

SOUTH AFRICA / JUDGMENT

Accounting Made Easy CC v School Accountin Made Easy (Pty) Ltd (81365/2016) [2019] ZAGPPHC 215 (25 June 2019) [2019] ZAGPPHC 215

COURT

North Gauteng High Court, Pretoria

BEFORE

Makhoba

CASE / FILE NUMBER

81365/2016

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REPUBLIC

OF SOUTH AFRICA

IN

THE HIGH COURT OF SOUTH AFRICA

GAUTENG

DIVISION, PRETORIA

DATE:25/6/2019

CASE

NO: 81365/2016

In

the matter between:

ACCOUNTING
MADE EASY CC
APPLICANT
And
SCHOOL
ACCOUNTIN MADE EASY (PTY) LTD
RESPONDENT
In
the counter application between
SCHOOL
ACCOUNTIN MADE EASY (PTY) LTD
APPLICANT
ACCOUNTING
MADE EASY CC
1st
RESPONDENT
THE

REGISTRAR OF TRADE MARKS: 2ND
RESPONDENT
THE
COMPANIES AND INTELLECTUAL
PROPERTY
COMMISSION

JUDGMENT

MAKHOBHA, AJ

- [1] This is an application for the relief to interdict and restrain the respondent in terms of section 34 (1) (a) of the Trade Marks Act 1993. The applicant trades under the name "Accounting Made Easy" whereas the respondent trades under the name "School Accounting Made Easy" both the applicant and the respondent offer lessons in accounting to various institutions of learning and offer as well learning materials in different ways. The applicant is seeking exclusive right to use the mark accounting made easy.
- [2] In a counter application the respondent contends that the applicant's mark is not registrable because it is generic and more description of a product for educational purposes and seeks the removal of the applicant's registered accounting made easy mark in terms of section 24 (1) read with section 9 and 2 (a) and (b) of the Trade Mark Act.
- [3] The registrar of Trade Marks has, however, taken no part in the litigation and abides by the decision of the court. The matter was argued on the papers and without either party seeking a reference to evidence.
- [4] The applicant is Accounting Made Easy CC a South African close Corporation registered in 2009 with its registered office at 8 Danga

Road, Victory Park Johannesburg. Mr Mark Samowitz is the sole member. The applicant provides short courses in accounting primarily to employees and to the general public at monthly seminars. The clients include school and university accounting students. These courses are presented under the trade mark Accounting made easy and printed material is also provided with the branded mark.

- [5] The respondent was registered on the 20th August 2014 under the domain name schoolaccountingmadeeasy.co.za and Mr Muller is the director. The respondent markets and supplies inter alia accounting electronic workbooks, lessons and tools either through its website or on a lockable USB. Its customers are government schools, IEB schools, ACE (Accelerated Christian Education School) and Cambridge curriculum school, bookshop, home scholars, teachers and individual learners. It also supplies its books on accounting practice to private schools in South Africa and to book shops in Namibia.

[6] Section 34(1) (a) of the Trade Mark Act no 194 of 1993 provides as follows: "(1) The rights acquired of a trade mark shall be infringed by-

(a) the authorized use in the course of trade in relation to goods or service in respect of which the trade mark is registered, of a mark so nearly resembling it as to be likely to deceive or cause confusion"

[7] Section 24 (1) of the same Act reads as follows:

"In the event of non-insertion in or omission from the register of an entry, or of any entry wrongly made in or wrongly remaining on the register, or of any error or defect in any entry in the register, any interested person may apply to the court or, at the option of the applicant and subject to the provisions of section 59, in the prescribed manner, to the registrar, for the desired relief: and thereupon the court or the registrar, as the case may be, may make such order for making, removing or varying the entry as it or he may deem fit."

[8] It was submitted on behalf of the applicant that the respondent mark "school accounting made easy incorporates the whole of applicant's registered trade mark and is plainly deceptive and similar to applicant's registered trade mark and thus it infringes applicant's registration in terms of section 34 (1) (a) of the Act and the court should invoke section 34 (3) of the Act and interdict the respondent.

[9] For the respondent counsel submitted that accounting made easy is not trade mark. It is inherently distinctive it only indicates the actual intended purpose and characteristics of the goods and service offered

under the mark, that is, the offering of teaching services and educational books so that accounting is made easy.

[10] The dispute between the two parties requires a comparison of the marks, in the circumstances in which they can be expected to be encountered, to determine whether they so nearly resemble one another that a substantial number of persons will probably be deceived into believing that the respondent's goods or services originates from or are connected with the applicant's trade mark or at least be confused as to whether that is so.

[11] in matters of his nature, our courts had always followed the decision in *Plascon-Evans paints Ltd v Van Riebeeck paints (Ltd)* Ltd[1984] ZASCA 51; , 1984 (3) SA 623 (A) .In this decision the court said the following on p640G

"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 established that a substantial number of such persons will be deceived or confused. If the concept of deception or confusion is not limited to inducing in the minds of interested person the erroneous belief or impression that the goods in relation to which he defendant's mark is used

are the goods of the proprietor of the registered mark, ie the plaintiff, or that there is a material connection between the defendant's goods and the proprietor of the registered mark; it is enough for the plaintiff to show that a substantial number of persons will probably be confused as to the origin of the goods or the existence or non-existence of such a connection.

The determination of these questions involves essentially a comparison between the mark used by the defendant and the registered mark and, having regard to the similarities and differences in the two marks, an assessment of the impact which the defendant's mark would make upon the average type of customer who would be likely to purchase the kind of goods to which the marks are applied. This notion customer must be conceived of as a person of average intelligence, having proper eyesight and buying with ordinary caution. The comparison must be made with reference of the sense, sound and appearance of the mark. The marks must be viewed as they would be encountered in the market place and against the background of relevance surrounding circumstances. The marks must not only be considered side by side, but also separately. It must be borne in mind that the ordinary purchaser may encounter goods, bearing the defendant's mark, with an imperfect recollection of the registered mark and due allowance must be made for this. If each of the marks contains a main or dominant feature or idea the likely impact made by this on the mind of the customer must be taken into account. As it has been put, marks are remembered rather by general impressions or by some significant or striking feature than by a photographic recollection of the whole. And finally consideration must be given to the manner in which the marks are likely to be employed as, for example, the use of name marks in conjunction with a generic description of the goods.

At page 642 E CORBETT JA went on to say"

"As I have emphasized, however, the comparison must not be confined to a viewing of the marks side by side. I must notionally transport myself to the market place (see the remarks of COLMAN J in *Laboratoire Lacharte SA v Armour- Dial Incorporated* 1976 (2) SA 744 (T) at 746D) and consider whether the average customer is likely to be deceived or confused. And here I must take into account relevant

surrounding circumstances, such as the way in which the goods to which the marks are applied are marketed, the types of customer who would be likely to purchase the goods, matters of common knowledge in the trade and the knowledge which such purchase would have of the goods in question and the marks applied to them"

[12] The applicant in this matter before this court must therefore prove that the mark "school accounting made easy" may cause confusion or deceive customers as it so closely resembles the applicant's registered mark. The applicant only have to show that a substantial number of persons may be confused as to the origin of the respondent's mark. To put it simple this court must decide whether there is any likelihood of deception or confusion in the market place in relation to the use of the two marks.

[13] There are a number of decisions dealing with the likelihood of deception or confusion in regard to either the sense, sound or appearance of the two marks. I will refer to few of them in order to illustrate what the court's approach should be.

[14] In *Sabel BP V Puma AG, Rudolf Dassler Sport* (1998] RPC 199 (ECJ) at 224 it was held:

"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...

In that perceptive, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive, either per se or because of the reputation it enjoys with the public. "

[15] In *African Sun Oil Refineries (Pty) Ltd v Unilever p/c* 2007 BIP 127 (NPD) at p132 Hurt J said the following "where an invented word has been registered as a mark, a person subsequently selecting an invented word for his mark, who has the whole spectrum of possible permutation of the letters of the alphabet at his disposal, should take care no to select a permutation which is too close to the registered mark. "

[16] In *John Craig (Pty) Ltd v Dupa Clothing Industries* 1977 (3) SA 144 (T) at 151 King AJ found:

"A reasonable likelihood of deception or confusion in regard to either the sense, sound of appearance of the two marks will suffice to discharge the onus on the applicant. Vide, *Cavalla Ltd v International Tobacco Co. of South Africa.*, 1953 (1) SA 461 (D. PARKER, J., in the *Pianotist* case, 23 R.P.C. 777, said:

"You must take two words; you must judge them by their look and their sound; you must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy these goods. In fact you must consider all the surrounding circumstances and you must further consider what is likely to happen if each of those trademarks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If after considering all the circumstances you come to the conclusion that there will be confusion, that it to say not necessarily that one man will be injured and the other will gain illicit benefit- but that there will be confusion in the mind of the public which lead to confusion in the goods, then you must refuse registration in that case. "

[17] In *Yuppiechef Holdings (Pty) Ltd v Yuppie gadgets Holdings (Pty) Ltd* (108/2015) 2016 ZASCA 118 (15 September 2016) in paragraph 13 the court said the following

"[13] In *Rembrandt Fabrikante & Handlaas (Edms) Bpk v Gulf Oil Corporation Trollip J* said that the stationary system of trademark protection 'is designed to protect, facilitate and further the trading in the particular goods in respect of which the trade the trademark is registered'. Save that, since he said that, it has become possible to register trademarks in respect of trading in

services as well as goods, the statement remains opposite. The trademark serves as a badge of origin of the goods or services to which it is applied. The reference to a badge of origin is directed at the original source of the goods or services, not the mechanism through which they were acquired. Thus, to say that one bought a pair of shoes at A & D Spitz or some other well-known shoe store merely identifies the shop where the goods were purchased and not their origin. The shoes in question will in turn bear a trademark, such as Carvela or Kurt Geiger or Jimmy Choo. Those are the marks that indicate their origin. The mark A & D Spitz identifies the shop not the goods that can be purchased there"

- [18] The marks that the applicant seek to protect are registered in respect of courses in accounting he provides and the learning material branded with the mark given to the attendees. The applicant gives these courses under its trade mark "Accounting made easy" whereas the respondent's customers are government schools, IEB schools, bookshops, home scholars, teachers and individual learners. Therefore in my view their marker is not completely the same.
- [19] The use of the same mark on other goods or services, falling outside the class of goods or services covered by the registration, does not amount to an infringement under section 34 (1) (a) See Yuppiefchef Holdings decision referred to above on para 17.
- [20] That brings me to the defence of the respondent. First the respondent submits that there are numerous different proprietors who have registered the phrase "MADE EASY" and the phrase can never indicate origin. Secondly it is simply impossible in such circumstances for the average consumer to associate the use of a descriptive word accompanied with the phrase "MADE EASY" with any particular mark proprietor. Thirdly the phrase school accounting made easy is descriptive of school accounting and therefore was not an infringement under section 34 (1) (a).
- [21] It is an undeniable truth that the phrase "MADE EASY" is used by many proprietors all over the world including South Africa. This court accepts therefore that the applicant cannot claim that the phrase "made easy" can only be associated with the mark "accounting made easy".
- [22] The obvious point of similarity between the two marks lies in the use of the phrase "Accounting made easy" Counsel for the applicant laid considerable emphasis on the actual confusion elicited by the mark school of accounting made easy. In the Yuppiefchef Holding case supra page 22 paragraph 38 the court said" ... "there are many cases in which it has been said that it is not the purpose of trade marks or copyright to enable people to secure monopolies on the commons of the English language"
- [23] In my view the mark "school accounting made easy" it is a unique mark for the business which is the school of accounting made easy and it can be distinguished from other similar marks there is no possibility of confusion. Similarly the mark "accounting made easy" it is a unique mark for the business conducted by the applicant and equally well it can be distinguished from other similar marks and there is no possibility of confusion. Moreover the services rendered by the two businesses can be distinguished from each other.

Furthermore they use different logos and their clients are not the same. The defences raised by the respondent to the claim of infringement under section 34 (1) (a) had to succeed. The applicant's action is dismissed with costs.

Counter application

- [24] In answering the counter application counsel for the applicant submitted that applicant's trade mark registrations were granted after due considerations by the second respondent in re-convention. The concept of the mark is by its nature descriptive. The trademark consist of the descriptive word "accounting" qualified with the phrase made easy.
- [25] On behalf of the respondent it is submitted that "accounting made easy" registration as a trade mark is of no significance. In addition counsel for the respondent submitted that the applicant itself does not use the phrase accounting made easy as a trade mark.
- [26] The question to be answered by the court is whether the mark is an entry wrongly remaining on the register on the grounds that it is incapable of distinguishing and is descriptive. The applicant bears an onus of establishing that its mark of Accounting made easy is capable distinguished and not descriptive.
- [27] Having found that the applicant's trade mark can be distinguished from other trademarks it follows that the counter application must fail and it is dismissed with costs.

D. MAKHOBHA

ACTING JUDGE OF THE GAUTENG DIVISION, PRETORIA

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