

SOUTH AFRICA / JUDGMENT

Adidas AG and Another v Pepkor Retail Ltd (187/12) [2013] ZASCA 3; 2013 BIP 203 (SCA) (28 February 2013)

[2013] ZASCA 3

COURT

Supreme Court of Appeal

BEFORE

Brand, Heher, Petse, Southwood, Erasmus

CASE / FILE NUMBER

187/12

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THE SUPREME COURT OF APPEAL OF SOUTH AFRICA

JUDGMENT

Case No: 187/12

In the matter between:

ADIDAS AGFirst Appellant

ADIDAS INTERNATIONAL MARKETING BVSecond Appellant

and

PEPKOR RETAIL LIMITEDRespondent

Neutral citation: Adidas AG & another v Pepkor Retail Limited (187/12) [2013] ZASCA 3 (28 February 2013)

Coram: Brand, Heher, Petse JJA and Southwood and Erasmus AJJA

Heard: 19 November 2012

Delivered: 28 February 2013

Summary: Trade mark infringement and passing off – appellants relying on four well-known registered three parallel stripe trademarks for infringement and the same registered as well as unregistered three stripe trademarks applied to their sporting footwear for passing off – respondent’s use of two and four parallel stripes on its sporting footwear alleged to infringe the first appellant’s trademarks in terms of s 34(1)(a) of the Trade Marks Act 194 of 1993 – also alleged to pass off the respondent’s footwear as those of the appellants – respondent’s use of the two and four parallel stripes on its footwear, trademark use and not decoration or embellishment –

appellants not impermissibly

extending the ambit of their rights – the fact that appellants’ three parallel stripes trademarks so well-known not eliminating the likelihood of deception or confusion, but increasing it – respondent’s four stripe marks infringing registered trademarks – respondent’s get-up incorporating four stripes a passing off.

ORDER

On appeal from: Western Cape High Court, Cape Town (Allie J sitting as court of first instance):

1. The appeal is upheld with costs, such costs to include the costs of two counsel.
2. The order of the court a quo dismissing the application with costs is set aside and replaced by the following order:

‘(a) The respondent is interdicted and restrained from infringing the first applicant’s rights acquired by the registration of trademarks numbers 1957/01959, 1995/12283, 1980/6446 and 2000/18582 (‘the registered trademarks’) by using in the course of trade in relation to goods for which the registered trademarks are registered, a mark consisting of four parallel stripes of a colour or material different from the colour or material of the footwear, and on the outside of the uppers of the footwear, to which they are applied, as represented in annexures TB8 and TB9 to the founding affidavit of Timothy George James Behean (‘the infringing marks’) or any other mark so nearly resembling the registered trademarks as to be likely to deceive or cause confusion as contemplated in s 34(1)(a) of the Trade Marks Act 194 of 1993 (‘the Act’);

(b) The respondent is directed to remove the infringing marks from its footwear and, where the infringing marks are inseparable or incapable of being removed from the respondent’s footwear, it is ordered that all such footwear be delivered to the first applicant as provided for in s 34(3)(b) of the Act;

(c) An enquiry is directed to be held for the purposes of determining the amount of any damages (as contemplated in s 34(3)(c) of the Act) or reasonable royalty (as contemplated in s 34(3)(d) of the Act) to be awarded to the first applicant as a result of the infringement of the first applicant’s rights acquired by the registration of the registered trademarks, in accordance with such procedures as this Court may deem fit (as contemplated in s 34 (4) of the Act), and that the respondent pay the amount found to be due to the first applicant;

(d) The respondent is interdicted and restrained from passing off its footwear as being that of the applicants or as being connected in the course of trade with the applicants by using in relation thereto a get-up as depicted in annexures TB9, TB10 and TB11 to the founding affidavit of Timothy George James Behean (including such trademarks as are depicted in those annexures) or any other get-up (including any trademarks) so closely resembling the get-ups (including any trademarks) of the applicants’ footwear as depicted in paragraph 24 of the founding affidavit of Timothy George James Behean as to be likely to deceive or cause

confusion;

- (e) An enquiry is directed to be held for the purposes of determining the amount of any damages to be awarded to the applicants as a result of the respondent's passing off as aforesaid and that the respondent pay the amount found to be due to the applicants and it is directed that, in the event of the parties being unable to reach agreement as to the further pleadings to be filed, discovery, inspection, or other matters of procedure relating to the enquiry, either party may make application to the court for directions in regard thereto;
- (f) The respondent is ordered to pay the costs of the application, including the costs of two counsel.'

SOUTHWOOD AJA (BRAND, HEHER AND PETSE JJA AND ERASMUS AJA CONCURRING):

- [1] The first appellant, a German corporation, the parent company of the Adidas group of companies, and the second appellant, a Netherlands corporation, and a wholly-owned subsidiary of the first appellant, brought an application against the respondent in the Western Cape High Court, Cape Town, in which they alleged that the respondent was infringing the first appellant's rights in respect of four well-known three stripe trademarks and that the respondent was passing off its sporting footwear as that of the appellants. The respondent brought a counter-application for the entry of disclaimers in terms of s 15 of the Trade Marks Act 194 of 1993 (the Act).¹ The court a quo (Allie J) found that the respondent was not infringing the trademarks or passing off its goods as those of the appellants and dismissed the application. The court a quo also dismissed the respondent's counter-application. The appellants appeal to this Court with the leave of the court a quo. The respondent has not sought to cross-appeal.
- [2] The nature and renown of the Adidas business, its products and trademarks was not in dispute and may be briefly summarised. Mr Adi Dassler (Adidas is a combination of his names), who was both an athlete and a shoemaker, founded the Adidas business in 1920. His aim was to create, for athletes, footwear of the highest quality and he developed shoes specially designed for almost every Olympic sport. In doing so, he pioneered the use of technology in the development of athletic shoes and he worked closely with leading athletes and trainers as well as experts in medicine and materials and various other fields. The high quality of his adidas products was soon recognised and since 1928 an increasing proportion of the athletes competing at the Olympic Games have worn his shoes. Adi Dassler also designed soccer boots, which have also been particularly successful and these boots, including the Predator soccer boot, have become the most widely worn soccer boots at the FIFA World Cup and the European Soccer Championships. In 1967 Adi Dassler extended his range of products to include sports clothing: tracksuits and jackets and then shorts and jerseys. In 1974 he began to manufacture and sell sporting equipment such as bags, balls and tennis rackets. All these products have become very successful and have been adopted by sportsmen and women all over the world. Over time the business was taken over by the first appellant and, as it diversified, by other companies in the Adidas

group of companies.

- [3] For many years the Adidas products have been extensively advertised, marketed and promoted throughout the world, including South Africa, and the strategy of associating the products with top class athletes has proved to be very successful. Adi Dassler devised the three stripe trademark and started using it on the first appellant's footwear in 1949. From the outset the focus was on the distinguishing function of the three stripes and the slogan 'die MARKE mit den 3 RIEMEN' ('the mark with the 3 stripes') was adopted. The first appellant's advertising and promotional literature has always emphasised that the first appellant's products can be identified by the three stripe mark. In 1967 the business started using the three stripe mark on clothing such as tracksuits, jackets and trousers. The three stripe mark has become an exceptionally valuable and distinctive mark because of its high degree of visibility. This enables Adidas products to be recognised and distinguished from a distance, something which is very important in the field of sporting products because it enables Adidas products to be easily recognised when worn by Adidas sponsored athletes and teams.
- [4] As a result of its marketing and promotion and extensive and prominent use, the three stripe mark has become highly distinctive and it is readily identified by consumers as a badge of origin of adidas products.
- [5] The respondent is a South African company. It conducts retail businesses by means of divisions such as Ackermans and Pep Stores, which, independently, carry on their businesses throughout South Africa. Both sell clothing and footwear. Ackermans caters for the mass middle market. It is a value retailer which sells, at low prices, everyday contemporary casual wear, as well as fashion clothing and footwear and it also stocks an assortment of more styled products including national and international brands. It sells the international 'Hang Ten' brand at its 'Hang Ten' outlets. Pep Stores carries on its business at more than 1 300 outlets. It is a cash business, has a low cost culture and it keeps its margins as low as possible. It sources its merchandise both locally and internationally to provide its customers with a wide range of good quality and fashionable merchandise. Pep Stores caters for consumers in the lower to middle markets.
- [6] For many years well-known manufacturers of sporting footwear, who market and sell their products in South Africa, have applied stripes of all shapes and sizes to their products – sometimes one, sometimes two and sometimes four or five and even more. The modern South African consumer is therefore exposed to such products and their get-ups and has to be able to distinguish between these products and the appellant's products.
- [7] The first appellant is the proprietor of four trademarks, each consisting of three parallel stripes of a specific configuration. The second appellant holds the rights in respect of the get-ups in respect of two of the sports shoes involved in this case: the 2006 Predator soccer boot and the adi Racer/Tuscany shoes. The appellants market and sell in South Africa, through adidas (South Africa) (Pty) Ltd, a wholly-owned subsidiary of the first appellant, sporting footwear, particularly trainers, which bear the appellants' registered and unregistered three

stripe trademarks. The South African company does this through its own retail outlets as well as a variety of independent retail outlets such as Foschini, Edgars, Sportsman's Warehouse, The Cross Trainer and Studio

88. The appellants have been doing this for many years and, as a result, the trademarks and the get-ups of their clothing and footwear are very well known in this country. In about October 2007 the appellants discovered that Ackermans and Pep Stores were selling trainers and soccer boots which prominently featured two and four parallel stripes which the appellants considered to be an infringement of the first appellant's four trademarks and also a passing off by the respondent of its goods as being those of the appellants. The appellants' attorney addressed letters to Ackermans and Pep Stores demanding that they cease their wrongful conduct and, after they refused to comply with the demands, the appellants launched their application for interdicts and ancillary relief. It was clear from the respondent's attorney's letters that the respondent denied that it was infringing the trademarks or passing off its trainers and soccer boots as those of the appellants by using the two and four stripe marks and that it would continue to do so unless restrained by an interdict.
- [8] In its answering affidavit the respondent said that it was no longer selling these goods when the application was launched and contended that the court should not grant interdictory relief. However, after the appellants demonstrated that the respondent's contention was factually unfounded the respondent did not persist with it. In any event the respondent's attitude that it saw nothing wrong in marketing its sporting shoes bearing the contentious marks was good reason for the appellants to apprehend that the wrongful conduct complained of would continue. Against that background I shall first consider the question of infringement.
- [9] The first appellant relied on s 34(1)(a) of the Act for its case based on trademark infringement.² The section provides that the rights in respect of a trademark are infringed by the unauthorised use in the course of trade in relation to goods in respect of which the trademark is registered, of an identical mark or of a mark so nearly resembling the registered trademark as to be likely to deceive or cause confusion. The section provides the same protection as s 44(1)(a) of the old Trade Marks Act³ and the principles applicable to that section, laid down in the decided cases, are equally applicable to s 34(1)(a) of the Act.⁴
- [10] The first appellant's trademarks are reproduced in the schedule at the end of this judgment. The following features of these trademarks are of importance:
- (1) Trademark No 1957/01959 is registered in Class 25 in respect of 'sporting footwear of all kinds' and consists of '... three stripes of a colour different to the colour of the shoe to which they are applied. The three stripes run parallel from the fastening downwards to the sole of the shoe and appear on both sides as illustrated in the representation filed. The three stripes will run parallel to each other, be of equal width and be equidistant from each other in the manner depicted in the representation affixed to the application';

- (2) Trademark No 1995/12283 is registered in Class 25 in respect of 'Clothing, footwear, headgear' and consists of '... three equally spaced parallel stripes of the same colour, such stripes being applied to the exterior of the goods covered by the specification. The colour of the stripes contrasts with the colour of that part of the goods to which the stripes are applied. The length of the three stripes varies according to the location of the stripes on the goods';
- (3) Trademark No 1980/06446 is registered in Class 25 in respect of 'sporting footwear of all kinds' and consists of '... three stripes appearing on footwear in the position depicted in the representation affixed to the application. The three stripes will run parallel to each other, be of equal width and be equidistant from each other in the manner depicted in the representation affixed to the application';
- (4) Trademark No 2000/18582 is registered in Class 25 in respect of 'articles of clothing including footwear' and consists of '... three equally spaced stripes, in one or more colours, on the outside of the uppers of the footwear. The stripes are contrasting in colour or material with that part of the upper on which they appear'.
- [11] The first appellant alleged that the respondent was infringing its rights in terms of s 34(1)(a) of the Act by using two and four parallel stripes of a particular configuration on six different items of sporting footwear, which

included five trainers and one soccer boot⁵ and are depicted in the schedule at the end of this judgment.⁶ These are -

- (1) The LDS Sports shoe bearing four stripes (annexures TB8 and AA16);
- (2) The Mens' ATH Leisure shoe bearing four stripes (annexures TB9 and AA17);
- (3) The soccer boot bearing four stripes (annexures TB10, AA18 and AA19);
- (4) The Boys' ATH Leisure shoe bearing four stripes (annexures TB11, AA20 and AA21);
- (5) The 'Hang Ten' shoe bearing two stripes (annexures TB12, AA22 and AA23);
- (6) The 'Girls Must Have' shoe bearing two stripes (annexures TB13, AA24 and AA25).

[12] Apart from denying any deceptive similarity between the two and four stripes applied to its footwear and the first appellant's trademarks, the respondent raised a number of other defences or contentions, which it will be convenient to consider first.

[13] These are listed in the respondent's counsels' heads of argument as follows:

- (1) The stripes on the respondent's shoes are not used as trademarks, but as embellishments or decoration. The respondent's own or licensed trademarks, as depicted on the goods, serve to indicate the source of the goods;

- (2) The protection afforded by the first appellant's registered trademarks is limited to three parallel stripes (and not to any other number of parallel stripes) configured in terms of its trademark registrations;
 - (3) The first appellant has impermissibly sought to expand the scope of the protection afforded by its registered trademarks by claiming generic features of shoes as constituent elements of its trademarks. Apart from the particular three-stripe configuration of its registered trademarks, the further 'dominant and striking' features relied upon by the appellants for the impermissible extension of its monopoly are in fact non-distinctive, ubiquitous, in the public domain and common to standard trainers featuring fashionable, but commonplace, decorative striping;
 - (4) The Adidas three stripe trademark is so notorious, recognisable and distinctive that there is no likelihood that a consumer of the goods concerned would, when confronted with trainers featuring two or four parallel stripes in a decorative fashion, be confused into believing that they are the goods of, or are associated with, the appellants;
 - (5) The appellant's reliance on previous South African judgments and foreign judgments is misplaced and of extremely limited assistance, since those cases cannot assist the factual inquiry and comparative analysis this Court is enjoined to make on the facts of this case. In my view there is no merit in any of these contentions and they serve only to divert attention from the key issue of whether the two and four stripes applied to the respondent's footwear so nearly resemble any of the first appellant's trademarks as to be likely to deceive or cause confusion.
- [14] The first defence raises the question of whether the respondent was using the two and four stripes as trademarks or not: whether they were 'marks' (they were clearly 'ornamentation' and were covered by the definition of 'mark') used in relation to goods for the purpose of distinguishing these goods from the same kind of goods connected in the course of trade from any other person (and would therefore be 'trademarks' as defined in the Act). This is a factual issue, which must be determined, objectively, by how the marks would be perceived by the consumer. It seems to me that it will be very difficult to persuade a court that any mark applied to goods for 'embellishment' or 'decoration' (which are both covered by the ordinary meaning of 'ornamentation') is not applied for the purpose of distinguishing the goods.⁷ In *Puma AG Rudolf Dassler Sport v Rampar Trading (Pty) Ltd*⁸ this Court said (in the context of counterfeiting in terms of the Counterfeit Goods Act,⁹ which the court said by its very nature amounts a fortiori to trademark infringement) that one cannot use a trademark and then argue that it was used as ornamentation and that where the registered mark consists of three stripes it would be a question of fact whether the use of two or four stripes would be perceived as decorative or as trademark use. As far as the factual enquiry is concerned, this Court said in *Verimark (Pty) Ltd v BMW AG; BMW AG v Verimark (Pty) Ltd*,¹⁰ that for infringement it must be established that consumers are likely to interpret the mark, as it is used by the third party, as designating or tending to designate the undertaking from which the third party's goods originate. If the use creates an impression of a material

link between the product and the owner of the mark there is infringement, otherwise not.¹¹

[15] It is obvious that if the respondent used marks identical to the first appellant's marks the respondent's marks would be perceived to be trademarks. The consumer is used to manufacturers of sporting footwear applying a variety of stripes to their products to identify them (the adidas stripes are merely one example) and there is no reason why the consumer would perceive marks similar to the first appellant's registered trademarks to be merely embellishment or decoration. The respondent had not advanced any reason other than the fact that many manufacturers apply stripes to their products but that begs the question. If they apply these stripes to identify the product that is trademark use. The fact that the respondent uses other trademarks on its footwear would not alter this perception or the legal position. In dealing with an argument that the offending mark was not used as a trade mark because another mark was also applied to the goods, the court said in *Luster Products Inc v Magic Styles Sale* CC12:

'As I understood him this submission rested on the statement that in all cases the containers also bore the words "Magic Style".

This, he said, was a trade mark and it followed that S-curl was not being used as a trade mark. I find this difficult to follow. I know of no principle that says that the use of one mark on a product excludes the possibility that any other mark thereon can be a trade mark. The simple fact is that the respondent's S-curl mark is being used on the goods and in relation to the goods in respect of which the trade mark is registered. That would seem to me to bring the respondent's use wholly within the terms of s 44(1)(a),

it also being common cause that it was unauthorised use'.

[16] As far as the second and third contentions are concerned, the respondent appears to be attempting to limit the ambit of the first appellant's trademarks without formally seeking an amendment of the registrations in terms of the Act. It will be remembered that the respondent was unsuccessful in its application for a disclaimer to be entered in respect of each registered trademark and has not sought to appeal against that order. Each of the first appellant's trademarks consists of three stripes, in a specific configuration, the colour of which contrasts with the colour of the material to which they are applied. Each registration incorporates a description of the mark and three of the registrations have a graphic representation of the mark showing the configuration of the stripes. Subject to the other relevant provisions of the Act, the limits of the protection conferred by the registration of the trademarks are determined by the provisions of s 34. Section 34(1)(a) extends the protection to preclude use of marks which so nearly resemble the registered mark as to be likely to deceive or cause confusion and s 34(1)(b) and

(c) extend the protection to preclude the use of marks which are 'similar' to the registered trademarks.¹³ The first appellant is simply seeking to enforce its rights in terms of s 34(1)(a) to prevent the use of marks which, it contends, so nearly resemble its registered trademarks as to be likely to deceive or cause confusion. The first appellant cannot informally extend

the ambit of the registered trademarks. Each allegedly infringing mark must be compared with each registered mark (as recorded in the register) to determine whether deception or confusion is likely.¹⁴ It is the mark as it appears on the register that the first appellant is entitled to protect.

- [17] As far as the fourth contention is concerned, the question of whether the first appellant's trademarks are so famous ('notorious, recognisable and distinctive') that there is no likelihood that a purchaser of the trainers and soccer boots would be confused by the respondent's two and four stripes is not a separate defence but simply a relevant circumstance which must be considered when the marks are compared for purposes of determining the issue of whether there is a likelihood of deception or confusion.
- [18] As far as the fifth contention is concerned, the first appellant is obviously entitled to rely on South African (and other) judgments, as persuasive, if not decisive precedents, if they were decided by applying the same principles (as are now involved) to the same or similar facts. The case of *Adidas Sportschuhfabriken Adi Dassler KG v Harry Walt & Co (Pty) Ltd* 1976 (1) SA 530 (T) is a case in point. It involved the infringement of trade mark no 1959/57 (the three stripe mark in the specific configuration on both sides of sporting footwear) in terms of s 44(1)(a) of the old Act by the use of a mark (on sporting footwear) identical in every respect to the trade mark save that the mark consisted of four stripes. The court found that infringement had been established, notwithstanding the fact that four stripes are clearly different from three stripes.¹⁵ The respondent does not contend that this case was wrongly decided, only that the relevant circumstances have changed. It argues that the fundamental difference is that the court did not have to decide whether the use of the four stripes on the defendant's

soccer boots was trademark use or mere embellishment (this has already been decided against the respondent) and that the likelihood

of deception or confusion must be considered in the light of present-day circumstances pertaining to the consumer: the pervasive

use of stripes in the market and the huge reputation enjoyed by the first appellant's three stripe trademarks. As I understand the argument, because of the appellants' advertising, marketing and promotion of its products under the three stripe trademarks, these three stripe trademarks have become so distinctive, or have acquired such a reputation, that present day consumers will immediately see that the respondent's two and four stripe marks are not the first appellant's three stripe marks (it will be remembered

that these are simply factors to be taken into account). I now turn to the real issue of infringement.

- [19] The respondent's use of its two and four stripe marks on the trainers and soccer boot was unauthorised, was in the course of trade and was in respect of goods in respect of which the first appellant's trademarks are registered. The two and four stripe marks are obviously not

identical to the registered trademarks and the issue to be decided, as far as trademark infringement is concerned, is whether the two and four stripe marks so nearly resemble any of the first appellant's trademarks as to be likely to deceive or cause confusion. This requires a comparison to be made between the four registered trademarks and the two and four stripe marks.

[20] The parties agree that the essential principles relating to the comparison to be made are set out in *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd*:¹⁶

'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 trademark 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 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, 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 notional 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 to the sense, sound and appearance of the marks. The marks must be viewed as they would be encountered in the marketplace and against the background of relevant 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.'

The court proceeded to say that where the contending marks have been used by both parties, 'the issue of deceptive or confusing resemblance can be decided on the basis of actual user by both parties'¹⁷ and emphasized that –

‘... the comparison must not be confined to a viewing of the marks side by side. I must notionally transport myself to the market place ... 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 purchasers would have of the goods in question and the marks applied to them.’¹⁸

[21] It must be emphasized that the likelihood of confusion must be appreciated globally and 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’.¹⁹

[22] It must be borne in mind that the question of the likelihood of confusion or deception is a matter of first impression and that ‘one should not peer too closely at the registered mark and the alleged infringement to find similarities or differences’.²⁰ The court must not consider the question of deception or confusion as if the purchaser of the goods will have had the opportunity of carefully considering the marks and even comparing them side by side. They must look at the marks as they will be seen in the marketplace and take into account a notional purchaser: ‘a person of average intelligence, and proper eyesight, buying with

ordinary caution’.²¹

[23] The question of deception or confusion for the purposes of infringement proceedings in terms of s 34(1)(a) requires a comparison of the allegedly offending mark with the registered mark: in this case, the two and four stripe marks with the first appellant’s three stripe trademarks.²² Unlike passing off, the get-up or trade dress of the goods is irrelevant.

[24] In my view, the fact that the first appellant’s three stripe trademarks are famous, does not justify a finding that there is no likelihood of deception or confusion because purchasers of the goods will see immediately that the respondent’s marks are not the first appellant’s trademarks. In my view the contrary is true. The more distinctive the trademark is, or the greater its reputation, the greater the likelihood that there will be deception or confusion where a similar mark is used on competing products. Purchasers who are used to seeing the first appellant’s trademarks will still experience imperfect perception or imperfect recollection and will be far more likely to conclude that the similar mark is the first appellant’s trademark or is associated with the first appellant’s trademark and consequently that the competing products come from the same source. That is clearly the position in other jurisdictions where the law is comparable with ours.²³

- [25] When making the comparison it is permissible to refer to the trademarks as they are applied to the appellants' sporting footwear. When this is done, it is immediately apparent, on first impression, that the four stripe marks on the respondents soccer boot (TB10) and the respondent's Boys ATH Leisure Shoe (TB11) and the two stripe marks on the respondent's 'Hang Ten' sports shoe (TB12) and the respondent's 'Girls Must Have' shoe (TB13) are not similar to the first appellant's trademarks and consequently that there is no likelihood of deception or confusion. That leaves the four mark stripe on the LDS Sportshoe (TB8) and on the Men's ATH Leisure Shoe (TB9).
- [26] In making the comparison in the founding affidavit the appellants' deponent used, what the respondent's deponent dismissively referred to as the 'adidas technique': the individual elements of the competing marks were enumerated and compared and, by this means, it was demonstrated that the only difference between them was the number of stripes. It was then contended that this difference is not sufficient to exclude the likelihood of deception or confusion. This is, of course, not how consumers will perceive the marks. However, it does illustrate that it is the configuration of the marks that will impress itself upon the mind. The three stripes are grouped together, run parallel from the fastening of the shoe or boot to the sole, slant towards the heel, are the same width, are equidistant from each other and are in a colour which contrasts with the colour of the material to which they are applied. The configuration of the four stripes is the same and the first appellant's trademarks and the respondent's four stripe marks make the same general impression. In my view the reasoning of the court in the Harry Walt case still applies, particularly if allowance is made for imperfect recollection and imperfect perception.²⁴ As already pointed out the likelihood of deception or confusion is increased by the distinctiveness or reputation which the registered trademarks have.
- [27] The respondent made much of the absence of evidence of deception or confusion but deception or confusion is a matter for the court to decide²⁵ and, taking into account the difficulties associated with the admissibility and the weight to be given to such evidence, no significance can be attached to the absence of this evidence.²⁶ The respondent also contended that there is no likelihood of deception or confusion because the respondent's footwear was sold in a market completely different from that in which the appellants' footwear was sold and the respondent's shoes and soccer boot were sold for prices ranging from R59,99 to R115,95 whereas the appellants were sold for prices ranging from R695

for the Adi-Racer shoe to R3128 for the most expensive Predator Absolute soccer boot. However, the evidence does not show that the markets are divided into watertight compartments, or that purchasers of Ackermans' and Pep Stores' goods do not shop in stores where the appellants' shoes and soccer boot were sold. The likelihood of at least momentary deception or confusion where the purchaser must select the goods from those on display was therefore shown. Accordingly, the first appellant established that the respondent's use of four stripes on its LDS Sport shoe (TB8) and on its Mens ATH Leisure shoe (TB9) was an infringement of the first appellant's trademark rights in terms of s 34(1)(a) of the Act and the first appellant is entitled to an interdict and the

ancillary relief sought in the notice of motion. I now turn to consider the question of passing off.

- [28] The principles governing passing off are well-established. Passing off occurs, in relation to goods or merchandise, when one trader represents to the public that his goods or merchandise are the goods or merchandise of another trader. Where the representation is implied it will usually be made by the one trader adopting a name, mark or get-up for his goods or merchandise which so resembles that of the other trader that there is a reasonable likelihood that ordinary members of the public, or a substantial section thereof, may be confused or deceived into believing that the goods or merchandise of the former are the goods or merchandise of the latter or are connected therewith. Whether there is such a reasonable likelihood of confusion or deception is a question of fact to be determined in the light of the particular circumstances of the case. In order to succeed in passing off proceedings based upon an implied representation the aggrieved trader must establish, first, that the name, mark or get-up used by that trader has become distinctive of the trader's goods or merchandise in that the public associates the name, mark or get-up with the goods or merchandise marketed by that trader and, secondly, that the name, mark or get-up used by the other trader is so used as to cause the public to be confused or deceived in the manner described.²⁷
- [29] The degree of distinctiveness (or the extent of the reputation) is of great importance in passing off proceedings as it affects the issue of whether the general public will be confused or deceived into thinking, because of the similarity of the name, mark or get-up, that the goods or merchandise of the second trader are those of the first trader or are connected therewith.²⁸ It follows therefore that (just as in the case of trademark infringement) the more distinctive the get-up is (or the greater the extent of its reputation) the greater the likelihood will be that the public will be confused or deceived. An aggrieved trader can establish such distinctiveness (or reputation) in respect of the goods or merchandise by adducing evidence as to the manner and the scale of the use of the name, mark or get-up which justifies the inference that the name, mark or get-up has become recognised by a substantial section of the relevant public as distinctive of the aggrieved trader's 'goods or merchandise'.²⁹ In this case the distinctiveness (or reputation) of the appellants' trademarks is not in dispute and the distinctiveness (or reputation) of the rest of the get-ups can be safely inferred from the scale and manner of the use of the trademarks and other features of the get-ups on the shoes and football boots concerned, which has not been disputed by the respondent.
- [30] When considering whether the public will be confused or deceived by an implied representation the court must postulate neither the very careful nor the very careless buyer, but an average purchaser, who has a good idea in his mind's eye of what he means to get but not an exact and accurate representation of it. The court must also take into account that the purchaser will not necessarily have the advantage of seeing the products side by side and will not be alerted to fine points of distinction or definition. The court must further take into account that the purchaser may not be able to read simple words as there are many people

in South Africa that are illiterate.³⁰

[31] Finally, it must be borne in mind that the law of passing off does not confer monopolies on successful get-ups. A trader may, to an extent, copy the successful get-up of a rival. However, the moment he copies he will be at risk. The trader will only avoid liability for passing off if 'he makes it perfectly clear to the public that the articles which he

is selling are not the other manufacturer's, but his own, so that there is no probability of the ordinary purchaser being deceived'.³¹

[32] Passing off (unlike trademark infringement in terms of s 34(1)(a) of the Act) requires that a comparison be made between the get-ups of the competing goods and not just the trade marks applied to those goods. What had to be proved was that, by adopting the particular get-ups, which included the two and four stripe marks, the respondent was representing its goods to be those of the appellants or to be connected therewith. This is a matter of first impression.³² In opposing the grant of relief on the grounds of passing off, the respondent again referred to what it considered to be the appellants' improper use of the 'adidas technique' and the fact that the appellants' trademarks are famous.

[33] The appellants contended that, by selling the footwear depicted in the schedule at the end of this judgment, the respondent was passing off its Mens ATH Leisure shoe (TB9 and AA17) as the appellants' Tuscany shoe (TB54) and Adi/Racer shoe (TB56); that the respondent was passing off its Soccer boot (TB10, AA18 and AA19) and its Boys ATH Leisure Shoe (TB11, AA20 and AA21) as the appellants' Predator Absolute (TB57) and Absolion soccer boots (TB58); and that the respondent was passing off its 'Hang Ten' shoe (TB12, AA22 and AA23) and its 'Girls Must Have' shoe (TB13, AA24 and AA25) as the appellants' Superstar shoe (TB62).

[34] It will be convenient to deal first with the alleged passing off of the 'Hang Ten' and 'Girls Must Have' shoes as the Superstar shoe. The most prominent feature of the Superstar shoe is obviously the three stripe trade mark. In my view the two stripe marks on the respondent's shoes, which are widely spaced, are clearly different from the stripes on the Superstar shoes and are not confusingly similar to the appellants' trade mark. In addition the Superstar shoe prominently features the adidas name and trefoil device on the back of the heel, the tongue of the shoe and the insole, while the respondent's shoes prominently feature the 'Hang Ten' and 'actif' trademarks on the back of the heel, the tongue of the shoe and on the insole. The marks on the respondent's shoes therefore

clearly identify the products in such a way that the notional purchaser of the shoes would not be misled. The appellants have therefore not made out a case of passing off in respect of the Superstar shoe.

[35] The remaining shoes fall into two categories: the shoes to which the marks (in the specific configuration) have been applied and the soccer boots and shoes to which bent stripes have been applied. The first category presents no difficulty. The appellants' famous trademark,

consisting of three bold black stripes with serrated edges against a white background, is the most prominent feature of the Adi-Racer shoe (TB56). This is highlighted by the black and white colouring of the shoe and the distinctive black heel. The respondent's Mens' ATH Leisure shoe (TB9) has four bold black stripes with serrated edges against a white background, the shoe is also black and white and it has the same distinctive black heel. It is also striking that the pattern of the stitching on both shoes is identical. The respondent's shoe has no distinctive marks on the outside of the shoe. In my view the notional purchaser would be confused, at least momentarily, as to whether the respondent's shoe is the appellants' shoe or is connected therewith.

- [36] The Predator soccer boots do not feature the famous stripes in the configuration of the first appellant's trademarks. On the instep the three stripes run from the sole up and over the top of the boot to meet the fastening or end at the line of the fastening, which is off-centre. These three stripes are more or less parallel and more or less the same width but taper slightly before they terminate. On the outside of the boots the three stripes run from the sole to the fastening. The stripes taper as they run away from the sole. They are more or less parallel. The Predator Absolute boot (TB57) features black stripes on a white background with decorative areas in gold on the heel, around the ankle and along the sole. It also features gold stripes along the top of the boot next to the fastening. The adidas trade mark and device appear on the tongue of the boots and another device on the heel. The stripes and the colouring are prominent features of the boots. The Predator Absolion boot (TB58) has all the features of the Absolute boot save that the stripes are blue against a white background and the heel and additional decorative stripes are blue. The respondent's competing products have similar features, but the colours of the respondent's football boot (TB10) are not the same as the colours of the Absolion boot. The stripes are white against a blue background and the additional markings are white. The colours of the Boys ATH Leisure Shoe (TB11) are white and gold. Neither product bears any other identifying mark

which is clearly visible. The only other trade mark used on the boot and the shoe is 'Xtreme Sports', which is on the insole. In my view, taking into account the distinctiveness of the appellants' footwear and soccer boots, the market and the purchasers of the competing goods, these get-ups are misleading and would be likely to cause the notional purchaser to think that the respondent's products are or are connected with the appellants' goods. The appellants have therefore established a passing off in respect of the respondent's football boot and Boys Leisure shoe and they are entitled to an interdict and the ancillary relief claimed.

- [37] It remains to record that the respondent contended without any factual basis that the appellants had acquiesced in the use by other manufacturers of two and four stripes on their sporting footwear. Although this was raised in the respondent's heads of argument it was not referred to in argument at the hearing and it requires no further consideration.

[38] There was no dispute as to the relief to be granted in the event of this Court finding infringement and passing off.³³ Both parties employed two counsel and, in my view, that was justified.

[39] The following order is made:

‘(a) The respondent is interdicted and restrained from infringing the first applicant’s rights acquired by the registration of trade-marks numbers 1957/01959, 1995/12283, 1980/6446 and 2000/18582 (‘the registered trademarks’) by using in the course of trade in relation to goods for which the registered trademarks are registered, a mark consisting of four parallel stripes of a colour or material different from the colour or material of the footwear, and on the outside of the uppers of the footwear, to which they are applied, as represented in annexures TB8 and TB9 to the founding affidavit of Timothy George James Behean (‘the infringing marks’) or any other mark so nearly resembling the registered trademarks as to be likely to deceive or cause confusion as contemplated in s 34(1)(a) of the Trade Marks Act 194 of 1993 (‘the Act’);

(c) An enquiry is directed to be held for the purposes of determining the amount of any damages (as contemplated in s 34(3)(c) of the Act) or reasonable royalty (as contemplated in s 34(3)(d) of the Act) to be awarded to the first applicant as a result of the infringement of the first applicant’s rights acquired by the registration of the registered trademarks, in accordance with such procedures as this Court may deem fit (as contemplated in s 34(4) of the Act), and that the respondent pay the amount found to be due to the first applicant;

(e) An enquiry is directed to be held for the purposes of determining the amount of any damages to be awarded to the applicants as a result of the respondent’s passing-off as aforesaid and that the respondent pay the amount found to be due to the applicants and it is directed that, in the event of the parties being unable to reach agreement as to the further pleadings to be filed, discovery, inspection, or other matters of procedure relating to the enquiry, either party may make application to the court for directions in regard thereto;

(f) The respondent is ordered to pay the costs of the application, including the costs of two counsel.’

BR Southwood

Acting Judge of Appeal

APPEARANCES

For Appellants: L BOWMAN S C (with B du Plessis)

Spoor and Fisher, Pretoria

Matsepe’s Inc, Bloemfontein

For Respondent: A SHOLTO-DOUGLAS SC (with B Vaughan)

Werksmans Inc, Cape Town

Webbers Attorneys, Bloemfontein

1The respondent sought the following disclaimer in respect of each of the registered trademarks: ‘Registration of this trademark shall give no right to the exclusive use of parallel and equidistant stripes upon the goods other than three such equidistant stripes as depicted.’

1The respondent sought the following disclaimer in respect of each of the registered trademarks: ‘Registration of this trademark shall give no right to the exclusive use of parallel and equidistant stripes upon the goods other than three such equidistant stripes as depicted.’

2After the respondent disputed that the goods in respect of which the respondent was using its two and four stripe marks were goods in respect of which all the trade marks were registered, the appellants amended their papers to rely on s 34(1)(b) of the Act as well. At the hearing of the appeal, it was common cause that only s 34(1)(a) need be considered.

3Act 62 of 1963.

4PPI Makelaars and another v Professional Provident Society of South Africa 1998 (1) SA 595 (SCA) at 602G-603D.

5In its answering affidavit the respondent disputed that its trainers were sporting footwear and consequently that its use of the stripes on these trainers could infringe two of the first appellant’s trademarks. The respondent did not persist with this at the hearing.

6The shoes and soccer boots depicted in the photographs in the schedule were shown to the court at the hearing of the appeal and it was observed that the colours were not always faithfully reproduced in the photographs.

7See the definitions of ‘mark’ and ‘trade mark’ in the Act.

8 2011

(2) SA 463 (SCA) at 470G-471A.

9Act 37 of 1997.

10 2007

(6) SA 263 (SCA) para 5.

11See also Puma AG Rudolf Dassler Sport v Global Warming (Pty) Ltd 2010 (6) SA 600 (SCA) para 6.

12 1997

(3) SA 13 (A) at 27H-27A.

13The learned authors of Webster and Page: South African Law of Trade Marks 4 ed (Webster and Page) contend in para 12.22 that the word ‘similar’ in s 34(1)(b) is synonymous with the words ‘so nearly resembling’ in s 34(1)(a) and that the degree of similarity required between the marks must be such that it is likely to give rise to deception or confusion. In para 12.26 they contend that in s 34(1)(c) the ordinary dictionary meaning should be given to the term ‘similar’; namely ‘Having a marked resemblance or likeness’ and that the

offending mark should immediately bring to mind the well-known trade mark. That is the conclusion reached in *Bata Ltd v Face Fashions CC* 2001 (1) SA 844 (SCA) at 852B-E. On either interpretation it is clear that the protection is not limited to marks consisting of three stripes having a specific configuration.

14Cointreau et Cie SA v Pagan International [1991] ZASCA 89; 1991 (4) SA 706 (a) at 709I-712B; Weltevrede Nursery v Keith Kirstens (Pty) Ltd & another 2004 (4) SA 110 (SCA): [2004] 1 All SA 181 (SCA) para 8.

15The judgment has been followed ever since. See eg *Adidas Sportschuhfabriken Adi Dassler Stiftung & Co v Continental Wholesalers* (Unreported judgment: Roux J: 16 August 1988: Transvaal Provincial Division: Case No 12034/87); *Adidas Aktiengesellschaft and another v Woolworths (Pty) Ltd* 1999 BIP 433 (C); *International Power Marketing (Pty) Ltd v Searles Industrials (Pty) Ltd* 1983 (4) SA 163 (T) at 165G-170B.

16Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd [1984] ZASCA 51; 1984 (3) SA 623 (A) at 640G-641E.

17Plascon-Evans supra at 642B-C.

18Plascon-Evans supra at 642D-F.

19Bata Ltd v Face Fashions CC & another 2001 (1) SA 844 (SCA) para 9; *Sabel B V v Puma A G, Rudolf Dassler Sport* [1998] RPC 199 at 224.

19Bata Ltd v Face Fashions CC & another 2001 (1) SA 844 (SCA) para 9; *Sabel B V v Puma A G, Rudolf Dassler Sport* [1998] RPC 199 at 224.

20Puma A G, Rudolf Dassler Sport v Global Warming (Pty) Ltd 2010 (2) SA 600 (SCA) para 9; *Laboratoire Lachartre SA v Armour-Dial Inc.* 1976 (2) SA 744 (T) at 746B-F.

21Laboratoire Lachartre SA v Armour-Dial Inc. 1976 (2) SA 744 (T) at 746B-F.

22Adidas Sportschuhfabriken Adi Dassler K G v Harry Walt & Co (Pty) Ltd 1976 (1) SA 530 (T) at 532A; *John Craig (Pty) Ltd v Dupa Clothing Industries (Pty) Ltd* 1977 (3) SA 144 (T) at 149C-H; *Plascon-Evans Paints (Pty) Ltd v Van Riebeeck Paints Ltd* 1984

(3) SA 620 (A) at 640I-641A.

23See eg *Specsavers International Healthcare Ltd & others v Asda Stores Ltd* [2012] EWCA Civ 24 where the court summarised the position as follows: ‘The Court of Justice has said in many cases ... that the reputation of an earlier mark is to be taken into account when determining the likelihood of deception or confusion. In particular, the more distinctive the earlier mark the greater the risk of confusion, and marks with a highly distinctive character, either per se or because of the reputation they possess in the market, enjoy broader protection than marks with a less distinctive character.’; *Sabel BV v Puma AG, Rudolf Dassler Sport* [1998] RPC 199 (European Court of Justice) 224 lines 6-24; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*

[1998] EUECJ C-39/97; [1998] ECR I-5507 para 18; *Marca Mode CV v adidas AG and adidas Benelux BV* (European Court of Justice (Sixth Chamber)), delivered 22 June 2000 para 41; *adidas-Salomon AG v Sketchers USA Deutschland GmbH* (Hamburg District Court) delivered 11 July 2003; *Webster and Page* para 12.8.2.

24*Adidas Sportschuhfabriken KG v Harry Walt & Co Ltd* 1976 (1) SA 530 (T) at 536A-537H.

25*Reckitt & Colman SA (Pty) Ltd v SC Johnson & Son SA (Pty) Ltd* 1993 (2) SA 307 (A) at 315D.

26*Webster and Page* paras 8.36, 8.37 and 8.39.

27*Brian Boswell Circus (Pty) Ltd & another v Boswell-Wilkie Circus (Pty) Ltd* 1985 (4) SA 466 (A) at 478F-479B; *Williams t/a Jenifer Williams & Associates & another v Life Line Southern Transvaal* [1996] ZASCA 46; 1996 (3) SA 408 (A) at 418D-F; *Pasquali Cigarette Co. Ltd v Diaconicolas & Capsopolus* 1905 TS 472 at 474; *Capital Estate and General Agencies (Pty) Ltd & others v Holliday Inns Inc. & others* 1977 (2) SA 916 (A) at 929C; *Blue Lion Manufacturing (Pty) Ltd v National Brands Ltd* 2001

(3) SA 884 (SCA) para 2.

28*Brian Boswell Circus* at 479B-I.

29*Hollywood Curl (Pty) Ltd v Twins Products (Pty) Ltd* (1) 1989 (1) SA 236 (A) at 251D-E; *Cambridge Plan A G & another v Moore & others* 1987 (4) SA 821 (D) at 837B-E.

30*Blue Lion Manufacturing (Pty) Ltd v National Brands Ltd* 2001 (3) SA 884 (SCA) para 3.

31Para 4.

32Para 1.

33The appellants’ counsel formulated its relief in a draft notice.

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