedly infringing the registered trademark, the assessment for infringement section 34(1) (a) must be a two-step enquiry. First, it must assess whether or not the defendant’s mark is identical or similar to the plaintiff’s registered trademark. Second, if similarity has been found, the court must move to assess whether or not this will lead to the ‘likelihood of confusion and deception’. This will ensure that the infringement assessment under section 34(1) (a) is not collapsed.

5.2.2. Maintaining a Distinction between the Enquiry into Similarity of Goods or Services and the ‘Likelihood of Confusion’

As observed in the discussion under chapter three, section 34(1) (b) extends the protection to include a use of an identical or similar mark being used on similar goods or services. It has been argued that the similarity between the mark and the registered trademark and the similarity between the respective goods or services is interdependent.⁷⁸⁹ The similarity of goods or services is not more important than the similarity of marks.⁷⁹⁰ However, the enquiry into the similarity of marks appears to be suppressed or less prominent than that of the similarity of goods or services.⁷⁹¹ The question of similarity of marks is distinct from the question of similarity of goods or services.⁷⁹²

⁷⁸⁶ See chapter 3 part 3.3.2.

⁷⁸⁷ 2007 (6) SA 263 (SCA).

⁷⁸⁸ *Verimark (Pty) Ltd v Bayerische Motoren Werke AktienGesellschaft; Bayerische Motoren Werke AktienGesellschaft v Verimark (Pty) Ltd*, paragraph 7.

⁷⁸⁹ See chapter 3 part 3.2.2. (a).

⁷⁹⁰ Karjiker S ‘The Role of Reputation in Trade Mark Infringement’ (2018) 2018(4) *Journal of South African Law* 733.

⁷⁹¹ Karjiker S ‘The Role of Reputation in Trade Mark Infringement’ (2018) 2018(4) *Journal of South African Law* 733.

⁷⁹² Karjiker S ‘The Role of Reputation in Trade Mark Infringement’ (2018) 2018(4) *Journal of South African Law* 733.

Therefore, for the court not to collapse the assessment of infringement under section 34(1) (b), the enquiry must consist of three steps. First, the enquiry must determine whether or not the defendant's allegedly infringing mark is similar to the plaintiff's registered trademark. Secondly, it must enquire whether or not the respective goods or services of the marks are similar. Thirdly, if similarity has been established under the first two steps, the court must move to assess whether or not there is a 'likelihood of confusion or deception'. This three-step enquiry will ensure that assessment for infringement under section 34(1) (b) is not collapsed.

5.2.3. Proposed Changes to Section 34(1) of South Africa's Trade Marks Act

The UK has a different approach to both primary and extended infringement. In the UK, for primary infringement, the claimant proves that there is a double identity.⁷⁹³ There is no requirement of the 'likelihood of confusion' and that of similarity of marks.⁷⁹⁴ The 'likelihood of confusion' is only a requirement for extended infringement. SA has the 'likelihood of confusion and deception' as a requirement for both primary and extended infringement. This has resulted in the courts blurring the lines between these subsections.

Accordingly, an alternative to the recommendation made in 5.2.1 is that section 34(1) (a) of the SA Trade Marks Act can only focus on double identity. The subsection can read as follows:

The rights acquired by registration of a trade mark shall be infringed by the unauthorised use of identical mark in the course of trade in relation to goods or services in respect of which the trade mark is registered.

The plaintiff will have to prove that: first, the defendant is using a mark identical to the plaintiff's registered trademark; secondly, that it is being used in relation to goods or services of the same classification as those of the registered trademark. The above provision excludes 'nearly resembling mark' and this will eliminate the need for the 'likelihood of confusion' with regard to primary infringement. This approach will be consistent with the UK approach.

⁷⁹³ See chapter 4 part 4.4.2.

⁷⁹⁴ See chapter 4 part 4.4.3.

Section 34(1) (b) may, therefore, be the only confusion-based infringement. This subsection can read as follows:

The rights acquired by registration of a trade mark shall be infringed by the unauthorised use in the course of trade of a:

- i. mark that is identical to registered trademark being used in relation to similar goods or services;
 - ii. mark that is similar to registered trademark being used in relation to identical goods or services;
- that in such use there exists the likelihood of deception or confusion.⁷⁹⁵

This section will be applicable in the absence of dual identity. The ‘likelihood of confusion or deception’ will be reserved for only extended infringements. The section will also apply in cases of double similarity. This approach can also avoid the blurring of the lines between the two subsections and it will ensure that the assessment of whether there is a ‘likelihood of confusion or deception’ remains a distinct requirement that involves a value judgement. In applying this provision, courts should again not collapse the ‘likelihood of confusion or deception’ into the test for assessing whether the relevant goods or services are similar. The ‘likelihood of confusion or deception’ should, therefore, remain a distinct requirement.

5.3. FINAL CONCLUSION

This thesis has revealed that the ‘likelihood of confusion or deception’ is central to primary and extended infringement. SA courts have collapsed the requirements for confusion-based infringements under subsections 34(1) (a) and (b).⁷⁹⁶ The assessment of the ‘likelihood of confusion or deception’ has been merged with the test for assessing the similarity of the infringing mark and the registered mark, or the similarity of the goods or services with respect to extended infringement. This research has thus shown that the approach to the ‘likelihood of confusion and deception’ currently being employed by the courts is a cause for concern and it needs to be revised to ensure that there is a coherent and consistent approach. The confusion-based infringement provisions protect the very fundamental function of a trademark as a badge of origin. These provisions seek to avoid potential confusion that would affect the average

⁷⁹⁵ The wording has been drawn from both section 10(2) of the UK Trade Marks Act and section 34 of the SA Trade Marks Act of 1993.

⁷⁹⁶ As explained earlier, the enquiry into the ‘likelihood of confusion or deception’ has been made part of the enquiry as to whether or not the defendant’s goods or services are similar to those for which the trademark has been registered.

consumer in the marketplace. More importantly, it could result in a loss of profit for the proprietor if the confusion eventually materialises and the consumer ends up purchasing the products of the defendant. SA can draw good lessons from the UK courts' approach to both primary and extended infringement. It is necessary that the collapsing of the enquiries of the confusion-based subsections be amended so that there is clarity in the application of the 'likelihood of confusion or deception' requirement in trademark infringement claims.

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