

SOUTH AFRICA / JUDGMENT

Jonsson Holdings (Pty) Ltd v Aktiebolaget, P.J Jonnson Och Soner (52169/2021) [2024] ZAGPPHC 1091 (23 October 2024)

[2024] ZAGPPHC 1091

COURT

North Gauteng High Court, Pretoria

BEFORE

Holland-Muter

CASE / FILE NUMBER

52169/2021

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FLYNOTES:

INTELLECTUAL

– Trade mark – Goods

not similar –

Seeking

to register same trade mark JONSSON under different goods –

Denies that use of logo can cause any confusion

– Goods in

question do not resemble any similarity of kind and use thereof –

Use of trade mark regarding specialised

mining equipment not

detrimental to reputation of trade mark in protective clothing and

footwear – Goods are so dissimilar

that uses do not overlap

– Trade mark opposition application dismissed – Trade

Marks Act 194 of 1993.

REPUBLIC

OF SOUTH AFRICA

IN

THE HIGH COURT OF SOUTH AFRICA

(GAUTENG

DIVISION, PRETORIA)

(1)

REPORTABLE: NO

(2)

OF INTEREST TO OTHER JUDGES: NO
(3)

REVISED: 23
October 2024
CASE
NO: 52169/2021
In

the matter between: JONSSON
HOLDINGS (PTY) LTD
Applicant
(Opponent)
and
AKTIEBOLAGET
P. J. JONNSON OCH SONER
Respondent
(Trade
Mark
Applicant)

JUDGMENT

(This matter was heard in open court but judgment was delivered electronically by uploading it onto CaseLines to the electronic file of the matter and submitted to the representatives of the parties as on CaseLines. The date of uploading onto CaseLines is deemed to be the date of the judgment.)

BEFORE: HOLLAND-MUTER J:

- [1] The Nice Classification of Trade Marks used by most countries in the world is used in South Africa. It is an international classification administered by the World Intellectual Property Organisation. The Nice Classification divides trademarks into 45 different classes. Classes 1 – 34 are “goods” classes while classes 35 – 45 are “service” classes. Each class contains a myriad of different goods and services, but they have been divided in such manner so as to categorise those that generally can be considered to be similar in nature in the same classes.
- [2] The present matter before court is an opposed trademark opposition by Jonsson Holdings (Pty) Ltd (“the Applicant”) to the trademark application no 2018/32668 JONSSON in class 7 (the “trademark application”) in the name of Aktiebolaget P. J. Jonsson Och Soner (“the respondent”). The opposition is based on the provisions of sections 10(12), 10(14) and 10(17) of the Trade Marks Act 194 of 1993 (the “TMA”).
- [3] The opposition proceedings were initially instituted before the Registrar of Trade Marks (“the Registrar”). The Registrar transferred the matter to this court in terms of section 59(2) of the TMA. The Registrar has waived her rights to be joined in this application and indicated that she will abide with the decision of the court.

ONUS IN OPPOSING PROCEEDINGS:

- [4] The party seeking registration to satisfy the court that there is no reasonable probability or confusion or deception with regard to the trademark bears the onus. The question is whether it would be likely to cause confusion if both marks were to be used in the ordinary way. See *Orange Brand Services v Account Works Software* (970/12) [2013] ZASCA 158 dd 22 November 2013, and *Upjohn Company v Merck and Another* 1987 (3) SA 221 --- at 224 G-H. This will be dealt with below.

SUMMARY OF THE GROUNDS OF OPPOSITION:

- [5] The Applicant is part of the Jonsson Workwear Group ("Jonsson Group"). The Jonsson Group manufactures and distributes

workwear, clothing, footwear and personal protective equipment under the well-known JONSSON brand in South Africa and in approximate 30 (thirty) countries worldwide.

- [6] The Applicant has registered JONSSON on its own as a trademark in class 9 under registration no 2011/28608 in respect of "protective clothing; protective headgear; protective footwear; eye wear; including protective eye wear; protective face shields and masks and goods ancillary or related to the abovementioned all in class 09" which has an effective date of 9 November 2011; and in class 25 under registration number B1968/1589 in respect of "Articles of clothing including men/s and boy's overalls", which has an effective date of 18 April 1968.
- [7] The Applicant has also registered various logo marks incorporating the JONNSON logo (the applicant's "logo marks") as its dominant feature. The most relevant logo mark for purposes of this application in the JONNSON logo registered under registration number 2011/28609 in class 9 in respect of "protective clothing, protective headgear, protective footwear, eye wear, including protective eye wear, protective face shields and masks and goods ancillary or related to the above mentioned all in class 09" with an effective date of 24 April 2013.
- [8] The Applicant's argument of "notional use" regarding the use by the Respondent of its trademark in "the exact same font and colours" expects the court to compare the marks with one another. In *Lucky Star Ltd v Lucky Brands (Pty) Ltd and Others* 2017 (2) SA 588 SCA [6-9] and *Orange Brand supra* it was held that "natural use to which the Appellant may put its mark, that is to 'all possible fair and normal applications of the mark within the ambit of the monopoly created in terms of the registration' but demonstrates that 'this permissible fair use' is for example "use of the marks in conjunction with a generic description of the goods".
- [9] When considering 'normal and fair use' the question arises that why would an international manufacturer of heavy mining equipment wish to copy the font, colour and logo of a clothing brand which will be of no benefit for the manufacturer? The court could not find any indication but for speculation that it may amount to confusion or prejudice to the Applicant should the Respondent be allowed to continue with its application for registration.

THE APPLICANT'S LOGO MARKS (examples):

- [10] The JONNISON logo has been used continuously in South Africa since 1955 and the Applicant has built up a reputation and goodwill in the JONNISON mark. The JONNISON is also notionally used by the Applicant in the exact same font and colours in various other JONNISON logo trademarks with further words such as JONNISON WORKWEAR ZONE and JONNISON WORKWEAR DEPOT by the Applicant. It argues that the elements “Workwear”, “Zone” and ‘Depot’ are purely descriptive or non-distinctive and do not serve to differentiate them from the JONSSON word. The goods protected by these logos are protective and other similar clothing and footwear.
- [11] It is clear from the arguments (heads) by the Applicant that these “non-distinctive” words are each registered individually with different registration numbers 2013/19769 (without any descriptive word); 2013/09718 (“Tritech”); 2018/11500 (Zone Logo) and 2018/11501 (Workwear Depot). If these were “non-descriptive” the question is why register each individually?
- [12] It seems that the Applicant contends that these “non-descriptive” words have more meaning than a pure “non-descriptive”

character. A reasonable inference is that the general mark JONNISON is used for different goods and/or services raising the question whether the word JONNISON is in fact so distinctive as proclaimed? The issue of possible confusion by end users will be dealt with below.

- [13] The Respondent is seeking to register a JONNISON mark in class 7 in respect of the following goods: * “Screening machines, crushing machines, conveying machines, screening panels, screening media, side liners for screening, crushing and conveying machines, conveyor belts for conveying machines, protective elements for

screening, crushing and conveying machines”.

The Applicant refers to this as the “opposing mark”.

- [14] The Respondent has admitted that the opposing mark is identical to the Applicant's JONNISON mark but denies that the use of the logo can cause any confusion in the trade. The JONNISON mark is the dominant feature of the Applicant's logo marks.

SIMILAR GOODS:

- [15] The Applicant's main objection is that the trademark to be registered in class 7 by the Respondent are “similar” to the goods covered by the Applicant's trade mark registrations in classes 9 (“protective equipment”) and 25 (“workwear”). This is with respect farfetched because the Applicant's goods in class 9 and 25 is protective clothing,

overalls and footwear while the Respondent's goods is heavy mining machinery and used for heavy mining works.

- [16] The Applicant contends that should the opposed mark be registered, it would be the exact same mark of the Applicant (JONNISON), which the Respondent be entitled to use. The font and style is identical or similar to the font and style used by the Applicant, it will be in the same colour white against the red background as in the Applicant's logo. The Applicant contends that the opposed mark is virtually identical, or very confusingly similar to the Applicant's logo marks.
- [17] The Applicant contends that the goods covered by the trademark application are used in aggregates production, recycling and mining operations which are in the same industries in which the goods and services covered by the Applicant's logo. The closest this be stretched is that both are often, not always used only in the mining industry.
- [18] The Applicant contends that the parties' respective goods are complementary in the sense that the Applicant's workwear (in class 25) and protective equipment (in class 9) are suitable to be used in the operation of the Respondent's crushing, screening and conveyancing machines. The Respondent contends that this argument is artificial and has no merit. The court shares the view of the Respondent in this regard.
- [19] The Applicant contends that the uses of the parties' respective goods are identical and include users in the mining and construction industry. The Respondent's argument is that even if this is correct, the goods are so far apart that the goods are not in competition with another. This has been addressed supra in [18] and [19].
- [20] The Applicant contends that it has become increasingly common practice for manufacturers of machinery to also produce clothing
- under the same brand and vice versa, eg well-known brands like Caterpillar, John Deere and Jeep. There is however no evidence that
- the Applicant is following same to produce similar heavy machinery as by the respondent.
- [21] The Applicant contends that the use of the opposed trademark will lead to the dispersion of identity and that the public will no longer perceive the distinctive character of the JONNISON mark and such use will be detrimental to the JONNISON trademark and weaken or even eradicate the Applicant's well-known trademark. This is mere speculation and no convincing evidence was tendered.
- [22] The question of similar goods was addressed by the SCA in *Metterheimer and Another v Zonquasdrif Vineyards CC and 2 Others* 201492) SA SCA where the complaint was about "wine grapes" and "wine". The SCA held that although the one is used for the production of the other, wine grapes and wine are far from similar. If applied to the complaint in the present matter the court is of the view that protective clothing and heavy mining machinery are even less similar.

- [23] The goods in question do not resemble any similarity of kind. In the *Etraction (Pty) Ltd v Tyrecor (Pty) Ltd* [2015] ZASCA 78 the SCA permitted side-by-side registration of the identical trade mark INFINITY for tyres on the one hand and wheels and rims on the other hand. Tyres and wheels and rims are far more similar than clothing (Applicant) and machinery (Respondent).
- [24] The further argument that the large mining equipment on the one hand and protective clothing on the other hand fall short and does not advance the case of the Appellant. A so-called “complementary relationship” between the protective clothing and the large mining equipment does not advance the Applicant’s case at all. *Boston Scientific Ltd v Office in the Internal Market (Trade Marks and Designs)*(OHIM)
- [25] The issue of identical or similar trademarks were discussed in *National Brand Ltd v Cape Cookies CC* 2024 92) SA 296 SCA. The matter is referred to as the “Cape Cookies” matter. In this matter the dispute was between the Appellant as the proprietor of various trademarks including trademark registration no 1951/2139 for ‘SALTICRAX’ in class 30 in respect of ‘salt flavoured biscuits’. The Respondent applied for registration in class 30 for trademark 2013/06837 for ‘SNACKCRAX’. It was common cause that this application covered ‘savoury biscuits’.
- [26] The SCA in *SA Cookies* considered the opposition based on section 10(17) of the TMA and referred to the listed requirements for proceedings under section 34(1)(c) of the TMA in *Laugh It Out* case (below) to be:
- (a) the unauthorised use by the respondent of a mark;
 - (b) in the course of trade;
 - (c) in relation to the goods;
 - (d) the mark must be identical or similar to a registered trademark;
 - (e) the trademark must be well known to the public; and
 - (f) the use of the defendant’s trademark would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trademark.
- [27] It is clear from the facts that requirements (a), (d) and (e) are common cause. The object of section 34(1)(c) according to *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International* CCT42/04 [2025] ZACC the “owner of a distinctive mark has a legitimate interest in continuing to maintain the position of exclusivity he acquired through large expenditures of time and money and that everything which could impair the originality and distinctive character of his distinctive mark as well as the advertising effectiveness derived from its uniqueness is to be avoided”... and “the section strives to protect the unique identity and reputation of a registered trademark”.

- [28] If the goods in question be compared it is clear that there is no similarity of kind in the goods its self and the use thereof. The course of trade may overlap in mining business but the protective clothing and footwear may be used in many other trades and industries such as construction and building and other manufactories of goods. The goods in SA Cookies were almost similar both being savoury biscuits even in appearance alike.
- [29] With regard to the requirement of unfair advantage, as in section 10(17) of the TMA, or detrimental consequences to the Applicant, no evidence of any value was produced. The Applicant's evidence lacked substance in this regard. Although the SCA held that the likelihood of detrimental consequences and unfair advantage is not required, the totality of the absence thereof taken into account the dissimilarity of the goods combined with lack of any unfair use and detriment to the Applicant has to be considered in deciding whether the registration of the trademark as requested by the Respondent should be refused.
- [30] The court did not find any evidence suggesting that the use of the trademark by the Respondent will take unfair advantage of the Applicant or be detrimental to the distinctive character and repute of the Applicant's trademark. There is nothing to suggest why the use of the trademark in respect of specialised mining equipment will be detrimental to the reputation of a trademark in protective clothing and footwear. The goods are simply to dissimilar. This objection cannot succeed.
- [31] The goods are so dissimilar that the uses do not overlap at all and it would be exceptional if any passing-off will occur. The objection based on section 10(12) cannot succeed.

ORDER:

1. The opposition to trade mark application no 2018/32668 in class 7 in the name of the Respondent is dismissed.
2. The Applicant is directed to pay the costs of the application proceedings, including the costs of two counsel where applicable on Scale C.

HOLLAND-MUTER J

JUDGE OF THE PRETORIA HIGH COURT

Matter heard on:

Judgment

delivered on: 3 June 2024 23 October 2024 Applicant's Attorneys: Applicant's Counsel: Von Seidels
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