

SOUTH AFRICA / JUDGMENT

Golden Fried Chicken (Pty) Ltd v Oh My Soul (Pty) Ltd t/a Oh My Soul Cafe (D1739/2019) [2019] ZAKZDHC 30; 2019 BIP 125 (KZD) (25 March 2019) [2019] ZAKZDHC 30

COURT

Kwazulu-Natal High Court, Durban

BEFORE

D Pillay

CASE / FILE NUMBER

D1739/2019

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IN

THE HIGH COURT OF SOUTH AFRICA

KWAZULU-NATAL

DIVISION,

DURBAN

CASE NO: D1739/2019

In

the matter between:

GOLDEN
FRIED CHICKEN (PTY)
LTD APPLICANT
and
OH MY SOUL (PTY) LTD
t/a
OH MY SOUL
CAFE RESPONDENT
ORDER
The application is
dismissed with costs.

JUDGMENT

D. Pillay J

[1] The applicant, Golden Fried Chicken (Pty) Ltd sought an urgent interdict against the respondent, Oh My Soul (Pty) Ltd t/a Oh My Soul Café, to restrain the latter from infringing its registered trade mark in terms of section 34(1)(a) and (c) of the Trade Marks Act 194 of 1993 ('the Act'). The application was brought urgently. Kruger J certified it as urgent and directed the parties to argue the merits of the matter on the adjourned date. After I became aware of the directive, it was not open to me to revisit the question of urgency.

Consequently, I approach the matter on its merits. Facts material to the dispute were uncontested. Neither were the general principles of law. What was in issue was the application of the law to the facts. More specifically, was the respondent's use of its marks likely to deceive or cause confusion?

[2] It was common cause that:

(a) the applicant owns the trade marks 'Bless My Soul', 'Soul', 'Soul Kitchen', 'Soul Food', 'Soul Slaw', 'Licken', 'Soul Food', 'Original Chicken' and 'Soul Food'

various classes of registration in the Act. The applicant wants the respondent to remove the trade marks 'Oh My Soul', 'Oh My Soul Café', 'Licken', 'Soul Food', 'Soul Food Sunday', 'Soul Salad' and 'Soul Salads from all of its websites and materials.

(b) the respondent used 'Oh my Soul (sf) without the authority of the applicant, but with a cow device mark.

(c) the respondent changed 'Licken' to 'Vicken' and 'soul salad' to 'sacred salad' after receiving the applicant's demand .

[3] Section 34(1)(a) of the Trade Marks Act 194 of 1993 provides:

'The rights acquired by registration of a trade mark shall be infringed by—

the unauthorized use in the course of trade in relation to goods or services in respect of which the trade mark is registered, of an identical mark or of a mark so nearly resembling it as to be likely to deceive or cause confusion;. . .' [1]

[4] Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd[2] set the test for establishing the likelihood of confusion or deception as follows:

'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.' (my underlining)

- [5] Deception or confusion would exist if the person is deceived into believing that there is a material connection between the goods or services bearing the respondent's mark and the applicant's trade mark or when a person is confused about whether any such connection exists.[3] The test is objective.[4] The nature of the market for the goods is an important consideration to enable the court to 'notionally transport itself into the shoes of the potential customer.'[5] Determining objectively how the marks would be perceived by the consumer is a major consideration for the court.[6] Importantly, the offending mark must be considered in context, not in isolation.[7] The manner in which the applicant uses its registered marks is not decisive but how it can use its mark fairly is relevant.[8] The applicant's notional use must be compared with the respondent's actual use of its mark.[9] Matters extraneous to the mark itself are irrelevant to determining an infringement.[10] The test is a mark for mark comparison which, consequently, would exclude the respondent's cow device.[11]
- [6] To establish an infringement under s 34(1)(c) the applicant must prove that the respondent's use of its identical or similar mark, used in the course of trade will most likely take unfair advantage of or be detrimental to the distinctive character or repute of the applicant's registered mark, which is well known in the Republic.[12] The aim of subsection (c) is to prevent the dilution of the value of the applicant's registered marks by protecting the reputation of the distinctive character of the mark.[13] The infringing mark must be similar to the registered mark. Interpreting the word 'similar' in s 34 is contextual and should not be

too wide.[14] An overly extensive interpretation might create ‘an unacceptable monopoly to a proprietor of a trade mark and thus unduly stultify freedom of trade’, a consequence that the legislature could not have intended.[15]

- [7] In this case, both the applicant and the respondent provide restaurant services selling pre-prepared meals. The applicant alleges that the respondent is misappropriating and prejudicing its goodwill by having recently started to use its marks, which could in future be confusingly and deceptively similar to the applicant’s statutorily protected marks. This would cause damage that would be extremely difficult if not virtually impossible to quantify. The applicant’s trade mark is an indication of origin, which identified a unique source of its products.[16]
- [8] The applicant described at length its Chicken Licken business, an enterprise approaching R3 billion, second only to Kentucky Fried Chicken (KFC) in the fast food restaurant sector. Its Chicken Licken business incorporates its entire operation including all its stores. In substantiation, the applicant continued:

’31 ... A brand is more than a trade mark. It is a cocktail of meaning associations which communicate meaning to consumers when they see the mark. These associations are established through association

with a particular business and/or product and significant advertisements. The meaning the SOUL brand communicates to Applicant’s consumers is of African cool, a pride in an Afrocentric heritage typified by success against adversity, a rising above racial prejudice and stereotypes where “blackness” is not a shortcoming but a positive advantage.

32 This sense of self validity was typified in the 1960’s in the United States by the civil rights movement, Martin Luther King, Malcom X and the great “soul” singing artists such as Percy Sledge, Isaac Hayes, Barry White, Otis Redding, Whitney

Houston, Dusty Springfield and Ertha Kitt. The “Afro” hairstyles of the time also featured heavily. In movies it was

celebrated by the film SHAFT and the Afro-American character “Linc Hayes” in the hit television series, the Mod Squad (who was played by Clarence Williams III).

33 The badge of this identity in the 1960’s and 1970’s was a certain conception of “cool” identified in many ways – by ever larger “Afro” hairdos, prominent jewellery, dark glasses, extreme fashions in clothing and cars. It has direct relevance to South Africa and has been a phenomenal brand image success for my company. It is an icon of the entire CHICKEN LICKEN experience, a very distinctive, unique brand image for my company and its business. It serves as a stark contrast to the brand image of Applicant’s prime competitor, Kentucky Fried Chicken.’ (sic)

- [9] Although two out of three words in the marks ‘Oh My Soul’ and ‘Bless My Soul’ are common, the context in which each is used differs markedly. The respondent’s mark characterises its business as a lifestyle restaurant supplying goods and services to vegans. Veganism is a philosophy premised on the belief that animals have souls. Hence veganism is a deep commitment to protecting animals by not eating meat or other products derived from animals.
- [10] Conceptually, the word ‘soul’ has different meanings for both litigants and is used in contexts that are diametrically opposite to each other. The applicant and its various trade marks are well known in the Republic for chicken meals and meat products. They are philosophically, ideologically and in reality the very antithesis of veganism. Vegans are discerning consumers most unlikely to confuse or associate ‘Oh My Soul’ with the applicant’s conception of ‘SOUL’ in whatever form its trade marks appear.
- [11] If the applicant wishes to trade as a vegan food service, even if it uses ‘Bless My Soul’ as its trade mark, it will have a hard row to hoe in convincing vegans that its meals are genuinely uncontaminated by meat products. Vegans would be anxious if not revulsed by the mere possibility of contamination. Their revulsion would not stop there. Ideologically opposed to killing animals, vegans would consciously avoid patronising the applicant and other meat services. Committed to veganism, the respondent is likely to distance itself as far as possible from the applicant and like products and services. The marks ‘Licken’ and ‘Vicken’ are merely a play on chicken and vegan to describe the product which, for vegans, would mean a chicken substitute.
- [12] Veganism is not known for the ostentation associated with ‘African cool’, ‘ever larger “Afro” hairdos, prominent jewellery, dark glasses, extreme fashions in clothing and cars.’ In as much as the applicant strives to distinguish itself as unconventional relative to the establishment image of the colonel in KFC, so too does the respondent seek to distinguish itself from the applicant and other meat producing services. In the circumstances, the applicant fails to prove that the respondent seeks to adopt its badge of identity.
- [13] And if, indeed, the applicant’s ‘SOUL’ brand has the remarkable capacity to communicate to its consumers ‘African cool, a pride in an Afrocentric heritage typified by success against adversity, a rising above racial prejudice and stereotypes where “blackness” is not a shortcoming but a positive advantage’ then in the spirit of ubuntu, which is the South African conception of humanity and Africanism, the applicant should, in the national interest, encourage rather than restrain the use of ‘SOUL’ to mend our social fractures and fissures. ‘Success against adversity’ also means allowing small businesses to survive onslaughts by large, economically powerful corporates like the applicant.
- [14] The application is dismissed with costs.

D. Pillay J

Judge of the High Court of KwaZulu-Natal

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Date of Hearing: Monday 11 March 2019

Date of Judgment: 25 March 2019

[1] Joubert (ed) The Law of South Africa (2 ed) vol 29 para 210-211; Bata Ltd v Face Fashions CC 2001 (1) SA 844 (SCA) 849-850.

[2] Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd

[1984] ZASCA 51; 1984

(3) SA 623 (A) at 640G-641D; [1984] 2 All SA 366 (A)

[3] 29 Lawsa 2 ed para 211

[4] 29 Lawsa 2 ed para 211; Puma AG Rudolf Dassler Sport v Global Warming (Pty) Ltd 2010 (2) SA 600 (SCA) para 11.

[5] Kraft Foods Inc v All Joy Foods (Pty) Ltd 1999 BIP 122 at 130A; 29 Lawsa 2 ed para 211;

[6] Adidas AG v Pepkor Retail Ltd (187/12)

[2013] ZASCA 3 (28 February 2013) para 14-15

[7] Verimark (Pty) Ltd v BMW AG; BMW AG v Verimark (Pty) Ltd 2007 (6) SA 263 (SCA) para 9; Société des Produits Nestlé SA v International Foodstuffs

[2015] 1 All SA 492 (SCA) para 43; 29 Lawsa 2 ed para 211

[8] Adidas Sportschuhfabriken Adi Dassler KG v Harry Walt & Co (Pty) Ltd 1976 (1) SA 530 at 534-535; Plascon-Evans, above, at 641E-I; Bata, above, 2001 (1) SA 844 (SCA) para 7

[8] Adidas Sportschuhfabriken Adi Dassler KG v Harry Walt & Co (Pty) Ltd 1976 (1) SA 530 at 534-535;

Plascon-Evans, above, at 641E-I; Bata, above, 2001 (1) SA 844 (SCA) para 7

[9] Plascon-Evans, above, at 641E-I; 29 Lawsa 2 ed para 212

[10] Adidas Sportschuhfabriken, above, at 535H

[11] Adidas Sportschuhfabriken, above, at 535E-536A; Verimark, above, para 9

[12] 29 Lawsa 2 ed para 224

[13] Verimark, above, para 13-14

[14] Bata, above, para 14; 29 Lawsa 2 ed para 225

[15] Bata, above, para 14; 29 Lawsa 2 ed para 225

[16] Founding Affidavit para 22.

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