

SOUTH AFRICA / JUDGMENT

Burton's Foods Ltd v Boxer Superstores (Pty) Ltd and Another (2023/124862) [2025] ZAGPPHC 650 (19 June 2025)

[2025] ZAGPPHC 650**COURT**

North Gauteng High Court, Pretoria

BEFORE

Swanepoel

CASE / FILE NUMBER

2023/124862

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Source record**SAFLII****Note: Page****3 image is not available in html and rtf versions, please refer to the PDF attachment for images.****FLYNOTES:**

INTELLECTUAL – Trade mark – Confectionery – Biscuits and cookies – Applicant's WAGON WHEELS trade mark – Opposing respondent's registration of trade marks – Respondent's trade mark carries specific design in specific colours – Visually, the two marks are quite distinct from one another – The mark WHEELS, even if used in respect of identical goods, is not likely to deceive or cause confusion – Applicant's opposition to respondent's applications is dismissed – Trade Marks Act 194 of 1993, s 10(14)

IN THE HIGH COURT OF
SOUTH AFRICA
GAUTENG
DIVISION, PRETORIA

Case number: 2023-124862
Date of hearing: 29 April 2025
Date delivered: 19 June 2025
(1) REPORTABLE: YES/NO
(2) OF INTEREST TO OTHERS
JUDGES: YES/NO
(3) REVISED
DATE: 19/6/25
SIGNATURE
In the application

between: BURTON'S FOODS LTD
Applicant
and
BOXER SUPERSTORES (PTY) LTD
First Respondent
THE REGISTRAR OF TRADE MARKS
Second Respondent
This judgment is handed down electronically by the Judge whose name is reflected herein, and is submitted to the parties or their legal representative by email. This order is further uploaded to the electronic file of CaseLines by the Judge or his Registrar.
The date of this order is deemed to be 19 June 2025.

JUDGMENT

SWANEPOEL J:

- [1] On 4 May 2020 the first respondent (applicant in the trade mark application) filed two trade mark applications in terms of s 16 of the Trade Marks Act, 194 of 1993 ("the Act"), under nos. 2020/08437 Wheels Device and 2020/08305 Wheels Device respectively. Application no. 2020/08305 was published for opposition on 28 July 2021, and no. 2020/08437 on 23 February 2022. Both trade mark applications have been made in Class 30, in respect of, inter alia, confectionery and baked goods, including biscuits and cookies.
- [2] The applicant (the opponent in the trade mark application) is the proprietor of trade mark registration number 1986/04372, also in Class 30, in respect of biscuits (other than biscuits for animals), non-medicated confectionery, biscuits containing non-medicated confectionery and marshmallow.

- [3] The applicant seeks an order refusing the first respondent's trade mark applications, and directing that the trade mark applications be removed from the register. The applicant's opposition is premised on the contention that the first respondent's trade mark is highly similar to that of the applicant, and that it covers goods that are identical, or at least highly similar. For that reason, the applicant says, the use of the first respondent's trade mark would lead to confusion or deception. The second respondent abides the decision of court.
- [4] The applicant relies for its opposition on the provisions of s 10
- (14) of the Act which reads as follows:

"10 Unregistrable trade marks

The following marks shall not be registered as trade marks, or if registered, shall, subject to the provisions of section 3 and 70, be liable to be removed from the register:

- (1)
- (14) 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 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...."
- [5] The marks are clearly not identical[1], as is clear from the marks depicted below:
- [6] The applicant contends that the marks are so similar that the use thereof in respect of what are essentially the same goods would be likely to deceive or cause confusion. Upon closer scrutiny, the applicant's complaint is really against the use of the word "WHEELS". The applicant says:

"The Applicant's WAGON WHEELS trade mark contains the word WHEELS which retains an independent identity within the composite mark WAGON WHEELS."

and:

"The Applicant's WAGON WHEELS trade mark and the Opposed Trade Mark Applications are visually similar in that they both contain the word WHEELS."

- [7] The difficulty with this contention is that the applicant enjoys protection in respect the composite trade mark. In Cadbury(Pty) Ltd v Beacon Sweets & Chocolates (Pty) Ltd[2] the Court held as follows:

"[13] As was pointed out by the hearing officer in Philip Morris Inc's Trade Mark Application [1980] RPC 527 at 532 – 533, a disclaimer is, theoretically, never necessary since registration of a trade mark cannot give rise to any rights except those arising from the mark as a whole."

- [8] The applicant cannot, therefore, claim rights in the individual words contained in the composite trade mark. The question is not whether the word WHEELS is identical in each mark, but whether the trade mark WAGON WHEELS is so similar to the trade mark WHEELS as to cause deception or confusion.
- [9] The wording of s 10 (14) is similar to the wording of s 34 (1) in relation to infringement, and guidance can be found in infringement cases. In *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd*[3] the Court laid down the following principles:

“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 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 market place 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.”

- [10] The above approach has been applied in numerous cases, and it is unnecessary to repeat each case. I do, however, find the following passage in *Pepsico Inc v Atlantic Industries*[4] useful:

“[19] There is an inter-relationship between the similarity of the marks and similarity of the goods to which the marks apply. Lesser similarities in the marks may be counter-balanced by stronger similarities in the goods but ultimately the question remains whether in combination there is a likelihood of confusion or deception. In regard specifically to the goods to which the respective marks are applied, relevant considerations will include (i) the uses of the respective goods; (ii) the users of the respective goods; (iii) the physical nature of the goods; and (iv) the trade channels through which the goods respectively reach the market.

[20] In testing for deception and confusion, courts will usually identify the features, if any, of the respective marks which are dominant. If they share a dominant feature, there is ordinarily a greater likelihood of deception or confusion. As recently affirmed by this court, in the global assessment of the marks, the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components.”

[11] The applicant’s trade mark is registered simply, as is evident above, as “WAGON WHEELS”, with no description as to colour or design. The first respondent’s trade mark carries a specific design in specific colours, namely yellow, black and white. Visually, the two marks are quite distinct from one another. Aurally, the marks also differ. There is no reason to conclude that the word “WHEELS” is dominant in the mark ‘WAGON WHEELS’. The adjective ‘wagon’ describes the noun ‘wheels’ and is, in my view, the dominant part of the trade mark, whilst in the first respondent’s trade mark, ‘wheels’ is dominant.

[12] In *Pianotist Co Ltd v Appin*[5], in relation to word marks, the Court held:

“You must take the two words. You must judge them both by the 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 those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.”

[13] I take into consideration that the type of goods to which the marks apply are essentially identical. This increases the likelihood of confusion. They will also likely be presented for sale in the same isle and section of the same type of retail outlets. I also consider that the probable customer will not pay as much attention to the product as would, for instance, the purchaser of computer software or items of high value, and that the possibility of confusion or deception is heightened.[6]

[14] However, in my view the mark ‘WHEELS’, even if used in respect of identical goods, is not likely to deceive or cause confusion with the mark ‘WAGON WHEELS’. In the result, the application must be dismissed and the registration of the respective trade marks must proceed.

[15] I make the following order:

The applicant's opposition to the first respondent's trade mark applications nos. 2020/08305 WHEELS DEVICE, and 2020/08437

WHEELS DEVICE is dismissed with costs on scale B.

SWANEPOEL J

JUDGE OF THE HIGH COURT

GAUTENG DIVISION PRETORIA

Counsel for the applicant:

Adv. I Learmonth

Instructed by:

Adams & Adams

Counsel for the first respondent:

Adv. H Worthington

Instructed by:

Spoor & Fisher

Heard on:

30 April 2025

Judgment

on:

19 June 2025

[1] On the meaning of 'identical' see *Standard Bank of South Africa Ltd v United Bank Ltd and Another* 1991 (4) SA 780 (T) at 795 A

[2] 2000

(2) SA 771 (SCA)

[3]

[1984] ZASCA 51; 1984

(3) SA 623 (A) at 640 G to 641 D

[4] [2017] ZASCA 109 (15 September 2017) at para [19]

[5] *Pionotist Co Ltd* (1906) 23 RPC 774 777 line 26

[6] See for instance: Orange Brand Services Ltd v Account Works Software (Pty) Ltd 2013 BIP 313 (SCA)

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