

SOUTH AFRICA / JUDGMENT

Feltex Holdings (Pty) Limited v Olymp Benzer GmbH and Co. KG (5918/2015) [2016] ZAGPPHC 651; 2016 BIP 215 (GP) (28 July 2016) [2016] ZAGPPHC 651

COURT

North Gauteng High Court, Pretoria

BEFORE

S L Margadie

CASE / FILE NUMBER

5918/2015

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IN

THE HIGH COURT OF SOUTH AFRICA

(GAUTENG

HIGH COURT, PRETORIA)

28/7/2016

Case

no: 5918/2015

Not

reportable

Not

of interest to other judges

In

the matter between:

FELTEX HOLDINGS
(PTY)
LIMITED
Applicant
and
OLYMP
BEZNER GmbH & Co.
KG
Respondent

JUDGMENT**MAGARDIE AJ**

1. This matter is a referral from the Office of the Registrar of Trade Marks in terms of the provisions of section 59 of the Trade Marks Act, 194 of 1993 ("the Act") pertaining to a dispute on an application for the registration of a trade mark. The Respondent had originally made application for the registration of the trade mark "OLYMP", which the Applicant opposed.
2. The Applicant is the registered proprietor of four trade marks in class 25 and/or trades under the trade mark "OLYMPIC". The Applicant's trade mark has been registered and used in South Africa for almost 100 years. The Applicant has been holding exclusive rights for the use of the trade mark OLYMPIC in South Africa since 1918. Since then, there has been numerous well-recorded amendments and extensions to the scope of the use of the OLYMPIC trade mark.
3. The Applicant's trade mark initially focused on sports footwear and became well entrenched and recognisable in South Africa. It then expanded its range to men's and women's wear as well as children's shoes. Currently the Applicant's trade mark is used in further ranges such as clothing, bags and caps, which is sold in a wide range of retail outlets.
4. It is significant to mention that there is nothing limiting the Applicant's registered trade mark of 1918 to sports clothing; the registration extends to all clothing.
5. On 31 July 2009, the Respondent made an application for the registration of its trade mark, namely, "OLYMP". On 09 February 2011, the Respondent's application was accepted by the Registrar of Trade Marks and advertised in the Patent Journal of 28 April 2011.
6. Whilst the period for the lodging of opposition expired during July 2011, the Respondent made application for the amendment in respect of the specification of goods referred to in class 25, thereby deleting the words "shoes and boots" from the specified goods to which the trade mark would apply.
7. On 19 March 2012, the Applicant filed its opposition to the application for the registration of the Respondent's trade mark. The basis of the Applicant's opposition to the trade mark registration was founded on sections 10(12) and 10(14) of the Trade Marks Act (the Act). [1] However, the Applicant decided to proceed with its opposition only in terms of section 10(14) of the Act.
8. Section 10(14) of the Act 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:

- (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 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;"
9. Whereas section 10(14) of the Act is invoked in applications that compete with trade marks already registered, sec 10(15) of the Act applies to competing applications.
10. Section 17(1) of the Act bars the registration of trade marks if the use of both marks in relation to goods or services in relation to which they are sought to be registered, and registered, is likely to deceive or cause confusion.
11. This court is called upon to decide if the goods for which the Respondent seeks to register its trade mark are same or similar to the goods for which the Applicant has already registered its trade mark. In addition, the court is also called upon to determine if the Respondent's use of the mark OLYMP on the goods for which it intends to register same has the likelihood to deceive or cause confusion.
12. From the wording of section 10(14) above, once opposition to the registration of the trade mark is made, the Respondent bears the onus to satisfy the court that there is no likelihood of such a trade mark deceiving or causing confusion. I must emphasise that such an onus only comes into the picture once it is accepted that the Respondent's trade mark is indeed identical or similar to a trade mark already registered by a different proprietor.
13. In this case, the Respondent argued that the two trade marks are neither identical nor similar. A point was made that there was a huge difference between OLYMPIC and OLYMP in that the "IC" in OLYMPIC could not just be ignored, arguing that as it stood OLYMPIC was grammatically an adjective and therefore descriptive. Some analogies were also drawn to OLYMPIAD.
14. It is trite that the

determination

of a dispute of this nature involve an exercise of comparison of the trade marks. In this regard the oft-quoted paragraphs in *Plascon-Evans Pty Ltd v Van Riebeeck Paints (Pty) Ltd*[2] are apposite, namely:

"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 consumer must be taken into account. As it has been put, marks are remembered rather by general impression 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."

15. It has also been held that the question of the likelihood of deception or confusion is a matter of first impression and that there should not be a close scrutiny of the trade marks in order to determine the similarities and differences between them. In this regard the court should not conduct such scrutiny in a manner as if a discerning consumer would have the opportunity of putting the two items side by side to see if there are any similarities and differences. Such exercise should assume of a person of a notional buyer with proper eyesight, average intelligence and ordinary caution.[3]
16. In *Adcock Ingram Intellectual Property (Pty) Ltd CIPLA Medpro (Pty) Ltd* [4] , the court confirmed the approach adopted in *Bristol Laboratories Inc v Ciba Ltd*[5] where it was held that the question was not what the applicant for registration intends doing, but what it will be permitted to do if its application is granted. That being the case, it was incumbent upon an applicant to discharge the onus in respect of all goods on which the intended trademark would apply. Thus, it will neither be sufficient for an applicant to discharge the onus only in respect of those goods on which it intends to use its proposed trademark immediately, nor will such onus be discharged by demonstrating that an identified method of user will not give rise to confusion or deception. In the final analysis the decisive question to be answered is to what the applicant can do.
17. Amongst its submission, the Respondent seems to concede that there may be similarities; however, such should not be the end of the enquiry. Sight should not be lost of the fact that, after lodging its application for registration, the Respondent subsequently amended its application insofar as the application of its mark was concerned, thereby removing shoes and boots. Had it not considered the confusion or deception that its mark would indeed effect in the market place, it is difficult to see why such amendment would have been necessary. However, this does not take away the Respondent's further submissions that determination must be made based on how each party identifies itself in the eyes of a

notional consumer. The Respondent argues that a customer who sees OLYPMPIC in sportswear will see the difference when encountering OLYMP in business and leisure wear. In a nutshell, the heart of the Respondent's submissions is the different market to which its trade mark would apply.

18. It was also the Respondent's case that in the recent past, the Applicant's trade mark experienced some form of dilution. Further,

that it was the use of suffixes, for example in OLYMPIAN and OLYMPIG, that was important insofar as such give the distinct difference from the Applicant's mark. I am not swayed by the Respondent's submission in this regard; there is just no merit in such submission. The Respondent's submission presupposes that the Applicant's trade mark is limited to apply only to sportswear. As already mentioned elsewhere herein, there was no limitation to the Applicant's trade mark registered in 1918 to only apply to sportswear; it applied to all manner of clothing. To this end, indeed it is apposite to refer to the decision in *Orange Brand Services Ltd v Account Works Software (Pty) Ltd*, in which the following was said:

"[5] The Orange Group of companies carries on extensive business in the telecommunications industry in various countries under the trade mark ORANGE of which it is the registered proprietor in those countries. In deciding whether the use by the parties of their respective marks would be likely to cause confusion the court below - and the registrar

- compared the use of the marks on the basis that - 'the goods of the appellant and the goods of the respondent are not in competition with each other as the appellant used ORANGE in the telecommunications industry, whilst the respondent used ORANGeworks in the accounting industry'.

[6] The registrar and the court below erred in approaching the matter in that way. While there is some question as to whether the comparison is to be made with reference to actual use in infringement proceedings, in opposition proceedings the question that falls to be decided is not how the parties use or intend to use their marks, but how they would be entitled to use them if both were to be registered - that is, how they might notionally be used. In this case if both marks were to be registered, the respective parties would be entitled to use them in relation to computer software, including software for accounting, and the question is whether it would be likely to cause confusion if both marks were to be used in that way. '[6]

19. The court went further to say that in determining the aspect of the likelihood of confusion or deception, regard must be had to the essential function of a trade mark, namely the origin of the goods or the service in connection with which it is used.[7]
20. In *Orange*, the court quoted with approval the work of Ker/y's *Law on Trade Marks and Trade Names*, that the determination of the question whether a mark is likely to deceive or cause confusion is a factual one and as such other decided cases are of no assistance to any particular or subsequent enquiry.

21. The Applicant also counters the Respondent's argument, saying that OLYMPIC is commonplace, just like NIKE. I am satisfied that the Applicant has made out a case demonstrating that if the Respondent's trade mark were allowed to be registered, a discerning consumer may well be deceived and/or the trade mark is likely to cause confusion that it originates from the Applicant. Given the fact that the Applicant's trade mark is not limited to only sportswear, the argument that OLYMP will only apply to business wear does not assist the Respondent's case.
22. The Respondent has failed to demonstrate how the likelihood of deception and confusion with the Applicant's trade mark could be avoided should the registration of its trade mark be allowed to proceed. Other than the pedantic grammatical elucidation, like

reference to "IC" in OLYMPIC as the difference between the two marks as well as analogies to OLYMPIAN and OLYMPIG, I have heard nothing of substance to persuade me to decide in favour of the Respondent.

23. I am of the view that the goods, to which the Respondent's mark will apply, are indeed similar to the goods on which the Applicant already is a holder of a registered trade mark. This is in keeping with the fact that there was no limitation to the Applicant's trade mark when it was first registered as early as 1918. The argument that the Respondent's mark will only apply to business wear and that the Applicant's trade mark is identifiable with some form of a distinct feature does not provide any solace and has no merit at all. I am also satisfied that the registration of the Respondent's mark is likely to deceive and may cause confusion to a discerning consumer who may well associate it with the Applicant's trade mark.
24. There is no reason why costs should not follow the result. The parties also did not make any submissions as to why a successful

party should not be indemnified from the costs of the litigation. In the result, I make the following order:

24.1 The Respondent's trade mark application 2009/14586 in class 25 is refused;

24.2 The Registrar of Trade Marks is hereby ordered not to register the Respondent's trade mark; and

24.3 The Respondent is ordered to pay the costs of the application.

S L MARGADIE

ACTING JUDGE OF THE HIGH COURT

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[1] Act 194 of 1993 as amended.

[2]

[1984] ZASCA 51; 1984 (3) SA 623 (A), at 641.

[3] Adidas AG & Another v Pepkor Retail Limited 9187/12) [2013] ZASCA 13 (28 February 2013) at par 22. See also Cowbell AG v ICS Holdings Ltd 2001 (3) SA 941 (SCA). Woolworths (Pty) Ltd v Wellness Warehouse (Pty) Ltd 62277/13 2014 ZAGPPHC 609 (29 July 2014).

[4] 2012 (4) SA 238 (SCA).

[5] Bristol Laboratories Inc v Ciba Ltd 1960 (1) SA 864 (A)

[6] (970/12) [2013] ZASCA 158 (22 November 2013). See also Adcock Ingram Intellectual Property (Pty) Ltd v Cipla Medpro (Pty) Ltd & Registrar of Trade Marks (265/2011) [2012] ZASCA 39 (29 March 2012)

[7] See also Cowbell AG v /CS Holdings Ltd.

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